

ADMINISTRATIVE PANEL DECISION

Bottega Veneta S.r.l. v. Jack Sparrow
Case No. D2024-2698

1. The Parties

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

The Respondent is Jack Sparrow, China.

2. The Domain Name and Registrar

The disputed domain name <bottegavenetastoreoutlet.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 2, 2024. On July 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 3, 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 July 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 amendment to the Complaint on July 4, 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 July 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 30, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 11, 2024.

The Center appointed Gustavo Patricio Giay as the sole panelist in this matter on August 16, 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 and is one of the world's premier luxury brands. The Complainant stands out especially for its outstanding craftsmanship, innovative design, contemporary functionality, and use of the highest quality materials.

The Complainant currently distributes its products through a worldwide network of directly operated stores located in countries such as Italy, United States of America, China, France, United Kingdom, Switzerland, Kuwait, India, among many others. These stores are built to the Complainant's exacting standards, providing customers with a shopping experience characterized by complete luxury, privacy, and comfort.

As shown in annexes 4.1 to 4.8, the Complainant has, over the years, published advertising campaigns in major international magazines with wide circulation, including Elle, Monocle, Vogue, Vanity Fair, and Harper's Bazaar. Additionally, in October 2012, the Complainant released its first book, titled "Bottega Veneta", which illustrates the craftsmanship, design, and materials that have defined the brand throughout its history.

The Complainant has also been recognized as Best International Luxury Brand at the prestigious Walpole British Luxury Award, for being the brand with the greatest impact in terms of sales in the United Kingdom and abroad during 2013-2014 (see Annex 5.2).

The Complainant is the owner of the trademark BOTTEGA VENETA in many jurisdictions, including European Union Intellectual Property Office (EUIPO) Reg. No. 6809362 for classes 3, 9, 11, 14, 16, 18, 20, 24, and 25; international registration Reg. No. 705303 for classes 3, 9, 14, 18, and 25; and United States Patent and Trademark Office (USPTO) Reg. No. 1086395 for classes 18, 20, and 25.

Likewise, the Complainant claims to own an important domain names portfolio, including, among others, its primary website "bottegabeneta.com" registered since July 10, 1997.

The Complainant tried to resolve this dispute outside of this administrative proceeding by sending a cease-and-desist letter to the Respondent on May 29, 2024, and on June 6, 2024, but did not receive a reply.

Lastly, the disputed domain name was registered on May 27, 2024, and it resolved to a webpage featuring the Complainant's trademark and purporting to be selling the Complainant's products at heavily discounted prices (of around 80-90%). Now, it 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.

The Complainant states that the disputed domain name is confusingly similar to its trademark BOTTEGA VENETA, and to its associated domain names.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, nor is the Respondent related in any way to the Complainant. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark BOTTEGA VENETA or apply for the registration of the disputed domain name.

More specifically, the Complainant alleged that the Respondent has not used and/or has no demonstrable intention to use the disputed domain name except to create a likelihood of confusion with the Complainant's trademark. In fact, the Complainant claims that the disputed domain name has been used to sell Complainant's counterfeit products for discounted prices and is now being passively held.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interest in respect of the disputed domain name; and
- (iii) the disputed domain name was 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 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.

Although the addition of other terms here, "store" and "outlet", may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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.

Moreover, the ".com" generic Top-Level Domain is viewed as a standard registration requirement and is generally disregarded under the first element of the confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

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.

The Complainant has claimed not to have authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the BOTTEGA VENETA trademark nor is there any other evidence in the file suggesting that the Respondent has or could have rights or legitimate interests in the disputed domain name.

Even more, it does not seem that the Respondent made nor is making a legitimate noncommercial or fair use of the disputed domain name. On the contrary, as evidenced by the Complainant in section VI of the Complaint and in Annex 8.1., the disputed domain name displayed a website featuring the Complainant’s trademark and offering what appears to be counterfeit BOTTEGA VENETA products at heavily discounted prices. Panels have held that the use of a domain name for illegal activity as the selling of counterfeit goods can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Currently, the Respondent is passively holding the disputed domain name, therefore, this Panel considers that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services.

Lastly, the composition of the disputed domain name, combining the Complainant’s trademark with the descriptive terms “store” and “outlet” that refer to a location where products can be purchased at discount prices, carries a risk of implied affiliation that cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

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 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 such connection, the Complainant has submitted evidence to support that the trademark BOTTEGA VENETA is widely known and was registered and used many years before the Respondent registered the disputed domain name. When registering the disputed domain name, the Respondent has targeted the Complainant’s trademarks to generate confusion among Internet users and benefit from the Complainant’s reputation under paragraph 4(b)(iv) of the Policy.

The Complainant has proven that the Respondent has used the disputed domain name to offer what appears to be counterfeit BOTTEGA VENETA products at heavily discounted prices. Panels have held that the use of a domain name for illegal activity constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

The Panel notes that the disputed domain name currently resolves to an inactive website. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Even more, the Respondent has ignored the cease-and-desist letter from the Complainant, which aimed at resolving this matter amicably outside of this administrative proceeding.

Lastly, the Respondent seems to have used the fictional name "Jack Sparrow", corresponding to a fictional character, and this name has been involved in other 3 previous UDRP proceedings from which all of them were transferred to the trademark owner (operating in the fashion industry). See, *VALENTINO S.p.A. v. Lian Junping and Jack Sparrow*, WIPO Case No. [D2024-2321](#); *VALENTINO S.p.A. v. Lian Junping and Jack Sparrow*, WIPO Case No. [D2023-4207](#); *Prada S.A. v. Whois Agent, Domain Protection Services, Inc. / Jack Sparrow*, WIPO Case No. [D2021-1722](#). While it is unclear the real identity of the person behind this fictional name in the present case, noting the conduct in these cases, and the similarities with the current case, the Panel finds this further supports that the Respondent has acted in bad faith, as it seems he has already engaged in similar illicit behavior in the past.

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 <bottegavenetastoreoutlet.com> be transferred to the Complainant.

/Gustavo Patricio Giay/

Gustavo Patricio Giay

Sole Panelist

Date: August 30, 2024