

ADMINISTRATIVE PANEL DECISION

Bottega Veneta S.r.l. v. asd ffe
Case No. D2024-1936

1. The Parties

The Complainant is Bottega Veneta S.r.l., Italy, represented by Studio Barbero S.p.A., Italy.

The Respondent is asd ffe, China.

2. The Domain Name and Registrar

The disputed domain name <bottegabenetaoulet.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 8, 2024. On May 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 10, 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, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 14, 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 amendment to the Complaint on May 15, 2024.

The Center verified that the Complaint together with the amendment to the 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 May 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 6, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 10, 2024.

The Center appointed Mireille Buydens as the sole panelist in this matter on June 18, 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 was founded in the mid-1960s in Italy, producing artisanal leather goods. Over time the Complainant's renown grew. In 2001 it was purchased by the Gucci Group. It currently offers a wide range of fashion products, in the first place leather goods but also eyewear, jewelry, home accessories and fragrances. The Complainant distributes its products through a worldwide network of directly operated stores, exclusive departments and specialty stores, encompassing Europe, Asia, North and South America. It runs Bottega Veneta-owned boutiques in various countries, including China. The Complainant's advertising campaigns appear in important international magazines with broad circulation such as, inter alia, Elle, Monocle, Vogue, Vanity Fair and Harper's Bazaar. The Complainant's revenues were 1,645 million in 2023, of which the 77 percent was generated through the sales of BOTTEGA VENETA leather goods.

The Complainant owns trademark registrations for BOTTEGA VENETA (word mark – hereafter “the Trademark”), including the following:

- International Trademark Registration No. 705303, for BOTTEGA VENETA (word mark) registered on October 8, 1998, in classes 3, 9, 14, 18, and 25;
- International Trademark Registration No. 420038, for BOTTEGA VENETA (word mark) registered on December 16, 1975, in classes 6, 11, 14, 16, 18, 20, 21, and 25, covering inter alia China;
- Chinese Trademark Registration No. 11880267, for BOTTEGA VENETA (word mark) registered on May 28, 2014, in class 25;
- Chinese Trademark Registration No. 22837444, for BOTTEGA VENETA (word mark) registered on February 21, 2018, in class 18.

The Complainant registered numerous domain names incorporating the Trademark, including <bottegabeneta.com>, registered on July 10, 1997. The Complainant is also using the Trademark in connection with the advertising and sale of its products in China, including through a dedicated website “www.bottegabeneta.cn/”.

The disputed domain name was registered on February 25, 2023. According to the Complaint, it is pointed to a website offering for sale counterfeit BOTTEGA VENETA products, along with products of the Complainant's competitors, such as CELINE and PRADA. The prices for such products are cheaper than the prices applied to the genuine Trademark products sold by the Complainant.

The Complainant sent a cease-and-desist letter on April 3, 2023, to the shielded e-mail address published in the WhoIs records of the disputed domain name. In absence of reply, reminders were sent on April 20, 2023, and May 12, 2023. The Respondent did not provide any answer.

At the time of this decision, the disputed domain name still resolves to a webshop offering products under the Trademark, these products being described as “replica's” and “imitations” of the genuine Trademark products.

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 that it owns rights in the Trademark and that the disputed domain name is confusingly similar to the Trademark. The disputed domain name incorporates the Complainant's Trademark. The fact that the disputed domain name differs from the Complainant's Trademark by the addition of the non-distinctive element "oulet" - which is a misspelling of "outlet" - does not affect the confusing similarity as the Trademark is still recognizable within the disputed domain name. Furthermore, the addition, of the word "oulet" reinforces the likelihood of confusion, as the term "outlet" refers to a location where consumers can shop for brand name items at a discount. Therefore, Internet users might believe that the disputed domain name is registered and used by the Complainant in order to promote and sell genuine products (at a discount). As to the addition of the generic Top-Level Domain ("gTLD") extension ".com", it is merely instrumental to the use of Internet and shall thus be disregarded in the assessment of confusing similarity.

Second, the Complainant asserts that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant has never licensed, contracted, or otherwise permitted the Respondent to register the disputed domain name. The Respondent has not been commonly known by the disputed domain name. There is no evidence that the Respondent is using disputed domain name for a bona fide offering of goods or services, nor is there any evidence of fair use. On the contrary, the disputed domain name is directed to a website in the alleged sale of counterfeit BOTTEGA VENETA products at discounted prices - failing to provide any disclaimer as to the lack of affiliation between the Respondent's website and the Complainant. The Respondent's use of the disputed domain name is, therefore, apt to mislead Internet users into believing that the website to which it resolves is operated by the Complainant or by a Complainant's affiliate. The Respondent has been undoubtedly attempting to gain from the offer for sale of the products advertised on its website, by free-riding the well-known character of the Complainant's Trademark and causing confusion amongst Internet users as to the source or affiliation of its website and the products offered for sale therein.

Third, the Complainant asserts that the disputed domain name was registered and is being used in bad faith. In particular, the Complainant's Trademark predates the registration of the disputed domain name for several years and has been extensively used since as early as mid-1960s in connection with the Complainant's advertising and sales of BOTTEGA VENETA products worldwide. The well-known character of the Trademark has been recognized in several prior UDRP decisions. The Respondent could not have ignored the existence of the Complainant's Trademark when it registered the disputed domain name. Furthermore, the use of the disputed domain name in connection with a website presumably offering for sale counterfeit BOTTEGA VENETA branded products, along with products of Complainant's competitors, such as CELINE and PRADA, clearly indicates that Respondent's purpose in registering and using the disputed domain name was to intentionally attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the website and the goods offered and promoted on said website. As a further circumstance evidencing Respondent's bad faith, the Respondent did not reply to the Complainant's cease-and-desist letter and subsequent reminders. Furthermore, the Complainant asserts that the Respondent indicated inaccurate contact information in the Whois records.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements to succeed in its Complaint:

- (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.

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 Panel finds the Trademark is recognizable within the disputed domain name. The disputed domain name consists of the Trademark followed by the word "outlet" (which is a misspelling of the word "outlet"). The word "outlet" is a descriptive term designating the offering of products at a discounted price. Although the addition of other terms, here "outlet", 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 Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8. The generic gTLD extension (".com"), as a standard requirement of domain name registration, may be disregarded in the assessment of identity or confusing similarity. [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the disputed domain name is confusingly similar to the BOTTEGA VENETA Trademark for the purposes of the Policy.

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 Respondent is not licensed by or affiliated with the Complainant in any way. There is no evidence that the Respondent would be commonly known under the disputed domain name, nor is there any evidence of use or demonstrable plans to use the disputed domain name for a bona fide offering of goods or services.

The composition of the disputed domain name, which includes the Trademark with the descriptive word "outlet" misspelled as "oulet", along with the gTLD ".com", affirms the Respondent's intention of taking unfair advantage of the likelihood of confusion between the disputed domain name and the Complainant's

Trademark as to the origin or affiliation of the website at the disputed domain name. This confirms that there is no use, nor preparations to use, of the disputed domain name in connection with a bona fide offering of goods or services, and thus no legitimate interest in the disputed domain name.

In the present case, the disputed domain name resolves to a website offering products under the Trademark, which are explicitly presented on the website as “replicas” or “imitations” which can mislead Internet users expecting to find Complainant or a website in association with Complainant. This demonstrates that the products offered on the website to which the disputed domain name resolves are counterfeit BOTTEGA VENETA products. Besides, these products are offered at much lower prices than the genuine products on the Complainant’s official website and there is no disclaimer of the lack of relationship with the Complainant. While the record is not determinative to be counterfeited, the circumstances of this case points towards the fact that the products are counterfeited. Panels have held that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. The Respondent’s use for illegal activities (such as the sale of counterfeit products and/or impersonation/passing-off) cannot confer rights or legitimate interests.

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.

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.

In the present case, the Panel first notes that the disputed domain name is confusingly similar to the Complainant’s Trademark, which predates the registration of the disputed domain name for many years and is widely known. The disputed domain name reproduces the Trademark with the mere addition of the word “outlet”, which is a misspelling of the term “outlet”. This typo would obviously go unnoticed by the Internet users and cannot be the result of chance. As a result, the Respondent was more likely than not aware of the Complainant’s earlier rights at the time of the registration of the disputed domain name. [WIPO Overview 3.0](#) section 3.2.2. In any event, a quick BOTTEGA VENETA trademark search, or even a Google search, would have revealed to the Respondent the existence of the Complainant and its Trademark. This the more so that the Complainant owns Trademark registrations in China, where the Respondent is allegedly located.

Panels have consistently found that the registration of a domain name that is confusingly similar (particularly domain names comprising typos or incorporating the trademark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

In the present case, the disputed domain name resolves to a website offering BOTTEGA VENETA branded products which are explicitly presented as “replicas” or “imitations” – which means that the products are counterfeit. The registration and use of the disputed domain name to run a website offering counterfeit products constitute bad faith under the Policy. Panels have held that the use of a domain name for illegal activity, like the sale of presumably counterfeit goods and/or impersonation/passing-off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Furthermore, the failure of the Respondent to submit a response is further evidence of bad faith, given all the circumstances of the case. [WIPO Overview 3.0](#), section 3.2.

Having reviewed the record, the Panel finds the Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

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 <bottegavenetaoulet.com> be transferred to the Complainant.

/Mireille Buydens/

Mireille Buydens

Sole Panelist

Date: July 2, 2024