

## **ADMINISTRATIVE PANEL DECISION**

Consorzio per la Tutela del Formaggio Gorgonzola v. Privacy Protect, LLC  
(PrivacyProtect.org) / Spencer Hurst  
Case No. D2022-0613

### **1. The Parties**

The Complainant is Consorzio per la Tutela del Formaggio Gorgonzola, Italy, represented by Jacobacci & Associati, Italy.

The Respondent is Privacy Protect, LLC (PrivacyProtect.org), United States of America (“United States”) / Spencer Hurst, United States.

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

The disputed domain name <gorgonzola.wtf> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 22, 2022. On February 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 23, 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 February 23, 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 amendment to the Complaint on February 24, 2022.

The Center verified that the Complaint together with the amendment to 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 March 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 23, 2022. The Respondent sent informal email communications on

February 23, 2022 and March 3, 2022. The Center informed the Parties of its commencement of Panel appointment process on March 25, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on March 30, 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 was created under Italian law to protect the GORGONZOLA denomination of origin for a specific cheese, having the sole authority (as per decree of the Italian Government) to certify which products may bear such denomination on the basis of territorial origin and specific qualities of the products.

In addition to the rights arising from Italian law, the Complainant is the owner of the following, amongst other trademark registrations (Annexes 4-6 to the Complaint):

- European Union trademark registration No. 010595015 for GORGONZOLA (word and device), registered on July 4, 2012, in classes 29 and 30; and
- European Union trademark registration No. 016315202 for GORGONZOLA (word and device), registered on September 11, 2017, in classes 29, 30, and 35.

The disputed domain name was registered on December 27, 2021 and presently does not resolve to an active webpage.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant was created in 1968 in the form of two entities which merged in 1970 to protect the GORGONZOLA trademark, having the sole authority according to an Italian Government Decree to authorize the use of the name and trademark GORGONZOLA, which functions as a collective trademark, certifying which products may bear the denomination on the basis not only of the territorial origin but also of specific qualities of the products.

According to the Complainant, the disputed domain name fully incorporates its GORGONZOLA trademark, causing a likelihood of confusion as to the source and/or sponsorship of the disputed domain name.

As to the Respondent's lack of rights or legitimate interests in the disputed domain name, the Complainant contends that:

- i) there is no evidence of the Respondent'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;
- (ii) the Respondent has never been commonly known in the normal course of business by the trademark, trade name or domain name GORZONGOLA; and
- (iii) there is no noncommercial fair use of the disputed domain name.

In relation to the bad faith use of the disputed domain name, the Complainant asserts that in spite of the fact that Gorgonzola is the name of a small town in Italy, a cursory search would easily reveal that the name GORGONZOLA evokes immediately the Complainant's trademark as recognized in *Consorzio per la Tutela del Formaggio Gorgonzola v. WhoisGuard, Inc. / John Tattersall*, WIPO Case No. [D2019-2848](#). In addition to that, whilst the disputed domain name is not currently in active use, it is reasonable to think that it is intended

to be used in the future in a way that would be commercial and detrimental to the Complainant's interests, precisely because it is identical to a famous trademark and denomination of origin.

## **B. Respondent**

On February 23, 2022 the Respondent sent an informal message to the Center stating "Hi - Just received this message and not sure what action I need to take. Please let me know. Thanks". A second informal message was sent by the Respondent on March 3, 2022, reading:

"I'm still a little confused as to if there are any action items on my part right now. I've read through the nature of what these complaints are, but I'm not sure what I can do to prepare a statement or where to send it. Could you please advice? Thanks"

No further communication or formal response was submitted by the Respondent.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present so as to have the disputed domain name transferred to it, according to paragraph 4(a) of the Policy.

In accordance with paragraph 14(b) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

### **A. Identical or Confusingly Similar**

The Complainant has established rights in the GORGONZOLA denomination of origin also registered as a trademark before the European Union and the Maldives as well as a collective mark in Japan and as a certification mark in Liechtenstein (Annex 4 to the Complaint).

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") notes that the consensus of a relatively straightforward comparison between the disputed domain name and the Complainant's trademark so as to assess whether the mark is recognizable within the disputed domain name.

In the present case, given that the disputed domain name incorporates the Complainant's trademark entirely, the first element of the Policy has been met.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate the Respondent's rights to or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

(ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to and/or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden is still on the Complainant to make a case against the Respondent.

In that sense, the Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the disputed domain name or to seek the registration of any domain name incorporating the "Gorgonzola" denomination of origin, or the GORGONZOLA trademark or a domain name similar to the GORGONZOLA denomination of origin or trademark.

Furthermore, from the Whois information available the Respondent is not named "Gorgonzola" nor is it based in the small town in Italy named Gorgonzola, what leads the Panel to the conclusion that the Respondent is not commonly known by the disputed domain name or any similar name.

Also, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or to a webpage relating to the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

Moreover, there is no evidence that the Respondent has used or made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial use.

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or interests in the disputed domain name. However, the Respondent has chosen not to respond to the Complaint and thus has failed to provide any evidence of rights and legitimate interests in the disputed domain name including any evidence that that the disputed domain name is (or is demonstrably intended) to be used in connection with any non-trademark or descriptive meaning.

Section 2.10.1. of the [WIPO Overview 3.0](#) indicates that: "Panels have recognized that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent; panels have held that mere arguments that a domain name corresponds to a dictionary term/phrase will not necessarily suffice. In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights. For example, a hypothetical respondent may well have a legitimate interest in the domain name <orange.com> if it uses the domain name for a website providing information about the fruit or the color orange. The same respondent would not however have a legitimate interest in the domain name if the corresponding website is aimed at goods or services that target a third-party trademark (in this example: *Orange*, well-known *inter alia* for telecommunications and Internet services) which uses the same term as a trademark in a non-dictionary sense."

Therefore, while strictly speaking given the finding below it is not necessary to make a finding under this element, the Panel would be prepared to find that the Complainant has satisfied its burden under the second element of the Policy.

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

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant who is the owner of a trademark relating to the disputed domain name or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed 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 Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

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

The registration and use requirements of paragraph 4(a)(iii) of the Policy are conjunctive, and a complainant bears the burden of proof on each. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). If either of the required elements is not established, the Complaint must fail. See *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

In the present case there are no circumstances that indicate that the Respondent has registered the disputed domain name primarily for the purpose of selling, renting, or otherwise the transferring the disputed domain name to the Complainant. There is no evidence that the Respondent has ever attempted to sell the disputed domain name or that the Respondent is in the business of registering domain names for sale to trademark owners.

In addition to that, there is no evidence that the Respondent has engaged in a pattern of registering domain names (including the disputed domain name) to prevent trademark owners from registering corresponding domain names. There is no evidence that the Respondent has ever registered a domain name other than the disputed domain name.

Furthermore, there is no evidence that the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor.

Moreover, the inactive use of the disputed domain name does not allow the Panel to conclude that the Respondent registered the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to its 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 the Respondent's website.

This case is similar to past ones involving the Complainant, in special *Consorzio per la Tutela del Formaggio Gorgonzola v. Gilberto Ramponi Rivelli, Publinord s.r.l.*, WIPO Case No. [D2021-0690](#), and *Consorzio per la Tutela del Formaggio Gorgonzola v. William Wise*, WIPO Case No. [D2017-0554](#), from which the Panel quotes the following, also applicable to this case:

"This is a decision reached with some difficulty as there is:

- (a) no evidence whatsoever from the Respondent about its reason for registering the Domain Name;
- (b) no evidence whatsoever about the Respondent that would assist the Panel in inferring the Respondent's intentions in registering the Domain Name;

(c) no evidence of use of the Domain Name such that the intention behind the registration of the Domain Name can be inferred.

The Complainant has submitted that 'There is no way that Respondent may have not been aware of the association of 'GORGONZOLA' with Complainant... as a cursory Google search would easily reveal, the name GORGONZOLA evokes immediately the Complainant's trademark as used for a cheese. Italian and European authorities have recognized Complainant's rights on the trademark GORGONZOLA and to control its use internationally [...]'. The evidence in the Complaint is that the CG GORGONZOLA Mark is not registered in the United States (the CG Mark is registered in that country) and neither is the Gorgonzola denomination of origin protected in the United States. There is insufficient evidence for the Panel to conclude that the Complainant has an unregistered trade mark for 'Gorgonzola' in the United States. As noted above the Panel is not satisfied by the evidence that the word 'gorgonzola' is anything other than a descriptive term for a particular type of cheese in the United States.

The evidence in the Complaint does not show that the Complainant and the denomination of origin 'gorgonzola' has such a strong reputation in the United States that any person who sought to register a domain name featuring the word 'gorgonzola' must have been aiming to take advantage of the confusion between the Domain Name and any rights the Complainant has in words or marks corresponding to the Domain Name, as opposed to registering the Domain Name for its descriptive qualities. It is not implausible that a party unaware of the Complainant, or a party aware of the Complainant but cognizant that the protection of the denomination of origin 'Gorgonzola' does not extend to the United States, would seek to register a Domain Name consisting of the word 'gorgonzola' to take advantage of the descriptive meaning of the word in the United States, namely as a particular type of cheese.

As seen above, the four circumstances listed in paragraph 4(b) of the Policy as evidence of bad faith do not appear to be present in this case, the Panel needing to address whether the passive holding of the disputed domain name could characterize the Respondent's bad faith. The [WIPO Overview 3.0](#), section 3.3 indicates that '[w]hile panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put'."

In the present case, as in the cited case, the Panel considers that there is insufficient evidence to show that the disputed domain name was registered or has been used in bad faith.

In the present case, by reason of the limited evidence provided by the Parties, the Panel finds that the Complainant has not satisfied its burden of showing circumstances that bring the case within the provisions of paragraph 4(b) of the Policy exist, or other facts showing that Respondent registered or has used the disputed domain name in bad faith.

The Panel notes that in the event that further information arises that establishes the motives of the Respondent in registering the disputed domain name in such manner that is dispositive of an attempt to target the Complainant, there may be grounds to consider a refiled complaint, subject to the applicable criteria.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: April 13, 2022