

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. 张济 (zhang ji)
Case No. DCN2023-0013

1. The Parties

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

The Respondent is 张济 (zhang ji), China.

2. The Domain Name and Registrar

The disputed domain name <bvlgari-watch.cn> is registered with 北京新网数码信息技术有限公司 (the "Registrar").

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 10, 2023. On March 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 13, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing contact details. In response to the Center's sent an email communication the Complainant filed an amended Complaint in English on March 15, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the China ccTLD Dispute Resolution Policy (the "Policy"), the China ccTLD Dispute Resolution Policy Rules (the "Rules"), and the WIPO Supplemental Rules for China ccTLD Dispute Resolution Policy and China ccTLD Dispute Resolution Policy Rules (the "WIPO Supplemental Rules").

In accordance with the Rules, Articles 5 and 6, and Articles 14 to 16, and the WIPO Supplemental Rules, Paragraph 4(d), the Center formally notified the Respondent in Chinese and English of the Complaint, and the proceedings commenced on March 22, 2023. In accordance with the Rules, Articles 17 and 49, the due date for Response was April 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 12, 2023.

The Center appointed Joseph Simone as the sole panelist in this matter on April 21, 2023. The Panel finds that it was properly constituted. The Panel submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, Article 29.

4. Factual Background

The Complainant, Bulgari S.p.A., is an Italian private company founded in 1884 by Sotirios Voulgaris operating in the luxury goods and hotel markets. The Complainant's luxury goods include rings, watches, necklaces and perfumes.

The Complainant has an extensive global portfolio of registrations containing the term BVLGARI, including the following:

- International Trade Mark registration No. 543321 for BVLGARI in Classes 3, 8, 11, 14, 16, 18, 20, 21, 25 and 34, designating a number of jurisdictions including China, registered on October 11, 1989;
- International Trade Mark registration No. 1290822 for BVLGARI in Classes 9, 35, 38 and 42, designating a number of jurisdictions including China, registered on December 23, 2015;
- International Trade Mark registration No. 494237 for BVLGARI in Classes 3, 8, 11, 14, 16, 18, 20, 21, 25 and 34, designating a number of jurisdictions including China, registered on July 5, 1985.

The disputed domain name was registered on May 27, 2022.

According to the evidence provided by the Complainant, at the time of filing of the Complaint, the disputed domain name resolved to a page displaying pornographic content and gambling and gaming advertisements. At the time of this decision, the disputed domain name resolves to an error page.

5. Parties' Contentions

A. Complainant

The Complainant asserts that it has prior rights in the BVLGARI trade mark and that it has acquired a strong reputation in its field of business. The Complainant further notes that the disputed domain name registered by the Respondent is confusingly similar to the Complainant's BVLGARI trade mark.

The Complainant asserts that it has not authorized the Respondent to use its BVLGARI mark, and there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services.

The Complainant has presented evidence showing that the disputed domain name was used in association with a site displaying pornographic content and gambling and gaming advertisements, and that it is implausible that the Respondent registered the disputed domain name in good faith, and that any use of the disputed domain name must be in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

Article 6 of the Policy provides that "[t]he language of the domain name dispute resolution proceedings shall be Chinese, unless otherwise agreed by the parties or determined by the Panel." Article 8 of the Rules

further provides that “[u]nless otherwise agreed by the Parties or determined in exceptional cases by the Panel, the language of the domain name dispute resolution proceedings shall be Chinese. [...]”

Hence, the default language of the proceeding should be Chinese.

However, the Complainant filed the Complaint in English, and requested that English be the language of the proceeding, mainly asserting the following:

- the disputed domain name contains the English word “watch”;
- the Respondent has registered many English language domain names, such as <almostlover.cn>, <childmodel.cn>, <hotelhelp.cn> and <shoppingfair.cn>; and
- to proceed in the Chinese language the Complainant would have to retain specialized translation services that would considerably increase costs to the Complainant, which already bears the cost of filing, and delay commencement of the proceeding.

The Respondent was notified in both Chinese and English of the commencement of the proceeding including an invitation to comment on the language of the proceeding, however, the Respondent did not comment on the language of the proceeding or submit any response in either Chinese or English.

Considering the circumstances of this case, the Panel has determined that the language of the proceeding shall be English, and the Panel has therefore issued this decision in English. The Panel further finds that such determination should not cause any prejudice to either Party and should ensure that the proceeding takes place with due expedition.

6.2. Substantive Issues: Three Elements

A. Identical or Confusingly Similar to the Complainant’s Name or Mark in Which the Complainant Has Rights or Interests

The Panel acknowledges that the Complainant has established rights in the BVLGARI trade mark.

Disregarding the country code Top-Level Domain (“ccTLD”) “.cn”, the disputed domain name incorporates the Complainant’s mark BVLGARI in its entirety. The additional hyphen and the term “watch” do not prevent a finding of confusing similarity.

Accordingly, the Complainant has satisfied the condition under Article 8(a) of the Policy.

B. Rights or Legitimate Interests

Under Article 10 of the Policy, a respondent may establish its rights to and legitimate interests in the disputed domain name by demonstrating any of the following before receiving the complaint:

- (a) the respondent uses of the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services;
- (b) the respondent has been commonly known by the disputed domain name, even if it has acquired no trade mark or service mark rights;
- (c) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent of or commercial gain to misleadingly divert consumers.

The Complainant asserts that it has not authorized the Respondent to use its trade marks and there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use,

the disputed domain names in connection with a *bona fide* offering of goods or services. The disputed domain name previously resolved to a page displaying pornographic content and gambling and gaming advertisements and is now inactive.

Thus, the Complainant has established its *prima facie* case with satisfactory evidence.

The Respondent did not file a response and has therefore failed to assert factors or put forth evidence to establish that they enjoy rights or legitimate interests in the disputed domain name. As such, the Respondent has failed to rebut the Complainant's *prima facie* showing of the Respondent's lack of rights or legitimate interests in the disputed domain name, and none of the circumstances of Article 10 of the Policy is applicable in this case.

Therefore, the Respondent has not shown that prior to the notice of the dispute, they have used or has demonstrated their preparation to use the disputed domain name in connection with a *bona fide* offering of goods or services. There is also no evidence showing that the Respondent has been commonly known by the disputed domain name or that the Respondent is making legitimate noncommercial or fair use of the disputed domain name.

Furthermore, given the composition of the disputed domain name <bvlhari-watch.cn>, which combines the Complainant's mark with the term "watch" descriptive of its products, the disputed domain name carries a risk of implied affiliation, contrary to the fact, which cannot constitute fair use.

Accordingly, the Complainant has satisfied the condition under Article 8(b) of the Policy.

C. Registered or Used in Bad Faith

Article 9 of the Policy provides certain examples of circumstances which, may be evidence of the registration and use of the disputed domain name in bad faith, namely:

- (a) the purpose for registering or acquiring the disputed domain name is to sell, rent, or otherwise transfer the disputed domain name registration to the complainant who is the owner of the name or mark or to a competitor of that complainant, and to obtain unjustified benefits;
- (b) the respondent registers the disputed domain name in order to prevent owners of the names or marks from reflecting the names or marks in corresponding domain names;
- (c) the respondent has registered or acquired the disputed domain name for the purpose of damaging the complainant's reputation, disrupting the complainant's normal business or creating confusion with the complainant's name or mark so as to mislead the public; and
- (d) other circumstances which may prove the bad faith.

For reasons discussed under this and the preceding heading, the Panel believes that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain name.

When the Respondent registered the disputed domain name, the BVLGARI trade marks were already widely known and directly associated with the Complainant's activities. Panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trade mark by an unaffiliated entity can by itself create a presumption of bad faith.

Given the extensive prior use and fame of the Complainant's marks, in the Panel's view, the Respondent should have been aware of the Complainant's marks when registering the disputed domain name and ultimately, given the composition of the disputed domain name, it is clear that the Respondent was aware of the Complainant and intentionally targeted the Complainant when registering the disputed domain name.

Panels have consistently held that the use of a disputed domain name to redirect to a website with pornographic content, such as the one used by the Respondent, may be evidence of bad faith. This content, and the links on the Respondent's website to other pornographic and gambling and gaming sites, indicate that the Respondent intended to use the disputed domain name for the purpose of damaging the complainant's reputation and disrupting the complainant's normal business. The Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating confusion with the Complainant's mark.

The Panel also finds that the current passive holding of the disputed domain name does not change the Panel's finding of the Respondent's bad faith.

Accordingly, the Complainant has satisfied the condition under Article 8(c) of the Policy.

7. Decision

For the foregoing reasons, in accordance with Article 14 of the Policy and Article 40 of the Rules, the Panel orders that the disputed domain name <bvlgari-watch.cn> be transferred to the Complainant.

/Joseph Simone/

Joseph Simone

Sole Panelist

Date: May 8, 2023