

ADMINISTRATIVE PANEL DECISION

Bottega Veneta S.r.l. v. Bottega Veneta, BOTTEGAVENETABAG INC
Case No. D2023-1671

1. The Parties

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

Respondent is Bottega Veneta, BOTTEGAVENETABAG INC, United States of America (“United States” _.

2. The Domain Name and Registrar

The disputed domain name <bottegavenetabagvip.com> is registered with NameCheap, Inc. (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 17, 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, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 24, 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 April 26, 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 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 22, 2023.

The Center appointed Torsten Bettinger as the sole panelist in this matter on June 16, 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

Complainant is an Italian fashion company founded in the mid-1960s in Vicenza, Italy.

Complainant is the owner of numerous trademark registrations for BOTTEGA VENETA (word mark), including the following:

- European Union Trade Mark Registration No. 006809362 registered on May 31, 2010, in classes 3, 9, 11, 14, 16, 18, 20, 24 and 25;
- International Trademark Registration No. 705303, registered on October 8, 1998, in classes 3, 9, 14, 18 and 25;
- International Trademark Registration No. 420038, registered on December 16, 1975, in classes 6, 11, 14, 16, 18, 20, 21 and 25, designating also United States;
- United States Trademark Registration No. 1086395, registered on February 28, 1978, in international classes 18, 20 and 25.

Complainant owns over 400 domain names incorporating BOTTEGA VENETA or variations thereof under several different Top-Level Domains (“TLDs”) including <bottegaveneta.com>, registered on July 10, 1997 and <bottegaveneta.us>, registered on registered on May 21, 2002.

The disputed domain name <bottegavenetabagvip.com> was registered by the Respondent on December 7, 2022.

The disputed domain name redirects to “www.sgvipbags.com”, a website offering for sale purported BOTTEGA VENETA handbags, along with products of Complainant’s competitors, such as BULGARI, CELINE, CHRISTIAN DIOR *et. al.*

On December 12, 2022, Complainant’s representative sent a Cease and Desist letter to the Respondent demanding to immediately cease any use of the disputed domain name and transfer it to Complainant.

In absence of any reply, Complainant sent reminders to the Respondent on December 19, 2022, December 28, 2022 and January 23, 2023. Respondent did not provide a response.

A. Complainant

Complainant contends that in light of Complainant’s substantial investments in advertising, marketing and sales worldwide, its use of the trademark BOTTEGA VENETA has become a well-known trademark worldwide, including in the United States, where Respondents is *prima facie* located.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, Complainant asserts that the disputed domain name is confusingly similar to its registered trademark BOTTEGA VENETA arguing that;

- the disputed domain name incorporates the whole of Complainant’s BOTTEGA VENETA word trademark;
- the fact that the disputed domain name differs from Complainant’s trademark by the addition of the non-distinctive elements “bag” and “vip” does not prevent the confusing similarity;
- where the relevant trademark is recognizable within the disputed domain name, the addition of generic or descriptive terms does not prevent a finding of confusing similarity under the first element.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, Complainant submitted that;

- the mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name;
- Respondent is not a licensee, authorized agent of Complainant or in any other way authorized to use Complainant's trademark.
- Complainant is not aware of the existence of any evidence demonstrating that Respondent might be commonly known by a name corresponding to the domain name as an individual, business, or other organization.
- Respondent has not provided Complainant with 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.
- there is no evidence that 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 Complainant's trademark;
- the disputed domain name was originally redirected to a website offering for sale purported BOTTEGA VENETA handbags at discounted prices and it is currently redirected to the website "www.sgvipsbags.com", where purported BOTTEGA VENETA handbags are advertised and offered for sale at discounted prices, along with products of Complainant's competitors;
- Respondent's use of the disputed domain name was and is apt to confuse and mislead Internet users into believing that the website to which the disputed domain name resolves is operated by Complainant or by an affiliated entity with Complainant's consent.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that;

- the trademark BOTTEGA VENETA has been extensively used since as early as mid-1960s in connection with Complainant's advertising and sales of BOTTEGA VENETA products worldwide, including in Respondent's country, and has been widely publicized globally and constantly featured throughout the Internet and therefore Respondent could not have possibly ignored the existence of Complainant's trademark BOTTEGA VENETA when it registered the disputed domain name;
- the well-known character of the trademark BOTTEGA VENETA has been recognized in several prior UDRP decisions;
- the fact that purported BOTTEGA VENETA handbags are offered for sale on the website to which the disputed domain name currently resolves and that Complainant's trademarks were published on the website to which the disputed domain name originally redirected, indicates that Respondent was fully aware of Complainant and its trademarks;
- the Respondent's primary intent with respect to the disputed domain name is to trade off the value of Complainant's trademark "BOTTEGA VENETA";
- the use of the disputed domain name in connection with the commercial websites previously offering for sale *prima facie* counterfeit BOTTEGA VENETA branded handbags along with products of Complainant's competitors clearly indicates that Respondent's purpose in registering and using the disputed domain name was to intentionally attempt to attract Internet users seeking Complainant's branded products to the corresponding websites for commercial gain, by creating a likelihood of

confusion with Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the websites and the goods offered and promoted on said websites, according to paragraph 4(b)(iv) of the Policy.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Complainant has demonstrated that it owns multiple trademark registrations for the mark BOTTEGA VENETA prior to the registration of the disputed domain name on December 7, 2022.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases (see sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

In this case, the disputed domain name contains the Complainant's mark in its entirety and only differs from Complainant's trademark BOTTEGA VENETA by the addition of the terms "bag" and "vip".

The Panel notes that despite the addition of the terms "bag" and "vip" to the BOTTEGA VENETA trademark in the disputed domain name, the BOTTEGA VENETA remains highly recognizable in the disputed domain name.

The Panel therefore agrees with the Complainant's assertion that such addition does not prevent a finding of confusing similarity between the disputed domain name and Complainant's trademark.

Furthermore, it is well accepted under the UDRP case law that the generic Top-Level Domain ("gTLD") designation such as ".com", ".net", ".org" is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark (see [WIPO Overview 3.0](#) section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain name is confusingly similar to Complainant's BOTTEGA VENETA trademarks in which Complainant has exclusive rights.

A. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

"(i) before any notice to you [the Respondent] of the dispute, your 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) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [the Respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

Complainant provided evidence of its extensive use and promotion of its BOTTEGA VENETA trademark and stated that Respondent is not a licensee, authorized agent of Complainant or in any other way authorized by Complainant to register the disputed domain name.

Furthermore, Respondent provided screenshots of websites that show that Respondent previously used the disputed domain name to host an imitation site, offering for sale purported BOTTEGA VENETA handbags at discounted prices and that the disputed domain name currently redirects to “www.sgvipsbags.com”, where purported BOTTEGA VENETA handbags are advertised and offered for sale at discounted prices, along with products of Complainant’s competitors.

These assertions and evidence are sufficient to establish a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name.

Where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element 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. See section 2.1 of the [WIPO Overview 3.0](#).

Respondent chose not to contest Complainant’s allegations and has failed to come forward with any evidence to refute Complainant’s *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, Respondent does not use the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

On this basis and in light of the fact that the disputed domain name except for the addition of the terms “bag” and “vip” contains Complainant’s trademark in its entirety the Panel concludes that the Respondent lacks rights and legitimate interests in the disputed domain name and that, accordingly, Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

B. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- i. circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

Complainant holds multiple trademark registrations for the mark BOTTEGA VENETA in the United States, the European Union and various other countries that predate the registration of the disputed domain name. Complainant provided evidence that the BOTTEGA VENETA marks have been extensively used and are widely known.

Given that the disputed domain name except for the addition of the terms “bag” and “vip” contains Complainant’s trademark BOTTEGA VENETA in its entirety in the Panel’s view, it is very likely that the Respondent was aware of Complainant at the time he selected the disputed domain name for registration. This is sufficient to infer bad registration of the disputed domain name.

Complainant provided screenshots of websites that show that Respondent previously used the disputed domain name to host an imitation site, offering for sale purported BOTTEGA VENETA handbags at discounted prices and that the disputed domain name currently redirects to “www.sgvipsbags.com”, where purported BOTTEGA VENETA handbags are advertised and offered for sale at discounted prices, along with products of Complainant’s competitors.

Given the widespread reputation of the BOTTEGA VENETA marks and the confusingly similar disputed domain name the Panel finds that the public is likely to be confused into thinking that the disputed domain name, contrary to fact, has a connection with Complainant.

Potential partners and end users are led to believe that the website at the disputed domain name is either Complainant’s website or a website of official authorized partner(s) of Complainant, which it is not.

The Panel therefore concludes that Respondent by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the website, intended to divert customers of Complainant to its website for commercial gain pursuant to Paragraph 4(b)(iv) of the Policy.

The Panel therefore finds that Complainant has also met its burden under 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 <bottegavenetabagvip.com> be transferred to Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: June 30, 2023