

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. Jerry Anderson
Case No. D2024-0504

1. The Parties

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

The Respondent is Jerry Anderson, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <bulgarihotel.info> is registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 2, 2024. On February 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 2024, 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, Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 5, 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 February 6, 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 February 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 29, 2024.

The Center appointed Benoit Van Asbroeck 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 an Italian company active in the luxury goods and hotel sectors. It was founded in 1884 and has more than 230 retail locations worldwide.

The Complainant is the owner of registered trademarks in the mark BULGARI, amongst which:

Australia Trademark No. 338663 for BULGARI, registered on October 5, 1979, in International Class 14;

United States Trademark No. 1184684 for BULGARI, registered on January 5, 1982, in International Class 14; and

International Trademark No. 452694 for BULGARI, registered on May 15, 1980, in International Classes 11, 14, 20, and 21.

The Complainant also owns a domain name incorporating the mark BULGARI, namely the domain name used for its official website: <bulgari.com>, and uses the mark BULGARI on various social media channels.

Moreover, the Complainant owns trademarks in the mark BVLGARI and operates hotels under the BVLGARI brand.

The disputed domain name was registered on June 8, 2023, well after the Complainant secured rights in the mark BULGARI. According to evidence submitted by the Complainant, the disputed domain name currently resolves to a website containing Pay-Per-Click (“PPC”) links relating to the Complainant’s offering of goods and some forward visitors to competing hotel offerings.

On July 27, 2023, and August 3, 2023, respectively, the Complainant issued two contact requests to the Respondent through the Registrar’s contact form, however the Respondent did not respond to these requests.

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.

With respect to the first element, the Complainant contends that it has rights in the mark BULGARI and that the disputed domain name is confusingly similar to this mark. Specifically, the Complainant notes, the disputed domain name merely appends the term “hotel” to the Complainant’s BULGARI trademark which in fact further reinforces the confusing similarity considering the Complainant’s luxury hotel offerings. Finally, the Complainant claims that the generic top-level domain (“gTLD”) “.info”, featured in the disputed domain name, does not negate a finding of confusing similarity under the first element as it is a standard registration requirement.

Regarding the second element, the Complainant claims that the Respondent lacks a right or legitimate interest in the disputed domain name. The Complainant contends that the Respondent does not have any trademark rights to the term “bulgari”, does not own unregistered trademark rights to the term “bulgari hotel”

or similar terms, and is not commonly known by the term “bulgari”. Furthermore, the Complainant confirms that the Respondent has not received any license from the Complainant to use domain names featuring the BULGARI trademark. Moreover, the Complainant contends that its BULGARI trademark is distinctive and well-known and refers to several prior UDRP decisions in support. In addition, the Complainant claims that instead of using the disputed domain name in connection with a bona fide offering of services, the Respondent has deliberately used the goodwill attached to the BULGARI brand for its own monetary gain by using the disputed domain name for a website containing PPC links relating to the Complainant’s offering of goods and competing hotels. This use of the disputed domain name does neither qualify as legitimate noncommercial or fair use.

As to the assessment of the Respondent’s bad faith at the time of registration, the Complainant contends that its earliest trademark registration in BULGARI predates the creation date of the disputed domain name by 44 years and that substantial goodwill has accrued in this trademark since the Complainant’s establishment in 1884. Furthermore, the Complainant claims that the Respondent’s knowledge of the Complainant’s BULGARI mark is also demonstrated by the fact that Google searches for “bulgari” or “bulgari hotel” list the Complainant’s brand and services as the first result.

As to bad faith use, the Complainant asserts that the Respondent has engaged in a pattern of registering infringing domain names, preventing the rightsholders from reflecting their marks. The Complainant provides evidence of domain names currently owned by the Respondent which appear to infringe on other companies’ existing trademark rights and points to the fact that in four other UDRP cases the relevant panels determined that the Respondent acted in bad faith. In addition, the Complainant claims that by using the disputed domain name for a website containing PPC links, of which some link to third party websites which are directly competing with the Complainant’s hotel services and jewelry items, the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s BULGARI mark. Finally, the Complainant notes that the fact that the Respondent did not respond to the Complainant’s contact requests also infers bad faith behavior.

B. Respondent

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

6. Discussion and Findings

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.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is 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”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Finally, as for the applicable gTLD “.info”, the Panel holds that this can be disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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.

The Panel finds that the Respondent does not use the disputed domain name in connection with a bona fide offering of services and has neither made a legitimate noncommercial or fair use of the disputed domain name. On the contrary, the Complainant has shown that the disputed domain name is being used for a website with PPC links relating to the Complainant’s offering of goods and some of these links forward visitors to competing hotel offerings. This kind of use of the disputed domain name does not represent a bona fide offering and does not support rights or legitimate interests in the disputed domain name. [WIPO Overview 3.0](#), section 2.9.

In addition, the Complainant confirmed that the Respondent is not affiliated with the Complainant in any way nor has the Complainant licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant’s trademarks. The Panel has taken note of the Complainant’s confirmation in this regard and has not seen any evidence that would suggest the contrary. Noting the composition of the disputed domain name, in the absence of any license or permission from the Complainant to use its trademarks, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); and *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

Finally, the Panel agrees with the Complainant that there is no evidence that the Respondent has been commonly known by the disputed domain name.

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 Respondent has registered the disputed domain name in order to prevent the Complainant from reflecting the BULGARI mark in a corresponding domain name. The Complainant has submitted evidence showing that the Respondent has been the respondent in four other

UDRP cases and that the panels in these cases all determined that the Respondent acted in bad faith. Moreover, the Complainant demonstrated that the Respondent is the current registrant of six other domain names, which appear to infringe pre-existing trademarks belonging to third parties. The Panel is therefore convinced that the Respondent has been engaged in a pattern of abusive domain name registrations.

In addition, the Panel notes that the Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's marks (paragraph 4(b)(iv) of the Policy). As the evidence submitted by the Complainant shows, the disputed domain name resolves to a website containing PPC links relating to the Complainant's offering of goods and some forward visitors to competing hotel offerings. One of the PPC advertisement links on this website even uses the Complainant's BULGARI trademark as it specifically mentions "Bulgari Jewelry". These circumstances, in combination with the Respondent's clear absence of rights or legitimate interests in the disputed domain name, are strong indicators of bad faith.

Furthermore, it should be noted that 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 also 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.

First of all, the Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain name included the Complainant's BULGARI trademarks. As demonstrated by the Complainant, prior Panels have previously recognised that the BULGARI trademark is distinctive and well-known (see, for example: *Bulgari S.p.A. v. Martin, Spain.*, WIPO Case No. [D2023-4755](#); and *Bulgari S.p.A. v. Obschestvo s ogranichennoy otvetstvennostyu "MD-AvtoKars"*, WIPO Case No. [D2023-3094](#)). Other prior Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see [WIPO Overview 3.0](#), Section 3.1.4).

Furthermore, as the evidence submitted by the Complainant demonstrates, one of the PPC advertisement links on the website that the disputed domain name resolves to uses the BULGARI mark as it specifically mentions "Bulgari Jewelry". In addition, the disputed domain name incorporates the BULGARI trademarks in their entirety and includes the term "hotels". This suggests that the Respondent had the Complainant and its trademarks in mind when registering the disputed domain name since the Complainant sells jewelry and operates several luxury hotels. Indeed, given the Complainant's luxury hotel offerings, the addition of the term "hotel" affirms the Respondent's intention of creating a likelihood of confusion between the disputed domain name and the BULGARI mark.

Moreover, the Complainant's evidence shows that such trademarks were registered many years before registration of the disputed domain name in several countries including the United States, the country of residence of the Respondent according to the Whois records. The Respondent's knowledge of the Complainant and its trademarks and therefore its registration in bad faith of the disputed domain name may accordingly also be inferred from these circumstances. [WIPO Overview 3.0](#), section 3.2.2.

In addition, the fact that the Respondent did not respond to the contact requests which the Complainant sent to the Respondent on July 27, 2023, and August 3, 2023, respectively as well as failed to submit a response in these proceedings, further supports a finding of bad faith (see *Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications*, WIPO Case No. [D2001-0210](#)).

Finally, the fact that the Respondent used a privacy service and, as demonstrated by the Complainant, used different names for domain names registered at the same address, can be used as further indicators of bad faith. [WIPO Overview 3.0](#), section 3.6.

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 <bulgarihotel.info> be transferred to the Complainant.

/Benoit Van Asbroeck/

Benoit Van Asbroeck

Sole Panelist

Date: March 19, 2024