

ADMINISTRATIVE PANEL DECISION

Bottega Veneta S.r.l. v. SKYEDGE EVENTS PTY LTD

Case No. DAU2023-0022

1. The Parties

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

The Respondent is SKYEDGE EVENTS PTY LTD, Australia.

2. The Domain Name and Registrar

The disputed domain name <bottegaveneta.au> is registered with Drop.com.au Pty Ltd (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2023. On May 3, 2023, the Center received an email from the Respondent. On May 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 5, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. On May 5, 2023, the Center sent an email regarding possible settlement to the Parties. On May 12, 2023, the Complainant informed the Center that it does not wish to explore settlement options with the Complainant.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 31, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was June 20, 2023. On June 19, 2023, the Respondent sent an email to the Center. However, the Respondent did not submit any formal response.

The Center appointed Rebecca Slater as the sole panelist in this matter on June 22, 2023. 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 Bottega Veneta S.r.l., a private company founded in the 1960s and headquartered in Montebello Vicentino, Italy. The name “Bottega Veneta” means “Venetian atelier”. The Complainant originally produced artisanal leather goods. Its artisans developed a signature technique for weaving leather, which is distinctive of the “Bottega Veneta” brand. The Complainant’s product offerings have expanded over time to include ready-to-wear fashion, fine jewelry, furniture, home accessories, fragrances, handbags, shoes, small leather goods, eyewear and luggage. The Complainant has stores all around the world, including in Australia. Consumers can also buy the Complainant’s products online.

The Complainant is the owner of Australian Trade Mark Registration No. 707362 for BOTTEGA VENETA word mark (registered April 29, 1996) (the “Trade Mark”). The Complainant also holds European Union and International trade mark registrations for the BOTTEGA VENETA word mark.

The Respondent is SKYEDGE EVENTS PTY LTD. The Respondent did not submit a formal response, and consequently little information is known about the Respondent.

The Respondent registered the disputed domain name on October 3, 2022. Prior to the Complainant’s representatives contacting the Respondent, the disputed domain name resolved to a website which displayed “click through” links to third party websites for competitive products. The website at the disputed domain name is currently inactive.

5. Parties’ Contentions

A. Complainant

The Complainant makes the following submissions.

Identical or Confusingly Similar

The disputed domain name is identical to the Complainant’s well-known Trade Mark. The disputed domain name consists of the Trade Mark plus the Australian country code Top-Level Domain (“ccTLD”) extension “.au”, which should be disregarded in the assessment of whether the disputed domain name is identical or confusingly similar. As such, the disputed domain name contains the entire Trade Mark without alteration.

Rights or Legitimate Interests

The Respondent has no rights or legitimate interests in respect of the disputed domain name. Specifically, the Respondent is not:

- a licensee or authorised agent of the Complainant, and the Complainant has not otherwise authorised the Respondent to use the Trade Mark;
- according to public searches, commonly known by the disputed domain name;
- making demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services; or
- using the disputed domain name in connection with a legitimate non-commercial or fair use.

The Complainant instructed a web agency to contact the Respondent to ascertain the Respondent’s intentions in relation to the disputed domain name. The agency received a response requesting the submission of the “best offer for the luxury brand name ‘bottegaveneta.au’”. The web agency replied proposing an amount in line with the Respondent’s out-of-pocket costs in relation to the disputed domain name. The Respondent refused this offer and requested EUR 100,000. The Complainant then instructed its

representative to send a cease and desist letter to the Respondent. Following an exchange of correspondence, the Respondent requested EUR 950 to transfer the disputed domain name to the Complainant. Both of the figures above are in excess of the Respondent's out-of-pocket costs in relation to the disputed domain name.

Prior to the Complainant's representatives contacting the Respondent, the disputed domain name resolved to a website displaying sponsored links mainly related to handbags. When the links were clicked, Internet users were redirected to a page displaying additional links to third party websites selling products of the Complainant and its competitors. This does not constitute a *bona fide* offering of goods or services or a legitimate non-commercial or fair use. The Respondent likely obtained "click-through" revenue from the sponsored links.

The current passive use of the website at the disputed domain name does not constitute a *bona fide* offering of goods or services or a legitimate non-commercial or fair use.

Registered or Used in Bad Faith

The Trade Mark has been extensively used since the mid-1960s to market the Complainant's products, including in Australia. The well-known character of the Trade Mark has been recognised in prior Uniform Domain Name Dispute Resolution Policy ("UDRP")¹ decisions. The Respondent would have been aware of the existence of the Trade Mark when it registered the disputed domain name. This is indicated in correspondence, where the Respondent refers to the disputed domain name as a "luxury brand domain".

The Respondent acted in opportunistic bad faith in registering the disputed domain name, for the purpose of taking commercial advantage of the Trade Mark.

The disputed domain name previously directed to a website providing "click-through" links to competitive products. This is a deliberate effort by the Respondent to trade off the goodwill associated with the Trade Mark. The Respondent cannot disclaim responsibility for these links.

The current passive holding of the disputed domain name does not prevent a finding of bad faith and the circumstances must be considered cumulatively.

The Respondent has:

- intentionally attempted to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Trade Mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and the products it promotes;
- registered the disputed domain name to prevent the Complainant (as the owner of the Trade Mark) from reflecting the Trade Mark in a corresponding domain name; and
- registered the disputed domain name with the purpose of selling it (likely to the Complainant) for valuable consideration in excess of the Respondent's out-of-pocket costs.

B. Respondent

The Respondent did not file a formal response. On June 19, 2023, the Respondent sent an email to the Center, in which the Respondent had been seeking a settlement.

¹ In view of the similarities between the auDRP and the UDRP, the Panel might refer to the UDRP, when relevant.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark 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 or subsequently used in bad faith.

The onus of proving these elements is on the Complainant even though the Respondent has not filed a formal response.

A. Identical or Confusingly Similar

The disputed domain name is identical to the Trade Mark in which the Complainant has rights. Generally, and as is appropriate in this case, the first level suffix (*i.e.* “.au”) is disregarded (see section 1.11 of the Overview of Panel Views on Selected auDRP Questions, Second Edition (“auDRP Overview 2.0”).

The Respondent does not contest this point.

The Complainant succeeds on the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy provides that the Complainant must establish that the Respondent has no rights or legitimate interests in the disputed domain name. Paragraph 4(c) non-exhaustively lists circumstances that can demonstrate the Respondent’s rights or legitimate interests in the disputed domain name.

In the Panel’s view, the following establish a *prime facie* case against the Respondent:

- the Complainant has not licensed or otherwise authorised the Respondent to use the Trade Mark;
- there is no evidence to suggest that the Respondent might be commonly known by the disputed domain name; and
- the Respondent has not been making a *bona fide* use of the disputed domain name. The disputed domain name currently resolves to an inactive website and prior to this inactivity the Respondent was using the website to direct business (via sponsored links) to the Complainant’s competitors (see section 2.9 of auDRP Overview 2.0 and the decisions cited therein).

The burden shifts to the Respondent to provide evidence of its rights or legitimate interests under paragraph 4(c) of the Policy (see, *e.g.*, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#)). The Respondent has not provided any evidence to demonstrate its rights or legitimate interests in the disputed domain name.

Under these circumstances, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. The second element of the Policy is satisfied.

C. Registered or Subsequently Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the disputed domain name has been registered or subsequently used in bad faith.

Paragraph 4(b)(iv) of the Policy provides that using the domain name to intentionally attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location may be evidence of bad faith.

Prior to the Complainant's representatives contacting the Respondent, the disputed domain name resolved to a website which displayed "click through" links to third party websites for competitive products. The Panel infers from this use that the Respondent was aware of the Complainant and its Trade Mark at this time and used the disputed domain name to trade off the value in the Trade Mark. This inference is further supported by the well-known nature of the Trade Mark and the Respondent's statement that the disputed domain name is a "luxury brand domain". It is well established that use of a domain name will be in bad faith where it is used to generate revenue in respect of "click through" traffic, and that traffic has been attracted because of the association of the domain name with the trade mark (see, e.g. *Arla Foods Amba v. William Wong*, WIPO Case No. [DAU2016-0007](#); *Entrust Corporation (formerly Entrust Datacard Corporation) v. Unicard Systems Pty Ltd*, WIPO Case No. [DAU2021-0003](#)).

Paragraph 4(b)(i) of the Policy provides that where the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to another person for valuable consideration in excess of the out-of-pocket expenses directly related to the domain name this may be evidence of bad faith. The Policy does not require that the respondent's offer to transfer be to the complainant (c.f. the position under the UDRP).

The Respondent has proposed transfer prices in excess of the Respondent's likely out-of-pocket expenses directly related to the domain name in response to approaches by the Complainant's representatives. Panels have drawn a distinction between unsolicited offers to transfer and offers that are solicited by the complainant. For the latter, a consequential offer by the respondent to transfer the domain name is generally considered insufficient, of itself, to demonstrate bad faith on the part of the respondent (see section 3.1.1 of auDRP Overview 2.0). Here, there are additional circumstances which indicate that the Respondent registered the disputed domain name with the intention of selling it (likely to the Complainant). These circumstances include the well-known nature of the Trade Mark, the Respondent's knowledge of the Complainant and the Trade Mark, the amount of the offer to the web agency and the Respondent's statement in correspondence that it has sold other domain names for amounts in excess of its out of pocket costs.

The Panel finds the above constitute use of the disputed domain name in bad faith. In light of this finding, the Panel does not need to address whether the Respondent's current passive holding of the disputed domain name also amounts to bad faith use.

The Complainant succeeds on the third element of the Policy.

7. Decision

For all 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 <bottegaveneta.au> be transferred to the Complainant.

/Rebecca Slater/

Rebecca Slater

Sole Panelist

Date: July 4, 2023