

## **ADMINISTRATIVE PANEL DECISION**

**Bulgari S.p.A. v. Eve ly**  
**Case No. D2023-1668**

### **1. The Parties**

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

The Respondent is Eve ly, Singapore.

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

The disputed domain names <bvlgariwatch.net> (the “Disputed Domain Name”) is registered with Key-Systems GmbH (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 17, 2023. On April 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 25, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 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 May 2, 2023.

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 May 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 31, 2023.

The Center appointed Nicholas Weston as the sole panelist in this matter on June 5, 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 owns and operates a luxury goods business founded in 1884, that sells, amongst other things, watches. The Complainant holds a number of registrations for the trademarks BVLGARI and BVLGARI in various jurisdictions including, for example: Australian Trade Mark Registration No. 338663 for the mark BULGARI registered on October 5, 1979 in class 14, and International Trade Mark Registration No. M-0494237 for the mark BVLGARI registered on March 28, 1996 in classes 3, 8, 11, 14, 16, 18, 20, 21, 25, and 34.

The Complainant owns and uses a number of domain names including <bvlgari.com>, which resolves to its main website at <bulgari.com>.

The Disputed Domain Name was registered on October 21, 2022, and it resolves to an inactive webpage.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant cites a number of trademark registrations internationally for the BVLGARI and BULGARI marks as *prima facie* evidence of ownership.

The Complainant submits that its rights in the BVLGARI trademark predate the Respondent's registration of the Disputed Domain Name <bvlgariwatch.net>. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the BVLGARI trademark, and that the confusing similarity is not removed by the additional word "watch", or the addition of the generic Top-Level Domain ("gTLD") ".net".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it is inactive, and that "the Disputed Domain Name does not currently resolve to content, despite being registered six months ago", so the Respondent has no legitimate interest in or legitimate *bona fide* business purpose for using the Disputed Domain Name. The Complainant also states that "the Respondent has not received any license from the Complainant to use domain names that features the BVLGARI trademark" and that "none of the circumstances [in paragraph 4(c) of the Policy] apply in this case".

Finally, the Complainant alleges that the registration and passive use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and Rules.

##### B. Respondent

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

#### 6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) that the Disputed Domain Name has been registered and is being used in bad faith.

## A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark BVLGARI in numerous jurisdictions. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the BVLGARI trademark, the Panel observes that the Disputed Domain Name comprises: (a) the Complainant’s trademark BVLGARI; (b) followed by the word “watch”; and (c) followed by the gTLD “.net”.

It is well established that the gTLD used as technical part of a domain name may be disregarded. The relevant comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: “bvlhariwatch” (see [WIPO Overview 3.0](#), section 1.11).

It is also well established that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see [WIPO Overview 3.0](#), section 1.7).

Accordingly, the Panel finds that the addition of the term “watch” to the BVLGARI trademark does not avoid a finding of confusing similarity between the Disputed Domain Name and the Complainant’s trademark (see [WIPO Overview 3.0](#), section 1.8).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden on the Complainant to establish the absence of the Respondent’s rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant only need to put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see: [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because (i) the Respondent has not acquired or owned any trademark or service mark rights in the name BVLGARI, and has not been commonly known by the name BVLGARI; and (ii) the Respondent is not 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 Complainant’s trademark.

Furthermore, the nature of the Disputed Domain Name, comprising the Complainant’s trademark and an additional related term “watch”, carries a risk of Internet user confusion, and possibly even in the case of an unsuspecting user, of implied affiliation with Complainant as it may mistakenly be seen as effectively impersonating or suggesting some connection to the Complainant, and accordingly cannot constitute a fair use in these circumstances.

The Panel is satisfied that the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. In the absence of a response, this Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Panel finds for the Complainant on the second element of the Policy.

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

The third element of the Policy requires that the Complainant must also demonstrate that the Disputed Domain Name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith is overwhelming.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the Complainant's evidence of the Respondent's use of third party websites to subsequently advertise the Disputed Domain Name for sale, the Panel is satisfied that the Respondent knew of and targeted the Complainant's trademark when it registered the Disputed Domain Name. On any view, the Respondent cannot credibly claim to have been unaware of the trademark (see [WIPO Overview 3.0](#), section 3.2.2).

On the issue of use, the Complainant's evidence is that the Disputed Domain Name is inactive and unconnected with any *bona fide* supply of goods or services by the Respondent. Previous UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see [WIPO Overview 3.0](#), section 3.3). The Panel finds that passive holding of the Disputed Domain Name does not, in the circumstances of this case, prevent a finding of bad faith: (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 implausibility of any good faith use to which the Disputed Domain Name may be put.

In the absence of any evidence to contend against the Complainant's evidence and claims, this Panel accepts the Complainant's evidence and finds that the Respondent has registered and used the Disputed Domain Name, without the Complainant's consent or authorization, for the likely purpose of capitalizing on the reputation of the trademark to target the Complainant's rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 Name <bvlgariwatch.net> be transferred to the Complainant.

*/Nicholas Weston/*

**Nicholas Weston**

Sole Panelist

Date: June 19, 2023