

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. morteza amini moghadam, zeus
Case No. D2024-0280

1. The Parties

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

The Respondent is morteza amini moghadam, zeus, Iran (Islamic Republic of).

2. The Domain Name and Registrar

The disputed domain name <bvlgarii.com> is registered with CSL Computer Service Langenbach GmbH dba Joker.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 23, 2024. On January 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 24, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to the Complainant on January 24, 2024, 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 January 29, 2024.

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 January 30, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 19, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 20, 2024.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on March 5, 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.

4. Factual Background

The Complainant is Bulgari S.p.A., an Italian company founded in 1884 which 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, Paris, Geneva, and Monte Carlo in the 1970s, reaching nowadays more than 230 retail locations worldwide.

The BVLGARI name derives from the founder's name ("Voulgaris"). The Complainant's trademark is both written as "BVLGARI" in the classic Latin alphabet and "BULGARI" in the modern alphabet.

The Complainant created the domain name <bulgari.com> on February 17, 1998, which directs users to the official website of the Complainant. Since then, the Complainant has a strong online presence and the Complainant's official website, which receives over 2 million visits per month from users around the world, enables users to access all product lines: jewelry, watches, fragrances, leather goods and accessories. Internet users are also able to locate the Complainant's stores and authorized retailers worldwide. The BVLGARI trademark is also reflected in the Complainant's domain name <bvlgari.com>, which redirects to the Complainant's official website.

The BVLGARI and BULGARI trademarks are well advertised globally, with promotional videos, billboards and other sources of marketing material, which has further promoted the brand's global recognition for high-end jewelry and accessories.

As part of its effort to protect its intellectual property, the Complainant, its affiliates, subsidiaries, and associated companies own trademark registrations for the BVLGARI and BULGARI trademarks within numerous jurisdictions including but not limited to the following:

- United States Trademark Registration No. 1,694,380 for BVLGARI, registered on June 16, 1992, in International Class 18;
- International Trademark Registration No. 494237 for BVLGARI, registered on July 5, 1985, in International Classes 03, 08, 11, 14, 16, 18, 20, 21, 25, 34;
- International Trademark Registration No. 1290822 for BVLGARI, registered on December 23, 2015, in International Classes 09, 35, 38, 42;
- European Union Trademark Registration No. 007138101 for BVLGARI, registered on June 03, 2009, in International Classes 35, 36, 41, 43.

The Complainant has also established a social media presence and uses its BVLGARI and BULGARI trademarks to promote its services under this name.

The disputed domain name was created on August 15, 2023, and used to resolve to a commercial website, using the Complainant's logo on the website, and selling third-party clothes. At the time of the administrative proceedings, it does not resolve to any active website but generates an error web page.

The Complainant sent the cease and desist letter to the Respondent on September 21, 2023, which remains unanswered.

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 name.

Notably, the Complainant contends the following.

Identical or Confusingly Similar

The Complainant contends that the disputed domain name and the BVLGARI trademark are confusingly similar.

According to the Complainant's contentions, the disputed domain name is made of the complete incorporation of the Complainant's BVLGARI trademark, slightly misspelled by addition of the letter "i" and the generic Top-Level-Domain ("gTLD") ".com", so as to create a likelihood of confusion with the Complainant's BVLGARI trademark.

No rights or legitimate Interests

The Respondent has no connection with the Complainant or any of its affiliates and has never sought or obtained any trademark registration for the BVLGARI trademark. The Complainant does not carry out any activity for, nor have any business with, the Respondent.

The Complainant further contends that the Respondent is not commonly known by the disputed domain name.

The Complainant asserts that there is no evidence that the Respondent retains unregistered trademark rights to the term 'bvlgarrii' or anything similar.

The Respondent is using the Complainant's mark to direct users to the commercial website impersonating the Complainant and offering third-party products, which cannot be considered a bona fide offering of goods or services.

The Complainant further asserts that such use carries a high risk of consumer confusion, and creates an unwanted association with the goods offered therefrom. The disputed domain name has no generic meaning pertaining to clothing, and can only be construed as a mistype of the Complainant's BVLGARI trademark.

Registered and used in bad faith

The Complainant submits that the Respondent registered and is using the disputed domain name in bad faith.

The Complainant submits that its earliest trademark registration predates the creation date of the disputed domain name by 38 years. In addition, substantial goodwill has accrued since the Complainant's establishment in 1884.

Thus, the Complainant asserts that the Respondent either knows or should have known of the Complainant's trademark. The additional evidence of the Respondent's knowledge of the Complainant and its BVLGARI mark is the Respondent's use of the Complainant's official logo on the commercial website under the disputed domain name.

The Complainant also asserts that a lack of reply to pre-complaint notices infers bad faith behaviour.

The Complainant also contends that a clear likelihood of confusion exists between the disputed domain name and the BVLGARI trademark, given the mere repetition of the last letter. From this, the Respondent attempts to make commercial gain from online users (regardless of whether the "online store" is currently operational, as it may become so in the future) who intended to access the Complainant's online services. The Respondent has further attempted to insinuate authorisation from the Complainant through the website, by utilising the Complainant's official BVLGARI logo, and otherwise purporting to be the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel “shall draw such inferences therefrom as it considers appropriate”.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (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.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

Ownership of a nationally or regionally registered trademark serves as a prima facie evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. See section 1.2 of the [WIPO Overview 3.0](#). The Complainant submitted evidence that the BVLGARI trademark enjoys protection in various jurisdictions.

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 disputed domain name incorporates the Complainant's trademark in its entirety with the repetition of the letter “i” at the end of the mark and followed by the gTLD “.com”.

According to section 1.8 of the [WIPO Overview 3.0](#), 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. The nature of such additional term may however bear on assessment of the second and third elements.

Under section 1.7 of the [WIPO Overview 3.0](#), while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

Finally, for the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the gTLD, see section 1.11.1 of the [WIPO Overview 3.0](#).

It is the view of the Panel that it is readily apparent that the Complainant's BVLGARI trademark remains recognizable in the disputed domain name.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the BVLGARI trademark in which the Complainant has rights.

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 the 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 Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has 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 name such as those enumerated in the Policy or otherwise.

Based on the Complainant’s contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use its BVLGARI trademark.

The Complainant’s trademark registrations for the BVLGARI trademark predate the Respondent’s registration of the disputed domain name.

Based on the case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

The Respondent has actively used the disputed domain name, which is confusingly similar to the Complainant’s BVLGARI trademark, to mislead Internet users into visiting the website linked to the disputed domain name, using the Complainant’s logo on the website, and selling third-party products. This shows the Respondent’s intention to divert consumers to the disputed domain name for commercial gain, by taking unfair advantage of the goodwill and reputation of the Complainant’s BVLGARI trademark.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has 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 name such as those enumerated in the Policy or otherwise.

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 the Complainant's registration and use of the trademark significantly predates the creation date of the disputed domain name.

When the Respondent created the disputed domain name, the BVLGARI trademark was already widely known and directly associated with the Complainant's activities. Panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trade mark by an unaffiliated entity can by itself create a presumption of bad faith.

Given the extensive prior use and fame of the Complainant's BVLGARI trademark, in the Panel's view, the Respondent should have been aware of the Complainant's BVLGARI trademark when registering the disputed domain name and ultimately, given the composition of the disputed domain name and the use of the Complainant's logo on the website, it is clear that the Respondent was aware of the Complainant and intentionally targeted the Complainant when registering the disputed domain name.

In light of the nature of the disputed domain name, comprising the entirety of the Complainant's trademark and just adding the letter "i" at the end of the mark, and the use of the Complainant's logo on the website, the Panel is in no doubt that the Respondent had the Complainant and its rights in the BVLGARI trademark in mind when it registered the disputed domain name. In the absence of any response by the Respondent, the Panel has no reason to doubt that the Respondent has used its website to mislead Internet users into believing that the website at the disputed domain name is operated by or authorized by the Complainant and to deceive customers of the Complainant into disclosing personal information. In the Panel's view, the use of a domain name for such activity, clearly with a view to commercial gain, amounts to paradigm bad faith registration and use for the purposes of the Policy.

The current non-use of the disputed domain name does not prevent the finding of bad faith. As noted in the [WIPO Overview 3.0](#), section 3.3, from the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In such a situation, it is appropriate to look at the totality of the circumstances of the case.

Here, the facts alleged in the Complaint, the Complainant's trademark reputation, the lack of the Respondent's rights or legitimate interests, and the lack of response from the Respondent to the Complainant's cease-and-desist letter and to the Complaint, support a finding of bad faith registration and use.

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 name <bvlgarii.com> be transferred to the Complainant.

/Kateryna Oliinyk/
Kateryna Oliinyk
Sole Panelist
Date: April 1, 2024