



香港國際仲裁中心
Hong Kong International
Arbitration Centre

ADMINISTRATIVE PANEL DECISION

Case No. DCN-1700789

Complainant:	Bulgari S.p.A.
Respondent:	徐东彦
Domain Name:	<bvlgarihotels.cn>
Registrar:	浙江贰贰网络有限公司

1. Procedural History

Complainant, Bulgari S.p.A., is an Italian company whose principal place of business is Lungotevere Marzio nr. 11, Rome, 00186.

Complainant is represented in these administrative proceedings by Mr. Dan Smith, Legal Adviser, Safenames Ltd., whose address is Safenames House, Sunrise Parkway, Linford Wood, Milton Keynes, MK14 6LS, United Kingdom.

The Complaint was filed with the Hong Kong International Arbitration Centre (“Centre”) on 11 December 2017 in relation to the disputed domain name.

On 12 December 2017, the Centre transmitted by email to the Registrar, 浙江贰贰网络有限公司 (22net, Inc.), whose address is 11/F, Bldg. No 2, Hangzhou Internet Innovation Pioneer Park, No.176 Zixia Street, West Lake District Hangzhou, Zhejiang 310030, China, a request for verification of the registered particulars of the Disputed Domain Name <bvlgarihotels.cn>. On 22 December 2017, the Registrar replied to the Centre, identifying the Respondent, 徐东彦, whose email address is: xdy1900@qq.com, as the Registrant of the disputed domain name. The Registrar noted in its reply that the domain name <bvlgarihotels.cn> had been registered for a period of more than 2 years.

The Centre confirmed that the Complaint satisfied the formal requirements of the *CNNIC ccTLD Dispute Resolution Policy* (“**CNDRP**”) issued by the China Internet Network Information Center (“**CNNIC**”); the *CNNIC ccTLD Dispute Resolution Policy Rules* (“**Rules of the CNDRP**”); and the *HKIAC Supplemental Rules for CNDRP and Rules of CNDRP* (“**Supplemental Rules**”) issued by the Centre; respectively, each of which became effective on 21 November 2014.

On 22 December 2017, the Registrar also notified the Respondent of the present administrative proceedings, by email to the Respondent at xdy1900@qq.com and justagoodname@gmail.com. On the same day, the Respondent forwarded the Registrar’s email notification to the Centre, beneath Respondent’s own reply email.

The Respondent's 22 December 2017 email to the Centre, which preceded the commencement of these administrative proceedings, recites:¹

"Hello. I received today from my registrar a notice that [HKIAC] has accepted an arbitration concerning my domain name <bvlgarihotels.cn>. However, I registered the domain name bvlgarihotels.cn more than 10 years ago on 24 September 2007, which is already long past the (within 2-years) limitation period for cases that you can accept.

Thus, both the CNDRP, as well as the Rules of the CNDRP, prohibit [HKIAC] from accepting this domain name dispute!

Regardless whether as a result of my registrar's mistake, or because you have not yet sent out a formal Notice of Arbitration Proceedings, please strictly abide by the CNDRP in handling the matter of this bvlgarihotel.cn domain name dispute!"

Thereafter, on 27 December 2017, in accordance with Articles 5 and 14 of the Rules of the CNDRP and Article 5(3) of the Supplemental Rules, the Centre formally notified the Respondent of the Complaint.² These proceedings commenced. In accordance with Article 17 of the Rules of the CNDRP, the due date for the Respondent's Response was 16 January 2018. No Response was submitted to the Centre by the Respondent in relation to the disputed domain name, whereupon, the Centre sent a Notice of Default to the parties by email on 17 January 2018.

The Centre appointed Mr. David L. Kreider as the sole panelist in this matter on 26 January 2018. 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 Centre to ensure compliance with Article 9(2) of the Supplemental Rules.

Language

The Complainant requests that English be used as the language of these proceedings. The Complainant's argument in support of its application recites:

"The Complainant submits that the Respondent is competent with the English language. The domain name, <bvlgarihotels.cn> features the English word "HOTELS" and furthermore, the Respondent has a portfolio of over 35 domain names, many of which feature English words, including but not limited to <digitaldna.com.cn>, <thecheesecakefactory.cn> and <formstack.cn> []. The fact that the Respondent's domain portfolio features English words supports the fact that the Respondent understands or is at the very least, competent, with the English language.

¹ The Respondent's original Chinese language email has been translated into English by the Panel.

² The Email Exchange Record in these proceedings includes an email receipt evidencing that the Respondent received the Notification of Commencement of Proceedings on 27 December 2017.

Furthermore, the Complainant submits that translating this complaint into Mandarin/Chinese will lead to undue delay and substantial expenses which goes against the spirit of the Policy. Further, pursuant to Article 6 of the Policy, the Panel has the power to make a determination that English be the language of the proceedings without prejudice to the liberty of the Centre to communicate with the Parties in both Chinese and English. The Complainant therefore relies on Article 6 of the CNNIC Policy. The Complainant further submits that similar considerations were applied by Panelists' in REGO-FIX AG v. 深圳市捷亚机械科技有限公司 Case No.DCN-1500624, BASF SE v 金大 Case No. DCN-1600674 and Marshall Amplification PLC v. 潘孝云 Case No. DCN-1700730. Therefore, the Complainant asks the Panel to give this case the same consideration."

The Respondent's 22 December 2017 email to the Centre, as well as the email receipt from the Respondent to the Centre dated 27 December 2018, proves conclusively that the Respondent, having received actual notice from the Registrar of the imminent commencement of proceedings, followed in short order by notice from the Centre of the actual, formal commencement of these administrative proceedings, nonetheless elected to default and not submit a Response.

The Panel notes additionally the Respondent's use of the engaging and colloquial English email address, "justagoodname@gmail.com", which further supports the Complainant's central argument that the Respondent, who owns a portfolio of English language domain names, is in all likelihood, "at the very least", competent with the English language.

This Panel accepts the Complainant's arguments and, therefore, decides that the language of these proceedings shall be the English language.

2. Factual background

The Complainant submits that they are an Italian private company founded in 1884 by Sotirio Voulgaris. The Complainant operates in the luxury goods and hotels markets. Some of the Complainant's high-end goods include rings, watches, necklaces and fragrance products. The Complainant prides itself on creating a distinctive style that celebrates its rich Roman history, blending modernity with classicism. Today, the Complainant has more than 230 retail locations worldwide.

The Complainant also owns several hotels since 2001, which is the result of a joint venture between Bulgari S.p.A. and the Luxury Group, a division of Marriott International that also manages Ritz-Carlton hotels. The Complainant's hotels can be found in such places as London, Bali, Beijing and Milan. The Complainant will soon to launch new hotels in Shanghai, Dubai and Moscow.

The "BVLGARI"/"BULGARI" trade mark is distinctive and exclusively refers to the Complainant's goods and services. The word "BVLGARI"/"BULGARI" derives from its founder's surname, Sotirio "Voulgaris". "BVLGARI" is simply the phonetic version of this

surname. The Complainant's trade mark is both written "BVLGARI" in the classical Latin alphabet and "BULGARI" in the modern alphabet.

The Complainant submits that they have registered international trade marks, which are valid and subsisting in China, as provided in the table below:

BVLGARI			
Registration Number	Registration Date	Trade Mark	Classes Covered
1290822	23-12-2015	BVLGARI	9,35,38,42
1065701	19-08-2010	BVLGARI	36,43

Significantly, the Complainant explains that, although the disputed domain name, <bvlgarihotels.cn>, was initially created on the 24 September 2007, the Respondent, who is subject to these proceedings, acquired the domain name on the 13 May 2016.

According to Article 2 of CNDRP, this complaint falls within the requirements as it refers to a domain name that utilises the ".cn" ccTLD and further, the Complaint is being filed before the 13 May 2018 (two years from when the Respondent acquired the domain name), which is within the two-year requirement set out by the CNDRP. The Complainant supports their submission that the two year time limit can start from the Respondent's acquisition of the domain name, following the case of *Leister Brands AG v. 被投诉人* Case No. DCN-1500641. In this decision, it was held that the transfer of a ".cn" domain name can amount to a new registration, which re-sets the two year time bar. Further, the complaint will rely on the Rules of the CNDRP.

The Respondent, 徐东彦, elected to default and not submit a Response.

3. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

A. The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights:

The Complainant submits that they hold registered international trade marks for the term "BVLGARI", which are valid in the Peoples Republic of China. The Complainant submits that these trade marks are not generic or commonly understood by any other meaning, other than their relationship with the Complainant's goods and services. As such, the Complainant maintains that they have "rights" for the purposes of these proceedings.

The domain name, <bvlgarihotels.cn>, features the well-known and instantly recognisable BVLGARI trade mark, together with the generic English word, "HOTELS". Furthermore,

the addition of the term "HOTELS" does nothing to materially alter the overall impression in the eyes of an unsuspecting Internet user, because the term "BVLGARI" is the distinguishing element of the overall domain name. Additionally, the word "HOTELS" makes an association with the Complainant's luxury hotels found on www.bulgarihotels.com. The Complainant submits that the same principle was also applied in *Enterprise Holding, Inc. v Internet Media* (Case No. DCN-1500665), where the panel held that there was a close relationship between the trade mark "ENTERPRISE" and the disputed domain name <enterprisecar.com.cn>, featuring the generic word "CAR"; the domain name was suggestive of the complainant's service, *i.e.* car rental and was, therefore, confusingly similar.

The addition of the ccTLD ".cn" is not sufficient to escape a finding that <bvlgarhotels.cn> is confusingly similar, as it is a technical addition for domain names registered in China (see *Hewlett-Packard Company v Mohammad Hossein Erfani and the Kotobi Group*, HKIAC Case No. DCN-0300005).

Based on the above submissions, the Complainant requests that the Panel agree that <bvlgarhotels.cn> is confusingly similar to the respective "BVLGARI" trade marks.

B. The Respondent has no rights or legitimate interests in respect of the domain name

The Complainant submits that the Respondent does not have any rights or legitimate interest in <bvlgarhotels.cn>. Under Article 10 of the CNDRP, the Complainant acknowledges that a Respondent may demonstrate a right or legitimate interest in the domain name only if it can be established that:

- Your use of the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
- You have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights;
- You are making a legitimate non-commercial or fair use of the domain name, without intent of or commercial gain to misleadingly divert consumers.

After the Complainant has put forward their arguments, the burden will then shift to the Respondent to put forward evidence that they do have rights or a legitimate interest in <bvlgarhotels.cn>.

The Complainant firstly maintains its legal right to <bvlgarhotels.cn>, is based on the statutory protection of the "BVLGARI" term by way of trade marks in several jurisdictions, including that of the Peoples Republic of China. The Complainant also relies on the goodwill that has been associated with the "BVLGARI" brand for over 17 years, which pre-dates the date when the Respondent took ownership of the domain name and even its initial registration date.

In order to rebut any possible legitimate interest held by the Respondent in this matter, the Complainant outlines objections to each of the provisions laid out under Article 10 of the CNDRP:

- i. *Your use of the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;*

The Complainant submits that <bvlgarihotels.cn> is currently inactive and appears to have been in the same state since the Respondent took ownership of the domain name last year. As there is no content on the domain name, there is no evidence to suggest that the Respondent is using <bvlgarihotels.cn> in connection with a *bona fide* offering of goods and/or services.

- ii. *You have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights;*

To the best of the Complainant's knowledge, the Respondent has never been known as "BVLGARI" or "BVLGARIHOTELS" and furthermore, has never been given permission by the Complainant to use their brand in domain names, or for any other purpose. It is a commonly held principle in domain disputes that merely registering a domain name, is not sufficient to establish rights or legitimate interests (*see Vestel Elektronik Sanayi ve Ticaret AS v Kahveci*. D2000-1244). These facts lead the Complainant to conclude that the only reason why the Respondent registered <bvlgarihotels.cn>, was to take advantage of the well-known "BVLGARI" brand. Therefore, the Respondent cannot claim under this exception.

- iii. *You are making a legitimate non-commercial or fair use of the domain name, without intent of or commercial gain to misleadingly divert consumers.*

The Complainant reiterates that <bvlgarihotels.cn> is inactive. Based on the strength of the BVLGARI trade mark and the addition of the generic term 'HOTELS', there is no plausible reason for the Respondent's registration of the domain name, other than to passively withhold it from the Complainant. As such, the Respondent does not come within this exception of the CNDRP.

In light of the comments submitted by the Complainant, the Respondent does not satisfy any of the above-mentioned grounds under Article 10.

C. The disputed domain name is registered or used in bad faith

For the purposes of Article 9 of the CNDRP, the following circumstances, in particular, but without limitation, if found by the Panel to be present, shall be evidence of the registration and/or use of a domain name in bad faith:

- a) The purpose for registering or acquiring the domain name is to sell, rent or otherwise transfer the domain name registration to the complainant who is the owner of the name or mark or to a competitor of that complainant, and to obtain unjustified benefits;
- b) The disputed domain name holder, on many occasions, registers domain names in order to prevent owners of the names or marks from reflecting the names or the marks in corresponding domain names;

- c) The disputed domain name holder has registered or acquired the domain name for the purpose of damaging the Complainant's reputation, disrupting the Complainant's normal business or creating confusion with the Complainant's name or mark so as to mislead the public;
- d) Other circumstances which may prove the bad faith.

The Complainant submits that they hold trade marks for the term "BVLGARI" both in China and other countries worldwide. In addition to trade mark registrations, the "BVLGARI" brand has been promoted extensively in The Peoples Republic of China. Furthermore, a Google or Baidu search for the term "BULGARI" or "BVLGARI" lists results solely related to the Complainant's brand. This factual consideration bears a significant burden on the Respondent in view of the fact that any pre-registration due diligence on their part would have made the Respondent aware of the Complainant's vast reputation and established goodwill at the time and it would have been extremely difficult to avoid knowledge of the Complainant.

In addition to the Respondent's lack of due diligence searches above, the make-up of the domain name is also suggestive of bad faith intent. Specifically, the Respondent has chosen a domain name featuring the "BVLGARI" term, with the addition of the generic term, "HOTELS", which creates further association with the Complainant's luxury hotels. Therefore, it is apparent that the Respondent had actual knowledge of the Complainant and their brand at the time <bvlgarihotels.cn> was registered and furthermore, chose to register this domain name based on its brand value. Therefore, bad faith registration is satisfied.

The Complainant submits that the Respondent has a portfolio of 35 domain names, several of which relate to 3rd party brand names. Examples include the registration of <aegion.com.cn>, <itson.com.cn>, <aspidental.com.cn> and <gummyvites.cn>. Such use shows that the Respondent has a complete disregard for Intellectual Property rights and will continue to dilute the goodwill and valuable reputation of brands, like the Complainant's. Furthermore, many of the Respondent's domain names, are advertised for sale. As such, it is more likely than not that the Respondent's intention for the domain name <bvlgarihotels.cn>, is to sell it to the Complainant, its competitor, or to take unfair advantage of the Complainant's mark through disruption or blocking registration.

In addition to the above, the domain name is inactive, which is an indication of passive holding, as identified by UDRP case law, notably *Telstra Corporation Limited v. Nuclear Marshmallows*. Case No. D2000-0003, whereby the Panelist, Andrew F. Christie explained that passive holding should be applied if: "it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate". On these facts, the Complainant submits that there is no plausible reason for anyone to register domain names featuring the well-known "BVLGARI" term without permission from the Complainant. Based on the lack of active use and the above-mentioned arguments surrounding the domain name and the Respondent's domain portfolio, there is no plausible reason for the domain name's registration, other than to target the Complainant.

Based on the above submissions, the Complainant requests the Panel to make a finding against the Respondent, that <bvlgarihotels.cn> has been registered in bad faith, which satisfies all grounds under Article 8 of the CNDRP.

B. Respondent

The Respondent's contentions may be summarized as follows:

The Respondent, 徐东彦, elected to default and not submit a Response.

4. Findings

Is the Complaint time barred under Article 2 of the CNDRP?

The Complainant submits a WHOIS record to show that the prior Registrant, 胡雪芳 (Hu Xue Fang), effected a transfer of the Disputed Domain Name to the Respondent, 徐东彦, on 13 May 2016. Relying on the panel decision in *Leister Brands*, the Complainant argues that such a transfer of a “.cn” domain name “can amount to a new registration, which re-sets the two year time bar” mandated by Article 2 of the CNDRP.

Article 2 of the CNDRP provides:

“The policy is applicable to disputes result from registration or usage of domain names. The disputed names shall, within the range of “.CN”, “.中国” domain names that were under the administration of China Internet Network Information Center (CNNIC). However, ***the Dispute Resolution Service Providers do not accept the Complaint regarding domain names with registration term of over TWO years.***”

(Emphasis supplied)

Because the Complaint in these administrative proceedings was filed before 13 May 2018 (the date two years from when the Respondent acquired the domain name), the Complainant argues that it's Complaint “is within the two-year requirement set out by the CNDRP”. Therefore, the question of whether or not the Complainant's action is barred by Article 2 of the CNDRP is a critical and determinative issue for decision by the Panel.

The *Leister Brands* decision, on which the Complainant relies, is addressed in HKIAC's “*Guide to HKIAC Domain Name Dispute Resolution*” (“**HKIAC Guide**”), which speaks to the Article 2 two-year time bar in the following terms:

“... [S]ome HKIAC panels have considered [] the transfer of a “.cn” domain name to a third party a new registration, thus re-setting the 2-year time bar. In ***Leister Brands AV v. Chen Qiuheng*** (HKIAC Case No. DCN-1500641, 10 October 2015, [] regarding the domain name www.leister.net.cn, the HKIAC panel ruled that the transfer of a “.cn” domain name from one party to another constituted a new registration under

the CNDPR and therefore “resets” the two-year time limit for bringing a domain name complaint.”

The HKIAC Guide goes on to explain the rationale underpinning the *Leister Brands* decision, commenting:

“According to the [*Leister Brands*] panel, the language “registering or acquiring,” which appeared in Article 9 of the CNDPR for the purpose of considering the registrant’s bad faith, indicated that a domain name that has been assigned or transferred to another party can be subject to the CNDPR if an “acquisition” occurred within two years before an administrative proceeding is commenced. The panel found that since procedures for registration and assignment of a domain name were substantially similar, the assignment of a domain name was essentially a form of registration. The panel also referred to the fact that it has generally been accepted that the transfer of a domain name constituted a new registration under the UDRP, for consideration of bad faith. Two years after *Lester Brands AV* was decided, a transfer to a third party that occurred within two years before a CNDPR complaint is filed has again been considered as re-setting the two-year time bar in *Airbnb Inc. v. Guo Lanzhi* (HKIAC Case No. DCN-1700742, 3 July 2017 [].”

In a similar vein to *Airbnb Inc.*, the WIPO Jurisprudential Overview 3.0 (“**WIPO Overview 3.0**”) observes within the UDRP context that, while merely formalistic changes or updates, or the mere renewal of a domain name by the same registrant would not re-set the relevant date to consider for purposes of assessing bad faith, “the transfer of a domain registration from a third-party to the respondent is not a [mere] renewal”, and would be the relevant date for a panel to consider in assessing bad faith. (See, WIPO Overview 3.0 at par. 3.9)

Although neither the CNDPR, nor the UDRP, operates on a strict doctrine of binding precedent, it is widely believed that panels should strive for consistency with prior decisions, such that parties can reasonably anticipate the result of their case where previous panels have confronted similar factual scenarios. Here, the Panel sees no reason to depart from the path taken by the panel in *Leister Brands*, and the reasoning put forward in *Airbnb Inc.*, as summarized in the HKIAC Guide and the WIPO Overview 3.0.

The Complaint is not time barred

Complainant’s Complaint having been filed on 11 December 2017, less than two years following the 13 May 2016 transfer of the Disputed Domain Name from the prior Registrant, 胡雪芳 (Hu Xue Fang), to the Respondent, 徐东彦, the Panel finds that the Complaint was filed within the two-year requirement set out by the CNDPR and that the Complainant’s action is not barred under Article 2 of the CNDPR. The transfer of the Disputed Domain Name to the Respondent re-set the Article 2 two-year limitation period with the same effect as if the Respondent had newly registered the domain on that date.

As to the case, Article 8 of CNDRP provides that a complaint against a registered domain name shall be supported if the following conditions are fulfilled:

- i. The disputed domain name is identical with or confusingly similar to the Complainant's name or mark in which the Complainant has civil rights or interests;
- ii. The disputed domain name holder has no right or legitimate interest in respect of the domain name or major part of the domain name;
- iii. The disputed domain name holder has registered or has been using the domain name in bad faith.

Article 7 of CNDRP states that the complainant and the respondent shall bear the burden of proof for their own claims. With reference to the complaint and the attached documents, the Panel of this case considers that:-

Identical or Confusing Similarity

The Disputed Domain Name incorporates the Complainant's registered "BVLGARI" trade mark in its entirety, along with the generic word "HOTELS", which further associates the domain with the Complainant's luxury hotels. That the Disputed Domain Name is identical or confusingly similar to the Complainant's trade marks, which are registered and subsisting in China, is beyond serious question.

The Complainant has satisfied the first element of Article 8 of the Policy.

Rights or Legitimate Interests of the Respondent

Based on the strength of the "BVLGARI" trade mark and the addition of the generic term "HOTELS", there is no plausible reason for the Respondent's registration of the domain name, other than to passively withhold it from the Complainant. Furthermore, the Respondent has defaulted and has failed to fulfill his burden to come forward with rebuttal evidence.

The Complainant has satisfied the second element of Article 8 of the Policy.

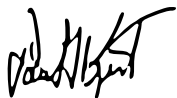
Bad Faith

The Complainant asserts that there is no plausible reason for anyone to register domain names featuring the well-known "BVLGARI" term without permission from the Complainant and that the lack of active use of the Disputed Domain Name, as well as other surrounding factors, including the Respondent's holdings of other infringing English language domain names, leads to the conclusion that no plausible reason may be found for the domain name's registration, other than to target the Complainant. This Panel accepts the Complainant's position, and therefore decides that the Disputed Domain Name was registered / acquired by the Respondent, or used by him, or both, in bad faith.

The Complainant has satisfied the third element of Article 8 of the Policy.

5. Decision

The Panel orders that the disputed domain name <bvlgarihotels.cn> be transferred to the Complainant.



Panelist: David L. Kreider (柯瑞德)

Date: 6 February 2018