

## **ADMINISTRATIVE PANEL DECISION**

**Bulgari S.p.A. v. David Czinczenheim**

**Case No. D2023-2373**

### **1. The Parties**

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

The Respondent is David Czinczenheim, France.

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

The disputed domain name <bulgariislanddubai.com> is registered with SNAPNAMES, LLC (the “First Registrar”).

The disputed domain name <bulgarivillas.com> is registered with DropFall.com Inc. (the “Second Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 1, 2023. On June 1, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On June 2, 2023, the Registrars transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Statutory Masking Enabled) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 5, 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 the same day.

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 June 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 5, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on July 10, 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 the owner of the BULGARI trademark which is registered around the world, including Australia, the United States of America (“United States”) and the European Union, China or Italy, starting from 1979; e.g. International Trademark Registration No. 452694, registered May 15, 1980, for the international classes 11, 14, 20, and 21, with the Italian Trademark Registration No. 322168, registered January 4, 1980 (Annex 9 and 14 to the Complaint).

The Complainant uses the domain name <bulgari.com> to offer and present its luxury goods on the Internet. The website under the domain name <bulgari.com> is highly frequented and visited (Annex 4 and 5 to the Complaint). The Complainant also uses the domain name <bulgarihotels.com> to provide information about its business in the hotel market (Annex 7 and 8 to the Complaint).

Finally, the Complainant has a strong social media presence e.g. on Facebook, Twitter, Instagram or Pinterest (Annex 10 to the Complaint).

The disputed domain names were registered on November 17, 2022 (Annex 1 to the Complaint) and are currently offered for sale (Annex 11 to the Complaint; and Panel’s independent research on July 15, 2023).

On February 22, 2023, the Complainant sent a cease-and-desist letter to the Respondent claiming the transfer of the disputed domain names and cease and desist from using the BULGARI trademark (Annex 12 to the Complaint), left unanswered.

#### **5. Parties’ Contentions**

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

The Complainant is an Italian company founded in 1884; it operates in the luxury goods and hotel markets, and is particularly known for its high-end jewelry including but not limited to watches, rings, necklaces and fragrance products. The Complainant is headquartered in Rome, Italy, and opened its first international locations in New York City, United States, Paris, France, Geneva, Switzerland, and Monte Carlo, Monaco, in the 1970s. Today, the Complainant has more than 230 retail locations worldwide.

The Complainant is the owner of numerous trademark registrations for the distinctive and famous BULGARI brand around the world. It also registered the domain name <bulgari.com> for its official website on February 17, 1998, and has had a strong web presence since that date with more than 2 million visits per month from users around the world.

Further, the Complainant has also operated several hotels since 2001; the hotels can be found in major locations across the globe such as United Kingdom, China, Italy, United Arab Emirates, Indonesia, France, and resorts scheduled to open such as in Italy, Japan, and Maldives. Specifically, the Complainant’s BULGARI Hotel Resort in Dubai, United Arab Emirates, has received significant media recognition prior to and since its launch in 2017. The Complainant owns moreover the domain name <bulgarihotels.com> and provides under this domain name information about its hotel business.

The Complainant has also established a strong social media presence and uses its trademark BULGARI to promote its services under this name, in particular Facebook, Twitter, Instagram and Pinterest.

The disputed domain names are confusingly similar to the Complainant’s registered trademark BULGARI since they encompass the BULGARI mark in its entirety with the addition of the term “island” and the

geographical identifier “dubai”, or “villas”. The Complainant’s BULGARI mark is the dominant and only distinctive element in the disputed domain names. The addition of the terms “island” and “Dubai”, or “villas” are not sufficient to alleviate the likelihood of confusion between the Complainant’s BULGARI mark and the disputed domain names.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent does not have any trademark rights to the mark BULGARI, it is not known under the disputed domain names, it has not used nor prepared to use, the disputed domain names in connection with a *bona fide* offering of goods or services and has not received any license or other authorization from the Complainant to use the disputed domain names featuring the BULGARI trademark.

Finally, the disputed domain names were registered and are being used in bad faith. The disputed domain names replicate the BULGARI trademark in its entirety. The addition of the term “island” and geographical indicator “dubai”, or “villas” only reinforces the connection to the Complainant, as Internet users will likely associate the disputed domain names with the Complainant’s hotel resort offerings, specifically in Dubai, United Arab Emirates, with regard to the disputed domain name <bulgariislanddubai.com>. Further, because of the fame of the BULGARI mark the Respondent must have been aware of the Complainant and its BULGARI trademark when registering the disputed domain names.

The Respondent also used the disputed domain names in bad faith. It offered the disputed domain names for sale and invited Internet users to purchase the domains for price(s) that far exceed any anticipated registration and maintenance costs. Further, the Complainant sent a cease-and-desist letter to the Respondent, which the Respondent did not reply. Finally, the Respondent has engaged in a pattern of abusive conduct by registering other domain names that encompass the marks (either in full or as typosquatting variations) of well-known third-party brands.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainant must prove that

- (i) the disputed domain names are 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 with respect to the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name. This test typically 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.

In the case at issue, the Complainant submitted evidence, which incontestably and conclusively establishes rights in the mark BULGARI.

The disputed domain names are confusingly similar to the BULGARI mark in which the Complainant has rights since the Complainant’s BULGARI mark is clearly recognizable in the disputed domain names. It has

long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

This is the case at hand, the addition of the terms "island" and "dubai" as well as "villas" in the disputed domain names does not prevent a finding of confusing similarity.

Finally, it has also long been held that gTLDs are generally disregarded when evaluating the confusing similarity under the first element (see section 1.11.1 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

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

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 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](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain names, comprising the Complainant's famous and distinctive mark in its entirety together with the term "island" and "dubai" as well as "villas", cannot be considered fair as these falsely suggest an affiliation with the Complainant that does not exist (see section 2.5 of the [WIPO Overview 3.0](#)).

Noting the above, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated. Consequently, the Complainant must show that;

- the disputed domain names were registered by the Respondent in bad faith; and
- the disputed domain names are being used by the Respondent in bad faith.

(i) In the present case, the Complainant has rights and is the owner of the well-known, famous and highly distinctive registered trademark BULGARI, which is registered and used in many jurisdictions around the world for more than 40 years. Moreover, the Complainant registered and is using various domain names containing BULGARI e.g. <bulgari.com> or <bulgarihotels.com> to address its websites, which are highly frequented and visited. Further, the Complainant has a strong social media presence with its BULGARI mark.

It is inconceivable for this Panel that the Respondent registered or has used the disputed domain names without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain names incorporate the Complainant's distinctive

trademark BULGARI entirely together with suffixes which refer to the Complainants business or business location.

Finally, the Respondent has engaged in a pattern of multiple trademark-abusive domain name registrations corresponding to distinct marks of individual brand owners which supports the finding that the disputed domain names were registered in bad faith by the Respondent. Indeed, the Complainant provided evidence on record that the Respondent was involved in several UDRP cases as respondent, ending with a transfer decision under the Policy and Rules (Annex 15 to the Complaint).

(ii) The disputed domain names are also being used in bad faith. According to the evidence on record, the disputed domain names are offered for sale for EUR 599 and EUR 1'500, these figures are likely in excess of the Respondent's out-of-pocket expenses and, in the circumstances of this case, reflects the Respondent's bad faith.

This Panel concludes that the disputed domain names are being used in bad faith, putting emphasis on the following:

- the Complainant's trademark BULGARI is well-known globally, famous, distinctive and has a strong Internet presence;
- the disputed domain names resolve to a website, where they are offered for sale;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain names;
- the disputed domain names incorporate the Complainant's trademark in its entirety, and is thus suited to divert or mislead potential web users from the website they are actually trying to visit (the Complainant's site);
- the disputed domain names moreover contain suffixes which refer to the business or business location of the Complainant; and
- there is no conceivable plausible reason for good faith use with regard to the disputed domain names.

Taking all these aspects and evidence on record into consideration and the fact that the Respondent failed to respond to the cease-and-desist letter sent by the Complainant and to the Complaint further supports the finding that the disputed domain names have been registered and are being used in bad faith 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 names ,<bulgariislanddubai.com> and <bulgarivillas.com>, be transferred to the Complainant.

*/Peter Burgstaller/*

**Peter Burgstaller**

Sole Panelist

Date: July 21, 2023