

ADMINISTRATIVE PANEL DECISION

Bottega Veneta S.r.l. v. 何容 (Rong He)

Case No. D2024-1965

1. The Parties

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

The Respondent is 何容 (Rong He), China.

2. The Domain Name and Registrar

The disputed domain name <itbottegaveneta.shop> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on May 10, 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 11, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 17, 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 in English on May 20, 2024.

On May 17, 2024 the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On May 20, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in Chinese and in English, and the proceedings commenced on May 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 12, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 13, 2024.

The Center appointed Hong Yang as the sole panelist in this matter on June 19, 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, which produces artisanal leather goods and developed a leather-weaving technique as the signature of the brand. The Complainant promoted its products under the mark BOTTEGA VENETA worldwide, including appearance in important international magazines such as Elle, Vogue and Vanity Fair, and that mark was recognized as Best International Luxury Brand at Walpole British Luxury Awards for the second time in 2014, as well as being ranked at the 13th position of the BrandZ™ Top 30 Most Valuable Italian Brands in 2018. Through its consistent use of the mark for decades, BOTTEGA VENETA has apparently become a well-known trademark worldwide, including in China where there is a growing number of branches owned by the Complainant.

The Complainant distributes its products through a worldwide network of directly operated stores and exclusive branches, encompassing Europe, Asia, North and South America, including websites operated through affiliated entities incorporating the mark, through which the Complainant offers online sale of products, such as, <bottegaveneta.com> registered in 1997, and <bottegaveneta.cn> registered in 2003.

The Complainant is proprietor of numerous registered trademarks for the word mark BOTTEGA VENETA in various jurisdictions, including: European Union Trademark Registration No. 006809362, registered on May 31, 2010, International Trademark Registration No. 420038, registered on December 16, 1975, designating, amongst others, China, and Chinese Trademark Registration No.11880267, registered on May 28, 2014.

The disputed domain name was registered by the Respondent on November 7, 2023, and the Respondent is reportedly located in China. The un rebutted evidence provided by the Complainant shows that, at the time of filing of this Complaint, the disputed domain name resolved to a website prominently featuring Complainant's trademark BOTTEGA VENETA, as well as copyrightable advertising images taken from Complainant's official website. There was on the Respondent's website also purportedly offering for sale BOTTEGA VENETA products at discounted prices lowered to 92% off. There is no disclaimer on the website about the Respondent's (lack of) relationship with the Complainant. On the date of this Decision, the disputed domain name resolves to an inactive webpage.

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.

B. Respondent

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

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that: (1) the Complainant communicates in English and would be prejudiced should it be required to translate the Complaint and participate in these proceedings in Chinese; (2) facts in this case have demonstrated that the Respondent understands English.

The Respondent had, moreover, been notified by the Center, in both Chinese and English, of the commencement of the proceeding, the language of the proceeding, and deadline for filing a Response in Chinese or English. The Respondent did not make any specific submissions with respect to the language of the proceeding and did not comment on the Complainant's request for the language of the proceeding be English.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above and in the absence of any rebuttal argument or justification therefore by the Respondent, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

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.

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 mark is recognizable 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.

The applicable generic Top-level Domain ("gTLD"), ".shop" in the disputed domain name does not change this finding, since the gTLD (including with regard to "new gTLDs"), as a standard registration requirement, is generally disregarded in such an assessment of confusingly similarity. [WIPO Overview 3.0](#), section 1.11.1.

Although the addition of other term "it" 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.

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.

The Panel notes that the composition of the disputed domain name itself carries a risk of implied affiliation, with the unrebutted fact that the Respondent was not affiliated, licensed or otherwise authorized by the Complainant, or held any registration of the BOTTEGA VENETA mark anywhere. There is no evidence indicating that the Respondent has rights and legitimate interests in or might be commonly known by the disputed domain name. Particularly, the additional term of “it” is descriptive as it refers to either the geographical indicator for “Italy” where the Complainant is established or the generic term of “information technology” generally relevant to E-Commerce. Where a domain name consists of a trademark plus an additional term, panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

The evidence provided by the Complainant shows that the disputed domain name previously resolved to a website prominently displaying the Complainant’s trademark and copyrightable contents including advertising images taken from the Complainant’s official website, without any consent or approval. Nor is there any disclaimer about the Respondent’s (lack of) relationship with the Complainant. The Respondent purportedly offered on the website the Complainant’s BOTTEGA VENETA branded products, at extremely low discount of 92% percent off for all the products displayed, disproportionately lower than the market value normally offered by the Complainant. Furthermore, the website contained a page of “about us”, where the Respondent, without any legitimate basis, claimed itself as “bottega veneta”, using the term, e.g., “*Benvenuti su BottegaVeneta*” (“Welcome to BottegaVeneta”). The Panel is convinced that the Respondent conveyed the false impression about the relationship with or endorsement from the Complainant, effectively impersonating the Complainant. Moreover, under an overall assessment of relevant factors, the Panel infers that the products sold on the website were likely counterfeit products. Those cannot constitute a bona fide offering of goods under, or a legitimate noncommercial or fair use of the disputed domain name.

Panels have held that the use of a domain name for illegal activity, specifically, here claimed sale of counterfeit goods and impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 the Respondent used without any license or authorization the Complainant's trademark in its entirety in the disputed domain name. The Complainant's trademark BOTTEGA VENETA is well-known and the Complainant's registration and use of its mark much predate the Respondent's registration of the disputed domain name, so the Respondent must have been aware of the Complainant's mark at the time of registering the disputed domain name. Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4

The available record shows that the disputed domain name previously resolved to a website offering a wide range of products identical or similar to those of the Complainant, all at discounted prices disproportionately lower than market value, making no disclaimer clarifying lack of affiliation with or sponsorship from the Complainant. Moreover, the Respondent claimed the website as from "bottega veneta" and used the Complainant's highly renowned mark without any legitimate basis. In this Panel's opinion, the Respondent indeed 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 the Respondent's website. The disputed domain name was thus registered and used in bad faith, according to paragraph 4(b)(iv) of the Policy.

Panels have held that the use of a domain name for illegal activity, specifically, here claimed sale of counterfeit goods and impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

On the date of this Decision, the disputed domain name resolves to an inactive website. Having reviewed the available record, the Panel notes the high reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the current passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy. [WIPO Overview 3.0](#), section 3.3.

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

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 <itbottegaveneta.shop> be transferred to the Complainant.

/Hong Yang/

Hong Yang

Sole Panelist

Date: July 3, 2024