

## **ADMINISTRATIVE PANEL DECISION**

Luigi Lavazza S.p.A. v. Otto Stroffek, Daguer  
Case No. D2022-3896

### **1. The Parties**

The Complainant is Luigi Lavazza S.p.A., Italy, represented by Studio Barbero, Italy.

The Respondent is Otto Stroffek, Daguer, Slovakia.

### **2. The Domain Name and Registrar**

The disputed domain name <lavazza.pro> (the “Domain Name”) is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 18, 2022. On October 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 19, 2022, 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.

The Center verified that the 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 the Respondent of the Complaint, and the proceedings commenced on November 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 23, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 28, 2022.

The Center appointed Gregor Vos as the sole panelist in this matter on December 9, 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 coffee producer that was founded in 1927 and its owners have been operating a coffee business since 1895. The Complainant is currently active in over 140 countries with more than 4,000 employees worldwide.

The Complainant is the owner of *inter alia* the following European Union (“EU”) and international trademark registrations (hereinafter jointly referred to as: the “Trademarks”):

- EU trademark registration No. 000317057 for LAVAZZA registered on May 25, 1998;
- International trademark registration No. 317174 for LAVAZZA registered on July 18, 1966;
- International trademark registration No. 1299219 for  registered on February 23, 2016.

Further, it is undisputed that the Complainant is the holder of *inter alia* the following domain name:

- <lavazza.com>, registered on May 19, 1996.

The Domain Name was registered on July 31, 2018. On the filing date of the Complaint, the Domain Name resolved to a parking page.

#### 5. Parties' Contentions

##### A. Complainant

With the Complaint, the Complainant seeks that the Domain Name is transferred to the Complainant. The Complaint is based on the following factual and legal grounds: the Domain Name is identical or confusingly similar to the Trademarks of the Complainant, the Respondent has no rights or legitimate interests in the Domain Name, and the Domain Name has been registered and is being used in bad faith.

Firstly, according to the Complainant, the Domain Name is identical or confusingly similar to its well-known Trademarks. The Domain Name is identical to the Complainant's Trademarks with the mere addition of the generic Top-Level Domain (“gTLD”) “.pro”.

Secondly, according to the Complainant, the Respondent has no rights or legitimate interests in the Domain Name. The Respondent is not commonly known under the name “lavazza.pro” and holds no relevant trademark registrations, license or any other form of authorization from the Complainant to use the Trademarks. In addition, the Respondent did not and does not use the Domain Name in connection with a *bona fide* offering of goods or services before or after any notice of the current dispute and does not make a legitimate noncommercial or fair use of the Domain Name. According to the Complainant, the Respondent intentionally attempted to divert consumers or to tarnish Complainant's Trademarks because in July 2022, the Domain Name redirected to a webpage that displayed several pay-per-click (“PPC”) links relating to coffee goods, including goods which compete with those sold under the Complainant's Trademarks.

Lastly, according to the Complainant, the Respondent has registered and uses the Domain Name in bad faith. The Respondent intentionally attempts, by using the Domain Name, to achieve commercial gain through the PPC links by creating a likelihood of confusion with the Complainant's Trademarks as to the source, sponsorship, affiliation or endorsement of the Domain Name. Also, the Respondent has set up MX records for the Domain Name that may be used to send fraudulent email communication. In light of the well-known character of the Complainant's Trademarks, it is inconceivable that the Respondent selected the Domain Name for any other reason than to mislead Internet users, create a likelihood of confusion with the Trademarks and capitalize on the Complainant's Trademarks.

## B. Respondent

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

## 6. Discussion and Findings

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual presentations.

For the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

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

Only if all three elements have been fulfilled, the Panel is able to grant the remedies requested by the Complainant. The Panel will deal with each of the requirements in turn.

### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the Domain Name is (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

With respect to having rights pursuant to paragraph 4(a)(i) of the Policy, it is noted that the Complainant is registered as the owner of the Trademarks. Consequently, the Panel finds that the Complainant has proven that it has rights in the Trademarks.

With regard to the assessment of identity or confusing similarity of the Domain Name with the Trademarks, it is generally accepted that this test involves a reasoned but relatively straightforward comparison between the Complainant's Trademarks and the Domain Name (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). In cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark (see section 1.7 of the [WIPO Overview 3.0](#)).

In the present case, the Domain Name is identical to the Complainant's Trademarks. The addition of the generic gTLD ".pro" does not prevent a finding of confusing similarity with the Trademarks (see section 1.11 of the [WIPO Overview 3.0](#)). Consequently, the Panel finds that the requirement under paragraph 4(a)(i) of the Policy has been satisfied.

### B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the Domain Name. The onus of proving this requirement, like each element, falls on the Complainant. Given the difficulty in proving a negative, however, it is usually sufficient for a complainant to make out a *prima facie* case that a respondent lacks rights or legitimate interests. If a complainant does establish a *prima facie* case, the burden of production shifts to the respondent (see, e.g. [WIPO Overview 3.0](#), section 2.1; *Sanofi v. Cimpress Schweiz GmbH*, WIPO Case No. [D2017-0522](#)).

Paragraph 4(c) of the Policy lists three non-limitative examples of instances in which a respondent may establish rights or legitimate interests in the disputed domain name.

The Complainant has substantiated that none of these circumstances apply in this case. By defaulting, the Respondent has failed to address the *prima facie* case thus established by the Complainant. Furthermore, based on the record before it, the Panel does not see an indication that any of the circumstances of paragraph 4(c) of the Policy is present.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name. Paragraph 4(a)(ii) is thereby fulfilled.

### **C. Registered and Used in Bad Faith**

Under paragraph 4(a)(iii) of the Policy, a complainant must show that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy lists four non-limitative circumstances which may be considered as evidence of registration and use in bad faith of a domain name.

In the present case, the Trademarks are registered by the Complainant and have been used for many years. The Complainant's rights to the Trademarks predate the registration date of the Domain Name. In light of the well-known character of the Trademarks, the Panel agrees with the Complainant that it is not conceivable that the Respondent chose the Domain Name without knowledge of the Complainant's activities and its Trademarks under which the Complainant is doing business. The well-known character of the Trademarks of the Complainant has been confirmed by earlier UDRP panels (see *e.g. Luigi Lavazza S.p.A. v. Protection of Private Person / COFFEEBRO LLC*, WIPO Case No. [D2020-3349](#); *Luigi Lavazza S.p.A. v. Flying Stingrays Ltd*, WIPO Case No. [D2012-1391](#)).

Further, in light of the lack of any rights to or legitimate interest in the Domain Name by the Respondent and in the absence of any conceivable good faith use of the Domain Name (identical to the Trademarks), the Panel finds from the present circumstances that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's well-known Trademarks. This is reinforced by the fact that the Domain Name resolves to a website on which PPC links are shown that are related to the Complainant's services and activities and the fact that the Respondent has set up MX records for the Domain Name which may be used for email communication.

Accordingly, the Panel finds that the Domain Name has been registered and is being used in bad faith and that the third element of paragraph 4(a)(iii) of the Policy is fulfilled.

### **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 <lavazza.pro> be transferred to the Complainant.

/Gregor Vos/

**Gregor Vos**

Sole Panelist

Date: December 23, 2022