

## ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. 崔晓红 (Xiao Hong Cui)  
Case No. D2023-0243

### 1. The Parties

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

The Respondent is 崔晓红 (Xiao Hong Cui), China.

### 2. The Domain Name and Registrar

The disputed domain name <bulgarishanghai.com> (the “Disputed Domain Name”) is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”).

### 3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 19, 2023. On January 19, 2023, the Center transmitted by email to the registrar, Hefei Juming Network Technology Co., Ltd, a request for registrar verification in connection with the Disputed Domain Name. On January 30, 2023, Hefei Juming Network Technology Co., Ltd informed the Center that they checked the status of the disputed domain name and the disputed domain name was no longer registered with them. Hefei Juming Network Technology Co., Ltd also forwarded the Center’s request for registrar verification email to the Registrar on the same day. On January 30, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 30, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Center also requested the Complainant to amend the registrar information on the same day. The Complainant filed an amended Complaint in English on February 1, 2023.

On January 30, 2023, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on February 1, 2023. The Respondent did not comment on 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 in English and Chinese of the Complaint, and the proceedings commenced on February 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 26, 2023. On February 7, 2023, the Respondent sent an email to the Center indicating that the Disputed Domain Name could be transferred to the Complainant for the price of CNY 2,000. On February 7, 2023, the Center sent an email regarding possible settlement to the Parties, however, the Complainant did not request suspension in the provided period. The Respondent did not submit any formal response. The Center informed the Parties of the commencement of panel appointment process on February 27, 2023.

The Center appointed Peter J. Dernbach as the sole panelist in this matter on March 6, 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 operating in the luxury goods and hotel markets with locations worldwide.

The Complainant is the owner of BULGARI and BVLGARI series trademarks in many jurisdictions, including:

- United States of America trademark BULGARI, registration number 1184684, registered since January 5, 1982;
- International trademark BULGARI, registration number 452694, registered since May 15, 1980;
- Australia trademark BULGARI, registration number 338663, registered since October 5, 1979;
- United States of America trademark BVLGARI, registration number 1694380, registered since June 16, 1992;
- International trademark BVLGARI, registration number 494237, registered since July 5, 1985; and
- European Union trademark BVLGARI, registration number 007138101, registered since June 3, 2009.

The Disputed Domain Name <bulgarishanghai.com> was registered on April 22, 2022, and the Disputed Domain Name resolves to a website written in Chinese and English that purports to offer the Complainant's Shanghai hotel reservation services. This website also contains links redirecting Internet users to reserve hotel rooms of the Complainant's competitors.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant's submissions may be summarized as follows:

- (i) The Disputed Domain Name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights.

The Complainant is the owner of BULGARI trademarks. The Complainant argues that the Disputed Domain Name is confusingly similar to its BULGARI trademark as the Disputed Domain Name incorporates the Complainant's BULGARI trademark in its entirety. The addition of the geographical indicator "shanghai" does not diminish but rather reinforces the apparent connection between the Disputed Domain Name and

the Complainant as the Complainant's Shanghai hotel services are well known. Furthermore, the addition of the generic Top-Level Domain ("gTLD") ".com" is a standard registration requirement that can be disregarded in determining the issue of similarity.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant argues that the Respondent does not have any trademark rights to the term "Bulgari". The Respondent has not received any license or authorization from the Complainant to use the BULGARI trademark, in domain names or any other use. There is no evidence suggesting that the Respondent is commonly known by the term "Bulgari".

In addition, the Respondent has not used, nor prepared to use, the Disputed Domain Name in connection with a *bona fide* offering of goods or services. The Disputed Domain Name currently resolves to a website which purports to offer the Complainant's Shanghai hotel reservation services. The Respondent also utilizes the Disputed Domain Name to redirect Internet visitors to competitive services, which shows that the Respondent attempts to disrupt the Complainant's operations and misrepresenting others as the Complainant's offerings. Therefore, the Respondent does not satisfy the requirements for fair use.

In light of the above, the Complainant concludes that the Respondent's activities do not correspond to any of the circumstances set forth in the Policy, paragraph 4(c).

(iii) The Disputed Domain Name was registered and is being used in bad faith.

The Complainant argues that it has accrued substantial goodwill in its BULGARI trademark since 1884 and its BULGARI trademark has been registered for more than 40 years before the registration of the Disputed Domain Name. In addition, the Disputed Domain Name is confusingly similar to the Complainant's BULGARI trademark. Therefore, the Respondent registered the Disputed Domain Name in bad faith.

Moreover, by offering hotel reservation services related to the Complainant, the Respondent is using the Disputed Domain Name to attract and mislead consumers seeking to reach the Complainant's BULGARI Shanghai hotel offerings. Internet users are directed to confirm their bookings on the Respondent's website by inserting their personal information. This indicates that the Respondent is likely using the Disputed Domain Name to gather Internet users' personal information and, therefore, uses the Disputed Domain Name in bad faith.

The Complainant further argues that the Respondent's email address has been used to register other domain names that specifically targets third-party brands from the hotel and hospitality industries. This shows that the Respondent has engaged in a pattern of registering and using domain names in bad faith.

## **B. Respondent**

The Respondent did not formally reply to the Complainant's contentions. However, the Respondent sent an email in Chinese to the Center on February 7, 2023 stating that the disputed domain name could be transferred to the Complainant for the price of CNY 2,000.

## **6. Discussion and Findings**

### **6.1 Language of the Proceeding**

Paragraph 11(a) of the Rules provides that "[u]nless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

Paragraph 10(b) of the Rules provides that “[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case”; and paragraph 10(c) of the Rules provides that “[t]he Panel shall ensure that the administrative proceeding takes place with due expedition [...]”.

The language of the Registration Agreement is Chinese, and the Complaint is filed in English. On January 30, 2023, the Center notified both Parties in English and Chinese that the language of the Registration Agreement is Chinese and invited both Parties to comment on the language of the proceeding. The Complainant confirmed its request that the language of the proceeding be English while the Respondent did not make any comments on the language of the proceeding and did not submit any arguments on the merits.

The Panel has considered the following elements of this case:

- (i) the Complainant requests that the language of the proceeding to be English.
- (ii) the Disputed Domain Name resolves to a website that allows Internet users to change the language to English, which indicates that the Respondent has the ability to understand English.
- (iii) the Respondent did not comment on the language of the proceeding and did not submit arguments on the merits of this case.
- (iv) using Chinese as the language of the proceeding could lead to unwarranted delay and costs for the Complainant and unnecessary delays to the administrative proceeding.

Given the above considerations, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

## **6.2 Substantive Issues**

In accordance with paragraph 4(a) of the Policy, in order to succeed in this administrative proceeding and obtain the requested remedy (in this case, transfer of the Disputed Domain Name), the Complainant must prove that each of the three following elements are present:

- (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 in bad faith.

### **A. Identical or Confusingly Similar**

The Complainant has established that it is the owner of valid trademark rights in the BULGARI trademarks. The Disputed Domain Name is a combination of the Complainant’s BULGARI trademark, the word “shanghai”, and the gTLD “.com”. The Panel finds that the Disputed Domain Name incorporates the entirety of the Complainant’s BULGARI trademark. The addition of the geographical term “shanghai” after the BULGARI trademark does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant’s BULGARI trademark.

As found in past UDRP decisions, gTLDs may generally be disregarded when evaluating the identity or confusing similarity between the disputed domain name and the complainant’s trademark. In the current case, the inclusion of the gTLD “.com” does not prevent the confusing similarity between the Disputed Domain Name and the Complainant’s BULGARI trademark.

For the reasons above, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark.

## **B. Rights or Legitimate Interests**

Paragraph 4(a)(ii) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative-dispute-resolution service provider], in compliance with the Rules of Procedure, that [...] (ii) [the respondent has] no rights or legitimate interests in respect of the [disputed] domain name[.]”

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, the Disputed Domain Name, for the purposes of paragraph 4(a)(ii) of the Policy:

“(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] (as an individual, business, or other organization) [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.”

Pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy, the Complainant is required to first establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The burden of production would then shift to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name.

The Complainant states that it has neither licensed nor authorized the Respondent to use the Complainant's BULGARI trademark in a domain name. According to the information provided by the Registrar, the Respondent's name, “崔晓红 (Xiao Hong Cui)”, does not appear to be related to the Disputed Domain Name. There is no evidence suggesting that the Disputed Domain Name is being used in connection with a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use. Moreover, the Disputed Domain Name currently resolves to a website purporting to offer the Complainant's Shanghai hotel reservation services. Although the bottom of the website contains a fine print disclaimer that “they are not the official website of the hotel”, the website also offers hotel reservation services provided by the Complainant's competitors. This is not a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, and the burden of production shifts to the Respondent. The Respondent has not submitted any argument or evidence in response.

Moreover, the nature of the disputed domain name carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.

Therefore, the Panel concludes that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

## **C. Registered and Used in Bad Faith**

Paragraph 4(a)(iii) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative dispute resolution service providers], in compliance with the Rules of Procedure, that [...] (iii) [the respondent's]

domain name has been registered and is being used in bad faith”.

Paragraph 4(b) of the Policy explicitly states, in relevant part, that “the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location.

The Complainant's BULGARI trademarks have been registered in many jurisdictions and have become well known before the registration of the Disputed Domain Name. The Disputed Domain Name is confusingly similar to the Complainant's BULGARI trademark and contains the Complainant's trademark in its entirety.

Moreover, the use of the Disputed Domain Name points to the Respondent's knowledge of the Complainant and its trademarks. The Panel therefore finds that the Disputed Domain Name has been registered in bad faith.

The Disputed Domain Name currently resolves to a website offering the Complainant's Shanghai hotel reservation services as well as the hotel reservation services provided by the Complainant's competitors. This indicates that the Disputed Domain Name is being used in an attempt to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's BULGARI trademark. Furthermore, when Internet users confirm their hotel reservation on the Respondent's website, they are required to insert their personal information. This shows that the Disputed Domain Name is most likely used to collect personal information and such use under the circumstances of this case is further evidence of bad faith.

In addition, the Respondent's email address has been used to register other domain names that specifically target third-party brands from the hotel and hospitality industries. This further demonstrates that the Respondent has engaged in a pattern of registering and using domain names in bad faith.

In light of the above, the Panel therefore finds that the Disputed Domain Name has been registered and used in bad faith, and thus the condition of paragraph 4(a)(iii) of the Policy has been fulfilled.

## **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 <bulgarishanghai.com> be transferred to the Complainant.

*/Peter J. Dernbach/*

**Peter J. Dernbach**

Sole Panelist

Date: March 20, 2023