

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. ebrahim feroz, venelsoa.jokolia, vertigo, milioneri ruslana
Case No. D2023-4639

1. The Parties

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

The Respondents are ebrahim feroz, United Kingdom, venelsoa.jokolia, vertigo, Italy, and milioneri ruslana, United Kingdom.

2. The Domain Names and Registrar

The disputed domain names <bulgari-hotelparis.com>, <bulgariparishotel.com>, and <bulgarihotel-paris.com> are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 8, 2023, with respect the disputed domain names <bulgari-hotelparis.com> and <bulgariparishotel.com>. On November 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 9, 2023, the Registrar 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 17, 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 November 20, 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 November 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 15, 2023.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on January 3, 2024. 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.

Due to an administrative oversight, the Center's email of November 17, 2023, only included registrant and contact information for the disputed domain name <bulgari-hotelparis.com>. In order to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, the Panel issued a Panel Order No.1 on January 23, 2024, in which: (a) the Registrar-disclosed registrant information for the disputed domain name <bulgariparishotel.com> was provided to the Parties, (b) the Complainant was invited to amend its Complaint by January 28, 2024, adding the Registrar-disclosed registrants as formal Respondents and provide relevant arguments or evidence demonstrating that all named Respondents are, in fact, the same entity and/or that all domain names are under common control; or (b) alternatively, if preferred, the Complainant may submit a request to remove the disputed domain name <bulgariparishotel.com> from the current proceeding by January 28, 2024, and file a separate complaint in relation to this disputed domain name.

On January 29, 2024, the Complainant sent an email to the Center requesting removal of the disputed domain name <bulgariparishotel.com> from the proceeding.

On February 2, 2024, the Panel issued a Panel Order inviting the Respondent to comment on the Complainant's request to withdraw the disputed domain name <bulgariparishotel.com> from the proceeding by February 5, 2024. The Respondent did not reply to this Panel Order.

On February 9, 2024, the Complainant sent an email to the Center requesting for addition of the disputed domain name <bulgarihotel-paris.com> (the "Additional Domain Name") to the proceeding. On the same day, the Complainant has also requested that the Panel disregard the Complainant's request for the withdrawal of the disputed domain name <bulgariparishotel.com> (the "Withdrawn Domain Name"), and requested the opportunity to argue for consolidation of all three disputed domain names, namely, <bulgari-hotelparis.com>, <bulgarihotel-paris.com>, and <bulgariparishotel.com>.

As instructed by the Panel, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Additional Domain Name on February 27, 2024. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Additional Domain Name which differed from the named Respondent in the Complaint. On March 7, 2024, the Panel issued a Panel Order No. 3: (a) disclosing the registrant and contact information in relation to the Additional Domain Name; (b) inviting the Complainant to amend the Complaint by March 12, 2024, to address why the Withdrawn Domain Name should be re-included and why the three disputed domain names should be consolidated, if so; and (c) inviting the Respondents to respond to the amended Complaint and the Complainant's request for consolidation by March 17, 2024. The Complainant filed an amended Complaint on March 12, 2024. The Respondents did not reply to the Panel Order No. 3 nor to the amended Complaint.

4. Factual Background

The Complainant is an Italian company founded in 1884 and operating in the luxury goods and hotel markets. It is known for its high-end jewellery and operates more than 230 retail locations worldwide. Within a joint venture with the Luxury Group, a division of Marriot International, the Complainant operates hotels in major locations around the world, including in Paris, France (Annex 7). The Complainant owns numerous trademarks in the designation BULGARI, including the following (Annex 8):

- International trademark registration no. 452694 BULGARI (word), registered on May 15, 1980, with designations to many jurisdictions worldwide, for goods in Classes 11, 14, 20, and 21;

- Unites States of America trademark registration BULGARI (word) no. 1184684, registered on January 5, 1982, for goods in Class 13; and
- Australian trademark registration no. 338663 BULGARI (word), registered on October 5, 1979, for goods in Class 14.

The Complainant's official website can be found under the domain name <bulgari.com>.

The disputed domain name <bulgariparishotel.com> was registered on May 30, 2023. It had been used to resolve to a website with per-per-click (PPC) links to jewellery and hotel offerings (Annex 14), but at the time of filing the Complaint was inactive (Annex 10). The disputed domain name <bulgarihotel-paris.com> was registered on July 11, 2023, and the disputed domain name <bulgari-hotelparis.com> was registered on July 12, 2023. Both last mentioned disputed domain names have so far not resolved to any content (Annex 10).

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that it holds numerous trademark registrations in the term "Bulgari" registered in various jurisdictions. It highlights the goodwill and recognition attained under the name "Bulgari" and that previous UDRP panels have recognized the value of the trademark and its association with the Complainant. The BULGARI trademark is recognizable in the second level of the disputed domain names. Thus, it is clear that they are confusingly similar to the Complainant's trademark. The addition of the terms "hotel" and "Paris" (with and without a hyphen) does not prevent this finding, as the BULGARI trademark is still recognizable within the disputed domain names. If at all, the additional terms reinforce confusing similarity with a view to the Complainant's activities in the hotel business.

The Complainant further submits that the Respondents lack rights or legitimate interests in the disputed domain names. The Respondents do, to the Complainant's knowledge and research, not dispose of any unregistered or registered rights in the term "Bulgari". They have not received a license to use it from the Complainant either. The disputed domain names currently do not resolve to any active content, and there is not offering of, not demonstrable preparations for offering, goods or services in good faith. The Respondents, according to the Complainant, have never been known by the disputed domain names, nor is there – in view of the distinctiveness of the BULGARI trademark – any plausible reason for the registration of the disputed domain names other than taking advantage from the reputation of the BULGARI trademark. Lastly, the Complainant points to the fact that the current passive holding of the disputed domain names does not constitute a legitimate interest either.

Finally, the Complainant argues that the disputed domain names were registered and are being used in bad faith. The Complainant's earliest trademarks predate their registration by more than 40 years. There is substantive goodwill connected with the BULGARI trademark. Anyone with access to Internet can find the Complainant's trademark on public trademark databases (Annex 11) and its brand and offerings as a first search result (Annex 12). The selection of a domain name so obviously connected to a complainant's trademark as in the present case strongly suggests opportunistic bad faith. The Complainant also submits a cease and desist letter sent to the Respondents on July 27, 2023, for the disputed domain name <bulgariparishotel.com> which remained unanswered. The Complainant further put forth that the disputed domain names were also used in bad faith, by intentionally using the goodwill and reputation of the Complainant's trademark to redirect Internet users to its own websites due to likelihood of confusion. The previous use of PPC links on the disputed domain name <bulgariparishotel.com> constitutes a clear attempt to generate commercial gain (Annex 14), also having used keyword in connection with the Complainant's

hotel offerings. The current passive holding of the disputed domain names does not prevent a finding of use in bad faith, given the international renown of the BULGARI trademarks, the absence of rights or legitimate interests on the Respondents' side and the high risk of implied affiliation.

B. Respondents

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

6. Discussion and Findings

6.1 Procedural matters

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants (referred to in this Decision as "the Respondents") pursuant to paragraph 10(e) of the Rules.

The Respondents did not comment on the Complainant's request and contentions.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, the Complainant has submitted the following: All three disputed domain names share identical technical details and follow the same pattern. They are all registered using the Registrar and using the same privacy service (Annex 1). At the time of registration, all three disputed domain names had set up an SSL (secure sockets layer), meaning the same SSL can be used for multiple domain names, which is the case here (Annex 15.1, pages 2, 12, and 14). They were all registered during the same period (within about 43 days from each other), have the same primary IP address as secondary address, have used the same MX record host (Annex 15.1, pages 1, 10, 11, 13, and 15) and follow the same pattern including the word sequence "bulgari", "hotel", and "paris", the only difference being the placement of a hyphen. All disputed domain names are currently inactive, and the Respondents failed to verify their details, which shows that the Respondents have used different aliases to hide their identities (Annex 15, pages 3-5).

Accordingly, applying the abovementioned principles to the facts in this case, and in the absence of any response from the Respondents, the Panel finds that the Complainant has established more likely than not that the disputed domain names are subject to common ownership or control. The Panel finds evidence of such common control to be appropriate to justify consolidation of the Complainant's claims against the Respondents in this proceeding. The Panel further concludes, in the absence of any response from the Respondents, in the circumstances of this case that consolidation would be fair and equitable to all parties and procedurally efficient, and therefore will allow the consolidation as requested by the Complainant pursuant to paragraph 10(e) of the Rules.

6.2 Substantive matters

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. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

In addition, the Panel finds the mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here, “hotel” and “paris” (with and without hyphen), may bear on assessment of the second and third elements, the Panel finds the addition of these terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which a respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondents lack rights or legitimate interests in the disputed domain names. The Respondents have not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Furthermore, the Panel finds the composition of the disputed domain names (addition of the terms “hotel” and “paris” with and without hyphen to the Complainant’s trademark) carries a risk of implied affiliation with the Complainant, particularly given the Complainant’s provision of hotel services in Paris. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that all disputed domain names currently are being passively held.

As for the disputed domain name <bulgariparishotel.com>, it has in the past been used to resolve to a website with PPC links to jewellery and hotel offerings, partly labelled with the BULGARI trademark. Such use constitutes bad faith in accordance with the paragraph 4(b)(iv) of the Policy.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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; and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

Having reviewed the record, the Panel finds the Respondents' registration and use of the disputed domain names constitutes bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third 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 names <bulgari-hotelparis.com>, <bulgariparishotel.com>, and <bulgarihotel-paris.com> be transferred to the Complainant.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: March 27, 2024