

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. 周国强 (zhou guo qiang)

Case No. DCN2024-0009

1. The Parties

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

The Respondent is 周国强 (zhou guo qiang), China.

2. The Domain Name and Registrar

The disputed domain name <bulgarishanghai.cn> is registered with 阿里云计算有限公司（万网） (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on March 20, 2024. On March 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 25, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 28, 2024. In accordance with the Rules, Article 17 and 49, the due date for Response was April 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 29, 2024.

The Center appointed C. K. Kwong as the sole panelist in this matter on May 10, 2024. 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, Article 29.

4. Factual Background

The Complainant, Bulgari S.p.A. (an Italian company) is in the luxury goods and hotel businesses with operations worldwide. The Complainant uses the domain names <bulgari.com> since 1998 to promote its stores and authorized retailers worldwide for its luxurious goods carrying its brand and the domain name <bulgarihotels.com> since 2001 to promote its hotel business with operations in Europe and Asia including Shanghai and Beijing.

The Complainant is the owner of numerous trademarks consisting of or comprising the word “Bulgari”. These registrations include the following international trademark registrations:

- 1) International Trademark Registration No. 1700602 for the mark BULGARI registered on July 25, 2022, in respect of goods and services under International Classes 9, 14, 18, 41, and 42 with protection extended to, inter alia, China.
- 2) International Trademark Registration No. 543321 for the mark BVLGARI registered on October 11, 1989, in respect of goods and services under International Classes 3, 8, 11, 14, 16, 18, 20, 21, 25, and 34 with protection extended to, inter alia, China.

The evidence produced by the Complainant shows its registrations for the mark BULGARI well before the registration of the disputed domain name <bulgarishanghai.cn> on September 19, 2023.

The disputed domain name resolves to an active website, allegedly offering to Internet users the opportunity to book rooms at the Complainant’s hotel in Shanghai. The Panel notes through its visit to the website that the bottom of the home page includes a fine print disclaimer indicating it is not the official website of Bulgari Hotel Shanghai.

Other than the particulars shown in the printout of the database searches conducted by the Complainant on the WhoIs Database (as provided in Annex 1 to the Complaint) and the screenshot of the website to which the disputed domain name resolves (as provided in Annex 15 to the Complaint) and the other domain name registrations of the Respondent as shown in Annex 17 to the Complaint, there is no other evidence concerning the background of the Respondent and its businesses or activities.

5. Parties’ Contentions

A. Complainant

The Complainant has made the following contentions.

The Complainant was founded in 1884 and now has more than 300 retail locations worldwide. Its trademark BVLGARI/BULGARI is derived from its founder’s surname, Sotirio “Voulgaris”, with BVLGARI being the phonetic conversion of the surname in Italian. The Complainant’s trademark is written both in the classical Latin alphabet as BVLGARI and in the modern alphabet as BULGARI. The Complainant also uses their BULGARI trademark as part of their company logo to distinguish their goods and services from their competitors.

The Complainant has spent a substantial amount of time, money and effort in promoting, marketing, and using the BULGARI trademarks to identify and distinguish their services domestically and internationally. The BULGARI trademarks are known worldwide and have customers who rely on the quality of the brand. The BULGARI trademark is distinctive and exclusively refers to the Complainant’s goods and services.

Information about the Complainant, its BULGARI trademarks and businesses using the BULGARI trademark is available in the public domain and can be accessed by any third parties through online tools, social media and news articles including those circulated in Asia including in China.

The disputed domain name is confusingly similar to the Complainant's registered trademark BULGARI. The disputed domain name features the mark BULGARI in its entirety. The addition of the geographical term "Shanghai" does not alter the overall impression on customers but adds to the confusion as the Complainant has a hotel operation in Shanghai.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. It does not have any application or registration for the trademark BULGARI or evidence to show that the Respondent is commonly known by the disputed domain name or BULGARI. The Complainant has not licensed the Respondent to use the BULGARI trademark.

The Respondent registered the disputed domain name for the purpose of confusing unsuspecting Internet users and tries to offer booking reservations of the Complainant's hotel for commercial gain. The Respondent has used the disputed domain name to host a website, purporting to offer Internet users the service or opportunity to book rooms at the Complainant's hotel in Shanghai (Annex 15 to the Complaint). This is not an offering of goods and services in good faith.

The Complainant's trademark registrations covering the jurisdiction of China predates the creation date of the disputed domain name for many years. The hotel services offered by the Complainant are present in Shanghai, China which suggests that the Respondent registered the disputed domain name with the Complainant's brand in mind when registering the disputed domain name by combining the Complainant's trademark BULGARI and the name of the famous Chinese city of Shanghai, where the Complainant has a high-profile hotel operation.

The Respondent did not reply or provide an explanation of its registration of the disputed domain name in response to a cease and desist letter sent by the Complainant's representatives on November 3, 2023 (Annex 16 to the Complaint).

The Respondent has registered many domain names of third-party brands such as <fourseasons-hotel.cn>, <sheratonhotelshenzhen.cn>, <hyattchangshahotel.cn> and <jwmarriotthotelqufu.cn> incorporating trademarks corresponding to the marks of the four popular hotel chains, namely Four Seasons, Sheraton, Hyatt and JW Marriott.

The Respondent registered and is using the disputed domain name for the purposes of disrupting the Complainant's business and creating confusion with the Complainant's mark. Indeed, its website allows users to allegedly book rooms with "guaranteed room", "lowest price" and "direct booking" from the Complainant's hotel in Shanghai (Annex 15 to the Complaint). The Respondent also used pictures and logo of the Complainant without authorization on the website to which the disputed domain name resolves, which are copyrighted materials exclusively owned by the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issues

A. Notice of the Proceedings

On March 28, 2024, the Center forwarded the Notification of Complaint and Commencement of Administrative Proceedings to the Respondent, using the contact details including those found in the Complaint, Whois, and Registrar Verification. The said notification was sent, inter alia, by email as per the said contact particulars with copies to the Complainant and the Registrar. The Written Notice was also sent

by courier service to the postal address of the Respondent.

In the circumstances, the Panel finds that the Respondent has been properly notified. As long as the Center communicated with the Respondent using the contact information which the Respondent has chosen to provide to the Registrar as reflected in the above contact details and the contact information of the Respondent provided in the Complaint, its notice obligations will be discharged, and the Respondent is bound accordingly.

The Panel has also noted the Center also informed the Respondent of these proceedings on March 28, 2024, through the Registrar's online Whois contact form. It has also used the message board at the hotel booking website to which the disputed domain name resolves, to notify the Respondent of these proceedings. All such notifications appear to have been successfully sent.

The Panel is satisfied that the Center has discharged its responsibility under the Rules and the WIPO Supplemental Rules to employ reasonably available means calculated to achieve actual notice of the Complaint to the Respondent.

B. Language of the Proceedings

In its Complaint filed on March 20, 2024, the Complainant requested that English to be the language of the proceedings in this case.

In accordance with Article 6 of the Policy, Article 8 of the Rules and Article 18 of the WIPO Supplemental Rules, unless otherwise agreed by the parties, or determined by the Panel under exceptional circumstances, the language of the administrative proceeding shall be Chinese. The Panel may order that any documents submitted in language is other than Chinese be accompanied by its translation in whole or in part into Chinese.

In support of its request, the Complainant has, inter alia, argued that:

- (a) The Respondent has English capability. The contents to which the disputed domain name resolves to is in English.
- (b) The Respondent has registered numerous domain names using English words, such as <fourseasons-hotel.cn> and <sheratonhotelshenzhen.cn>.
- (c) Translation from English into Chinese would add considerable costs to the Complainant and will cause a delay.

The Panel has taken into consideration the following facts:

- (a) The disputed domain name consists of English alphabets.
- (b) There was express notification by the Center to the Parties on March 28, 2024 ("Notification of Complaint and Commencement of Administrative Proceeding") by email to the Respondent (in both the English and the Chinese languages) specifically addressing the issue of language of the proceedings, drawing the Respondent's attention to Article 8 of the Rules and inviting the Respondent to make comments on that.
- (c) Notwithstanding the above-mentioned communication, the Respondent has made no objection to the use of English as the language for these proceedings at any material time despite opportunities given to comment and/or object.
- (d) The Respondent has chosen not to file any response despite bilingual notifications of these proceedings by the Center which would have clearly conveyed to the Respondent the nature of these

proceedings and the remedies sought. Yet, the Respondent has not taken up the opportunity to raise any ground of objections or defence.

(e) The disputed domain name resolves to a website in both Chinese and English.

(f) Translation of documentation under these circumstances would be disproportionate to the interest of disposing of the dispute in a costs effective and speedy way.

In exercising its discretion to use the language other than Chinese, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties considering all relevant circumstances of the case including matters such as the party's abilities to understand and use of the proposed language, time, and costs.

Taking all the circumstances into account, the Panel is satisfied that there is no prejudice or unfairness to the Respondent for these proceedings to be conducted in English and for its decision to be rendered in English. Accordingly, the Panel determines that the language of the administrative proceedings should be English.

6.2 Substantive Issues

In rendering its decision, the Panel should adjudicate the dispute in accordance with Article 31 of the Rules which provides that, "[t]he Panel shall conduct the proceedings in such manner as it considers appropriate according to these Rules and Supplemental Rules and decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, as well as any rules and principles of law which it deems applicable. If a Respondent does not submit a response, the Panel shall, in the absence of exceptional circumstances, decide the dispute based upon the complaint". Article 35 of the Rules further provides that, "[i]f a Party, in the absence of exceptional circumstances, does not comply with any provisions of, these Rules and Supplemental Rules or any requests from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate".

The failure of the Respondent to respond does not automatically result in a favourable decision for the Complainant. Under Article 8 of the Policy, support of a complaint is conditional on establishing each of the three elements as provided therein.

The said three elements are considered below.

A. Identical or Confusingly Similar to the Complainant's Name or Mark in which the Complainant has Civil Rights or Interests

On the evidence available, the Panel has no hesitation in finding that the Complainant has rights in the trademark BULGARI by reason of the trademark registrations recited in Section 4 above.

Furthermore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark BULGARI.

The disputed domain name entirely incorporates the Complainant's BULGARI trademark. Despite addition of "shanghai" and being followed by the country code Top-Level Domain ("ccTLD") ".cn", the Complainant's BULGARI mark remains clearly recognizable in the disputed domain name. It is well-established practice to disregard the ccTLD parts of a domain name, when assessing whether a domain name is identical or confusingly similar to the mark in issue.

Accordingly, the Panel finds that the first element of Article 8(a) of the Policy is established.

B. Rights or Legitimate Interests

The Complainant needs to establish a prima facie case showing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Once such prima facie case is made, the burden will shift to the Respondent to come forward with relevant evidence proving that it has rights or legitimate interests in the disputed domain name.

The Complainant has confirmed that it has not licensed the Respondent to use the mark BULGARI.

There is no explanation on the record as to why it was necessary for the Respondent to adopt the term “Bulgari” in the disputed domain name.

There is no evidence before the Panel to suggest that the Respondent is commonly known as the disputed domain name.

There is also no evidence available to demonstrate any legitimate noncommercial or fair use of the disputed domain name by the Respondent. The Complainant has put forward a very strong prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent. Furthermore, the fact that the Complainant has a luxurious hotel operation in Shanghai under or by reference to its name or mark BULGARI and the Respondent’s purported booking service to secure rooms in the Complainant’s hotel makes the composition of the disputed domain name carries a risk of implied affiliation with the Complainant.

Accordingly, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name. The Complaint has satisfied Article 8(b) of the Policy.

C. Registered or Used in Bad Faith

The Complainant has filed for registration of its BULGARI trademark since at least 1989 as claimed in the aforesaid International Trademark Registrations and has been using it many years before the registration of the disputed domain name by the Respondent. Such use includes the use of the domain names <bulgari.com> and <bulgarihotels.com> for the operation of the Complainant’s official websites.

The Complainant has alleged that the Respondent’s conduct of providing purported hotel booking services amounts to impersonation of the Complainant’s identity. It has expressed fear of consumer’s credit card details being abused when they are obtained by the Respondent to secure “guaranteed room”, “lowest price” and “direct booking” which directly disrupt the Complainant’s business. These are serious allegations. Notwithstanding that, the Respondent has not come forward with any defense on its choice of adopting the word “bulgari”, which entirely incorporates the Complainant’s word mark BULGARI in the disputed domain name.

The incorporation of the rather distinctive word “bulgari” as created by the founder of the Complainant as part of the disputed domain name without any explanation under the above circumstances, the prior substantial use of the Complainant’s BULGARI mark and the information of the Complainant’s hotel on the website at the disputed domain name lead to the conclusion that the Respondent must have been aware of the existence of the Complainant and its trademark BULGARI at the time of the registration of the disputed domain name.

The disputed domain name resolves to an active website for hotel booking services referring to Bulgari, being the Complainant’s mark, which is rather distinctive and well known. Further, there is use of photos and contents in which the Complainant claims copyright. Although the bottom of the home page at the disputed domain name includes a fine print disclaimer indicating it is not the official website of Bulgari Hotel Shanghai, under the overall circumstances of this case, the Panel finds that the mere existence of such disclaimer cannot cure the Respondent’s bad faith. Moreover, the Respondent has failed to submit a response or to provide any evidence of actual or contemplated good-faith use of the disputed domain name.

The Panel finds that the circumstances under Articles 9(c) of the Policy have been established.

Accordingly, the Panel finds that the disputed domain name has been registered and used in bad faith. The Complaint has satisfied Article 8(c) of the Policy.

7. Decision

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

/C. K. Kwong/

C. K. Kwong

Sole Panelist

Date: May 24, 2024