

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A v. Gerry Fredericksen
Case No. D2022-3903

1. The Parties

The Complainant is Bulgari S.p.A, Italy, represented by SafeNames Ltd., United Kingdom.

The Respondent is Gerry Fredericksen, United States of America (“U.S.”).

2. The Domain Names and Registrar

The disputed domain names <bulgari.buzz>, <bulgariofficial.top> and <bulgariofficial.xyz> (“Disputed Domain Names”) are registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 18, 2022. On October 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (Domain Administrator, See PrivacyGuardian.org) and contact information in the Complaint.

The Center sent an email communication to the Complainant on October 24, 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 October 25, 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 of the Complaint, and the proceedings commenced on October 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 16, 2022.

The Center appointed José Pio Tamassia Santos as the sole panelist in this matter on November 21, 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.

4. Factual Background

4.1. The Complainant is an Italian company founded in 1884 by Sotirios Voulgaris. The Complainant operates in the luxury goods and hotel markets, and is particularly known for its high-end jewelry including but not limited to watches, rings, necklaces and fragrance products. The Complainant is headquartered in Rome, Italy; it opened its first international locations in New York City, Paris, Geneva and Monte Carlo in the 1970s. Today, the Complainant has more than 230 retail locations worldwide.

4.2. The “Bulgari” name derives from the founder’s name (Voulgaris). The Complainant’s trademark is both written as “Bvlgari” in the classic Latin alphabet and “Bulgari” in the modern alphabet. The Complainant submits that the terms “Bulgari” and “Bvlgari” are often used synonymously, but are traditionally intended for the following purposes: “Bulgari” is used in relation to the company name (Bulgari S.p.A), whilst the term “Bvlgari” relates to the brand name.

4.3. The Complainant holds numerous trademark registrations for BVLGARI and BULGARI registered in various jurisdictions, including the following:

- U.S. trademark 1,184,684 BULGARI, registered on January 5, 1982; and
- U.S. trademark 1,694,380 BVLGARI, registered on June 16, 1992.

4.4. The Complainant’s registered the domain name of its official website, “www.bulgari.com”, on the February 17, 1998, and has had a strong web presence since that date. The Complainant’s official website enables users to access all product lines: jewelry, fragrances, leather goods, accessories, watches and the bridal collection. Internet users are also able to locate the Complainant’s stores and authorized retailers worldwide.

4.5. As a further indication of the Complainant’s success, the Complainant’s store in Rome has become a popular meeting place for movie stars and socialites, amplifying the international fame of the brand. The BVLGARI / BULGARI brand is well advertised globally, with promotional videos, billboards and other sources of marketing material, which has further promoted the brand’s global recognition for high-end jewelry and accessories. As a further indication of the Complainant’s success, the BVLGARI / BULGARI brand and its products have been used by many celebrities at high-profile events such as the Oscars and Premieres.

4.6. The Complainant’s products are renowned for having a distinctive style that celebrates the Complainant’s rich Roman history. Over the decades of the Complainant’s existence, the BVLGARI / BULGARI brand has been recognized for its vibrant color combinations and innovations in regards to jewelry.

4.7. The Complainant has also operated several hotels since 2001, which was the result of a joint venture between Bulgari S.p.A and the Luxury Group, a division of Marriot International that also manages Ritz-Carlton hotels. The Complainant’s hotels can be found in major locations across the globe such as London, Beijing, Milan, Bali, Dubai, Paris and Moscow, and resorts scheduled to open such as in Rome, Tokyo, and Ranfushi.

4.8. As part of their effort to protect their Intellectual Property, the Complainant, its affiliates, subsidiaries and associated companies own trademarks for the terms “Bvlgari” and “Bulgari” within numerous jurisdictions.

4.9. The Complainant has spent a substantial amount of time, money and effort in promoting, marketing and using the BVLGARI trademark to identify and distinguish its services domestically and internationally. Consequently, the BVLGARI / BULGARI trademarks have acquired distinctiveness in the market worldwide and have customers who rely on the brand's name and quality.

4.10. The Disputed Domain Names <bvlgari.buzz>, <bvlgariofficial.top> and <bvlgariofficial.xyz> were registered by the Respondent on March 23, 2022.

4.11. According to the evidence submitted with the Complaint, the disputed domain name <bvlgari.buzz> resolved to a website that offered for sale a "Bvlgari" non-fungible token ("NFT") related to its new limited watch, Octo Finissimo Ultra; the disputed domain name <bvlgariofficial.xyz> redirected to <bvlgari.buzz>; and <bvlgariofficial.top> resolved to an inactive website. At the moment the Complaint was filed, and currently, all the Disputed Domain Names resolve to inactive websites.

5. Parties' Contentions

A. Complainant

5.1. The Complainant states that the Disputed Domain Names are confusingly similar to the BVLGARI / BULGARI trademarks, in which it has registered and unregistered rights.

5.2. The Complainant submits that the Respondent lacks a right or legitimate interest in the Disputed Domain Names.

5.3. The Complainant states that the Respondent registered and used the Disputed Domain Names in bad faith. The Complainant further claims that the unauthorized registration of the Disputed Domain Names by the Respondent and its passive holding do not prevent a finding of bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1. Paragraph 4(a) of the Policy provides specific remedies to trade mark owners against registrants of domain names where the owner of the mark (*i.e.*, the complainant) proves each of the following elements:

- (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 was registered and is being used in bad faith.

6.2. The Complainant has the burden of proof, by a preponderance of the evidence, in respect to each element in paragraph 4(a) of the Policy.

6.3. The Respondent, having failed to respond in the present proceeding, is in default, and in accordance with paragraph 14(b) of the Rules, "the panel shall draw such inferences [...] as it considers appropriate".

A. Identical or Confusingly Similar

6.4. Regarding the first element of the UDRP, the consensus view among Panels is that, where a Complainant holds a registered trademark in any country, this *prima facie* satisfies the threshold of having trademark rights for the purpose of standing to file a UDRP case.

6.5. With regards to the above, as established in the Factual Background, the Complainant holds numerous trademark registrations for BVLGARI and BULGARI, registered in various jurisdictions.

6.6. The Disputed domain names <bvlgariofficial.top> and <bvlgariofficial.xyz> both incorporate the BVLGARI trademark, with the addition of the term “official”. It is a general consensus that where the relevant trademark is recognizable within a domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See section 1.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

6.7. Regarding the Disputed domain name <bvlgari.buzz>, the Complainant submits that it is also identical to the Complainant’s trademark BVLGARI.

6.8. The first element of the Policy, therefore, has been met.

B. Rights or Legitimate Interests

6.10. The Complainant submits that the Respondent lacks rights or legitimate interests in the Disputed Domain Names.

6.11. The Complainant states that the Respondent has not registered any trademarks for the term “bvlgari”, and there is no evidence that the Respondent holds any unregistered right to the term “bvlgari”. Moreover, the Respondent has not received any license from the Complainant to use domain names that features the BVLGARI trademark. All active trademarks for the term BVLGARI are held by the Complainant.

6.12. The fact that the Disputed Domain Names currently are not active shows that the Respondent is not using the Disputed Domain Names in connection with an offering of goods and services in good faith. The Complainant further asserts that there is no evidence of demonstrable preparations to use the Disputed Domain Names in good faith.

6.13. In addition, prior to the Complainant’s cease and desist letter, the domain name <bvlgari.buzz> hosted a website claiming to be affiliated with the Complainant’s brand. Specifically, the Respondent made a reference to the BVLGARI Octo Finissimo Ultra watch sold by the Complainant and advertised the possibility to get exclusive access to an Octo Finissimo Ultra NFT. The Disputed Domain Name <bvlgariofficial.xyz> was previously used to redirect to the Disputed Domain Name <bvlgari.buzz>. The Complainant asserts that the Respondent was never given authorization to advertise BVLGARI NFTs. The Complainant, when it launched its exclusive limited watch, gave access to its buyers to a unique NFT representing digital art (each watch has a unique QR code engraved). For those reasons, it is clear that the Respondent falsely purports to give people access to the Complainant’s NFTs. Consequently, the Respondent cannot claim that it has used the Disputed Domain Names for a *bona fide* offering of services.

6.14. The Complainant submits that the Respondent is not known, nor has it ever been known as “Bvlgari”. The BVLGARI trademark is distinctive and not used in commerce other than by the Complainant. Therefore, there is no plausible reason for the registration of the Disputed Domain Names other than to take advantage of the goodwill and valuable reputation attached to the BVLGARI brand, as the Respondent has no connection or affiliation with the Complainant and has not received any license or consent to use the Complainant’s trademark in any way. Prior Panels have held that in the absence of any license or permission from the Complainant to use its trademark, no actual or contemplated *bona fide* or legitimate use of the Disputed Domain Names could be reasonably claimed.

6.15. Clearly, the mere ownership of one or more domain names does not confer rights or legitimate interest on the Respondent, see *National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., a/k/a chargergirls.net*, WIPO Case No. [D2000-0118](#).

6.16. There is no evidence that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Names. With respect to the current passive holding of the Disputed Domain Names, the Panel finds that the composition of the Disputed Domain Names, <bvlgariofficial.top> and <bvlgariofficial.xyz> both incorporating the BVLGARI trademark, with the addition of the term “official”, and <bvlgari.buzz> being identical to the BVLGARI trademark, does not satisfy a legitimate interest as it effectively suggests sponsorship or endorsement by the Complainant.

6.17. Regarding the previous use of <bvlgari.buzz> and <bvlgariofficial.xyz> the Complainant asserts that the Respondent was not making a legitimate noncommercial or fair use. The Complainant tried to sell NFTs through the Disputed Domain Names and advertised the mint of an NFT for a price of ETH 0.12 (equivalent to about GBP 140.53 as of today’s exchange rate). Therefore, it is clear that the Respondent used the Complainant’s mark for commercial gain and this cannot constitute a legitimate noncommercial or fair use.

6.18. In conclusion, the Respondent is not making any legitimate non-commercial or fair use of the Disputed Domain Names. Accordingly, the second element of the Policy has been established.

C. Registered and Used in Bad Faith

6.19. Paragraph 4(b) of the Policy provides that “for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith”:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) that the respondent has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) that the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent’s website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on the respondent’s website or location.

6.20. The Complainant’s earliest BVLGARI trademark registration predates the creation date of the Disputed Domain Names by at least 43 years. In addition, the Complainant has accrued substantial goodwill and recognition since the Complainant’s establishment in 1884 – the “Bvlgarl” and “Bulgari” names have become synonymous with high-end and stylistically unique luxury jewelry, watches and accessories as evidenced in the Factual Grounds.

6.21. The Complainant further submits that anyone with access to the Internet can find the Complainant’s trademarks on public trademark databases. To date, results on popular search engines such as Google for the term “Bvlgari” or “Bulgari” list the Complainant’s brands and services as the first result. Moreover, it has been accepted in past decisions that the selection of a domain name that is so obviously connected to a

complainant's trademark strongly suggests "*opportunistic bad faith*", particularly where it is held by someone with no affiliation with the complainant, see *Singapore Airlines Ltd v. European Travel Network*, WIPO Case No. [D2000-0641](#). In the case of *Wikimedia Foundation Inc. v. Kevo Ouz a/k/a Online Marketing Realty*, WIPO Case No. [D2009-0798](#), the Panel also highlighted the fact that the Complainant's mark predated the Respondent's registration of the domain name, which is also true in the current case.

6.22. The choice of the Disputed Domain Names, two of them incorporating the term "official" and one being identical to the Complainant's mark shows that the Respondent was well aware of the Complainant at the time of registration.

6.23. Moreover, the Complainant submits that a cease and desist letter was sent to the Respondent on May 4, 2022. This notice was sent in order to put the Respondent on notice of the Complainant's trademark rights and with a view of resolving the matter amicably. Previous panel decisions have stated that a lack of reply to a cease and desist letter prior to commencing the proceedings infers bad faith behavior, see *Facebook, Inc. and Instagram, LLC v. C W / c w, c w*, WIPO Case No. [D2018-1159](#). The Respondent was given the opportunity to provide evidence of any actual or contemplated good faith use but chose not to respond. Therefore, the Panel finds that this is further evidence of bad faith.

6.24. Prior to the Complainant's cease and desist letter, two of the Disputed Domain Names hosted content, where the Respondent allegedly sold the Complainant's NFTs related to its new limited watch, Octo Finissimo Ultra. By registering and using those Disputed Domain Names, the Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark. Indeed, the term "official" chosen by the Respondent in two of the Disputed Domain Names mislead Internet users into believing they will find official products of the Complainant. When landing on the webpage, Internet users were then redirected to content where the Respondent falsely advertised the sale/minting of NFTs.

6.25. By previously hosting such content, the Respondent attempted to commercially gain from the Disputed Domain Names and advertised the minting of the Complainant's NFTs for about GBP 140 per NFT. The Respondent, likely falsely, stated that it held 2,222 NFTs. Therefore, it is clear that the Respondent previously used the Disputed Domain Names for its own commercial benefit and this constitutes bad faith under the Policy, see *Indivision Picasso, also called the Picasso Estate v. Domains By Proxy, LLC / JIAOLONG LIU*, WIPO Case No. [DIO2021-0028](#), where the Panel found bad faith under similar circumstances.

6.26. The Complainant also submits that given the circumstances of this case, the Respondent's current passive holding of all of the Disputed Domain Names does not prevent a finding of bad faith, see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

6.27. Finally, the Complainant submits that the Respondent has registered the three Disputed Domain Names, targeting the same brand, BVLGAR". Under the Policy, in order to establish a pattern of conduct, the Respondent must infringe a single's owner rights with multiple registrations or having a history of multiple registrations involving a diversity of trademarks (see section 3.1.2 of the [WIPO Overview 3.0](#)). As mentioned above, the Respondent registered the three Disputed Domain Names on the same day, targeting the same brand, the Complainant.

6.28. Moreover, the Complainant submits that the Respondent was also involved in a previous domain name dispute, where the panel found in favor of the complaining party, L'Oreal. The dispute involved three domain names, all using the '.xyz' extension; two of them were inactive and one domain was used to sell NFTs. Therefore, it is clear that the circumstances of this past case and this current dispute are very similar, and for these reasons, the Panel finds that the Respondent has engaged in a pattern of abusive conduct, and this is evidence of bad faith registration and use.

6.29. The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Names, <bulgari.buzz>, <bulgariofficial.top>, and <bulgariofficial.xyz> be transferred to the Complainant.

/José Pio Tamassia Santos/

José Pio Tamassia Santos

Sole Panelist

Date: November 30, 2022