

## **ADMINISTRATIVE PANEL DECISION**

**Bulgari S.p.A v. uirislam vertkolera**

**Case No. D2023-3093**

### **1. The Parties**

Complainant is Bulgari S.p.A, Italy, represented by SafeNames Ltd., United Kingdom ("UK").

Respondent is uirislam vertkolera, UK.

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

The disputed domain name <bulgarihotelgroup.com> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed 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 name. On July 19, 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 (Redacted for Privacy, Privacy service provided by Withheld) and contact information in the Complaint. The Center sent an email communication to Complainant on July 20, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 20, 2023.

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 Respondent of the Complaint, and the proceedings commenced on July 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on August 11, 2023.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on August 17, 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

Complainant is a company organized under the laws of Italy that is active in the jewelry and luxury goods as well as in the hotel industry.

Complainant has provided evidence that it is the registered owner of numerous trademarks relating to its company name and brand BULGARI / BVLGARI, including, but not limited, to the following:

- word mark BULGARI, World Intellectual Property Organization (WIPO) International registration number: 452694, registration date: May 15, 1980, status: active;
- word mark BULGARI, United States Patent and Trademark Office (USPTO) registration number: 1,184, 684, registration date: January 5, 1982, status: active;
- word mark BVLGARI, European Union Intellectual Property Office (EUIPO) registration number: 007138101, registration date: June 3, 2009, status: active.

Moreover, Complainant has demonstrated to own various domain names relating to its BULGARI trademark, *inter alia*, since 1998 the domain name <bulgari.com> which resolves to Complainant's main website at "www.bulgari.com", promoting Complainant's jewelry and other luxury goods as well as Complainant's hotels worldwide.

Respondent, according to the disclosed Whois information for the disputed domain name, is a resident of the UK who registered the disputed domain name on February 28, 2023. By the time of rendering this decision, the disputed domain name has been suspended and does not resolve to any webpage. Complainant, however, has demonstrated, that Respondent apparently has set up mail exchange (MX) records and at least one email address under the disputed domain name, namely @bulgarihotelgroup.com, which Respondent used to send an email on April 5, 2023, thereby impersonating an employee of Complainant from the reservations department of BULGARI Hotels, with the aim of acquiring sensitive financial information from at least one of Complainant's customers for illegitimate financial gain.

Complainant requests that the disputed domain name be transferred to Complainant.

#### 5. Parties' Contentions

##### A. Complainant

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

Notably, Complainant contends that its roots date back to 1884 and that due to a substantial amount of time, money and effort in promoting, marketing and using the BULGARI trademark to identify and distinguish Complainant's services domestically and internationally, this trademark has meanwhile acquired distinctiveness in the market worldwide.

Complainant submits that the disputed domain name is confusingly similar to Complainant's BULGARI trademark as it encompasses the latter in its entirety with the addition of the terms "hotel" and "group". Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Respondent has not received any license from Complainant to register or use domain names featuring the BULGARI trademark and Respondent obviously neither retains registered nor unregistered trademark rights therein, (2) Respondent is not using the disputed domain name to offer any goods or services thereunder, but is passively holding it instead, and (3) by the same time, Respondent set up MX records and an email address under the disputed domain name in order to undertake a phishing attack by sending emails and impersonating an employee of Complainant from the reservations department

of BULGARI Hotels, with the aim of acquiring sensitive financial information. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) Complainant's BULGARI trademark registrations predate the registration of the disputed domain name by many decades, (2) Complainant's BULGARI trademark enjoys strong reputation and the circumstances of this case indicate that Respondent intentionally used the commercial value and goodwill of this trademark to confuse online users for Respondent's own gain through the perpetration of illegitimate hotel offerings, and (3) the latter is reconfirmed by the fact that Respondent set up MX records under the disputed domain name, enabling Respondent to send and receive emails using email addresses ending in "@bulgarihotelgroup.com" and to undertake a phishing attack by impersonating an employee of Complainant from the reservations department of BULGARI Hotels, with the aim of acquiring sensitive information (e.g., customer's card details).

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a Response as it considers appropriate.

### **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 Complainant's BULGARI trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds 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 Complainant's BULGARI trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to this trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms (here, the terms "hotel" and "group") 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 name and Complainant's BULGARI trademark 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 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 Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity (e.g., a phishing attack by sending an email on April 5, 2023, thereby impersonating an employee of Complainant from the reservations department of BULGARI Hotels, with the aim of acquiring sensitive financial information from at least one of Complainant’s customers for illegitimate financial gain) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and is being used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The circumstances to this case leave no doubt that Respondent was fully aware of Complainant’s rights in the BULGARI trademark when registering the disputed domain name and that the latter clearly is directed to such trademark.

Moreover, using the disputed domain name for illegal phishing activities by sending fraudulent emails under it, thereby impersonating an employee of Complainant from the reservations department of BULGARI Hotels, with the aim of acquiring sensitive financial information from at least one of Complainant’s customers for illegitimate financial gain, is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own email communication by creating a likelihood of confusion with Complainant’s BULGARI trademark as to the source, sponsorship, affiliation or endorsement of Respondent’s phishing emails. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy (see also [WIPO Overview 3.0](#), section 3.4).

In connection with this finding, it also carries weight in the eyes of the Panel that Respondent obviously provided false or incomplete postal address in the Whois register for the disputed domain name because the

Written Notice could not be sent by courier. This fact at least throws a light on Respondent's behavior which supports the Panel's bad faith finding.

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 name, <bulgarihotelgroup.com>, be transferred to Complainant.

*/Stephanie G. Hartung/*

**Stephanie G. Hartung**

Sole Panelist

Date: August 23, 2023