



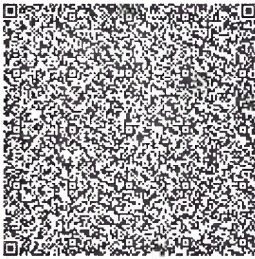
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INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No.	: IN-DL30880486680636Q
Certificate Issued Date	: 26-May-2018 01:59 PM
Account Reference	: IMPACC (IV)/ dl737903/ DELHI/ DL-DLH
Unique Doc. Reference	: SUBIN-DL73790365615281198318Q
Purchased by	: V K AGARWAL
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: V K AGARWAL
Second Party	: OTHERS
Stamp Duty Paid By	: V K AGARWAL
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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NATIONAL INTERNET EXCHANGE OF INDIA
6C, 6D, 6E, Hansalaya Building,
15, Barakhamba Road,
New Delhi – 110 001

BULGARI S.p.A. v. KRISTIN FRANKFURTER

AWARD

V K Agarwal

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shclsestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.

1. The Parties

The Complainant is BULGARI S.p.A., Lungotevere Marzio nr. 11, Rome, 00186, ITALY

The Respondent is Mr. KRISTIN FRANKFURTER, Grabengasse 1, Heidelberg, Brandenburg – 69117, Germany

2. The Domain Name and Registrar

The disputed domain name is <www.bulgari.co.in>. The said domain name is registered with Endurance Domains Technology LL.P., The details of registration of the disputed domain name are as follows:

- (a) Domain ID: D8417355 – AFIN
- (b) Registrar: Endurance Domains Technology LL.P.,
- (c) Date of creation: May 18, 2014
- (d) Expiry date: May 18, 2018

3. Procedural History

- (a) A Complaint dated April 19, 2018 has been filed with the National Internet Exchange of India. The Complainant has made the registrar verification in connection with the domain name at issue. The print outs of the WHOIS is attached as Annexure 2 to the Complaint. It is confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The National Internet Exchange of India verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the “Policy”) and the Rules framed thereunder.
- (b) The Exchange appointed Dr. Vinod K. Agarwal, Advocate and former Law Secretary to the Government of India as the sole arbitrator in this matter. The arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the National Internet Exchange of India.
- (b) In accordance with the Policy and the Rules, an attempt was made to notify the Respondent about the Complaint on the given address through the courier. However, it could not be served due to wrong and incomplete address. Hence, the present proceedings have to be ex parte.

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4. Factual Background

From the Complaint and the various annexure to it, the Arbitrator has found the following facts:

Complainant's activities

The Complainant is an Italian private company founded in the year 1884 by Sotirios Voulgaris. According to the Complaint, the Complainant is engaged in the business of luxury goods industry including, but not limited to watches, rings necklaces, jewellery, leather goods and fragrance products. The Complainant opened its first stores in New York City, (U.S.A.), Paris (France), Geneva (Switzerland), and Monte Carlo (France) in the year 1970. The Complainant also has a store of such products in some parts of India including New Delhi. Presently, the Complainant has more than 230 retail locations worldwide.

The Complainant also owns several hotels since 2001 as a result of joint venture between Bulgari S.p.A. and the Luxury Group, a division of Marriott International. The joint venture also manages Ritz Carlton hotels at various places.

Respondent's Identity and Activities

Respondent has not provided the response. Hence, the activities of the Respondent are not known.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the Policy is applicable to this dispute.

In relation to element (i), the Complainant contends that the words "BVLGARI/BULGARI" are derived from its founder's name Sotirios Voulgaris". "BVLGARI" is a phonetic version of this surname.

The Complainant is, inter alia, the owner of several trademark registrations of the word "BVLGARI/BULGARI" all of which are for protected goods and services in relation to its business throughout the world. These trademarks are not generic or commonly understood by any

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other meaning, other than their relationship with the Complainant's goods and services.

The word "BVLGARI" is written in the classical Latin alphabet and "BULGARI" in the modern alphabet. The terms "BULGARI" and "BVLGARI" are pronounced in the same way, but in textual form, they are intended for different purposes. The word "BULGARI" is used in relation to the name of the company (Bulgari S.p.A.) while the term "BVLGARI" related to the brand name.

The Complainant's trademarks "BVLGARI" and "BULGARI" are registered in various countries of the world including Brazil, Canada, Italy, Mexico, Philippines, Sweden, United States of America and the World Intellectual Property Organisation, Geneva (WIOP). The said trademarks are registered in these countries in various Classes.

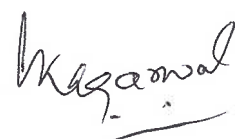
The Complainant's trademark "BVLGARI" is also registered in India vide Registration Certificate Nos. 1208133, 1208134, 1208135, 1208136 and 1208137, all dated 20th June 2003. They are registered in Classes 3, 9, 14, 18, and 25. Copies of the said Registration Certificates are available as Annexures to the Complaint.

The Complainant is also the registrant and proprietor of various domain name registrations at international and domestic levels incorporating the expression "bulgari". Some such illustrations are as follows: <www.bulgari.com>; <www.bulgarihotels.com>; <www.bulgari.com/en-us>; etc.

The Complainant contends that the disputed domain name contains the complete trademark of the Complainant, that is, "BVLGARI" in small letters. The addition of the generic words "co" or "in" in a domain name is insignificant. They will not be perceived by the relevant public as a different, eligible to distinguish the Respondent or the goods and services offered under the disputed domain name from the Complainant. Further that, they do not help in distinguishing the disputed domain name from the Complainant's trademark. On the contrary, the disputed domain name leads the public to believe that it relates to the Complainant's products.

Therefore, the disputed domain name is confusingly similar or identical to the registered trademark of the Complainant.

In support of its contentions, the Complainant has relied on the following decisions: *Zippo Manufacturing Company Inc., v. Zhaxia*, (Case No. INDRP/840); *Urban Outfitters, Inc. v. Hus An Holdings (H.K.)*



Limited, (Case No. INDRP/601) wherein the Learned Arbitrator has held that "The disputed domain name www.anthropologie.in is identical to the Complainant ... except for the generic term ".in" appended to it. However, such differences can be ignored for the purposes of determining similarity between the disputed domain name and the Complainant's trademark as it is a generic and technical requirement and is non-distinctive."

In relation to element (ii), the Complainant contends that the Respondent (as an individual, business, or other organization) has not been commonly known by the mark "BVLGARI" or "BULGARI" and therefore has no right or interest in the disputed domain name. The Respondent does not own any trademark registration as "BVLGARI" or "BULGARI" or a mark that incorporates the expression "BVLGARI" and "BULGARI". The Respondent has no license or authorization or permission from the Complainant to either use the trademark "BVLGARI" or "BULGARI" or to register the disputed domain name.

Further, the Respondent is not making a legitimate or fair use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.

According to the Complaint, the disputed domain name "bvlgai.co.in" is currently active as a Pay-Per-Click ("PPC") landing page, with various links referring to the Complainant and their competitors, such as Gucci. The use of a domain name to offer PPC links, can be legitimate, so long as the links do not take advantage of any third party rights. As per the Complainant, in the case of *Urban Outfitters, Inc v. GoaGou Yerect International Limited* (Case No. INDRP/624) it has been held that *"The fact that the Respondent's website carries nothing but sponsored links of another competitor websites and is merely a "PPC" parking page further proves that the Respondent is just a cyber-squatter."* As such the Respondent's use of PPC links on <bvlgai.co.in> is not legitimate, because the headings generated relate to either the Complainant or to their competitors.

In support of its contentions, the Complainant has relied on the following decisions: *Wal-Mart Stores, Inc. v. Machang*, (Case No. INDRP/539); *Vestel Elektronik Sanayi ve Ticaret AS v. Kahveci*, (WIPO Case No. D2000-1244); *Mozilla Foundation v. Lina/Doublefist Limited*, (Case No. INDRP/934) wherein it has been held that, *"... it is a settled position that if the Respondent does not have trademark right in the word corresponding to the disputed domain name and in the absence of the evidence that the Respondent was commonly known by the disputed*

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domain name, the Respondent can have no right or legitimate interest."

Therefore, the Respondent has no legitimate justification or interest in the disputed domain name.

Regarding the element at (iii), the Complainant contends that the Respondent has registered the disputed domain name in bad faith and for its actual use in bad faith. The main object of registering the domain name <www.bvlgari.co.in> by the Respondent is to mislead the customers of the Complainant and internet users and the general public. The Respondent has not demonstrated any preparations to use the domain name or a name corresponding to the domain name in connection with any bona fide offering of goods or services. The Respondent is not commonly known by the domain name or is engaged in any business activity associated with the mark "BVLGARI" and "BULGARI".

The Complainant has stated that on 20th November 2017 on behalf of the Complainant a cease and desist notice was sent to the Respondent to stop using the disputed domain name. In response, the Respondent has offered to sell the domain name for Euros 4,999 to the Complainant. This amount is very much in excess of the out of pocket cost and the cost of registering the domain name. Thus, it is highly likely that the Respondent has registered the disputed domain name solely for the purpose of making unjust and improper monetary gains from the Complainant.

The Complainant has further stated that their investigation of WHOIS reveals that the Respondent has also attempted to shield his correct or proper identity to frustrate any legal action being taken against him. Further that, the Respondent has registered a large number of domain names belonging to other entities.

The Complainant has stated that the use of a domain name that appropriates a well-known trademark to promote competing or infringing products cannot be considered a "*bona fide offering of goods and services*".

In support of its contentions, the Complainant has relied on the decision in the case of *Laterooms Limited v. Lin Yanxiao*, (Case No. INDRP/818).

B. Respondent

The Respondent did not submit any evidence or argument indicating his relation with the disputed domain name <www.bvlgari.co.in> or any

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trademark right, domain name right or contractual right.

6. Discussion and Findings

The Rules instructs this arbitrator as to the principles to be used in rendering its decision. It says that, "a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable".

According to the Policy, the Complainant must prove that:

- (i) The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) The Registrant's has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The Registrant's domain name has been registered or is being used in bad faith.

A. *Identical or Confusingly Similar*

The disputed domain name <bvlgari.co.in> was registered by the Respondent on May 18, 2014. The registration of the said disputed domain name was due to expire on May 18, 2018. Thus, by the time this Award is pronounced, the registration of the disputed domain name has already expired.

The Complainant is an owner of the registered trademarks "BVLGARI" and "BULGARI". The Complainant is also the owner of a large number of domains with the trademark "bvlgari" and "bulgari" as stated above and referred to in the Complaint. Most of these domain names and the trademarks have been created by the Complainant much before the date of creation of the disputed domain name by the Respondent. The disputed domain name is <bvlgari.co.in>. Thus, the disputed domain name is very much similar to the name and the trademark of the Complainant.

The Hon'ble Supreme Court of India has recent held that the domain name has become a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that, there is a strong likelihood that a web browser

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looking for the products of Bvlgari and Bulgari in India or elsewhere would mistake the disputed domain name as of the Complainant.

Therefore, I hold that the domain name <www.bvlgari.co.in> is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- (iii) The Registrant is making a legitimate non-commercial 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 Respondent's response is not available in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant/Respondent is Mr. Kristin Frankfurter. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

Further, the Complainant has not consented, licensed or otherwise permitted the Respondent to use its name or trademark "BVLGARI" and "BULGARI" or to apply for or use the domain name incorporating said mark. The domain name bears no relationship with the Registrant. Further that, the Registrant has nothing to do remotely with the business of the Complainant.

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I, therefore, find that the Respondent has no rights or legitimate interests in the domain name under INDRP Policy, Paragraph 4(ii).

C. *Registered and Used in Bad Faith*

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- (ii) the Registrant's has 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 the Registrant has engaged in a pattern of such conduct; or
- (iv) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public.

According to the Complainant, the Respondent has registered many domain name. The Complainant has given some such domain names by way of illustration. This leads to the presumption that the Respondent is registering domain names of various entities for the sake of earning illegal

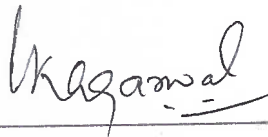
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profits. The very fact that the disputed domain name was offered for sale by the Respondent to the Claimant indicates bad faith.

The foregoing circumstances lead to the presumption that the domain name in dispute was registered and used by the Respondent in bad faith.

7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to the trademark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name, and that the domain name was registered in bad faith and is being used in bad faith, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <www.bvlgari.co.in> be transferred to the Complainant.



Vinod K. Agarwal
Sole Arbitrator

Date: 28th May 2018