

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. Martin, Spain.
Case No. D2023-4755

1. The Parties

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

The Respondent is Martin, Spain.

2. The Domain Names and Registrar

The disputed domain names <bulgariresortdubai.com> <bulgariresortdubai.info> <bulgariresortdubai.net> and <bulgariresortdubai.org> are registered with Arsys Internet, S.L. dba NICLINE.COM (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2023. On November 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 27, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (N/A) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 28, 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 December 12, 2023.

On November 28, 2023, the Center informed the parties in Spanish and English, that the language of the registration agreement for the disputed domain names is Spanish. On November 30, 2023, Respondent requested the proceeding to be in Spanish. On December 1, 2023, the Complainant requested English to be the language of the proceeding.

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 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 28, 2023. The Center informed the parties about the commencement of panel appointment process on January 6, 2024.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on January 11, 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, paragraph 7.

4. Factual Background

The Complainant, Bulgari S.p. A, is an Italian company founded in 1884 by Sotirios Voulgaris, headquartered in Rome, Italy. The Complainant operates in the luxury goods and hotel markets and is particularly known for its high-end jewelry including but not limited to watches, rings, necklaces, and fragrance products that has been enjoying of a very privileged presence all around the world.

The Complainant opened its first international locations in New York City, Paris, Geneva, and Monte Carlo in the 1970s.

In the present, the Complainant has more than 230 retail locations worldwide.

The Complainant's trademark is written as both BVLGARI (in the classic Latin alphabet) and BULGARI (in the modern alphabet) the BULGARI name derives from the founder's name ('Voulgaris'). The Complainant submits that the terms BULGARI and BVLGARI are often used synonymously, although traditionally BULGARI is used in relation to the company name (Bulgari S.p.A), whilst BVLGARI relates to the trademark name.

The Complainant's success in Rome, has permitted the store to become a popular meeting place for movie stars and socialites, amplifying the international reputation of the trademark.

The BVLGARI/BULGARI trademarks are well advertised globally, with promotional videos, billboards, and other sources of marketing material, which has further promoted the trademark's global recognition for high-end jewelry and accessories.

As a further indication of the Complainant's success, the BVLGARI/BULGARI trademarks and its products have been used by many celebrities at high-profile events such as the Oscars and Premieres.

The Complainant has also operated several hotels since 2001, which was the result of a joint venture between Bulgari S.p.A and the Luxury Group, a division of Marriot International that also manages Ritz-Carlton hotels. The Complainant's hotels can be found in major locations across the globe such as London, Beijing, Milan, Bali, Dubai, and Paris, and resorts scheduled to open, such as Miami Beach, Los Angeles, and Ranfushi.

The Complainant holds a number of registered trademarks for the BVLGARI and BULGARI term within numerous jurisdictions, some of which are exhibited below:

Trademark	County	Registration Number	Registration Date	Class(es) covered
BULGARI	Australia	338663	October 5, 1979	14
BULGARI	United States of America	1184684	January 5, 1982	14
BULGARI	International	452694	May 15, 1980	11,14, 20, 21

BULGARI	Mexico	503494	September 09, 1995	9, 40, 42
BVLGARI	Canada	TMA 312178	March 03, 1986	14, 21, 26
BVLGARI	International	494237	July 05, 1985	3, 8, 11, 14, 16, 18, 20, 21, 25, 34
BVLGARI	Italy	0000984147	November, 18 2005	25, 34, 38, 41
BVLGARI	European Union	007138101	June 03, 2009	35, 36, 41, 43

The Complainant submitted enough evidence of the above-mentioned trademark registrations.

According to the Complaint, the Complainant has spent a substantial amount of time, money, and effort in promoting, marketing and using the BULGARI/BVLGARI trademarks to identify and distinguish its services domestically and internationally. Consequently, the BVLGARI/BULGARI trademarks have acquired distinctiveness in the market worldwide and have customers who rely on the trademark's name and quality.

The Complainant registered the domain name of its official website, "www.bulgari.com", on February 17, 1998 and has had a strong web presence since that date. The Complainant's official website, which receives over two million visits per month from users around the world and enables access to all product lines: jeweler, watches, fragrances, leather goods and accessories.

In the website, the Internet users are also able to locate the Complainant's stores and authorized retailers worldwide.

The disputed domain names are:

disputed domain names	Registration date
<bulgairesortdubai.info>	May 01, 2023
<bulgairesortdubai.com>	May 01, 2023
<bulgairesortdubai.net>	May 01, 2023
<bulgairesortdubai.org>	May 01, 2023

The disputed domain names resolve to a parked page.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for all of the disputed domain names to be transferred.

Notably, the Complainant contends that the disputed domain names are confusingly similar to the trademarks BULGARI/BVLGARI in which the Complainant has rights. The four disputed domain names incorporate the BULGARI trademark with the addition of the descriptive English term "resort" and the geographical term "Dubai".

It is a general consensus that where the relevant trademark is recognizable within a domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The generic Top-Level Domains ("gTLDs") ".info", ".com", ".net", ".org" should be disregarded as it is a standard registration requirement.

The Complainant made the following contentions to establish that the Respondent has no rights or legitimate interests in respect of the disputed domain names. To the best of the Complainant's knowledge, the Respondent has not obtained any trademark registrations for the term BULGARI or BVLGARI, and there is no evidence that the Respondent holds any unregistered right to the terms BULGARI or BVLGARI. The Respondent has not received any license from the Complainant to use a domain name that features the BVLGARI trademark, and all active trademark registrations for BVLGARI are held by the Complainant.

The Respondent is not known, and never has been known, as "BVLGARI" or "BULGARI". The BULGARI/BVLGARI trademark is distinctive and not used in commerce other than by the Complainant. The Respondent has no connection or affiliation with the Complainant and has not received any license or consent to use the Complainant's trademark in any way. The disputed domain names are not active; therefore, the Respondent is not making a legitimate non-commercial or fair use of the disputed domain names, without intent for commercial gain.

The Complainant made the following contentions to establish that the disputed domain names were registered and are being used in bad faith. The Complainant's earliest BVLGARI trademark registration predates the creation date of the disputed domain names by at least 40 years, and the Complainant has accrued substantial goodwill and recognition since the Complainant's establishment in 1884. The choice of the disputed domain names, incorporating the Complainant's trademark and the English term "resort" and the geographical indicator "Dubai" along with the Complainant's trademark which operates in Europe and in Dubai, shows that the Respondent was well aware of the Complainant at the time of registration.

On July 5, 2023, the Complainant sent a cease-and-desist letter to the Respondent giving the Respondent the opportunity to provide evidence of any actual or contemplated good faith use of the disputed domain names, but the Respondent chose not to respond. The Respondent's use of the disputed domain names for inactive websites constitutes bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions, in the Respondent's informal communication of November 2023 he only argues about the language of the proceeding. No further communications were received from the Respondent following the formal commencement and notification of the Complaint.

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain names is Spanish. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English and the registration agreement is in Spanish. The Complainant requested that the language of the proceeding to be English.

On the date November 30, 2023, the Respondent sent an informal email in Spanish to the Center, indicating that the proceeding should be in Spanish due to the fact that he does not understand English, and that the language of the domain name registration agreement is Spanish.

The Panel considers the following assertions of the Complainant:

- The Complainant requests that the language of the proceedings to be English, as neither the Complainant nor its representatives are familiar with the Spanish language. The Complainant's representatives are based in the UK, and requiring a translation would result in the incurrence of additional expenses and unnecessary delay.
- Although the language of the Registration Agreements of the disputed domain names is Spanish, the Respondent is the holder of the disputed domain names, which compromises common English-language word such as "resort" and the country name "Dubai". Accordingly, the Respondent appears to have some understanding of the English language.
- The Complainant would be unduly disadvantaged by having to conduct the proceeding in Spanish. The Complainant also refers to Paragraphs 10(b) and (c) of the Rules, the latter of which requires the Panel to ensure the administrative proceeding takes place with due expedition. The Complainant reiterates that requiring it to translate the Complaint into Spanish would create an undue burden and delay.

The Center's communications and the notification of the Complaint were sent in both languages English and Spanish and despite allowing for the submission of the Response in Spanish, the Respondent did not submit any further communications than its informal email of November 30, 2023, nor replied to the Complainant's contentions.

The Respondent registered the disputed domain names including the English term "resort" and the geographical name "dubai". The Panel accepts the Complainant's arguments as summarized above as sufficient to justify that the language of the proceedings should be English.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such carefulness judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs, see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1.

Having considered all the matters above, and especially that the Respondent did not reply to the Complainant's contentions, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

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 names. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7. In the present case the four disputed domain names include the Complainant's trademark BULGARI and the addition of the English term "resort" and the geographical name "Dubai".

The Complainant has shown rights in respect of their BULGARI/BVLGARI trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the trademark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms such as "resort" and "Dubai" may bear on the assessment of the second and third elements, the Panel finds that the addition of such terms does not prevent a finding of confusing similarity between each of the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The four disputed domain names consist in the reproduction of the trademark BULGARI with the addition of the English term “resort” and the geographical name “dubai” and the gTLD. Once the gTLDs: “.info, com, net, and org” are ignored (section 1.11.1 of the [WIPO Overview 3.0](#)), the disputed domain names consist of the Complainant’s registered word trademark BULGARI, followed by the English term “resort” and the geographical name “Dubai”. The Complainant’s trademark BULGARI is clearly recognizable within the four disputed domain names.

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 names. 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 names such as those enumerated in the Policy or otherwise.

To the best of the Complainant’s knowledge, the Respondent has not registered any trademarks for the term BULGARI, and there is no evidence that the Respondent holds any unregistered right to the term BULGARI. Moreover, the Respondent has not received any license from the Complainant to use domain names that feature the BULGARI trademark. All active trademarks for the term BULGARI are held by the Complainant.

According to the Paragraph 4(c) of the Policy stipulates the circumstances where the Respondent can demonstrate a right or legitimate interest in a domain name. The Complainant argues that none of the circumstances apply in this case. “(i) Before any notice of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services.” In the present case the Complainant argues that the disputed domain names do not currently resolve to any content, despite being registered over six months ago. Panels have held in numerous cases that a “Respondent’s failure to use the domain names in connection with a *bona fide* offering of goods or services or legitimate noncommercial or fair use further demonstrates lack of rights or legitimate interests in the domain name”.

The fact that the disputed domain names are not active shows that the Respondent is not using the disputed domain names in connection with an offering of goods and services in good faith.

The Complainant further asserts that there is no evidence of demonstrable preparations to use the disputed domain names in good faith. “(ii) The Respondent (as an individual, business or other organization) has been commonly known by the disputed domain names, even if the Respondent has acquired no trademark or service mark rights.”

The Complainant argues that the Respondent is not known, nor has it ever been known as BULGARI. The BULGARI trademark is distinctive and not used in commerce other than by the Complainant. Therefore, there is no plausible reason for the registration of the disputed domain names other than to take advantage of the goodwill and valuable reputation attached to the BULGARI trademark, as the Respondent has no connection or affiliation with the Complainant and has not received any license or consent to use the Complainant's trademark in any way. Prior Panels have held that in the absence of any license or permission from the Complainant to use its trademark, no actual or contemplated *bona fide* or legitimate use of the disputed domain names could be reasonably claimed.

Clearly, the mere ownership of one or more domain names does not confer rights or legitimate interests on the Respondent (see, for example, *National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., a/k/a chargergirls.net*, WIPO Case No. [D2000-0118](#)).

There is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain names. With respect to the current passive holding of the disputed domain names, UDRP panels have established that a respondent does not satisfy a legitimate interest under paragraph 4(c)(iii) where a domain name is not being actively used (see, for example, *Instagram, LLC v. Nezh Akhun*, WIPO Case No. [D2020-1721](#)). In the present case, the Complainant has presented a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names for the purposes of Paragraph 4(a)(ii) of the Policy.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names and that 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.

According to the paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and 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. See section 3.2.1 of the [WIPO Overview 3.0](#).

In the present case, the Panel notes that the Respondent registered four domain names that incorporate a well-known trademark BULGARI. Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and 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 Panel also finds that the Complainant's earliest BULGARI trademark registration predates the creation date of the disputed domain names by at least 40 years. In addition, the Complainant has accrued substantial goodwill and recognition since the Complainant's establishment in 1884 the BVLGARI/BULGARI name has become synonymous with high-end and stylistically unique luxury jewelry, watches, accessories and luxury hotels and as it was previously stated, the trademark name is inspired on the name of their founder, so is fair to say is a very distinctive and personal name directly linked to the history of the trademark, this one not being common. Moreover, it has been accepted in past decisions that the selection of domain names that is so obviously connected to a complainant's trademark strongly suggests 'opportunistic bad faith', particularly where it is held by someone with no affiliation with the complainant (see *Singapore Airlines Ltd v. European Travel Network*, WIPO Case No. [D2000-0641](#)).

Panels have found that the non-use of a domain name including a blank or "coming soon" page would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the

circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

Moreover, the Complainant submits that a cease-and-desist letter was sent to the Respondent on July 5, 2023 for the disputed domain names. This notice was sent in order to put the Respondent on notification of the Complainant's trademark rights and with a view of resolving the matter amicably. Previous Panel decisions have stated that a lack of reply to a cease-and-desist letter prior to commencing the proceedings infers bad faith behavior (see *Facebook, Inc. and Instagram, LLC v. C W / c w, c w*, WIPO Case No. [D2018-1159](#)). The Respondent was given the opportunity to provide evidence of any actual or contemplated good faith use but chose not to respond to the Complainant's contentions. This can also be considered evidence of bad faith.

The Panel notes that the Respondent has engaged in a pattern of conduct and registered four domain names, targeting the same trademark, BULGARI, that display the same Arsys parking page, that were registered on the same day. This is also evidence of bad faith registration and use of the disputed domain names. Under the policy, in order to establish a pattern of conduct, the respondent must infringe on a single's owner's rights with multiple registrations or have a history of multiple registrations involving a diversity of trademarks (see [WIPO Overview 3.0](#), section 3.1.2).

Based on the available record, 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 names <bulgariresortdubai.com>, <bulgariresortdubai.info>, <bulgariresortdubai.net>, and <bulgariresortdubai.org> be transferred to the Complainant.

/Ada L. Redondo Aguilera/

Ada L. Redondo Aguilera

Sole Panelist

Date: January 25, 2024