

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. K888VIP

Case No. D2023-3092

1. The Parties

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

The Respondent is K888VIP, United States of America (“United States”).

2. The Domain Names and Registrar

The disputed domain names <bvlgarihotsales.asia>, <bvlgari-japan.asia>, <bvlgari-outlet.asia>, <bvlgaritumijapan.asia>, <bvlgaritumisale.asia>, and <bvlgaritumishop.asia> are registered with Hongkong Domain Name Information Management Co., Limited (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2023. On July 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 21, 2023, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted for Privacy, K888VIP) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 26, 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 in English on July 28, 2023.

On July 26, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain names is in Chinese. On July 28, 2023, the Complainant confirmed the request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in Chinese and English of the Complaint, and the proceedings commenced on August 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 23, 2023.

The Center appointed Rosita Li as the sole panelist in this matter on September 6, 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 is an Italian company founded in 1884. 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. Headquartered in Rome, Italy, the Complainant opened its first international locations in New York City, Paris, Geneva and Monte Carlo in the 1970s.

The Complainant's mark BVLGARI serves as the brand name and BULGARI, which is the modern alphabet of BVLGARI, is often used in relation to the company name; the two are often used synonymously. The Complainant, its affiliates, subsidiaries and associated companies own the BVLGARI trademark within numerous jurisdictions including but not limited to the following:

- 1) United States Trademark Registration No. 1694380 for BVLGARI registered on June 16, 1992;
- 2) Canada Trademark Registration No. TMA312178 for BVLGARI registered on March 14, 1986;
- 3) International Trademark Registration No. 494237 for BVLGARI registered on July 5, 1985;
- 4) Italy Trademark Registration No. 0000984147 for BVLGARI registered on November 18, 2005;
- 5) European Union Trademark Registration No. 007138101 for BVLGARI registered on June 3, 2009;
- 6) Australia Trademark Registration No. 338663 for BULGARI registered on October 5, 1979;
- 7) United States Trademark Registration No. 1184684 for BULGARI registered on January 5, 1982; and
- 8) International Trademark Registration No. 452694 for BULGARI registered on May 15, 1980.

(together with the other trademarks of the Complainant, the "BVLGARI trademarks", each a "BVLGARI trademark").

The Complainant submitted that it has acquired distinctiveness in the market worldwide and has customers who rely on the brand's name and quality. The Complainant has also established social media presence and uses of the BVLGARI trademarks to promote its services on Facebook (www.facebook.com/Bulgari), Twitter (www.twitter.com/bulgariofficial), Instagram (www.instagram.com/bulgari/), and Pinterest (www.pinterest.com/bulgari/).

The Complainant submitted that it operates its home page at "www.bulgari.com", showing information about the Complainant and the goods and services it offers. The BVLGARI trademark is shown on the said home page of the Complainant.

The disputed domain names were registered by the Respondent on February 14, 2023 with respect to <bvlgarihotsales.asia>, <bvlgari-japan.asia>, <bvlgari-outlet.asia>, <bvlgaritumisale.asia>, and <bvlgaritumishop.asia>, and March 31, 2023 with respect to <bvlgaritumijapan.asia>.

On March 22, 2023, the Complainant sent a cease and desist notice to the Respondent, in order to put the Respondent on notice of the Complainant's BVLGARI trademarks and with a view to resolving the matter amicably. The Complainant did not receive a reply from the Respondent.

As of the date of filing this Complaint, the disputed domain names resolved to different websites containing online casino platform contents, while the disputed domain names <bvlgari-japan.asia> and <bvlgaritumijapan.asia> resolved to an error page.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that:

- (i) The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant contends that:
 - Previous panels have recognized the value of the BVLGARI trademark and its association with the Complainant. Goodwill and recognition that has been attained under the name of BVLGARI is a distinctive identifier associated with the Complainant's services;
 - The disputed domain names contain in their entirety, without alteration or adornment, the BVLGARI trademark;
 - The addition of the terms, such as "outlet" and "hotsales", given their clear connotations to the Complainant as a provider of products and services, only serves to increase the likelihood of confusion between the disputed domain names and the BVLGARI trademarks;
 - The generic top-level domain of ".asia" is a standard registration requirement, which should be disregarded for the purposes of comparison as it is a necessary component of a domain name.

- (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant contends that:
 - To the best of the Complainant's knowledge, the Respondent does not have any trademark rights to the term BVLGARI;
 - The Respondent has not received any license from the Complainant to use a domain name featuring the BVLGARI trademarks;
 - The Respondent has not used, nor prepared to use, the disputed domain names in connection with a *bona fide* offering of goods or services;
 - The Respondent is not making a legitimate noncommercial or fair use of the disputed domain names as the Respondent's use of the disputed domain names are clearly calculated to advertise and redirect Internet users to unconnected gambling sites;
 - The disputed domain names <bvlgari-japan.asia> and <bvlgaritumijapan.asia> do not resolve to active websites or webpages and are passively held. The Respondent's passive holding of <bvlgari-japan.asia> and <bvlgaritumijapan.asia> does not confer a legitimate noncommercial or fair use of the disputed domain names.

- (iii) The disputed domain names were registered and are being used in bad faith. The Complainant contends that:
 - The Complainant's trademark registrations predate the creation date of the disputed domain names by 43 years;
 - The Complainant has accrued substantial goodwill and recognition since the Complainant's establishment in 1884, and the BVLGARI name has become synonymous with high-end and stylistically unique luxury jewellery, watches, perfumes, and accessories;
 - The Respondent has clearly registered the disputed domain names to target the Complainant's brand intentionally, given the disputed domain names comprise the Complainant's distinctive BVLGARI trademark with the addition of terms such as "outlet" and "hotsales";
 - The Respondent was given the opportunity to provide evidence of any actual or contemplated good faith use in a cease and desist letter that was sent to the Respondent via email on March 22, 2023, but the Respondent chose not to respond;

- The Respondent's conduct is calculated to intentionally confuse and mislead users seeking *bona fide* and well-known services of the Complainant. The Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's BVLGARI mark;
- The Respondent's registration of multiple disputed domain names that encompass the BVLGARI trademark prevents the Complainant from effectively reflecting the said marks in domain names, which is a pattern of bad faith and a finding of abusive conduct. Passive holding also does not preclude a finding of bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a complainant must satisfy each of the following three elements in a complaint:

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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.

6.1. Language of the Proceeding

The language of the Registration Agreement for the disputed domain names is Chinese. Pursuant to paragraph 11(a) of the Rules, in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that there is evidence of the Respondent's ability to understand English. It was submitted that the landing page of the disputed domain names which are operating can be changed to English, and no translation request was received from the Respondent when an English cease and desist letter was sent by the Complainant. The Complainant further submits that the commission of a translator would add considerable costs to the Complainant, and will cause delay to the commencement of the proceeding.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered the above circumstances and the fact that:

- (i) The Respondent is located in the United States;
- (ii) English is the primary language for the content displayed on the sites of the disputed domain names;

(iii) Even though the Center has used English and Chinese in the relevant correspondences with the Respondent, the Respondent has not filed any response and did not comment on the language of the proceeding;

(iv) Translating this Decision will not be prejudicial against the Respondent nor will it result in considerable costs to the Respondent.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2. Substantive issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, "hotsales", "-japan", "-outlet", "tumijapan", "tumisale", "tumishop" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

In accordance with [WIPO Overview 3.0](#), section 2.5.1, where a domain name consists of a trademark plus an additional term (at the second or top level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark

owner. The disputed domain names have included the Complainant's BVLGARI trademark in its entirety and have also included an indistinctive geographical term "japan" and terms such as "hotsales", "outlet", "sale" and "shop", which are highly relevant to the Complainant's business.

As of the time of filing the Complaint, <bvlgari-japan.asia> and <bvlgaritumijapan.asia> resolved to an error page. The Panel is of the view that there is no indication that the Respondent has any plan to use <bvlgari-japan.asia> and <bvlgaritumijapan.asia> for any *bona fide* offering of goods or services.

Given that the disputed domain names, with the exception of <bvlgari-japan.asia> and <bvlgaritumijapan.asia> which resolved to an error page, resolved to online casino platforms, the Panel finds that the disputed domain names tend to suggest sponsorship or endorsement by the Complainant as the owner of the BVLGARI trademark and the Respondent has not been conducting legitimate noncommercial or fair use of the disputed domain names.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent registered the disputed domain names on February 14, 2023 and March 31, 2023, which is well after the registration of the BVLGARI trademarks. The Complainant has accrued substantial goodwill and recognition over the years since its establishment, and has been renowned for high-end and stylistically unique luxury jewellery. The Complainant also provided supporting documents such as the types of products sold under the BVLGARI trademarks, its social media presence, its hotel brands, and internet search results to show that the BVLGARI trademark is well known and reputable amongst the general public. The Panel finds that it would not be plausible for the Respondent to claim that it was unaware of the Complainant and the BVLGARI trademarks. The Panel is prepared to infer that the Respondent knew or should have known that its registration of the disputed domain names would be confusingly similar to the BVLGARI trademarks ([WIPO Overview 3.0](#), section 3.2.2.). Accordingly, the Panel finds that the Respondent registering the disputed domain names, which are confusingly similar to the BVLGARI trademarks, which are well known and registered earlier, is a clear indication of bad faith.

With respect to <bvlgari-japan.asia> and <bvlgaritumijapan.asia>, panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names and the use of the other disputed domain names resolving to online casino platform contents in an attempt to target BVLGARI trademarks and mislead the Internet users does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

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, <bvgarihotsales.asia>, <bvgari-japan.asia>, <bvgari-outlet.asia>, <bvlgaritimijapan.asia>, <bvlgaritumisale.asia>, and <bvlgaritumishop.asia> be transferred to the Complainant.

/Rosita Li/

Rosita Li

Sole Panelist

Date: September 20, 2023