

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A v. Fang Miao
Case No. D2022-3905

1. The Parties

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

The Respondent is Fang Miao, China.

2. The Domain Name and Registrar

The disputed domain name <bvlgari-us.xyz> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 18, 2022. On October 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 20, 2022, 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 (Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 21, 2022, 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 October 25, 2022.

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 November 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 22, 2022.

The Center appointed Andrew F. Christie as the sole panelist in this matter on November 30, 2022. 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 by Sotirios Voulgaris. 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 for its fragrance products. It opened its first international locations in the 1970s, and today has more than 230 retail locations worldwide. The “Bulgari” name derives from the founder’s name, “Voulgaris”.

The Complainant’s trademark is written as both BVLGARI (in the classic Latin alphabet) and BULGARI (in the modern alphabet). 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 brand name.

The Complainant, its affiliates, subsidiaries and associated companies own registrations for the trademarks BVLGARI and BULGARI within numerous jurisdictions. These include United States of America (“United States”) Trademark Registration No. 1184684 (registered on January 5, 1982) for the word trademark BULGARI, and International Trademark No. 494237 (registered on July 5, 1985) for the word trademark BVLGARI, both of which are currently registered in the name of the Complainant.

The Complainant registered the domain name <bulgari.com> on February 17, 1998, and has used it since that date to develop a strong web presence. The Complainant’s official website at “www.bulgari.com” enables Internet users both to access the Complainant’s product lines and to locate the Complainant’s stores and authorized retailers worldwide.

The disputed domain name was registered on May 6, 2022. The Complainant has provided a screenshot, taken on October 17, 2022, showing that the disputed domain name resolved to a website featuring the Complainant’s BVLGARI word trademark at the top of each page, and purportedly offering the Complainant’s BVLGARI products for sale. At the time of this decision, the disputed domain name resolves to a website that is very similar in appearance to the website shown in the Complainant’s screenshot.

5. Parties’ Contentions

A. Complainant

The Complainant made the following contentions to establish that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The disputed domain name incorporates the BVLGARI trademark with the addition of the geographical abbreviation “us”. 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 Domain (“gTLD”) “.xyz” 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 name. To the best of the Complainant’s knowledge, the Respondent has not obtained any trademark registrations for the term BVLGARI, and there is no evidence that the Respondent holds any unregistered right to the term 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 disputed domain name has been used to advertise the sale of alleged counterfeit jewelry, accessories, and beauty goods. The advertised goods are heavily discounted, and the website to which the disputed domain name resolves does not accurately and prominently disclose its relationship with the respective legitimate brand and trademark holder. It is clear that the Respondent is trying to pass itself off as the Complainant in order to advertise its own commercial fake goods. The Respondent is also attempting to solicit the personal details of deceived Internet users, as they need to input their personal information (including name, address, phone number,

email address etc.) and card details in order to place orders, and these details may be used for further illegitimate and unauthorised activities. The Respondent is not known, and never has been known, as “BVLGARI”. The 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 Respondent is not making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the BVLGARI trademark.

The Complainant made the following contentions to establish that the disputed domain name was registered and is being used in bad faith. The Complainant’s earliest BVLGARI trademark registration predates the creation date of the disputed domain name by at least 43 years, and the Complainant has accrued substantial goodwill and recognition since the Complainant’s establishment in 1884. Anyone with access to the Internet can find the Complainant’s trademark registrations on public trademark databases. The choice of the disputed domain name, incorporating the geographical indicator “us” along with the Complainant’s brand (which operates in the United States), shows that the Respondent was well aware of the Complainant at the time of registration. On June 17, 2022, 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 name, but the Respondent chose not to respond. The Respondent’s use of the disputed domain name to offer commercial, counterfeit goods reflects its intention to capitalise on the Complainant’s BVLGARI trademark for the purposes of deriving commercial gain. The Respondent does nothing to prevent confusion among Internet users. The Respondent has likely engaged in further fraudulent activity by stealing the details of any Internet user who orders through the disputed domain name’s website.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

Once the gTLD “.xyz” is ignored (which is appropriate in this case), the disputed domain name consists of the Complainant’s registered word trademark BVLGARI, followed by a hyphen and the letters “us”. The Complainant’s trademark is clearly recognizable within the disputed domain name. The addition of a hyphen and the letters “us” (which most Internet users will read as an abbreviation of the geographic location United States) does not avoid a finding of confusing similarity of the disputed domain name with the trademark. Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Respondent is not a licensee of the Complainant, is not otherwise affiliated with the Complainant, and has not been authorized by the Complainant to use its BVLGARI trademark. The Respondent has not provided any evidence that it has been commonly known by, or has made a *bona fide* use of, the disputed domain name, or that it has, for any other reason, rights or legitimate interests in the disputed domain name. The evidence provided by the Complainant shows that the disputed domain name has been used to resolve to a website displaying the BVLGARI word trademark, and purporting to offer BVLGARI products for sale at heavily discounted prices. The contents of the Respondent’s website are such that many Internet users will form the false belief that the website is operated by, or affiliated with, the Complainant. Given the confusing similarity of the disputed domain name to the Complainant’s trademark, the absence of any relationship between the Respondent and the Complainant, and the failure to avoid the implied false affiliation with the Complainant, the Respondent’s use of the disputed domain name is neither a *bona fide* use nor a legitimate non-commercial or fair use.

The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the Respondent has not rebutted this. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The disputed domain name was registered several decades after the Complainant first registered its BVLGARI word trademark. It is inconceivable that the Respondent registered the disputed domain name ignorant of the existence of the Complainant's trademark, given the renown of the Complainant's trademark, that the disputed domain name consists of the Complainant's trademark with merely the addition of a hyphen and the letters "us", and that the Respondent used the disputed domain name to resolve to a website that displays the Complainant's name and BVLGARI word trademark, and which purports to offer for sale the Complainant's goods.

Given the Respondent's lack of rights or legitimate interests in the disputed domain name and the confusing similarity of the disputed domain name to the Complainant's trademark, any use of the disputed domain name by the Respondent almost certainly implies an affiliation with the Complainant that does not exist. The Respondent's registration of the disputed domain name in these circumstances is a bad faith registration.

Furthermore, the evidence on the record provided by the Complainant indicates that the Respondent has used the disputed domain name in an attempt to attract, for commercial gain, Internet users to a website by creating confusion in the minds of the public as to an association between the website and the Complainant. The Respondent's use of the disputed domain name in this manner is a bad faith use.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

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 <bvlgari-us.xyz> be transferred to the Complainant.

/Andrew F. Christie/

Andrew F. Christie

Sole Panelist

Date: December 14, 2022