

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. Ali Sabir, Gulf Visa Services
Case No. D2023-2328

1. The Parties

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

The Respondent is Ali Sabir, Gulf Visa Services, United Arab Emirates.

2. The Domain Name and Registrar

The Disputed Domain Name <bulgarihotelsdubai.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 May 30, 2023. On May 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 31, 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 for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 1, 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 on June 1, 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 the Respondent of the Complaint, and the proceedings commenced on June 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 23, 2023.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on June 28, 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 and is known for its high-end luxury goods and jewelry business with retail locations across the globe. The Complainant also operates a hotel business since 2001 under its joint venture with the Luxury Group, with hotel locations in, *inter alia*, Dubai, London, Beijing, Milan, Bali, and Paris. The Complainant uses “BVLGARI” as a brand name, which is the Complainant’s company name “BULGARI” in classic latin alphabet.

The Complainant owns a number of trademarks registrations for or containing “BULGARI” / “BVLGARI” (both “the Complainant’s Trademark”) around the globe. The relevant trademarks include, *inter alia*, International Trademark Registration No. 452694 in classes 11, 14, 20, and 21 registered on May 15, 1980, Australia Trademark Registration No. 338663 in class 14 registered on October 5, 1979, China Trademark Registration No. 341625 in class 25 registered on February 10, 1988, and China Trademark Registration No. 15659745 in class 3 registered on December 28, 2015.

The Complainant’s Trademark is also fully incorporated in the Complainant’s domain name <bulgari.com>, which resolves to the Complainant’s website at “www.bulgari.com” (the “Complainant’s Website”).

The Disputed Domain Name was registered on January 18, 2023, which is over 43 years after the Complainant first registered the Complainant’s Trademark. The Disputed Domain Name only resolves to an inactive webpage which displays a message stating “Connection timed out”.

5. Parties’ Contentions

A. Complainant

The Complainant’s primary contentions can be summarized as follows:

- (a) The Disputed Domain Name is confusingly similar to the Complainant’s Trademark. The Complainant’s Trademark is reproduced in its entirety. Apart from the Complainant’s Trademark, the remaining elements in the Disputed Domain Name are the terms “hotels” and “dubai”, which do not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant’s Trademark. The generic Top Level Domain (“gTLD”) extension, “.com” in the Disputed Domain Name also does not distinguish it from the Complainant’s Trademark.
- (b) The Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not obtained any authorization from the Complainant to use the Complainant’s Trademark as part of a domain name or otherwise. The Respondent is not known by the Disputed Domain Name. Moreover, the Disputed Domain Name is not being used in relation to a *bona fide* offering of goods or services and the Respondent is not making legitimate or fair use of the Disputed Domain Name.
- (c) Both the Respondent’s registration and use of the Disputed Domain Name establish the Respondent’s bad faith. Given the history of the BVLGARI brand and reputation that the Complainant has acquired in the Complainant’s Trademark, the Respondent must have been fully aware of the existence of the Complainant’s rights in the Complainant’s Trademark when the Respondent registered and used the Disputed Domain Name. The Disputed Domain Name resolves to a webpage with no activity and amounts to passive holding. In addition, the Complainant notes that the Respondent has activated mail exchange (MX) records for the Disputed Domain Name, which may indicate that the Respondent intends to engage in or has engaged in a phishing activities. Moreover, the Complainant sent a cease-and-desist letter to the Respondent on February 27, 2023 (the “Cease-and-desist Letter”) requesting the Respondent to, *inter alia*, transfer the Disputed Domain Name to the Complainant, to which the Respondent had failed to respond. In so doing, the Respondent’s actions amounted to bad faith.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (i) The Disputed Domain Name is identical or confusingly similar to a trademark 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 by the Respondent in bad faith.

A. Identical or Confusingly Similar

The Panel accepts that the Complainant has rights in the Complainant's Trademark, based on its various trademark registrations listed in Section 4.

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety with the addition of the terms "hotels" and "dubai". UDRP panels have consistently found that the addition of other terms to a mark (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element. See Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Panel therefore agrees with the Complainant that the additional terms in the Disputed Domain Name do not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's Trademark.

Furthermore, it is well established that the gTLD extension, ".com" in this case, may be disregarded. See 1.11 of the [WIPO Overview 3.0](#).

As such, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademark, and accordingly, paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

The Panel accepts that the Complainant has not authorized the Respondent to use the Complainant's Trademark. There is no relationship between the Complainant and the Respondent, which would otherwise entitle the Respondent to use the Complainant's Trademark. Accordingly, the Panel is of the view that a *prima facie* case has been established by the Complainant and it is for the Respondent to show rights or legitimate interests in the Disputed Domain Name.

Once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent in a disputed domain name, the respondent then carries the burden of demonstrating that it has rights or legitimate interests in the disputed domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent did not submit a formal Response. The fact that the Respondent did not submit a formal Response does not automatically result in a decision in favor of the Complainant. However, the Respondent's failure to file a formal Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing

from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) Before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) The Respondent has been commonly known by the Disputed Domain Name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel agrees with the Complainant that there is no evidence to show that the Respondent has trademark rights corresponding to the Disputed Domain Name, or that the Respondent has become known by the Disputed Domain Name.

The Disputed Domain Name resolves to an inactive webpage which displays the message "Connection timed out". There is therefore no evidence to suggest that the Respondent has used, or has made any demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed Domain Name. Neither is there evidence to suggest that the Respondent is making legitimate, noncommercial or fair use of the Disputed Domain Name, without the intent to misleadingly divert Internet users from the Complainant's Website and/or services. The Panel also notes that the nature of the Disputed Domain Name, which incorporates the Complainant's Trademark in its entirety with the addition of a dictionary and a geographical term, carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety. After reviewing the supporting evidence submitted by the Complainant, the Panel agrees that the Complainant's Trademark appears to be well-known. A quick Internet search conducted by the Panel shows that the top search results returned for the keywords "BULGARI" and "BVLGARI" are the Complainant's Website and third-party websites providing information about the Complainant and/or its products or services. Therefore, the Panel agrees that the Respondent must have been aware of the Complainant and its rights in the Complainant's Trademark when registering and using the Disputed Domain Name.

The Disputed Domain Name resolves to an inactive website. This does not prevent a finding of bad faith under the doctrine of passive holding. See section 3.3 of the [WIPO Overview 3.0](#). The Panel finds that the following factors support a finding that the Disputed Domain Name was registered and has been used by the Respondent in bad faith:

- (i) The Complainant's Trademark appears to be well-known.
- (ii) Based on the Respondent's use of the Complainant's Trademark with the terms "hotels" and "dubai", the Disputed Domain Name clearly refers to the hotel which the Complainant operates in Dubai. This indicates that the Respondent must have been aware of the Complainant and the Complainant's

Trademark when registering the Disputed Domain Name (see *Dansko, LLC v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-0425](#)).

- (iii) The fact that the Respondent has activated mail exchange (MX) records for the Disputed Domain Name indicates that the Respondent could potentially use the Disputed Domain Name for fraudulent schemes such as email scams (see *ZipRecruiter, Inc. v. Nguyen Van Hieu, Van Hieu*, WIPO Case No. [D2023-0543](#)).
- (iv) The Complainant's Trademark is used as if it was the domain name of the Complainant's Website.

The Panel also notes that the Respondent failed to respond to the Complainant's Cease-and-desist Letter and its contentions in the proceedings. The Respondent has provided no evidence of any actual or contemplated *bona fide* use of the Disputed Domain Name. This further supports a finding of bad faith registration and use of the Disputed Domain Name.

In the circumstances, the Panel finds that the Respondent registered and is using the Disputed Domain Name in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

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, <bulgarihotelsdubai.com> be transferred to the Complainant.

/Gabriela Kennedy/

Gabriela Kennedy

Sole Panelist

Date: July 12, 2023