

ADMINISTRATIVE PANEL DECISION

Bugatti International S.A. v. Jacques Pensini, Point Office / Philippe Schriqui
Case No. D2022-2805

1. The Parties

The Complainant is Bugatti International S.A., Luxembourg, represented by Lynde & Associates, France.

The Respondent is Jacques Pensini, Point Office, Monaco / Philippe Schriqui, Monaco, both parties represented by NOMIA Conseils, France.

2. The Domain Name and Registrar

The disputed domain name <bugatti-monaco.com> is registered with Wild West Domains, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 29, 2022. On August 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 2, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 5, 2022, providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 8, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent Jacques Pensini, Point Office of the Complaint and the proceedings commenced on August 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 31, 2022. On August 11, 2022, M. Pensini sent an email communication to the Center asserting that, whilst he was the technical and administrative contact for the disputed domain name, Philippe Schriqui was the owner of the disputed domain name.

The Center notified the commencement of panel appointment process on September 5, 2022, and appointed Antony Gold as the sole panelist in this matter on September 14, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

Having regard to M. Pensini's assertion that he was not the intended registrant of the disputed domain name, on September 22, 2022, the Panel issued Administrative Panel Procedural Order No. 1 (the "First Panel Order") which;

- (1) requested M. Pensini and M. Schriqui to clarify the relationship between them and to explain why his details were not provided, as at the date of registration of the disputed domain name, in order to show him as registrant;
- (2) subject to the final determination of the Panel as to whether he was the owner of the disputed domain name, gave leave to M. Schriqui to file a Response to the Complaint; and
- (3) gave leave to the Complainant to comment on any submission(s) by M. Pensini and/or M. Schriqui in response to the First Panel Order.

On September 29, 2022, M. Pensini and M. Schriqui filed statements in compliance with the first part of the First Panel Order. On October 3, 2022, M. Schriqui filed his Response to the Complaint and on October 10, 2022, the Complainant filed its Response to M. Schriqui's Response. For the reasons set out at paragraph 6A of this Administrative Panel Decision, the Panel has concluded that both M. Pensini and M. Schriqui are proper Respondents to the Complaint. However, as M. Pensini does not play an active role in most of the events discussed below, which mainly relate to M. Schriqui and a company with which he is associated, references in the remainder of this decision to "the Respondent" are, save where the context otherwise requires, to M. Schriqui.

Whilst the Respondent's Response included evidence that suggested that the Complainant and Respondent had a business relationship for many years, neither the Complainant nor the Respondent specifically directed their respective submissions to explaining the nature of that relationship as at the date of registration of the disputed domain name in April 2013. Accordingly, on October 20, 2022, the Panel issued Administrative Panel Procedural Order No. 2 (the "Second Panel Order"). This requested the Complainant and the Respondent to provide details and evidence of any agreement they maintained was in place with the Complainant as at the date of registration of the disputed domain name which either authorised the Respondent, or any entities with which he was connected, to register the disputed domain name or which, conversely, prohibited the registration of the disputed domain name by those parties. The parties were given the opportunity to comment on any submission made in response to this Second Panel Order by the other party.

The parties filed their respective Responses to this Second Panel Order by the due dates, namely on or before November 1, 2022.

4. Factual Background

The Complainant is a Luxembourg company. It was formed in 1987 and is the successor in title to the BUGATTI luxury car brand, which was established in 1909. The Complainant's vehicles are sold in many countries worldwide, including through 13 concessions in Europe.

The Complainant has many trade mark registrations for BUGATTI, including by way of example only, International Registration, no. 512415, registered on May 19, 1987, in class 12. It is also the owner of several domain name registrations which comprise or include its mark including, by way of example only, <bugatti.com> and <bugatti.fr>.

The Respondent has produced copies of two agreements dated January 23, 2006, which, it maintains, were entered into between an associated company of the Complainant¹ and S.A.M. Twelve. Both documents have been signed by the Complainant but not by S.A.M. Twelve. At all material times, the Respondent appears to have been the owner of 90% of the shares in the ultimate parent company of S.A.M. Twelve. The Complainant denies that the 2006 agreements were in force and effect. Whilst the Panel uses the term “agreement” in relation to each of these documents in order to describe their form, it makes no finding as to whether or not they were binding on the parties.

Under the first agreement, S.A.M. Twelve agreed to locate and contact potential purchasers of the Complainant’s vehicles. S.A.M. Twelve was not authorized to negotiate on behalf of the Complainant, nor to conclude contracts with the prospective purchasers, nor to represent the Complainant. It was given a limited authorization to use the Complainant’s trade marks on business cards, business stationery and interior signs, but was not permitted to use any other signs, marks or intellectual property of the Complainant.

Under the second agreement, S.A.M. Twelve agreed to carry out various services connected with the servicing, maintenance and repair of the Complainant’s vehicles. The agreement did not give S.A.M. Twelve any rights in respect of the Complainant’s trade marks and it was expressly forbidden to use them without prior authorization from the Complainant.

There were common terms in each agreement. Both were of three years’ duration and contained a provision which stated; “This Agreement shall not be renewed by tacit agreement. If the parties wish to continue their collaboration, a new agreement must be signed by both parties.” Each also contained a provision that S.A.M. Twelve was to have no rights in the Complainant’s trade marks “other than those which are strictly necessary for the performance by [S.A.M. Twelve] of this Agreement” and a further provision that it was to be subject to French law and the sole jurisdiction of the French courts.

In April 2013, S.A.M. Twelve instructed M. Pensini by letter to register the disputed domain name, and it was registered on April 29, 2013. As at the beginning of 2022, the disputed domain name resolved to a holding page featuring the Complainant’s figurative mark and a message in French which, in translation, read; “This website is registered. Thank you to come back later”. Following receipt of a claim letter sent on behalf of the Complainant to M. Pensini on May 10, 2022, the webpage to which the disputed domain name resolved was modified so that the BUGATTI device was removed and the website notice modified to state “Under Construction”. Additionally, the registrant details were altered so that they were hidden by a privacy service.

Whilst the disputed domain name does not appear to have resolved at any point to an active website, the Respondent has produced examples of use by employees of S.A.M. Twelve of email addresses associated with the disputed domain name (for example, [sender]@bugatti-monaco.com). This comprises:

- an email dated August 10, 2013, from a sales executive at Bugatti Monaco to two recipients at the Complainant, stating that a prospective customer had contacted them and requesting an order form from the Complainant;
- an email from M. Caquelin, Regional Director Europe and Russia, to the Respondent (whose email address was not derived from the disputed domain name) and a M. Duboc at S.A.M. Twelve, dated June 22, 2015. Amongst other matters, this attached what was described as a “new partner contract for the new car” and asked for information which would enable the contract to be finalized;
- a further email, dated June 25, 2015, from M. Caquelin, to the same parties as the June 22, 2015, email, attaching proposals for the sales area (the context suggests this was a showroom for the Complainant’s vehicles operated by S.A.M. Twelve);
- an email dated July 22, 2015 from M. Caquelin to the Respondent and copied to M. Duboc, providing possible dates/times for a meeting or telephone call;
- an email from M. Caquelin dated October 5, 2015, to a new sales representative at Bugatti Monaco, M. Sedlmeier, copied to the Respondent and M. Duboc, welcoming him to his new role as “our dedicated Bugatti representative for Monaco”;

¹ As nothing turns on the point, associated entities of the Complainant are referred to in this decision as “the Complainant”.

- an email dated January 18, 2016, from M. Caquelin to M. Sedlmeier, M. Duboc and the Respondent about a new marketing initiative; and
- an email from M. Caquelin to the Respondent, dated June 9, 2020, copied to M. Sedlmeier, seeking more information about a proposal for a showroom which had evidently been put forward by the Respondent.

On August 5, 2022, after M.Pensini was made aware of the claim asserted by the Complainant, he attempted to change the registrant information for the disputed domain name, asserting that he was only the technical-administrative support, that the owner was the Respondent and that he had attempted to change the details two months earlier, but had been unable to do so.

5. Parties' Contentions

A. Complainant

The Complainant says that the disputed domain name is confusingly similar to its BUGATTI trade marks, full details of one of these marks having been set out above. The "Monaco" component of the disputed domain name associates it with Monaco, which is the location of one of the well-known Formula 1 races, as well as with the "Grand Prix Automobile de Monaco" competition sportive event in which the Complainant's cars are entered. Moreover, the Complainant conducts business in Monaco, which is well known for its luxury lifestyle and luxurious cars.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not affiliated with the Complainant and has not authorized a third party to register the disputed domain name. The Respondent has previously used the Complainant's BUGATTI device on the webpage to which the disputed domain name resolved. Whilst the form of the webpage has since changed, it is not being used for any legitimate purpose.

Lastly, the Complainant says that the disputed domain name was registered and is being used in bad faith. It is virtually impossible that the Respondent was not aware of the Complainant's activities at the time it registered the disputed domain name. Registration of a well-known trade mark of which a respondent must reasonably be aware, will often constitute bad faith. Additionally, the fact that the disputed domain name resolved to a limited-access website requesting an ID and password and containing the Complainant's figurative BUGATTI trade mark is likely to mislead Internet users into believing the disputed domain name is connected with the Complainant's operations in Monaco. Moreover, the fact that the Respondent has sought to conceal its identity by use of a privacy service is, in the circumstances of this Complaint, a further indicator of bad faith.

B. Respondent

The Respondent states that it was always his intention to be the owner of the disputed domain name which he first registered, via M. Pensini, in April 2013. Due to a mistake, he was not shown as the registrant.

It is incorrect that the Complainant has only recently learned of the registration of the disputed domain name as between 2013 and 2022 the Respondent's company (S.A.M. Twelve) was affiliated to the Complainant by an authorized sales consultant agreement and an authorized service provider agreement, both signed in 2006. The disputed domain name was registered in order that S.A.M. Twelve might fulfill its obligations under the agreements. The use of the word "Monaco" in the disputed domain name was intended to indicate that its geographical influence was limited to the principality of Monaco. The Complainant never complained about the use of the disputed domain name prior to 2022. Moreover, the Complainant and S.A.M. Twelve exchanged numerous emails using the address of the disputed domain name about the commercialization and offer for sale of the Complainant's cars. The disputed domain name has therefore been used with the consent of the Complainant, as it must have been well aware of the Respondent's registration and use of it.

C. Complainant's Reply to the Respondent's Response

The Complainant draws attention to the period of approximately 9 years which has elapsed between the registration of the disputed domain name and the claimed realization by the Respondent and M. Pensini that the disputed domain name should have been registered in the name of the Respondent. The Complainant is skeptical of the claim that the alleged confusion over the intended registrant of the disputed domain name did not become apparent earlier. Moreover, the evidence provided by the Respondent is incomplete, nor does it explain why the Respondent should be the owner of the disputed domain name when the instructions to M. Pensini in April 2013 indicated that S.A.M. Twelve should be the owner. The Respondent is not a signatory to the 2006 agreements and has a separate legal identity to a S.A.M. Twelve. Furthermore, the fact that emails used by employees of S.A.M. Twelve were associated with the disputed domain name may not have been noticed by the Complainant or, if it had, the Complainant might have assumed that it was the owner of the disputed domain name.

D. Parties' responses to the Second Panel Order

The Complainant says that no agreement was in place with the Respondent, or any entities connected with him, as at the date of registration of the disputed domain name in April 2013. Additionally, the correct registrant of the disputed domain name is M. Pensini, who had no rights or legitimate interests in registering it. The agreements which the Respondent has produced were not binding and essential terms were missing from them. Furthermore, the agreements had expired by the date of the registration of the disputed domain name and they could not be renewed automatically, nor did they authorize the registration of the disputed domain name. A further 2015 agreement produced by the Respondent (see below) is irrelevant because it post-dates the date of registration of the disputed domain name and relates to S.A.M. Twelve, not to the Respondent.

The Respondent says that, as at the date of registration of the disputed domain name, he was the main owner of S.A.M. Twelve, as the Complainant was well aware. The 2006 agreements were in force at the date of registration of the disputed domain name, notwithstanding that the Respondent cannot produce copies signed by both parties. The correspondence between the parties evidences the fact that S.A.M. Twelve was operating pursuant to the terms of the agreements. Further examples of the many exchanges between the Complainant and the Respondent and/or S.A.M. Twelve over the material period include:

- a circular email to "Bugatti Partners", which included S.A.M. Twelve, dated July 23, 2013, advising them of the availability of a "Bugatti Partner Portal";
- an email from the Complainant to S.A.M. Twelve dated August 5, 2013 indicating that one of its vehicles will be collected; and
- an email from M. Caquelin to S.A.M. Twelve and the Respondent dated December 4, 2014, seeking a meeting in order to review "Sales and service situation in Monaco since 2006 to 2014".

Moreover, the parties entered into a further "Dealer Agreement" in July 2015, which was a continuation of the agreements entered into in 2006, and a fully executed copy of this agreement is produced. This agreement assumed that the trading name of S.A.M. Twelve would be "Bugatti Monaco".

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith

A. Preliminary issue – the correct identity of the Respondent

Before turning to the substantive issues, it is evident from the summary of the evidence set out above that there are three candidates as the correct registrant of the disputed domain name: namely M. Pensini, the Respondent, and S.A.M. Twelve.

Paragraph 1 of the Rules defines a respondent as “the holder of a domain-name registration against which a complaint is initiated”. The Whois information provided by a registrar would usually be considered as the definitive record of the identity of a registrant and therefore of the party that is the proper respondent to proceedings under the Policy.

As the Whois record still records M. Pensini as the registrant of the disputed domain name, it is appropriate that he is retained as a Respondent to the Complaint, irrespective of any explanation as to the fact that this was not his intention, nor that of the Respondent. See, by way of example, *koda Auto a.s. v. GlobeHosting, Inc.*; *Bogdan Hasnes, Evox Protrade SRL*, WIPO Case No. [DRO2019-0017](#).

The Panel accepts many of the criticisms made by the Complainant as to whether the Respondent has established on the basis of the statements filed in response to the First Panel Order that the intention of M. Pensini and the Respondent was that the Respondent, as opposed to S.A.M. Twelve, be the intended registrant of the disputed domain name. However, M. Pensini and the Respondent have both stated in responses filed in the course of these proceedings that the true intention was that the Respondent be the registrant and, in any event, there is a clear nexus between S.A.M. Twelve and the Respondent. The Panel notes, for example, that as at the date of registration of the disputed domain name, the Respondent was the owner of the majority of shares in the ultimate parent company of S.A.M. Twelve and therefore very likely to have been in de facto control of it. Moreover, the emails exchanged between S.A.M. Twelve and the Complainant between 2013 and 2020 indicate that the Respondent was a key participant in the business which was being undertaken relating to the promotion of the Complainant’s vehicles in Monaco under the name of “Bugatti Monaco” in connection with which the disputed domain name was being used.

Having regard to the statements of M. Pensini and M. Schriqui, the Panel concludes that M. Schriqui is a proper Respondent to the Complaint as the evidence suggests that, *prima facie*, he has an indirect beneficial interest in the disputed domain name. Lastly, it should also be noted that, irrespective of whether M. Pensini, the Respondent, S.A.M. Twelve, or any combination of them, is named as the Respondent to the Complaint, the Panel’s decision in this proceeding would be the same. Accordingly, no purpose is to be served by extending these proceedings further in order to add S.A.M. Twelve as a Respondent to the Complaint.

B. Identical or Confusingly Similar

The Complainant has provided evidence of its trade marks for BUGATTI, including the mark in respect of which details have been provided above, which establishes its rights in this name.

The disputed domain name contains the Complainant’s BUGATTI mark in full, followed by a hyphen and the word “monaco”. The hyphen is of little, or no, significance for the purpose of the comparison. These additional elements do not prevent the disputed domain name from being considered confusingly similar to the Complainant’s mark. As explained at section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), if a trade mark is recognizable within a domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element.

The Complainant’s BUGATTI mark is clearly recognizable within the disputed domain name, and the Panel therefore finds that it is confusingly similar to a trade mark in which the Complainant has rights.

C. Rights or Legitimate Interests/Registered and Used in Bad Faith; the suitability of the Policy for determination of the dispute between the parties

As is evident from the factual summary above, the Complainant and S.A.M. Twelve, a company in which the Respondent was closely involved, appear to have had business dealings during the period between, at least, 2006 and 2020. The 2006 agreements related to the engagement of S.A.M. Twelve as a sales agent and the provision by it of services for, amongst other things, the repair, maintenance and servicing of the Complainant's vehicles. They contained restrictive provisions in terms of the use of the Complainant's intellectual property. Those provisions did not expressly mention the use, or prohibition of use by the Respondent, of domain names incorporating the Complainant's mark, albeit restrictions of this type would often be construed as preventing registration by a distributor or agent, without express permission, of domain names which included the brand owner's trade mark.

The Complainant asserts that the 2006 agreements were not in force. But whilst neither party has produced copies of these agreements signed by both parties, the Complainant has not explained why it signed them at all if they were not intended to have some legal effect. Moreover, it is obvious, from the emails produced by the Respondent, that some form of business dealings were being conducted between S.A.M. Twelve and the Complainant over many years. Whilst the Complainant denies that the 2006 agreements were operative, it has not provided any explanation as to the basis that the parties were, in fact, dealing with each other. Indeed, the Complaint does not even address the existence of the Bugatti dealership in Monaco with which the Respondent and S.A.M. Twelve were connected.

The 2006 agreements were of 3 years' duration, that is they would have expired in 2009. Neither party explained in their initial submissions on what basis the parties were dealing with each other between 2009 and 2013, when the disputed domain name was registered. The Second Panel Order gave both parties the opportunity to clarify their positions in this respect because this issue is central to a consideration of whether the Complaint is capable of being determined under the Policy and the appropriate order for the Panel to make. Were it the case, to take a hypothetical example, that, as at the date of registration of the disputed domain name, the parties were clearly dealing with each other under the terms of a written agreement which unambiguously prohibited any use by the Respondent of the Complainant's intellectual property, it might have been appropriate for the Panel to conclude (subject to consideration of any arguments of the Respondent) that the registration and use of the disputed domain name was, in these circumstances, in bad faith.

However, that is not the Complainant's position. It is not contending that the 2006 agreements were in force or were extended (expressly or impliedly) so that the specific prohibition against the use of the Complainant's intellectual property was in effect as at the date of registration of the disputed domain name, nor has it asserted an alternative case as to the basis on which the parties were dealing with each other as at the date of registration of the disputed domain name. As a consequence, there are two lacunae that the Panel is unable to resolve for the purpose of substantively resolving this Complaint. The first is factual; the Panel does not know what the parties agreed as a basis for future dealing with each other following the expiration of the 2006 agreements. Alternatively, if the Complainant is correct that these agreements never governed the parties' relationship, the basis of their dealings is still more opaque. It is for the Complainant to make out its case on a balance of probabilities and the evidence available to the Panel is insufficient to enable it to make any substantive finding in this respect. Second, the agreements were each subject to French law. Whether the agreements were in operation at all and, if so, whether they would be deemed to be extended following the expiration of the three year terms and, if so, whether any other doctrines might come into play as to whether specific terms might be implied or excluded following expiration of the fixed terms, is a matter for determination by French law and, absent agreement between the parties, the jurisdiction of the French courts.

There are other issues which are similarly outside the form of summary determination which the Policy is designed to address. By way of example, the Complainant has contended that there is no reason as to why the Complainant (presumably, in this context, M. Caquelin) should have noticed or attached any significance to the fact that employees of S.A.M. Twelve were using email addresses associated with the disputed

domain name in their communications with the Complainant and that therefore no weight should be attached to his omission to raise this issue with S.A.M. Twelve/the Respondent. Further investigation might establish this to be a fair point, but proper evaluation would require evidence from M. Caquelin (which has not been provided) and an opportunity for the Respondent to challenge it. Issues of this nature take the parties' dispute outside the realm of those which the Panel is able to decide.

To take a further example, the Respondent has alleged that it was entitled to register the disputed domain name because of the provisions in the 2006 agreements that enabled it to use the Complainant's intellectual property, provided that it was strictly necessary for the performance by S.A.M. Twelve of its obligations under the agreements. The Panel is doubtful of the merits of this line of argument, but, once again, proper construction of the parties' rights and obligations under the 2006 agreements is a matter for French law and the French courts.

Section 4.14.6 of the [WIPO Overview 3.0](#) explains that; "Depending on the facts and circumstances of a particular case, and irrespective of whether the parties may also be engaged in court litigation, in some instances (e.g., complex business or contractual disputes) panels have tended to deny the case not on the UDRP merits but on the narrow grounds that the dispute between the parties exceeds the relatively limited 'cybersquatting' scope of the UDRP, and would be more appropriately addressed by a court of competent jurisdiction". See, by way of example, *Tonino Lamborghini s.p.a. Mr. Tonino Lamborghini v. Samvel R Yusufiants*, WIPO Case No. [D2017-1112](#) where the panel explained that "It is beyond the scope of the Policy to interpret agreements between the Parties or to determine whether they have breached the Complainant's trademark." See also *Capital Distribution Consulting Inc. v. Hiro Bharwani, Horizons Group (London) Ltd*, WIPO Case No. [D2021-2871](#) where the panel commented that; "The Panel recalls that the Policy is not designed to adjudicate all disputes of any kind that relate in any way to domain names. Rather, the Policy establishes a streamlined, inexpensive administrative dispute-resolution procedure intended only for the relatively narrow class of cases of 'abusive cybersquatting'. The UDRP is not an appropriate process to adjudicate a complex business dispute such as this because the Panel does not have the benefit of witness testimony, disclosure of documents, or the other appropriate instruments that are typically available to assist a court to resolve such a dispute."

The Panel takes a similar view of the issues which have developed in these proceedings, which are now far removed from those which the Policy is intended to address. Accordingly save for the finding in relation to the first element, which can be determined under the Policy and is likely uncontroversial, the Panel makes no finding in respect of the Complaint. The issues between the parties are more appropriately determined by a court of competent jurisdiction.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Antony Gold/

Antony Gold

Sole Panelist

Date: November 15, 2022