

ADMINISTRATIVE PANEL DECISION

Bottega Veneta S.r.l. v. Whhdc Ybdh
Case No. D2023-0561

1. The Parties

The Complainant is Bottega Veneta S.r.l., Italy, represented by Studio Barbero, Italy.

The Respondent is Whhdc Ybdh, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <debottegaveneta.store> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2023. On February 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 9, 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 (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 10, 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 amendment to the Complaint on February 10, 2023.

The Center verified that the Complaint together with the amendment to the 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 February 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 15, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on March 24, 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 fashion company founded in the mid-1960s in Vicenza, Italy, by Michele Taddei and Renzo Zengiaro, having developed a leather-weaving technique, called “intrecciato”, which has become its signature. Now a part of the multinational Kering group it has reached revenues of EUR 1.5 billion in 2021 and is frequently displayed in rankings relating to fashion and luxury brands.

The Complainant owns over 400 domain names incorporating BOTTEGA VENETA or variations thereof under several different Top Level Domains (“TLDs”) (Annex 7.1), including <bottegaveneta.com>, registered on July 10, 1997 and <bottegaveneta.us>, registered on registered on May 21, 2002, formally registered in the name of Luxury Goods International (L.G.I.) S.A., part of the Kering Group.

The Complainant’s official website is available at <bottegaveneta.com> where the Complainant’s products are available. In addition to that, the Complainant is the owner, amongst many others, of the European Union trademark registration No. 006809362 for the word mark BOTTEGA VENETA, filed on April 4, 2008, registered on May 31, 2010, subsequently renewed, in classes 03, 09, 11, 14, 16, 18, 20, 24 and 25.

The disputed domain name was registered on July 18, 2022 and presently resolves to an online shop reproducing the Complainant’s trademark and purportedly offering the Complainant’s products at discounted prices and directed to the German market.

On July 22, 2022, August 2, 2022, August 11, 2022, September 6, 2022, September 29, 2022, October 6, 2022, October 27, 2022, November 11, 2022, November 18, 2022 and December 16, 2022 the Complainant’s representatives sent a Cease-and-Desist letter and subsequent reminders to the Respondent, demanding it to immediately cease any use of the disputed domain name and transfer it to the Complainant (Annexes 9.1 to 9.4), all of which remained unanswered.

5. Parties’ Contentions

A. Complainant

The Complainant asserts to have become one of the world’s premier luxury brands, being defined by outstanding craftsmanship, innovative design, contemporary functionality, and the highest quality materials. The Complainant further asserts that, in 2014, for the second time, BOTTEGA VENETA was recognized as Best International Luxury Brand at the prestigious Walpole British Luxury Awards, for being the brand with the greatest impact in terms of sales in the United Kingdom and abroad, through innovation, business, strategy and media exposure during 2013-2014, also having been ranked at the 13th position of the BrandZ™ Top 30 Most Valuable Italian Brands 2018 Ranking.

According to the Complainant, it distributes its products through a worldwide network of directly operated stores, exclusive departments and specialty stores, encompassing Europe, Asia, North and South America, as well as by a growing number of Bottega Veneta-owned boutiques, located, *inter alia*, in Italy, United States of America, China, France, United Kingdom, Germany, Russia, Turkey, Japan, Korea, Singapore, Indonesia, Thailand, Kuwait, India, United Arab Emirates, Saudi Arabia, Hong Kong, China.

Under the Complainant’s view, in light of the Complainant’s substantial investments in advertising and marketing as well as consistent use of the trademark BOTTEGA VENETA for decades and substantial sales worldwide, its BOTTEGA VENETA has indisputably become a well-known trademark worldwide.

Under the Complainant’s view, the disputed domain name incorporates the Complainant’s well-known BOTTEGA VENETA trademark with the addition of “de” as a prefix and which may be interpreted as the country code for Germany, what however does not affect the confusing similarity under the first element of the Policy.

Regarding the absence of the Respondent's rights or legitimate interests, the Complainant argues that:

- i) the Respondents is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant's trademark, specifically not being the Respondent an authorized reseller of the Complainant and never having been authorized to register and use the disputed domain name;
- ii) the Respondents is not currently and has never been known under the disputed domain name;
- iii) the Respondent has not provided any evidence of use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or service before or after any notice of the dispute herein, not there being any evidence that the Respondent might have used the disputed domain name in connection with a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark;
- iv) the Respondent has been using the disputed domain name to redirect users to a website displaying the Complainant's BOTTEGA VENETA trademark, where purported BOTTEGA VENETA products are advertised and offered for sale at discounted prices and no disclaimer is provided as to the lack of affiliation between the Respondent's website and the Complainant; and
- v) in view of the very low prices at which the purported BOTTEGA VENETA goods are being offered by the Respondent and the lack of complete and reliable information about the entity operating the Respondent's website, the Complainant concludes that the Respondent might have engaged in the sale of counterfeit goods and wilfully indicated inaccurate and incomplete contact details to avoid being identified and prosecuted for its illegal conduct.

As to the registration and use of the disputed domain names in bad faith, the Complainant asserts that:

- i) the Respondent could not have ignored the well-known character and the reputation of the trademark BOTTEGA VENETA, already found in several prior UDRP decisions in favour of the Complainant (*Bottega Veneta SA v. Hon LO, Lee*, WIPO Case No. [D2016-0225](#); *Bottega Veneta SA v. Chen Kai a.k.a. Kai Chen/ Whols Agent, Domain Whols Protection Service*, WIPO Case No. [D2013-0436](#); *Bottega Veneta International S.A.R.L. v. Wang Jun*, WIPO Case No. [D2012-0600](#) and *Luxury Goods International (L.G.I.) SA v. qiang he*, WIPO Case No. [D2020-3189](#)) when registering the disputed domain names;
- ii) the fact that purported BOTTEGA VENETA products are offered for sale at the disputed domain name and the Complainant's trademark is displayed on the website to which the disputed domain name resolves, indicates that the Respondent was fully aware of the Complainant and its trademark; and
- iii) the use of the disputed domain name in connection with the commercial website described above, displaying the Complainant's trademark and offering for sale *prima facie* counterfeit BOTTEGA VENETA branded products, clearly indicates that the Respondent's purpose in registering and using the disputed domain name was to intentionally attempt to attract Internet users seeking the Complainant's branded products to its own website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of their websites and the goods offered and promoted on said website, according to paragraph 4(b)(iv) of the Policy; and
- iv) a further circumstance evidencing the Respondents' bad faith is the lack of reply to the Complainant's Cease-and-Desist letter and subsequent reminders sent.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

A. Identical or Confusingly Similar

The Complainant has established rights over the BOTTEGA VENETA trademark.

The disputed domain name reproduces in its entirety the Complainant's BOTTEGA VENETA trademark. The addition of the prefix "de" does not prevent a finding of confusing similarity under the Policy which, as recognized by past UDRP panels, involves a "side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name" (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7).

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(c) of the Policy provides a nonexclusive list of circumstances that may indicate the Respondent's rights or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice 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, in spite of not having acquired 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 Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed

domain name. This entitles the Panel to draw any inferences from such default, as it considers appropriate, pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make at least a *prima facie* case against the Respondent under the second UDRP element.

In that sense, and according to the evidence submitted, the Complainant has made a *prime facie* case against the Respondent whom has not been commonly known by the disputed domain name and is neither a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant's trademark, specifically not being the Respondent an authorized reseller of the Complainant and never having been authorized to register and use the disputed domain name.

Also, the lack of evidence as to any trademarks registered by the Respondent corresponding to the disputed domain name, corroborates the indication of an absence of rights or legitimate interests in the disputed domain name.

Moreover, according to the evidence submitted by the Complainant, the use made of the disputed domain name in connection with an online shop targeting the German speaking market, displaying the Complainant's trademark where purported BOTTEGA VENETA products are advertised and offered for sale at very low prices (a factor that could indicate that the products may be counterfeits, as claimed by the Complainant) and where no disclaimer is provided as to the lack of affiliation between the Respondent's website and the Complainant, in addition to the lack of complete and reliable information about the entity operating the Respondent's website clearly does not constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain name in these circumstances.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, both the registration and use of the disputed domain name in bad faith can be found pursuant to Policy, paragraph 4(b)(iv), in view of the reproduction of the Complainant's trademark and purportedly offer of the Complainant's products at the online shop available at the webpage relating to the disputed domain name, which creates a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement thereof.

Moreover, the bad faith of the Respondent is also supported here by (i) the choice to retain a privacy protection service in an attempt to conceal the Respondent's true identity; (ii) the lack of reply by the Respondent invoking any rights or legitimate interests; (iii) the lack of reply to the Cease-and-desist letter and reminders sent prior to this procedure and (iv) the indication of false or incomplete information used by the Respondent for registering the disputed domain name, since the Written Notices was undeliverable to the Respondent by courier service.

For the reasons above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(b)(iv) of the Policy. The third element of the Policy has therefore been met.

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 <debottegaveneta.store> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: April 3, 2023