

## **ADMINISTRATIVE PANEL DECISION**

**Bulgari S.p.A. v. Ibrahim Hasan**

**Case No. D2023-1004**

### **1. The Parties**

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

The Respondent is Ibrahim Hisan, Maldives.

### **2. The Domain Names and Registrar**

The disputed domain names <bulgariranfushi.com>, <bulgariresortranfushi.com>, <bvlgariranfushi.com>, and <bvlgariresortranfushi.com> are registered with GoDaddy.com, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 7, 2023. On March 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 8, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 March 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 5, 2023.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on April 18, 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 submits that it 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 jewellery including but not limited to watches, rings, necklaces and fragrance products.

The BULGARI name derives from the founder's name ('Voulgaris'). The Complainant's trademark is both written as 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, but are traditionally intended for the following purposes: "bulgari" is used in relation to the company name (Bulgari S.p.A.), whilst the term "bvlgari" relates to the brand name.

The Complainant is headquartered in Rome, Italy; it opened its first international locations in New York City, Paris, Geneva and Monte Carlo in the 1970s. Today, the Complainant has more than 230 retail locations worldwide.

In addition to selling luxury goods, the Complainant has also operated several hotels since 2001, which can be found in major locations across the globe such as Shanghai, London, Beijing, Milan, Bali, Dubai and Paris, and has resorts scheduled to open in the future such as in Rome, Tokyo, and Ranfushi. Specifically, the Complainant's BVLGARI/BULGARI Resort in Ranfushi, the Maldives is set to open in 2025 and has had extensive media coverage following its public announcement at the end of June 2022.

The Complainant, its affiliates, subsidiaries and associated companies own trademark registrations for the terms BVLGARI and BULGARI in various jurisdictions, including but not limited to the following:

- Australian Trademark Registration No. 338663 BULGARI, registered on October 5, 1979, in class14;
- United States of America ("United States") Trademark Registration No. 1,184,684 BULGARI, registered on January 5, 1982, in class 14;
- International Trademark Registration No. 452694 BULGARI, registered on May 15, 1980, in classes 11, 14, 20, and 21;
- United States Trademark Registration No. 1694380 BVULGARI, registered on June 16, 1992, in class 18;
- International Trademark Registration No. 494237 BVLGARI, registered on July 5, 1985, in classes 3, 8, 11, 14, 16, 18, 20, 21, 25 and 34;
- European Union Trade Mark Registration No. 007138101 BVLGARI, registered on June 3, 2009, in classes35, 36, 41 and 43.

The Complainant registered the domain name of its official website, "www.bulgari.com", on February 17, 1998 which enables users to access all product lines: jewellery, fragrances, leather goods, accessories, watches and the bridal collection and locate the Complainant's stores and authorized retailers worldwide.

The disputed domain names were registered on July 1, 2022, and resolve to parked webpages hosted by GoDaddy.

## 5. Parties' Contentions

### A. Complainant

The BVLGARI/BULGARI brand is well advertised globally, with promotional videos, billboards and other sources of marketing material, which has further promoted the brand's global recognition for high-end jewellery and accessories. The BVLGARI/BULGARI brand and its products have been used by many celebrities at high-profile events such as the Oscars and Premieres.

The Complainant, in essence, claims that the disputed domain names are confusingly similar to the trademarks BULGARI/BVULGARI in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain names, which were registered and are being used in bad faith.

More specifically, the Complainant has not authorized or licensed the use of the trademarks BULGARI/BVULGARI to the Respondent or to register domain names containing them.

To the best of the Complainant's knowledge, the Respondent does not have any trademark rights to the terms "bulgari" or "bvlgari". There is also no evidence that the Respondent retains any unregistered trademark rights to the terms "bulgari/bvlgari".

In addition, the Complainant submits that the disputed domain names were previously used to display Pay-Per-Click ("PPC") advertisement links that redirected users to the Complainant's BULGARI/BVULGARI offerings, as well as its competitors (Annex 11 to the Complaint). Such use does not confer a *bona fide* offerings of services, since the disputed domain names utilised the Complainant's trademarks BULGARI/BVULGARI to compete and capitalize on the reputation and goodwill of the Complainant's marks.

The disputed domain names currently resolve to parked webpages hosted by GoDaddy. As such, they are being passively held. The Respondent has deliberately registered the disputed domain names that are confusingly similar to the distinctive BULGARI/BVULGARI marks. These made-up terms are not ones a trader would legitimately choose unless seeking to create an impression of association with the Complainant.

The Complainant highlights its previous correspondence with the Respondent, in which the Respondent solicited the sale of the disputed domain names, and demonstrated that it clearly registered the disputed domain names for the purpose of capitalising on the Complainant's BULGARI/BVULGARI marks (Annex 14 to the Complaint, page 1). This correspondence emphasises the Respondent's targeting of the Complainant when registering the disputed domain names. In addition, the Respondent's initiation of the disputed domain names' sale suggests that the Respondent intends to generate undue profit based on the disputed domain names' value as a trademark.

In addition, the Complainant submits that upon identifying the registration of the disputed domain names, a cease and desist letter was sent out to the Respondent on September 2, 2022 by the Complainant's representative (Annex 15 to the Complaint). This notice was sent out to put the Respondent on notice of the Complainant's trademarks and rights, and with a view to resolving the matter amicably. However, in response, the Respondent openly admitted to having registered the disputed domain names primarily with a view of selling them to the Complainant and instigated a further offer for sale of the disputed domain names, among others, for USD 5500 (Annex 14 to the Complaint, pages 2-4). Such an offer is far beyond any anticipated out-of-pocket costs expected from the Respondent and further demonstrates that the Respondent intended to register the disputed domain names to sell them back to the Complainant for profit, thus capitalizing on the BULGARI/BVULGARI marks.

Finally, the Complainant highlights the Complainant's announcement of its opening of the BVLGARI Resort in Ranfushi, the Maldives in which several media publications, including *Luxury Australian Travel Trade E-News*, were released and available on the same day and the days prior to the disputed domain names' registrations (Annex 7 to the Complaint). Such timing is by no means coincidental and the Complainant

submits that the Respondent took advantage of such announcements by registering the disputed domain names constituting opportunistic bad faith.

The Complainant has proven that it has a strong reputation in the BULGARI/BVLGARI brands; the circumstances of this case indicate that the Respondent has intentionally used the commercial value and goodwill of the Complainant's brands to attract and redirect Internet users to its own websites. There is a high likelihood of confusion given the terms used in the disputed domain names, as alluded to above.

The previous use of PPC links by the Respondent on the disputed domain names constitutes a clear attempt to generate a commercial gain, particularly by misleading online users with the disputed domain names and subsequently redirecting these online users to the Complainant's offerings as well as its competitors.

In view of the foregoing, the Complainant requests the Panel to make a finding of bad faith registration and use of the disputed domain names, and to order the transfer of the disputed domain names to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain names, the Complainant must prove each of the following, namely that:

- (i) the disputed domain names are identical or confusingly similar with 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 names; and
- (iii) the disputed domain names were registered and are being used in bad faith.

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

As set forth in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain names are confusingly similar to the Complainant's BULGARI/BVLGARI trademarks.

The disputed domain names incorporate the Complainant's trademarks BULGARI/BVLGARI in their entirety with the addition of the geographical term "ranfushi" in the disputed domain names <bulgariranfushi.com> and <bvlgariranfushi.com> and the terms "resort" and "ranfushi" in the disputed domain names <bulgariresortranfushi.com> and <bvlgariresortranfushi.com>, none of which are sufficient to prevent a finding of confusing similarity between the Complainant's trademarks BULGARI/BVLGARI and the disputed domain names. Section 1.8 of the [WIPO Overview 3.0](#) indicates that, where the relevant trademark is recognizable within the disputed domain name, as it clearly is in this case with the disputed domain names, the addition of other terms would not prevent a finding of confusing similarity under the first element.

The “.com” generic Top-Level Domain (“gTLD”) is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s trademarks BULGARI/BVLGARI and that the requirements of paragraph 4(a) of the Policy are fulfilled.

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

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it 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; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain names, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain names.

Likewise, and as further discussed under section 6.C of this decision, it does not seem that the Respondent is making any legitimate noncommercial or fair use of the disputed domain names.

As established in section 2.5 of [WIPO Overview 3.0](#): “Fundamentally, a respondent’s use of a domain name will not be considered ‘fair’ if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry.” Here, the nature of the disputed domain names carry a risk of implied affiliation.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain names (*Telstra Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

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

The Panel is satisfied that the Respondent must have been aware of the Complainant's trademarks BULGARI/BVULGARI mentioned in section 4 above (Factual Background) when it registered the disputed domain names on July 1, 2022.

In accordance with section 3.1.4 of [WIPO Overview 3.0](#), the Panel considers that the inclusion of the Complainant's BULGARI/BVULGARI trademarks in the disputed domain names creates a presumption of bad faith. Moreover, the addition of the term "ranfushi" in two of the disputed domain names and the terms "resort" and "ranfushi" in the other two rather than helping to distinguish the disputed domain names from the Complainant's trademarks contributes to their confusion among Internet users.

The Respondent, when registering the disputed domain names, has targeted the Complainant's trademarks BULGARI/BVULGARI with the intention to confuse Internet users and capitalize on the fame of the Complainant's trademarks for its own monetary benefit.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain names is also a significant factor to consider that the disputed domain names were registered in bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has registered and intentionally used the disputed domain names intentionally to attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's BULGARI trademark as to the source, sponsorship, affiliation, or endorsement. This amounts to bad faith under paragraph 4(b)(iv) of the Policy.

The fact that the disputed domain names currently resolve to parked webpages, in the circumstances of the case, does not prevent a finding of bad faith under the "passive holding" theory of section 3.3 of the [WIPO Overview 3.0](#).

The Panel finds that the Respondent has registered and is using the disputed domain names in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have 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 names, <bulgariranfushi.com>, <bulgariresortranfushi.com>, <bvlgariranfushi.com> and <bvlgariresortranfushi.com>, be transferred to the Complainant.

*/Miguel B. O'Farrell/*

**Miguel B. O'Farrell**

Sole Panelist

Date: May 1, 2023