

## **ADMINISTRATIVE PANEL DECISION**

Bulgari S.p.A. v. bvlgari jewelry  
Case No. D2023-0806

### **1. The Parties**

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

The Respondent is bvlgari jewelry, United States of America.

### **2. The Domain Name and Registrar**

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 22, 2023. On February 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 24, 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 amended Complaint on February 27, 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 March 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 23, 2022.

The Center appointed Alistair Payne as the sole panelist in this matter on March 29, 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

The Complainant operates in the luxury goods and hotel markets, and is particularly known for its high-end jewellery including but not limited to watches, rings, necklaces and fragrance products. It is headquartered in Rome, Italy and opened its first international locations in New York City, Paris, Geneva and Monte Carlo in the 1970s. It now has more than 230 retail locations worldwide.

The Complainant's trade mark 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. The Complainant owns various trade mark registrations for BULGARI and BVLGARI including United States trade mark registration 1184684 for BULGARI registered on January 5, 1982 and United States trade mark registration 1694380 for BVLGARI registered on June 16, 1992. The Complainant also owns the domain name <bulgari.com> which is its official website and from which Internet users can access all its product lines and locate the Complainant's stores and authorized retailers worldwide.

The disputed domain name was registered on August 27, 2022 and resolves to a page featuring jewellery advertisements and articles from the Complainant's competitors.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant submits that it owns registered trade mark rights as set out above for both its BULGARI and BVLGARI trade marks. It says that the disputed domain name wholly incorporates its BVLGARI mark and is therefore confusingly similar to it. It asserts that the addition of the misspelt word "jewelry" to the disputed domain name does not prevent a finding of confusing similarity.

The Complainant submits that to the best of its knowledge the Respondent does not have any trade mark rights to the BVLGARI or BULGARI marks. It says that there is also no evidence that the Respondent retains any unregistered trade mark rights for the BVLGARI or BULGARI marks. Neither, says the Complainant, has the Respondent received any licence from the Complainant to use domain names featuring the BVLGARI or BULGARI trade marks.

The Complainant further submits that to the best of its knowledge, the Respondent is not commonly known by the distinctive term BVLGARI/BULGARI. Therefore, there is no plausible reason for the registration and use of the disputed domain name, other than the motive of taking advantage of the goodwill and reputation attaching to the BVLGARI or BULGARI mark.

The Complainant submits that the Respondent has not used, or prepared to use, the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant says that to the best of its knowledge the disputed domain name has been used to resolve to an advertisement site featuring articles for the Complainant's competitors, since its registration. Within these articles, Internet visitors are re-directed to purchase competitive offerings at <amazon.com>.

It says that the use of the disputed domain name to advertise and redirect Internet users to competitor content and products does not constitute a *bona fide* offering of goods and services. Featuring the heading "Bvlgari Fine Jewelry for Sale" on the site and then presenting Internet visitors with articles on competitor jewellery and redirection links is not a *bona fide* offering of goods or services according to the Complainant. Further, being re-directed to offers for sale competing products is not a *bona fide* use of the disputed domain name. On the contrary, says the Complainant, such use targets the Complainant and attempts to disrupt the Complainant's operations by misleading Internet visitors into purchasing competitor products they believe are associated with the Complainant. Neither, says the Complainant, is the use of the disputed domain name to advertise competing products a legitimate noncommercial or fair use.

The Complainant further submits that, by purporting to offer for purchase competitor jewellery products from the disputed domain name, Internet visitors are directed to submit their personal information such as username, email address, and password when registering an account/logging in. They are also directed to insert their billing details including name, address, phone number, and card details on checkout. The Complainant submits that the Respondent is likely using the disputed domain name to carry out fraudulent activity, in passing off as the Complainant and collecting personal information from its users. According to the Complainant, such use can never confer rights or legitimate interests as maintained in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.13.

As far as bad faith is concerned, the Complainant says that its trade mark registrations long pre-date the registration of the disputed domain name and it asserts that the BVLGARI/BULGARI name has become synonymous with high-end and stylistically unique luxury accessories. The Complainant notes that searching "BVLGARI" on popular Internet search engines such as Google lists the Complainant's brand and services as the first result and considering the degree of renown attaching to it the Respondent must have registered the disputed domain name in bad faith with the intention of taking advantage of the Complainant's brand. This in and of itself is bad faith according to the Complainant. The Complainant notes that a cease and desist notice was sent out to the Respondent on October 4, 2022 but that no response was received.

The Complainant submits that the requirements of both paragraphs 4(b)iii and 4(b)iv are fulfilled in the circumstances which is evidence of registration and use of the disputed domain name in bad faith.

The Complainant also notes that the Respondent has configured the disputed domain name with mail exchange (MX) records. Therefore, says the Complainant, there is a risk that could be caused to unsuspecting customers of the Complainant on receipt of emails from the disputed domain name in that the Respondent has likely engaged in or will engage at some point in phishing activity, given the evidently implied affiliation with the disputed domain name due to the Complainant's BVLGARI trade mark. According to the Complainant, the risk of fraud is only compounded by Internet visitors being directed to insert their personal information in the login and checkout process to confirm their purchases on the Respondent's site as this information could be used to gain access to users' personal information who mistake the site for the Complainant's.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Complainant has demonstrated that it owns various trade mark registrations for BULGARI and BVLGARI including United States trade mark registration 1184684 for BULGARI registered on January 5, 1982 and United States trade mark registration 1694380 for BVLGARI registered on June 16, 1992. The disputed domain name wholly incorporates the Complainant's BVLGARI mark and is therefore confusingly similar to it. The Panel finds that the addition of the misspelt word "jewelry" to the disputed domain name does not prevent a finding of confusing similarity. Accordingly, the Complaint succeeds under this element of the Policy.

### **B. Rights or Legitimate Interests**

The Complainant has submitted that to the best of its knowledge, the Respondent is not commonly known by the distinctive term BVLGARI or BULGARI. Therefore, there is no plausible reason for the registration and use of the disputed domain name, other than the motive of taking advantage of the goodwill and reputation attaching to the BVLGARI or BULGARI mark.

The Complainant has further submitted that the Respondent has not used, or prepared to use, the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant has asserted that to the best of its knowledge the disputed domain name has been used to resolve to an advertisement site featuring articles for the Complainant's competitors or to competing jewellery product offers. Within these articles, Internet visitors are re-directed to purchase competitive offerings at <amazon.com>.

The Complainant has also contended that the use of the disputed domain name to advertise and redirect Internet users to competitor content and products does not constitute a *bona fide* offering of goods and services. It has rightly asserted that featuring the heading "Bulgari Fine Jewelry for Sale" on the site and then presenting Internet visitors with articles on competitor jewellery and re-direction links is not a *bona fide* offering of goods or services and neither is being re-directed to offers for sale of competing products. The Complainant has maintained that such use targets the Complainant and attempts to disrupt the Complainant's operations by misleading Internet visitors into purchasing competitor products they believe are associated with the Complainant. It has also said that the use of the disputed domain name to advertise competing products is not a legitimate noncommercial or fair use of the disputed domain name.

The Complainant has also suggested that by purporting to offer for purchase competitor jewellery products from the disputed domain name, Internet visitors are directed to submit their personal information such as username, email address, and password when registering an account/logging in. It has also noted that Internet visitors are directed to insert their billing details including name, address, phone number, and card details on checkout. According to the Complainant, the Respondent has likely used the disputed domain name to carry out fraudulent activity, in passing itself off as the Complainant and collecting personal information from its users which it has said cannot confer rights or legitimate interests.

In all of these circumstances the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to respond to or to rebut the Complainant's case and explain its conduct and the Panel therefore finds that the Complaint also succeeds under this element of the Policy.

### **C. Registered and Used in Bad Faith**

The disputed domain name was registered many years after the Complainant's trade marks. The BULGARI and BVLGARI marks are distinctive and it is apparent that through considerable use and promotion they enjoy a very considerable goodwill and reputation in the United States and internationally in connection with jewellery and a range of luxury goods. The fact that the website to which the disputed domain name resolves features the heading "Bulgari Fine Jewelry for Sale" but then re-directs website visitors to articles concerning competitors' products, or to sale offers for such products, indicates to the Panel that the Respondent has purposefully and blatantly sought to register and to use the disputed domain name incorporating the BVLGARI mark for its own advantage and most likely registered the disputed domain name with knowledge of the Complainant's business and trade marks.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of the disputed domain name in bad faith where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website.

The circumstances of this case, as described in Part B above fulfill the requirements of paragraph 4(b)(iv) of the Policy. The Respondent has clearly used the disputed domain name incorporating the BVLGARI mark to confuse Internet users and to re-direct them to a website which promotes and/or leads Internet users to offers for sale of competing jewellery products. In part the Respondent facilitates this through the Amazon Services LLC Associates Program and states on the website at the disputed domain name that this program "...is designed to provide a way for websites to earn advertising revenues by advertising and linking to <amazon.com>". It is therefore clear that the Respondent is using the disputed domain name to take advantage of the reputation attaching to the BVLGARI mark for its own commercial benefit in terms of paragraph 4(b)(iv) of the Policy. Such use amounts to evidence of registration and use in bad faith under this paragraph of the Policy.

The Respondent's failure to reply to the Complainant's pre-action notice or to explain its conduct in the course of these proceedings and its use of a privacy service to mask its identity only reinforces the Panel's view of the Respondent's blatant registration and use of the disputed domain name in bad faith.

Accordingly, the Panel finds that the disputed domain name has been registered and used in bad faith and that the Complaint also succeeds under this element 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, <bvlgarijewelry.com>, be transferred to the Complainant.

*/Alistair Payne/*

**Alistair Payne**

Sole Panelist

Date: April 12, 2023