

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. Hasan Kilic

Case No. D2023-3090

1. The Parties

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

The Respondent is Hasan Kilic, Türkiye.

2. The Domain Name and Registrar

The disputed domain name <bulgaristandutyfree.shop> 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 (Redacted for Privacy, Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 1, 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 August 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 August 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 31, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on September 8, 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 Italian company that is active in the jewelry and luxury goods as well as in the hotel industry. The Complainant is the registered owner of numerous trademarks relating to its company name and brand BULGARI / BVLGARI, including, but not limited, to the following:

- word mark BULGARI, International Trademark No. 452694, registered as of May 15, 1980, in classes 11, 14, 20, and 21;
- word mark BULGARI, the United States trademark No. 1184684, registered as of January 5, 1982, in class 14;
- word mark BVLGARI, European Union trademark No. 007138101, registered as of June 3, 2009, in classes 35, 36, 41, and 43.

The Complainant has demonstrated to own various domain names relating to its BULGARI trademark, *inter alia*, since 1998 the domain name which resolves to the Complainant's main website at "www.bulgari.com", promoting the Complainant's jewelry and other luxury goods as well as the Complainant's hotels worldwide. The Complainant's official website enables users to access all product lines: jewelry, fragrances, leather goods, accessories, watches and the bridal collection.

The Respondent registered the disputed domain name on March 3, 2023. At the time of filing the Complaint, the disputed domain name resolved to a website that displays a webpage that purports to sell men's and women's perfumes. Upon clicking "Men's Perfumes" or "Women's Perfumes" on that webpage, user is redirected to another site that offers various perfume products of different manufacturers for sale.

On April 25, 2023, the Complainant sent a cease-and-desist letter to the Respondent claiming the transfer of the disputed domain name and cease and desist from using the BULGARI trademark, left unanswered.

5. Parties' Contentions

A. Complainant

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

- (1) the disputed domain name is confusingly similar to the Complainant's BULGARI trademark. The Complainant holds numerous trademark registrations for BULGARI registered in various jurisdictions. The Complainant also holds the goodwill and recognition that has been attained under the name BULGARI, which is a distinctive identifier associated with the Complainant's services. The disputed domain name clearly contains, in its entirety without alteration or adornment, the BULGARI trademark, in addition to the term "standutyfree". The generic Top-Level Domain ".shop" shall be viewed as a standard registration requirement and as such is disregarded;
- (2) the Respondent lacks a right or a legitimate interest in the disputed domain name. The Respondent does not have any trademark rights to the term BULGARI or "bulgaristandutyfree". The Respondent is not commonly known by the term "bulgaristandutyfree". There is also no evidence that the Respondent retains any unregistered trademark rights to the term BULGARI or "bulgaristandutyfree". Neither has the Respondent received any license from the Complainant to use a domain name featuring the BULGARI trademark. The Respondent is using the Complainant's mark to redirect users to another site offering products competitive to the Complainant, which cannot be considered a *bona fide* offering of goods or services.

- (3) the disputed domain name was registered and is being used in bad faith. The Complainant's trademark registrations predate the creation date of the disputed domain name by 43 years. The Respondent has clearly registered the disputed domain name to target the Complainant's brand intentionally. The Respondent is using the Complainant's BULGARI mark to attract Internet users to the disputed domain name in an attempt to confuse and mislead Internet users seeking or expecting to reach the Complainant's BULGARI perfume offerings. The Respondent did not respond to a cease and desist notice sent by the Complainant in regard to the disputed domain name.

The Complainant requests transfer of the disputed domain name in order to protect its rights and legitimate business interests.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (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 Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complaint.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy it should be established that the disputed domain name is identical or confusingly similar to a mark in which the complainant has rights.

The Panel confirms that for the purposes of paragraph 4(a)(i) of the Policy the Complainant has satisfied the threshold requirement of having relevant trademark rights for BULGARI in jurisdictions throughout the world.

With the Complainant's rights in BULGARI trademark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to the Complainant's mark.

It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. 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.

The disputed domain name contains the name "BULGARI" in its entirety, in addition to the term "standutyfree". It is established that the mere addition of descriptive terms to a trademark does not prevent a

finding of confusing similarity under this element. See [WIPO Overview 3.0](#), section 1.8. Therefore, it is confusingly similar to the BULGARI trademark. Prior UDRP panels have recognized that confusing similarity is established for purposes of the Policy where the disputed domain name incorporates the complainant's trademark in its entirety. See [WIPO Overview 3.0](#), section 1.7.

The addition of the generic Top-Level Domain ".shop" shall be disregarded for the purposes of assessing confusing similarity, as it is a standard requirement of registration. See [WIPO Overview 3.0](#), section 1.11.1.

For all of the above-mentioned reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

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.

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of "proving a negative", in particular as the evidence needed to show the Respondent's rights or legitimate interests is often primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name to meet the requirements of paragraph 4(a)(ii) of the Policy.

The Panel has found out that the Respondent is not a licensee of the Complainant and not affiliated with the Complainant in any way. The Complainant has not granted any authorization for the Respondent to make use of its BULGARI trademarks, in a domain name or otherwise.

There is no evidence to suggest that the Respondent is commonly known by the disputed domain name.

There are no evidence in the case file that the Respondent has ever used, or had made demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services.

On the moment of filing the Complaint, the disputed domain name displayed a webpage that purports to sell men's and women's perfumes. When users click "Men's Perfumes" or "Women's Perfumes" on the webpage, they were redirected to another side offering various perfume products of different manufacturers. This cannot be considered a *bona fide* offering of goods or services, since the Respondent is using the Complainant's mark to redirect users to another site offering products competitive to the Complainant. Previous panels have held such use to not constitute a *bona fide* goods or services (see *Yusuf A. Alghanim & Sons W.L.L. v. Anees Salah Salameh*, WIPO Case No. [D2018-1231](#)).

In view of the above, the Complainant has presented a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name for the purposes of Paragraph 4(a)(ii) of the Policy. Accordingly, the burden of production shifted to the Respondent to come forward with evidence to rebut the Complainant's case. The Respondent has failed to demonstrate any of the non-exclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c), or provide any other evidence of rights or legitimate interests in the disputed domain name.

The Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name. With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, 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.

The Complainant's BULGARI trademark registrations predate the creation date of the Disputed Domain Name by 43 years. The Complainant refers that it has accrued substantial goodwill and recognition since the Complainant's establishment in 1884 – the BULGARI name has become synonymous with high-end and stylistically unique luxury jewelry, watches, perfumes, and accessories and, based on the evidence submitted, the Panels agrees. This Panel considers that it is inconceivable to believe that 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. See [WIPO Overview 3.0](#), section 3.1.4.

The Panel also takes due note of the cease and desist letter sent to the Respondent which remained unanswered. A lack of reply to a cease and desist notice prior to commencing the proceedings infers bad faith behavior (see *Facebook, Inc. and Instagram, LLC v. C W / c w, c w*, WIPO Case No. [D2018-1159](#)).

For all these reasons, the Panel is of the opinion that the Respondent registered the disputed domain name in bad faith.

The Complainant submits that the Respondent is using the Complainant's BULGARI mark to attract Internet users to the disputed domain name in an attempt to confuse and mislead Internet users seeking or expecting to reach the Complainant's BULGARI perfume offerings. The Panel has considered the case file and found that the disputed domain name is used to redirect users to a webpage that offers various perfume products competitive to the Complainant, whereas the Respondent has not been authorised to use the mark for redirection to competing offerings. Such use is commonly seen by panelists as bad faith behavior. See [WIPO Overview 3.0](#), section 3.1.3.

Therefore, the Panel is of the view that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of that website. In accordance with paragraph 4(b)(iv) of the Policy, this shall be evidence of both the registration and use in bad faith of the disputed domain name for the purposes as set out in paragraph 4(a)(iii) of the Policy.

The Respondent has not participated in these proceedings and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good-faith use and indeed none would seem plausible.

In light of the above, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith and that the Complainant has established its case 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 <bulgaristandutyfree.shop> be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: September 22, 2023