

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. 余观德 (Yu GuanDe)

Case No. D2023-0560

1. The Parties

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

Respondent is 余观德 (Yu GuanDe), China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2023. On February 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 8, 2023, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on February 9, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. On the same day, the Center transmitted another email in Chinese and English to the Parties regarding the language of the proceeding. Complainant filed an amended Complaint in English on February 9, 2023 including a request for English to be the language of the proceeding. Respondent did not comment on the language of the proceeding.

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 Respondent in Chinese and English of the Complaint, and the proceedings commenced on February 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 8, 2023.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on March 14, 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

Complainant, an Italian company founded in 1884, operates in the luxury goods and hotel markets, with 230 retail locations worldwide. The Bulgari brand is promoted globally for its high-end jewelry, related luxury goods and accessories. Since 2001, Complainant has operated luxury hotels worldwide.

Complainant indicates that the Bulgari name is derived from the founder's name ("Voulgaris"). Complainant's trademark is both written as BVLGARI in the classic Latin alphabet and BULGARI in the modern alphabet and submits that the terms Bulgari and Bvlgari are often used interchangeably, however, Bulgari is generally used in relation to the company name (Bulgari S.p.A.), whilst the term Bvlgari typically refers to the brand name.

Complainant owns numerous registered trademarks for the BULGARI and BVLGARI marks globally, including:

- Australian registered trademark number 338663 for the BULGARI word mark, registered on October 5, 1979;
- United States of America registered trademark number 1184684 for the BULGARI word mark, registered on January 5, 1982;
- International registered trademark number 452694 for the BULGARI word mark, registered on May 15, 1980;
- Mexican registered trademark number 503494 for the BULGARI word mark, registered on September 12, 1995;
- United States of America registered trademark number 1694380 for the BVLGARI word mark, registered on June 16, 1992;
- Canadian registered trademark number TMA312178 for the BVLGARI word mark, registered on March 14, 1986;
- International registered trademark number 494237 for the BVLGARI word mark, registered on July 5, 1985;
- Italian registered trademark number 0000984147 for the BVLGARI word mark, registered on November 18, 2005; and
- European Union trademark number 007138101 for the BVLGARI word mark, registered on June 3, 2009.

In addition, Complainant operates its official website at the domain name <bulgari.com>, which Complainant has owned since February 17, 1998.

The Domain Name was registered on July 30, 2022 and reverts to an inactive page.

Upon knowledge of the registration of the Domain Name, Complainant sent a cease and desist communication to Respondent on October 5, 2022, notifying Respondent of Complainant's trademarks and

rights, with an attempt to resolving the matter amicably. Respondent did not respond. The Complaint was then filed.

5. Parties' Contentions

A. Complainant

Complainant contends that (i) the Domain Name is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Name; and (iii) Respondent registered and is using the Domain Name in bad faith.

In particular, Complainant contends that it has trademark registrations for BULGARI and that Respondent registered and is using the Domain Name with the intention to confuse Internet users looking for *bona fide* and well-known Bulgari products and services.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use a domain name, which includes Complainant's trademark, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Name. Rather, Complainant contends that Respondent has acted in bad faith in registering and using the Domain Name, when Respondent clearly knew of Complainant's rights.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

The Rules, in paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Complainant submitted its original Complaint in English. In its Complaint and amended Complaint, Complainant submitted a request that the language of the proceeding should be English. According to the information received from the Registrar, the language of the Registration Agreement for the Domain Name is Chinese.

Complainant asserts that the Domain Name is registered in Latin characters, with Complainant's mark in combination with an English word/suffix. Complainant also contends that Respondent has registered several other domain names that comprises generic or descriptive English words. In addition, Complainant indicates that it sent Respondent a cease and desist notice, but did not receive a response nor attempts from Respondent to inform Complainant of Respondent's inability to understand the notice. Complainant also contends that holding the proceeding in Chinese would cause undue delay, considerable expense, unfair disadvantage and burden on Complainant as well as the dispensation of the current matter.

In exercising its discretion to use a language other than that of the Registration Agreement for the Domain Name, 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.

The Panel accepts Complainant's submissions regarding the language of the proceeding. The Panel notes that the Center notified the Parties in Chinese and English of the language of the proceeding as well as notified Respondent in Chinese and English of the Complaint. Respondent chose not to comment on the language of the proceeding nor did Respondent choose to file a Response in either Chinese or English.

The Panel is also mindful of the need to ensure that the proceeding is conducted in a timely and cost-effective manner. Complainant may be unduly disadvantaged by having to translate the Complaint into Chinese and to conduct the proceeding in Chinese.

Having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

6.2. Substantive Issues

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that failure to respond to the complainant's contentions would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true.

Thus, although in this case Respondent has failed to respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence of its rights in the BULGARI trademarks, as noted above. Complainant has also submitted evidence which supports that the BULGARI trademarks are widely known and a source identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the BULGARI trademarks.

With Complainant's rights in the BULGARI trademarks established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the Top-Level Domain in which it is registered (in this case, ".com"), is identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Name is confusingly similar to Complainant's BULGARI trademark. The BULGARI trademark is recognizable in the Domain Name. In particular, the Domain Name's inclusion of Complainant's trademark BULGARI in its entirety, with the addition of the term "online" does not prevent a finding of confusing similarity between the Domain Name and the BULGARI trademark. See [WIPO Overview 3.0](#), section 1.8.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its BULGARI trademarks, and does not have any rights or legitimate interests in the Domain Name. Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the BULGARI trademarks or to seek registration of any domain name incorporating the trademarks. Respondent is also not known to be associated with the BULGARI trademarks, and there is no evidence showing that Respondent has been commonly known by the Domain Name.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, the Domain Name redirects to an inactive page. Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Moreover, the nature of the Domain Name is inherently misleading as it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See [WIPO Overview 3.0](#), section 2.5.1. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The Panel finds that Complainant has provided ample evidence to show that registration and use of the BULGARI trademarks long predate the registration of the Domain Name. Complainant is also well established and known. Indeed, the record shows that Complainant's BULGARI trademarks and related products and services are widely known and recognized. Therefore, Respondent knew or should have known of Complainant's trademark at the time of registering the Domain Name. See [WIPO Overview 3.0](#), section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the mere registration of the Domain Name that is confusingly similar (particularly the Domain Name incorporating Complainant's BULGARI trademark plus a descriptive term) to Complainant's widely-known trademark by Respondent, who is unaffiliated with Complainant, can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Moreover, Respondent has used the Domain Name to divert users to an inactive webpage. Considering the circumstances of this case, particularly the fame of Complainant's trademark, the non-use of the Domain Name does not prevent a finding of bad faith under the doctrine of "passive holding". See [WIPO Overview 3.0](#), section 3.3.

Moreover, Respondent's registration of the Domain Name may confuse and mislead consumers looking for *bona fide* and well-known Bulgari products and services of Complainant or authorized partners of Complainant. The use of the BULGARI mark as the dominant part of the Domain Name is intended to capture Internet traffic from Internet users who are looking for Complainant's products and services. Further, the Panel also notes the failure of Respondent to submit a Response or to provide any evidence of actual or contemplated good faith use, and the implausibility of any good faith use to which the Domain Name may be put.

Accordingly, the Panel finds that Respondent has registered and is using the Domain Name in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 <bulgarionline.com> be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: March 26, 2023