

ADMINISTRATIVE PANEL DECISION

Bottega Veneta S.r.l. v. xue li
Case No. D2023-0564

1. The Parties

The Complainant is Bottega Veneta S.r.l., Italy, represented by Studio Barbero, Italy.

The Respondent is xue li, China.

2. The Domain Name and Registrar

The disputed domain name <bottegavenetaselling.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2023. On February 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 7, 2023, 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 (See PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 8, 2023 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 amendment to the Complaint on February 9, 2023.

The Center verified that the Complaint together with the amendment to the 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 February 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 1, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 2, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on March 10, 2023. 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

Bottega Veneta was founded in the mid-1960s in Vicenza, Italy. Today, the Complainant is a well-known supplier of high fashion and luxury goods, including leather goods, ladies' wear, menswear, shoes, jewelry, and fragrances. It sells its products through directly operated boutiques and department stores, in particular also in China. Bottega Veneta's revenues were 1.503 million in 2021, of which the 71% was generated through the sales of BOTTEGA VENETA leather goods products.

The disputed domain name was registered on May 31, 2021. The language of the registration agreement at the time of registration was English.

The Complaint is based amongst others on International Trademark Registration No. 420038 BOTTEGA VENETA (verbal), registered on December 16, 1975, for goods in classes 6, 11, 14, 16, 18, 20, 21 and 25, designating, amongst others, China.

It results from the undisputed evidence provided by the Complainant that the disputed domain name resolves to a website in English language, featuring the Complainant's trademark BOTTEGA VENETA and offering for sale products which are expressly defined as BOTTEGA VENETA *Replicas* at prices which are much cheaper than the prices applied to the original BOTTEGA VENETA products sold by the Complainant.

It further results from the Complainant's evidence, which has not been contested, that on September 21, 2021, the Complainant's representatives sent a Cease and Desist letter to the Respondent under the e-mail addresses indicated (i) in the public Whois records and (ii) displayed on the website available under the disputed domain name. Reminders have been sent on October 15, 2021, October 27, 2021 and February 7, 2023. However, the Respondent did not provide any answer to these communications.

5. Parties' Contentions

A. Complainant

Firstly, the Complainant contends that the disputed domain name is confusingly similar to its earlier trademark BOTTEGA VENETA. In fact, it incorporates the entire BOTTEGA VENETA-trademark and combines it with the term "selling". The mere addition of the term "selling" does not eliminate the confusing similarity between the Complainant's marks and the disputed domain name. All to the contrary, it may be apt to increase confusion amongst Internet users since they may believe that the disputed domain name is used by the Complainant to sell its products online.

Secondly, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. In particular, the Complainant contends that (1) the Respondent is using the disputed domain name to advertise and offer for sale *prima facie* counterfeit BOTTEGA VENETA products, in view of the very low prices and there can be no legitimate interest in the sale of counterfeits; (2) the Respondent is not authorized by the Complainant to use the disputed domain name; (3) the Respondent has been undoubtedly attempted to gain from the offer for sale of the products advertised on its website, by free-riding the well-known character of the Complainant's trademark and causing confusion amongst user; (4) the Respondent has undoubtedly failed to accurately and prominently disclose its (lack of) relationship with the trademark holder; (5) the Respondent did not reply to the Complainant's Cease and Desist letter.

Thirdly, the Respondent's registration and use of the disputed domain name constitutes – in the Complainant's view – bad faith. In particular, the Complainant contends that (1) the Respondent could not have ignored the existence of the Complainant's trademark BOTTEGA VENETA when it registered the disputed domain name; (2) this is confirmed by the fact that purported BOTTEGA VENETA products are offered for sale and the Complainant's trademarks are published on the website to which the disputed

domain name resolves; (3) the well-known character of the trademark BOTTEGA VENETA has been recognized in several prior UDRP decisions; (4) the Respondent did not reply to the Complainant's Cease and Desist letter and subsequent reminders sent to its attention.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

The Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the undisputed evidence provided that the Complainant is the registered owner of various trademark registrations in several jurisdictions consisting of the terms BOTTEGA VENETA. The Complaint is based amongst others on International Trademark Registration No. 420038 BOTTEGA VENETA (verbal), registered on December 16, 1975, for goods in classes 6, 11, 14, 16, 18, 20, 21 and 25, designating, amongst others, China, where the Respondent is located according to the Registrar Verification Response.

Many UDRP panels have found that a domain name is confusingly similar to a complainant's trademark for purposes of the first element where the relevant trademark is recognizable within the domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#))). This Panel shares the same view and notes that the disputed domain name contains the Complainant's registered trademark BOTTEGA VENETA identically, which is placed at the beginning of the disputed domain name. The addition of the term "selling" at the end of the disputed domain name does not prevent a finding of confusing similarity between the said domain name and the Complainant's trademark. The Panel is of the opinion that the trademark BOTTEGA VENETA remains clearly recognizable within the disputed domain name.

Finally, the generic Top-Level-Domain ("gTLD") ".com" of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to a disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

First, it results from the Complainant's uncontested evidence that the disputed domain name resolves to a website featuring the Complainant's trademark BOTTEGA VENETA and offering for sale products which are expressly defined as BOTTEGA VENETA *Replicas* at prices which are much cheaper than the prices applied to the original BOTTEGA VENETA products sold by the Complainant. In the Panel's view, the website is therefore used to sell *prima facie* counterfeit BOTTEGA VENETA products. Such use cannot be qualified as (i) a *bona fide* offering of goods or services or (ii) a noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(i) and (iii) of the Policy: all to the contrary: It is categorically consensus view amongst UDRP panels that the use of a domain name for illegal activity - such as the sale of counterfeit goods - can never confer rights or legitimate interests on a respondent. Particularly in the case of counterfeits, this is true irrespective of any disclosure on the related website that such infringing goods are "*replicas*" or "*reproductions*" or indeed the use of such term in the domain name itself (see section 2.13.1 of the [WIPO Overview 3.0](#)).

In addition, the Respondent did not submit any evidence of *bona fide* pre-Complaint preparations to use the disputed domain name. In particular, the Complainant's uncontested allegations demonstrate that it has not authorized or licensed the Respondent's use of the BOTTEGA VENETA trademarks for registering the disputed domain name, which are confusingly similar.

Furthermore, the Panel notes that there is no evidence in the record or Whois information showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

It is acknowledged that once the Panel finds a *prima facie* case has been established, the burden of production shifts to the Respondent to come forward with relevant and concrete evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

One of these circumstances that the Panel finds applicable to the present dispute is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand:

It results from the documented and undisputed evidence provided by the Complainant that the disputed domain name currently resolves to a website featuring the Complainant's trademark BOTTEGA VENETA and offering for sale products which are expressly defined as BOTTEGA VENETA *Replicas* at prices which are much cheaper than the prices applied to the original BOTTEGA VENETA products sold by the Complainant. As explained above, the Panel considers this website to be used to sell *prima facie* counterfeit BOTTEGA VENETA products, obviously without the Complainant's authorisation. For the Panel, it is therefore evident that the Respondent positively knew the Complainant's trademarks and products. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant's trademarks BOTTEGA VENETA entirely when it registered the disputed domain name. Registration of a domain name which contains a third party's trademark, in awareness of said trademark and in the absence of rights or legitimate interests is suggestive of registration in bad faith (see *e.g.*, *Charlotte Tilbury TM Limited v. Domains By Proxy, LLC / Qiangdong Liu, 365rw.com.ltd*, WIPO Case No. [D2020-0408](#) with further references).

The finding of bad faith registration and use is supported by the following further circumstances resulting from the case at hand:

- (i) the domain name identically including the Complainant's reputed trademark BOTTEGA VENETA which predates the registration of the disputed domain name of more than five decades;
- (ii) the fact that the details disclosed for the Respondent by the Registrar were incomplete, noting the mail courier's inability to deliver the Center's written communications;
- (iii) the Respondent's failure to submit a response to the Cease and Desist letters and reminders;
- (iv) the Respondent's failure to reply to the Complaint and provide any evidence of actual or contemplated good-faith use; and
- (v) the implausibility of any good faith use to which the disputed domain name may be put.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

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 name <bottegavenetaselling.com> be transferred to the Complainant.

/Tobias Malte Müller/
Tobias Malte Müller
Sole Panelist
Date: March 24, 2022