

ADMINISTRATIVE PANEL DECISION

Automobili Lamborghini S.p.A. v. Kualitat Auto EOOD
Case No. D2024-2225

1. The Parties

The Complainant is Automobili Lamborghini S.p.A., Italy, represented by HK2 Rechtsanwälte, Germany.

The Respondent is Kualitat Auto EOOD, Bulgaria.

2. The Domain Name and Registrar

The disputed domain name <lamborhinishbulgaria.com> (the “Domain Name”) is registered with eNom, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 30, 2024. On May 31, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 31, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Private Registration) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 3, 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 June 5, 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 June 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 30, 2024. The Respondent sent an email on June 5, June 10, and June 30, 2024, respectively. On July 1, 2024, the Center notified the Parties that it would proceed to panel appointment. On July 3, 2024, the Complainant submitted supplemental filings.

The Center appointed Ian Lowe as the sole panelist in this matter on July 9, 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.

For the reasons set out below, the Panel decided to admit the supplemental filing by the Complainant, but issued a Procedural Order on July 23, 2024. It noted that in its Response dated June 30, 2024 the Respondent stated that “Recently we have signed a partnership agreement with a major holding company that holds Lamborghini rights in several countries.” The Procedural Order gave the Respondent the opportunity to provide a copy of the partnership agreement referred to and evidence that the counterparty holds relevant “Lamborghini rights” by July 28, 2024. The Complainant was then to have five days from receipt of any submission by the Respondent to comment on the submission.

The Respondent filed a response to the Procedural Order on July 27, 2024 and the Complainant filed a statement commenting on the Respondent’s submission on August 1, 2024.

4. Factual Background

The Complainant is a world-renowned Italian manufacturer of high-performance sports cars founded in 1963 by Ferruccio Lamborghini. It has been owned by the Volkswagen Group since 1998. It is the proprietor of a number of registered trademarks for the mark LAMBORGHINI, including International trademark number 444261 registered on March 15, 1979 designating a number of countries including Italy and Bulgaria; European Union trademark number 001098383 registered on June 21, 2000; and United States of America trademark number 74019105 registered on November 13, 1990.

The Complainant is also the registered proprietor in a number of countries of the device mark illustrated below (the “Complainant’s Logo”), including Estonia trademark number 12556 registered on August 15, 1994:



The Complainant owns a website at “www.lamborghini.com” (and other domain names) promoting its motor cars.

The Respondent operates a garage in Sofia, Bulgaria under the name Das Auto Service, claiming to service medium and high-end cars from the Volkswagen Group, which include Audi, VW, Skoda, Seat, Porsche and Bentley, as well as Lamborghini.

The Domain Name was registered on July 7, 2023. It currently resolves to a website at “www.dasautoservice.com” (the “Current Website”) promoting the services of the Das Auto Service garage. The Privacy Policy published on the website states that the data processor in respect of personal data collected through the website is the Respondent. The website home page incorporates trademarks of each of the Volkswagen Group brands, including the Complainant’s Logo.

At the time of filing of the Complaint, the Domain Name resolved to a website at “www.lamborghinibulgaria.com” (the “Previous Website”) offering services relating to Lamborghini vehicles and featuring the Complainant’s LAMBORGHINI marks, including the Complainant’s Logo. It advertised spare parts for Lamborghini as well as what purported to be an official and certified service for Lamborghini vehicles. In addition, “Lamborghini Club Bulgaria” was advertised for a membership fee of EUR 2,000 per year.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to its LAMBORGHINI trademark (the "Mark"), that the Respondent has no rights or legitimate interests in respect of the Domain Name, and that the Respondent registered and is using the Domain Name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. In particular, the Complainant relies on the following:

- a) the Respondent falsely claimed on the Previous Website that it was an authorized service and car agent for the Complainant in Bulgaria;
- b) under the Complainant's Logo, the Respondent also falsely claimed to be a part of the official "Selezione Lamborghini Certified Pre-Owned" programme;
- c) without authorization, the Respondent further advertised a wide range of services in connection with Lamborghini vehicles including the "Lamborghini Club Bulgaria". The Complainant does support official fan clubs in a number of countries, but not Bulgaria. The Respondent's activities make it more difficult for the Complainant to found its own official fan club in that country;
- d) the Respondent has not been authorized in any way by the Complainant to hold itself out as an official representative or agent of the Complainant.

B. Respondent

In its response email of June 30, 2024, the Respondent accepted that it was using the Lamborghini brand in serving numerous Lamborghini owners on a daily basis. It stated that it had been making regular "weekly" attempts to secure official dealership rights with the Complainant but had received no substantive reply. It claimed, however, that it had recently signed a partnership agreement with a major holding company that holds Lamborghini rights in several countries.

6. Discussion and Findings

Although the Respondent claimed in its Response that it had signed a partnership with a company holding Lamborghini rights, it did not provide any evidence of such an agreement, or specify which company it had made an agreement with, or explain how such agreement gave it relevant rights to justify its registration and use of the Domain Name. In its supplemental filing, the Complainant denied that the Respondent could have entered into such an agreement and in the circumstances the Panel determined to admit the supplemental filing, but to issue a Procedural Order giving the Respondent the opportunity to provide evidence of such an agreement and to explain how it gave the Respondent relevant rights.

In response to the Procedural Order, the Respondent failed to provide any evidence of the claimed partnership agreement or to address it in any way. It simply questioned how a company such as the Respondent might enter into a partnership agreement with a factory like the Complainant. It stated that it had arranged to redirect the Domain Name to the Current Website at "www.dasautoservice.com".

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name the Complainant must prove that:

- (i) the 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 Domain Name; and

(iii) the 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 uncontested rights in the Mark, both by virtue of its trademark registrations and as a result of the goodwill and reputation acquired through use by the Complainant of the Mark over very many years. Ignoring the generic Top-Level Domain ("gTLD") ".com", the Domain Name comprises the Complainant's mark together with the country name "Bulgaria". In the Panel's view, this does not prevent a finding of confusing similarity between the Domain Name and the Complainant's mark for the purposes of the first element under the Policy. Accordingly, the Panel finds that the Domain Name is confusingly similar to a mark in which the Complainant has rights.

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. Accordingly, 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 evidence, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the 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 Domain Name such as those enumerated in the Policy or otherwise.

Although originally claiming that it had entered into a partnership agreement with a company holding relevant Lamborghini rights, the implication being that the Respondent therefore had sufficient rights or legitimate interests in the Domain Name and was authorized to use the Complainant's LAMBORGHINI mark, it failed to produce any evidence of such partnership agreement or rights in response to the Procedural Order.

The Panel does have in mind that previous UDRP panels have recognized that resellers using a domain name containing the complainant's trademark to undertake sales or repairs of the complainant's goods may be making a bona fide offering of goods or services and thus have a legitimate interest in such domain name. The Oki Data¹ test as set out in the [WIPO Overview 3.0](#) section 2.8 outlines the following cumulative requirements for such a finding:

¹ *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site only to sell the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

So far as the first requirement is concerned, both the Respondent's Previous Website and Current Website offer what purport to be the Complainant's goods and services relating to the Complainant's vehicles. So far as the second requirement is concerned, the Respondent's Previous Website also offered membership of the "Lamborghini Club Bulgaria", but while the Complainant does support official fan clubs in a number of countries, Bulgaria is not one of those. The Current Website also offers services not only in relation to the Complainant's vehicles, but also the vehicles of competitors of the Complainant, albeit those part of the same Group. Turning to the third requirement, the Respondent's websites fail to make clear in an accurate and prominent way, or at all, the Respondent's relationship (or absence of relationship) with the Complainant. The Panel finds that at least the second and third requirements are not therefore met.

Accordingly, the Panel does not consider that the Respondent has met the Oki Data test.

In addition, while the Domain Name has been used in connection with a membership of some sort of a LAMBORGHINI fan club, noting the commercial nature of both the Respondent's Previous Website and Current Website, the Panel finds that the Respondent cannot be said to be making legitimate noncommercial use of the Domain Name and such use does not give rise to rights or legitimate interests under the Policy.

In any event, other UDRP panels have found that the use of a complainant's trademark in a domain name, either on its own or with the addition of a geographic term, cannot amount to fair use as it carries a risk of implied affiliation with the complainant.

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 light of the nature of the Domain Name, comprising the entirety of the Complainant's LAMBORGHINI mark together with the country name "Bulgaria", and the use to which the Respondent has put the Domain Name, there is no doubt that the Respondent had the Complainant and its rights in the Mark in mind when it registered the Domain Name.

The Respondent has used the Domain Name for websites falsely purporting to be an authorized representative of the Complainant in Bulgaria, and the Domain Name falsely implies that it is the official agent of the Complainant in Bulgaria. Accordingly, there is no doubt that the Respondent has used the Domain Name to attract Internet users by creating a likelihood of confusion with the Mark and to mislead such users into believing that the Respondent's websites were operated or authorized by the Complainant.

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 Domain Name <lamborghiniibulgaria.com> be transferred to the Complainant.

/Ian Lowe/

Ian Lowe

Sole Panelist

Date: August 6, 2024