

## **ADMINISTRATIVE PANEL DECISION**

Bulgari S.p.A. v. berniko veronka

Case No. D2023-3089

### **1. The Parties**

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

The Respondent is berniko veronka, United Kingdom.

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

The disputed domain name <bulgarihotelmilano.com> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2023. On July 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 19, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 20, 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 July 21, 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 July 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 15, 2023.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on August 17, 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, Bulgari S.p.A., is an Italian company founded in 1884 and operating in the luxury goods and hotel markets.

The Complainant is the owner of numerous trademarks including the following:

- BULGARI, International word mark registered under No. 452694 on May 15, 1980 in classes 11, 14, 20 and 21.

The Respondent registered the Disputed Domain Name on February 24, 2023. The Disputed Domain Name appears to be inactive as it resolves to a registrar suspension page.

The Complainant sent a cease & desist letter to the Respondent on March 22, 2023, but received no response.

#### **5. Parties' Contentions**

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

The Complainant considers the Disputed Domain Name to be confusingly similar to a trademark in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. To the best of the Complainant's knowledge, the Respondent does not have any registered or unregistered trademark rights to the term BULGARI or 'bulgarihotelmilano' and is not commonly known by the term 'bulgarihotelmilano'. According to the Complainant, the Respondent has not received any license to use a domain name featuring the BULGARI trademark. The Complainant further claims that the passive holding of the Disputed Domain Name does not amount to use in connection with a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use of the Disputed Domain Name.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant, it is inconceivable to believe the Respondent has chosen to register the Disputed Domain Name comprising of the Complainant's fanciful trademark, which has no descriptive or generic meaning, for any reason other than to target the Complainant's trademark. The Complainant also claims that the Respondent's lack of reply to a cease-and-desist notice prior to commencing the proceedings infers bad faith behavior. According to the Complainant, the current passive holding of the Disputed Domain Name does not negate a finding of bad faith use in view of the reputation of the Complainant's mark.

##### **B. Respondent**

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

## 6. Discussion and Findings

Paragraph 15(a) of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. As the UDRP proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (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 Panel will therefore deal with each of these requirements.

### A. Identical or Confusingly Similar

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there are trademarks in which it has rights. The Complainant's BULGARI trademark has been registered and used in various countries in connection to the Complainant's luxury goods and hotel business.

The Disputed Domain Name incorporates the Complainant's BULGARI trademark in its entirety, simply adding the terms "hotel" and "milano". Where the relevant trademark is recognizable within the Disputed Domain Name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

It is well established that generic Top-Level-Domains ("gTLDs"), here ".com", may be disregarded when considering whether the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights.

In light of the above, the Panel considers the Disputed Domain Name to be confusingly similar to the Complainant's BULGARI trademark.

### B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel notes that the Respondent has not apparently been commonly known by the Disputed Domain Name, and that the Respondent does not seem to have acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is "berniko veronka". The Respondent's use and registration of the Disputed Domain Name was not authorized by the Complainant.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Name incorporates the Complainant's BULGARI trademark and company name in its entirety and merely adds the descriptive term "hotel" and the Italian geographic term "milano" ("Milan" in English). Both terms can be obviously linked to the Complainant as the Complainant shows it provides hotel services in Milan. Therefore, the Panel finds that the Disputed Domain Name carries a high risk of implied affiliation with the Complainant and cannot constitute fair use.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, including the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

In this case, the Panel is of the opinion that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name. In fact, the Respondent does not appear to make any use of the Disputed Domain Name. The passive holding or non-use of a domain name is, in appropriate circumstances, evidence of a lack of rights or legitimate interests in the Disputed Domain Name (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#)).

The Respondent had the opportunity to demonstrate his rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

In light of the above, the Complainant succeeds on the second element of the Policy.

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

The Complainant must prove on the balance of probabilities both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

In the present case, the Panel finds it inconceivable that the Respondent was unaware of the Complainant and its trademark rights when it registered the Disputed Domain Name. As mentioned above, the Disputed Domain Name incorporates the Complainant's distinctive trademark and company name in its entirety, and combines it with terms directly referring to the Complainant's hotel services in Milan. The Complainant's mark predates the registration of the Disputed Domain Name by more than 40 years, and previous UDRP panels already recognized the well-known character of the Complainant's mark (see *e.g. Bulgari S.p.A. v. Zhoua, Guan Wei*, WIPO Case No. [D2023-0880](#), and the cases referred to in this decision). In the Panel's view, the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#)).

The Panel observes that the Respondent is not presently using the Disputed Domain Name. While UDRP panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (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, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put (see section 3.3 of [WIPO Overview 3.0](#)).

In the present case, the Panel is of the opinion that all above factors apply in this case:

- the Panel finds that the Complainant's BULGARI trademark is distinctive and well-known;
- the Respondent did not submit any response or provided any evidence of actual or contemplated good-faith use;
- there are indications that the Respondent concealed its identity by using false contact details. Even after the privacy shield was lifted in the context of the present proceedings, the Panel observes that the Respondent's contact information does not include a valid physical address; and
- given the confusing similarity with the Complainant's company name and registered trademark, the Panel finds it difficult to conceive any plausible legitimate future use of the Disputed Domain Name by the Respondent.

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is established that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last element 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 <bulgarihotelmilano.com> be transferred to the Complainant.

*/Flip Jan Claude Petillion/*

**Flip Jan Claude Petillion**

Sole Panelist

Date: August 31, 2023