

## ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A v. Chanki Lee  
Case No. D2024-5011

### 1. The Parties

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

The Respondent is Chanki Lee, Republic of Korea.

### 2. The Domain Name and Registrar

The disputed domain name <bulgarihotels.org> is registered with Squarespace Domains II LLC (the "Registrar").

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 4, 2024. On December 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 2024, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 9, 2024, 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 December 10, 2024.

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 December 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 1, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 14, 2025.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on January 17, 2025. 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 a corporation based in Italy and active in the hotels and luxury goods markets, in particular jewelry including watches, rings, necklaces and fragrances. The Complainant is the owner of registered trademarks in numerous jurisdictions for the term BULGARI, including in China No 15659745 registered on December 28, 2015 in class 3; International registration No 452694 registered on May 15, 1980, in classes 11, 14, 20 and 21; in the United States of America No 1694380 registered on June 16, 1992 in class 18; and in the European Union No 007138101 registered on March 6, 2009 in classes 35, 36, 41, and 43.

The Complainant maintains a social media presence online inter alia on Facebook at “www.facebook.com/Bulgari” with 4.7 million followers; and on Instagram at “www.instagram.com/bulgari/” with 13.9 million followers.

The disputed domain name was registered on May 29, 2024, and at one time resolved to an aftermarket website where it was offered for sale. Currently it resolves to a parking 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 name.

Notably, the Complainant notes that the disputed domain name encompasses the BULGARI mark in its entirety with the addition of the term “hotels”. The Complainant argues that it is accepted in the UDRP that where a domain name incorporates the entirety of a trademark, it will normally be considered identical or confusingly similar to a Complainant’s trademark for the purposes of the First Element (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7). The Complainant also says that the addition of the term “hotels” is not sufficient to alleviate the likelihood of confusion between the Complainant’s BULGARI mark and the disputed domain name. The Complainant thus submits that the disputed domain name is confusingly similar to the Complainant’s mark for the purposes of paragraph 4(a)(i) of the Policy.

The Complainant says that to the best of its knowledge, the Respondent does not have any trademark rights to the term BULGARI. The Complainant maintains that there is no evidence that the Respondent retains any unregistered trademark rights to the term BULGARI. The Respondent has not received any license from the Complainant to use a domain name featuring the BULGARI trademark.

The Complainant further submits that the Respondent has not used, nor prepared to use, the disputed domain name in connection with a bona fide offering of goods or services. The disputed domain name currently resolves to an Afternic.com/GoDaddy parking page, thus being passively held. The Complainant points out that the disputed domain name previously redirected to the aftermarket website “www.dan.com” where it was advertised for sale at a “buy now” price of USD 1,990. The Complainant contends that this shows that the Respondent registered the disputed domain name to generate undue profit based on the domain name’s value as a trademark. The Complainant contends that such use does not constitute a genuine offering of goods or services. The Complainant says that to the best of its knowledge, the Respondent is not commonly known by the term “bulgari”, “bulgarihotels” or anything similar. There is

therefore no plausible reason for the registration and use of the disputed domain name by the Respondent, other than to take unfair advantage of the goodwill and reputation attached to the BULGARI mark.

The Complainant submits that the Respondent targeted the Complainant in a manner likely to confuse people into believing the disputed domain name is registered to, operated or authorized by, or otherwise connected with the Complainant, where this is not the case. Any online user seeing the disputed domain name would believe it is connected to the Complainant, which is the owner of multiple hotels.

The Complainant further submits that non-use of a domain name is “not a legitimate noncommercial or fair use of the domain name”. The Respondent’s previous listing of the disputed domain name for sale for USD 1,990 is clear evidence that it intended to generate monetary revenue through the sale of the disputed domain based on its value as a trademark, the Complainant maintains.

Having presented a sufficient prima facie case, the burden of establishing rights or interests shifts to the Respondent, something the latter has been unable to do, the Complainant contends.

The Complainant also points out that its trademark registrations for BULGARI predate the creation date of the disputed domain name by over 30 years. In addition, the Complainant asserts that substantial goodwill has accrued in its mark since the Complainant’s establishment in 1884. A search of BULGARI and “bulgarihotels” on popular Internet search engines such as Google, generates the Complainant’s brand and goods as the first results.

The Complainant also maintains that an average Internet user has access to the BULGARI trademark registrations, as they can be found on public trademark databases. The simplest degree of due diligence would have made the Respondent aware of the Complainant’s rights in its globally distinctive BULGARI mark. For all these reasons, the Complainant submits that the Respondent registered the disputed domain name in bad faith, with the primary intention of taking advantage of the Complainant’s brand.

The Complainant points out that the disputed domain name currently resolves to an Afternic.com/GoDaddy parking page and is therefore passively held. The Complainant points to the fact that previous panels have found bad faith “passive use” simply where the complainant has a distinctive mark and the respondent provides no evidence of “any actual or contemplated good faith use”. The Complainant says that the mark BULGARI has a strong reputation and has no ordinary or dictionary meaning. The Complainant also submits that the Respondent previously listed the disputed domain name for sale at a buy now price of USD 1,990, far beyond what would be reasonably expected out-of-pocket costs. While the offer for sale was not made directly to the Complainant, the circumstances surrounding the registration and use of the disputed domain name indicate bad faith, suggesting that the Respondent was aware of its value as a trademark.

Finally, the Complainant also points out that the Respondent did not respond to the cease and desist letter of the Complainant. Previous Panel decisions have stated that a lack of reply to a cease and desist notice prior to commencing UDRP proceedings infers bad faith behavior, according to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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.

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 mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here, “hotels” may bear on assessment of the second and third elements, the Panel finds the addition of the “hotels” does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy [WIPO Overview 3.0](#), section 1.8. The Panel notes that the Complainant has registered and uses its BULGARI trademark in relation to hotels.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. 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 name such as those enumerated in the Policy or otherwise.

There is no evidence before the Panel that the Respondent has prior rights to the mark BULGARI, is known by that term or by the disputed domain name, or has any valid authorization to use the distinctive BULGARI mark in any way. The disputed domain name resolved to an aftermarket website at one time, and now resolves to a parking page. Neither of these circumstances is apt to function as justification for the recognition of rights or interests in the Respondent.

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 a domain name that includes a highly distinctive trademark with a widespread reputation and did so without any authorization or excuse. The Respondent also included the term “hotels” further suggesting that he was aware of the Complainant’s use of, and rights in the BULGARI trademark at the time of registration, since the Complainant is active in that field. The offering for sale for an amount exceeding out-of-pocket expenses (absent any evidence from the

Respondent to the contrary), and then the subsequent passive holding of the disputed domain name, are consistent with a finding of use in bad faith. That is particularly the case where the Respondent has no rights or claims in the distinctive trademark incorporated without permission in the disputed domain name, as is the case here.

The Panel finds that the Complainant has established the third 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 <bulgarihotels.org> be transferred to the Complainant.

*/William A. Van Caenegem/*

**William A. Van Caenegem**

Sole Panelist

Date: January 31, 2025