

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. Registration Private, Domains By Proxy, LLC / Mahamed Sharief

Case No. D2022-1168

1. The Parties

The Complainant is Bulgari S.p.A., Italy, represented by SafeNames Ltd., United Kingdom.

The Respondent is Registration Private, Domains By Proxy, LLC, United States of America (the “United States”) / Mahamed Sharief, United Arab Emirates.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 4, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 5, 2022, 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 and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 7, 2022 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 April 8, 2022.

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 sent notification to the Respondent of the Complaint, and the proceedings commenced on April 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 1, 2022. The Respondent did not submit any response. Accordingly, the Center sent notification of the Respondent’s default on May 2, 2022.

The Center appointed Petra Pecar as the sole panelist in this matter on May 6, 2022. 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 an Italian company founded in 1884. The Complainant is headquartered in Rome, Italy, and operates in luxury goods and in the hotel market, and is particularly known for its high-end jewelry including but not limited to watches, rings, and necklaces, as well as fragrance products. The Complainant also advertises and sells its goods on its official website at “www.bulgari.com”, and has approximately 300 retail locations worldwide. The domain name for the official website was registered on February 17, 1998, and the Complainant has maintained a strong web presence since.

The BULGARI name derives from the founder’s name, “Voulgaris”. The Complainant’s trademark is written as BVLGARI in the classic Latin alphabet and BULGARI in the modern alphabet. The Complainant submits that the terms BULGARI and BVLGARI are often used synonymously, but the term BULGARI is used in relation to the company name, whilst the term BVLGARI relates to the brand name.

The Complainant owns numerous trademark registrations for BVLGARI and BULGARI, including the following registrations:

- Italian Trademark Registration No. 0000896469, registered for goods in classes 11, 14, 20, 21 on June 11, 2003, for BULGARI;
- Italian Trademark Registration No. 0001140217, registered for goods in classes 11, 20 and 21 on September 22, 2008, for BULGARI;
- United States Trademark Registration No. 1694380, registered for goods in class 18 on June 16, 1992, for BVLGARI;
- Canadian Trademark Registration No. TMA312178, registered for goods in classes 14, 21 and 26 on March 14, 1986, for BVLGARI;
- International Trademark Registration No. 494237, registered for goods and services in classes 3, 8, 11, 14, 16, 18, 20, 21, 25 and 34 on July 5, 1985, for BVLGARI; and
- European Union Trade Mark Registration No. 007138101, registered for services in classes 35, 36, 41 and 43 on June 3, 2009, for “BVLGARI”.

The disputed domain name was registered on January 24, 2022, and at the time of the decision, it is redirecting users to the Complainant’s official hotel website at “www.bulgarihotels.com/london”.

5. Parties’ Contentions

A. Complainant

The Complainant states that it holds numerous trademark registrations for the signs BULGARI and BVLGARI, registered in various jurisdictions. The earliest registration for Complainant’s trademark BVLGARI dates from 1985, while the Respondent registered the disputed domain name on January 24, 2022. The Complainant highlights the goodwill and recognition that has been attained under the name BULGARI which is a distinctive identifier associated with the Complainant’s products and services. Consequently, the Complainant contends that it has satisfied the requirement of holding rights in the BULGARI and BVLGARI trademarks.

The Complainant further submits that the disputed domain name is confusingly similar to the Complainant’s trademark. The Complainant’s trademark is recognizable within the disputed domain name because it incorporates the Complainant’s BULGARI trademark in its entirety, with the addition of the geographical indicator “London”. The Complainant submits that the conjunction of “London” with the BULGARI trademark

creates confusion in the minds of Internet users, so that Internet users familiar with the Complainant's services could assume that the disputed domain name is affiliated with the Complainant.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy for the following reasons. The Complainant alleges that it has never authorized the Respondent to use domain names which encompass the BULGARI or BVLGARI trademarks, that the Respondent has used the disputed domain name in connection with phishing correspondence purporting to originate from the Complainant, failing to create a *bona fide* offering of goods or services, that the Respondent has never been commonly known by the disputed domain name and has never acquired any trademark or service mark rights in the disputed domain name, and that the use of the disputed domain name to redirect Internet users to the Complainant's official hotel site shows that the Respondent's actions clearly do not constitute *bona fide* or legitimate noncommercial or fair use.

The Complainant contends that the disputed domain name should be considered as having been registered and used in bad faith by the Respondent because the Complainant's BULGARI and BVLGARI trademark registrations clearly predate the disputed domain name's 2022 registration and anyone with access to the Internet can easily find its BULGARI and BVLGARI trademarks on public trademark databases. According to the Complainant, all top Google search results for the BULGARI and BVLGARI terms pertain to the Complainant and the simplest degree of due diligence would have made the Respondent aware of the Complainant's internationally-established rights in the BULGARI and BVLGARI trademarks.

Further, the Complainant also emphasizes that Internet users, wishing to check the authenticity of the disputed domain name (e.g. by searching it in a web browser), would be redirected to the Complainant's official "www.bulgarihotels.com/london" website, giving the false impression that the disputed domain name forms part of the Complainant's portfolio and that it is being used legitimately.

According to the Complainant's allegations, the Respondent has caused actual Internet user confusion from using the disputed domain name in connection with phishing correspondence falsely purporting to originate from the Complainant, when it sent communications using the email address "[...].@bulgarilondon.com", in relation with a "Bulgari Spa Experience in London" invitation, for the purposes of encouraging deceived customers of the Complainant to provide the Respondent with sensitive personal details. The Complainant contends that the use of a domain name for *per se* illegitimate activity, such as phishing, is manifestly considered evidence of bad faith.

B. Respondent

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

6. Discussion and Findings

Even if the Respondent did not file a Response to the Complainant's contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant. "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable", as indicated in paragraph 15(a) of the Rules.

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

(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 by the Respondent in bad faith.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must, firstly, establish rights in a trademark or service mark and, secondly, establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.2.1). The Panel finds that the Complainant has provided evidence of ownership of registrations for the BULGARI and BVLGARI trademarks, demonstrating that it has rights in the BULGARI and BVLGARI trademarks, through earlier registrations and use for luxury goods and hotel brand names.

The Panel further finds that the disputed domain name incorporates the BULGARI trademark in its entirety, along with the additional geographic indicator “London” and TLD “.com”. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) do not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademarks, in accordance with section 1.8 of the [WIPO Overview 3.0](#).

Finally, it is well accepted practice by UDRP panels that a gTLD, such as “.com”, is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11.1 of the [WIPO Overview 3.0](#)). Accordingly, the Panel determines that the disputed domain name is confusingly similar to the Complainant’s trademark.

In accordance with the above, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is confusingly similar to its BULGARI trademark.

B. Rights or Legitimate Interests

Under the second element of the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is generally deemed to have satisfied the second element, as set out in paragraph 4(a)(ii) of the Policy (see also [WIPO Overview 3.0](#), section 2.1.).

Moreover, the Policy provides guidance to respondents on how to demonstrate rights or legitimate interests in the domain name. In particular, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name, including: (i) use of the domain name “in connection with a *bona fide* offering of goods or services”; or (ii) demonstration that the Respondent has been “commonly known by the domain name”; or (iii) “legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue”.

The Panel finds that the Complainant has not authorized the Respondent to use the Complainant’s BULGARI / BVLGARI trademarks, as the Respondent failed to provide any evidence or respond to the cease and desist letter of the Complainant. The Respondent is not commonly known by the disputed domain name or the name “bulgari”. The Respondent has not used the disputed domain name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. The disputed domain name impersonates the Complainant or creates the impression of an association with the Complainant and its marks, by including the entirety of the Complainant’s BULGARI mark as the dominant element in the disputed domain name, along with the geographic indication “London”, a city where one of the

Complainant's BULGARI hotels is located. The disputed domain name redirects to the official website of the Complainant's London hotel at "www.bulgarihotels.com/london". Furthermore, the Complainant provided evidence of an online fraud/phishing scheme launched by the Respondent, by which Internet users were offered to submit requests for promotional vouchers to the email address "[...]"@bulgarilondon.com" and thereby reveal sensitive personal information to the Respondent. UDRP Panels have categorically held that the use of a domain name for illegal activity (e.g., phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see also [WIPO Overview 3.0](#), section 2.13.1).

The Panel therefore finds that the Complainant has made a *prima facie* demonstration of the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent, and that the Complainant has accordingly established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires the Complainant to demonstrate that the Respondent registered and is using the disputed domain name in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a Respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

The Panel finds that at the time of the disputed domain name's registration, the Respondent was aware of the Complainant and its BULGARI / BVLGARI trademarks, and intentionally targeted those trademarks when registering the disputed domain name, since the disputed domain name was used to redirect Internet users to the Complainant's official website for its London hotel. The geographical indication "London" does not avoid potential confusion among Internet users, as it is in fact the location of one of Complainant's hotels, which additionally creates confusion and links the disputed domain name to the Complainant's BULGARI marks and its hotel. Internet users' arrival at the Complainant's website would have given the false impression that the disputed domain name formed part of the Complainant's portfolio, and that it was being used legitimately.

Furthermore, based on the information and the evidence provided by the Complainant, the Panel finds that at the time of registration of the disputed domain name, the Respondent was or should have been aware of the Complainant's trademarks, since the Respondent's registration of the disputed domain name occurred more than 37 years after the Complainant's registration of the earliest of its trademarks, and since a trademark register search, or even a simple online search prior to the registration of the disputed domain name would have informed the Respondent of the existence of the oldest trademarks and the Complainant's extensive use of the BULGARI and BVLGARI trademarks as source identifiers

The disputed domain name appears to be a part of an online fraud scheme by which the Respondent is inviting Internet users to send emails for alleged promotional vouchers for the Complainant's hotel in London. In this way, Internet users would be tricked into handing their personal information to the Respondent through the email address configured on the disputed domain name, believing that they are communicating with the Complainant, while a redirection to the Complainant's official website would additionally assure Internet users that they indeed are communicating with the Complainant. Such use of the disputed domain name for fraudulent and phishing purposes is sufficient evidence of bad faith (see *Accor v. SANGHO HEO / Contact Privacy Inc.*, WIPO Case No. [D2014-1471](#)).

For these reasons, this Panel finds that the Respondent's registration and use of the disputed domain name is in bad faith in accordance with paragraph 4(a)(iii) 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 <bulgarilondon.com> be transferred to the Complainant.

/Petra Pecar/

Petra Pecar

Sole Panelist

Date: May 20, 2022