

ADMINISTRATIVE PANEL DECISION

Lidl Stiftung & Co. KG v. Dejan Jovanovic
Case No. D2022-3323

1. The Parties

The Complainant is Lidl Stiftung & Co. KG, Germany, represented by HK2 Rechtsanwälte, Germany.

The Respondent is Dejan Jovanovic, Serbia.

2. The Domain Name and Registrar

The disputed domain name <lidl-shop.trade> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 6, 2022. On September 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 7, 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 September 9, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On September 10, 2022, the Respondent sent an informal email. The Complainant filed an amendment to the Complaint on September 12, 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 September 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 5, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the Parties that it will proceed to Panel Appointment.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on October 17, 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 part of a group which operates a discount supermarket chain in 31 countries. The Complainant owns many trademark registrations for LIDL such as:

- German trademark registration No. 2006134 registered on November 11, 1991;
- International trademark registration No. 748064 registered on July 26, 2000.

The disputed domain name was registered by the Respondent on April 7, 2022. The disputed domain name appears to be inactive.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant owns the trademark LIDL and has registered it in many countries. The Complainant's trademark does not have a dictionary meaning but is derived from the name of a co-founder. It is inherently distinctive and has a worldwide reputation. The disputed domain name is confusingly similar to the Complainant's trademark LIDL as it incorporates it in its entirety. The addition of a descriptive term does not eliminate the confusing similarity. In the present case, the term "shop" together with the generic Top-Level Domain ("gTLD") "trade" leads Internet users to think that this is the Complainant's online shop. Furthermore, a gTLD is irrelevant in determining confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof shifts to the Respondent. The Respondent is not making a noncommercial or fair use of the disputed domain name as the term "shop" together with the gTLD "trade" leads Internet users to think that this is the Complainant's online shop. The Respondent has not registered the disputed domain name in connection with a *bona fide* offering of goods or services as the disputed domain name resolves to an inactive website. The Respondent is not commonly known by the disputed domain name nor was it granted permission to use the Complainant's trademark.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The mere registration of a domain name that is identical or confusingly similar to a famous trademark can create a presumption of bad faith. Furthermore, the disputed domain name creates the impression of being endorsed by the Complainant. The Respondent knew of the Complainant's trademark as the use of the trademark LIDL precedes the registration of the disputed domain name by decades and as the Complainant's trademark is well known. The use of the term "trade" and "shop" further confirms such knowledge. There is no conceivable plausible actual or contemplated active use as the disputed domain name does not resolve to an active website. Lastly, passive use in the current case infers bad faith.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions but on September 10, 2022, the Respondent sent an informal email stating that the disputed domain name "was on free sale" when it purchased it, that there are thousands of other domain names available in the market, and provides a list of available domain names containing "lidl-shop".

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for LIDL. The Panel is satisfied that the Complainant has established its ownership of the trademark LIDL.

The disputed domain name incorporates the Complainant's trademark LIDL in its entirety. It is established by prior UDRP panels that when a domain name incorporates a complainant's registered trademark, such incorporation is sufficient to establish identity or confusing similarity for the purposes of the Policy (*Delta Dental Plans Association v. Fundacion Private Whois / PPA Media Services*, WIPO Case No. [D2012-1440](#)).

The addition of the term "shop" does not prevent the fact that the disputed domain name is confusingly similar to the Complainant's trademark. The gTLD ".trade" should typically be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is identical to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not authorized by the Complainant to use its trademark. The Complainant further asserts that the Respondent is not using the disputed domain name for a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use, and the Respondent is not commonly known by the disputed domain name. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests.

The absence of a substantive response by the Respondent allows the Panel to draw inferences, and under the circumstances, the absence of a response leaves the Complainant's *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name un rebutted.

The Respondent claims that the disputed domain name was freely available for purchase. However, the Panel notes that the fact that the disputed domain name was available for purchase does not give the Respondent any rights or legitimate interests in the disputed domain name reproducing the Complainant's trademark in its entirety.

Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

There are many indications that the disputed domain name is registered and is being used in bad faith. The nature of the disputed domain name suggests affiliation with the Complainant as it incorporates the Complainant's trademark in full. The use of the term "shop" reinforces the impression that the website at the disputed domain name is the Complainant's website for selling its products online.

The Respondent must have been aware of the Complainant's trademark as the Complainant's trademark is well-known and had been registered for more than three decades when the disputed domain name was created. It has been found by prior UDRP panels that the mere registration of a domain name that is identical or confusingly similar to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The disputed domain name resolves to an inactive website. Prior UDRP panels have found that passive holding does not prevent a finding of confusing similarity if the totality of circumstances support an inference of bad faith. See section 3.3 of the [WIPO Overview 3.0](#). Noting the Respondent's failure to provide any good-faith explanation for his registration and use of the disputed domain name, and more importantly the absence of a plausible use of the disputed domain name that would be legitimate under the Policy (*Johnson & Johnson v. Daniel Wistbacka*, WIPO Case No. [D2017-0709](#)) the Panel finds that the current passive holding of the disputed domain name does not prevent the Panel's bad faith finding.

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 disputed domain name <lidl-shop.trade> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: October 31, 2022