

ADMINISTRATIVE PANEL DECISION

Aldi GmbH & Co. KG and Aldi Stores Limited v. Darren Coles
Case No. D2023-0753

1. The Parties

The Complainants are Aldi GmbH & Co. KG (the “First Complainant”), Germany, and Aldi Stores Limited (the “Second Complainant”), United Kingdom, represented by Freeths LLP, United Kingdom.

The Respondent is Darren Coles, United Kingdom.

2. The Domain Names and Registrar

The disputed domain names <aldiskunk.com> and <aldiweed.com> are registered with Register SPA (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 20, 2023. On February 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 23, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainants on February 23, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on February 27, 2023.

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 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 23, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on March 29, 2023. 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 disputed domain names were both registered on August 19, 2022 (Annex 1 to the Complaint).

The First Complainant is the owner of the ALDI registered trademarks, *inter alia*:

- United Kingdom trademark ALDI (word), Registration No. UK00002250300, registered on March 30, 2001, in int. classes 1, 3, 5, 6, 11, 16, 21, 24, 25, 29, 30, 31, 32, 33, 34, and 35;
- United Kingdom trademark ALDI (word), Registration No. UK00902071728, registered on April 14, 2005, in int. classes 3, 4, 9, 16, 24, 25, 29, 30, 31, 32, 33, and 34;
- European Union trademark ALDI (word), Registration No. 002071728, registered on April 14, 2005, in int. classes 3, 4, 9, 16, 24, 25, 29, 32, 33, and 34;
- European Union trademark ALDI (word), Registration No. 002714459, registered on September 5, 2003, in int. classes 35 and 36;
- European Union trademark ALDI (word), Registration No. 003360914, registered on June 2, 2010, in int. classes 35, 38, and 39; and
- European Union trademark ALDI (word), Registration No. 003639408, registered on April 19, 2005, in int. classes 36, 39, 41, and 43 (Annex 4 to the Complaint).

The Second Complainant is the exclusive United Kingdom licensee of the ALDI trademarks owned by the First Complainant; it provides its website under the domain name <aldi.co.uk> (Annex 6 to the Complaint).

The ALDI mark is well known in the field of grocery retailing (Annex 7 to the Complaint).

The disputed domain names currently resolve to a website stating: “We’re sorry, aldiskunk.com is not available [...]” and “We’re sorry, aldiweed.com is not available [...]”.

5. Parties’ Contentions

A. Complainants

The First Complainant is a company registered under the laws of Germany, and the Second Complainant a company incorporated under the laws of England. The Complainants are part of the same corporate group and under common control, and both Complainants have an interest in the right relied upon, and therefore a common grievance against the Respondent.

The First Complainant owns, and the Second Complainant is the exclusive licensee in the United Kingdom of various registered trademarks which comprise and/or include the sign ALDI.

The Complainants and their connected companies are recognized as international leaders in grocery retailing. They have more than 5,000 stores across the world and are also active in Australia, Austria, Belgium, Denmark, France, Germany, Ireland, Luxembourg, the Netherlands, Poland, Portugal, Slovenia, Spain, Switzerland, and the United States of America. In Q1 2022, the ALDI trademark was one of the most popular brand in the supermarket sector in the United Kingdom, and the 22nd most popular brand across all sectors in the United Kingdom.

The disputed domain names are identical or confusingly similar to the trademarks of the Complainants since they incorporate the ALDI mark together with the descriptive term “skunk” or “weed” which enhances confusion as it suggests that the disputed domain names host a webpage relating to goods or services which are specifically sold by the Complainants.

The Respondent has no rights or legitimate interests in respect of the disputed domain names: The Complainants have not licensed or otherwise authorized the Respondent to use the ALDI mark in any way. Furthermore, the Respondent has not used the disputed domain names or any name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services and has not been commonly known by the disputed domain names or has not made any legitimate noncommercial or fair use of the disputed domain names.

Finally, the disputed domain names were registered and are being used in bad faith: The disputed domain names make unauthorized use of a sign confusingly similar to the Complainants’ registered trademark ALDI, in direct contravention of the Complainants’ trademark rights and rights in passing off. Moreover, it is inevitable that Internet users will be confused into believing that the disputed domain names have some form of association with the Complainants. The registration of the disputed domain names therefore took unfair advantage of the Complainants’ rights. On this basis alone, the registration of the disputed domain names to be in bad faith. In addition, the disputed domain names have been (or is planning to be) intentionally used to attract Internet users, for commercial gain, to any website hosted at the disputed domain names by creating a likelihood of confusion with the ALDI trademark, such likelihood arising as to the source, sponsorship, affiliation, or endorsement of the website of the Respondent. Even on the chance that a consumer perceives something amiss before taking any action in relation to the disputed domain names, the distinctive character and reputation of the Complainants and their trademarks are harmed by association in any event. In all the circumstances, there is a detrimental impact on the reputation and professional activities of the Complainants. Further, there is the distinct possibility that the disputed domain names were registered in order that the Respondent might offer the same for sale to either the Complainants (or their competitors) at a price higher than the cost of registration and in the hope that the parties bid against each other to secure the disputed domain names.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Complainants submitted evidence, which clearly establishes rights in the mark ALDI.

In the present case, the disputed domain names <aldiskunk.com> and <aldiweed.com> are confusingly similar to the Complainants' registered trademark ALDI since they include the Complainants' trademark in its entirety and only add the terms "skunk" and "weed".

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) or omission of letters or hyphens will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

This is the case at present: The trademark ALDI is clearly and easily recognizable in the disputed domain names.

Finally, it has also long been held that generic Top-Level-Domains are generally disregarded when evaluating the confusing similarity of a disputed domain name.

Therefore, the Panel finds that the Complainants has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)).

In this regard, the fact that the disputed domain names contain the Complainants' trademark ALDI in a confusingly similar form without resolving to an active website, the Complainants' contentions that the Respondent has no rights or legitimate interests in the disputed domain names, the fact that the Respondent has no connection or affiliation with the Complainants, and that the Respondent has not received any license or consent, express or implied, to use the Complainants' trademark in a domain name or in any other manner, as well as the Respondent not having rebutted these allegations, lead the Panel to the conclusion that the Complainants have made out an undisputed *prima facie* case so that the conditions set out in paragraph 4(a)(ii) of the Policy have been met by the Complainants.

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (e.g., *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainants must show that:

- the disputed domain names were registered by the Respondent in bad faith; and
- the disputed domain names are being used by the Respondent in bad faith.

(i) The Complainants have rights in the well known and highly distinctive registered trademark ALDI, which is registered and used in many jurisdictions around the world long before the registration of the disputed domain names. Moreover, the Complainants maintain a strong Internet presence e.g., in United Kingdom under the domain name <aldi.co.uk> and the mark ALDI is well known in United Kingdom (where the Respondent is located) and beyond.

Therefore, it is inconceivable for this Panel that the Respondent registered and holds the disputed domain names without knowledge of the Complainants' rights, which leads to the necessary inference of bad faith.

This finding is supported by the fact that the disputed domain names incorporate the Complainants' distinctive trademark ALDI entirely and that the ALDI mark is used intensively for decades.

(ii) Although there is no evidence that the disputed domain names are being actively used – they only refer to a website which states that the disputed domain names are not available for registration – previous UDRP panels have found that bad faith use under paragraph 4(a)(iii) does not necessarily require a positive act on the part of the respondent – inaction is within the concept of paragraph 4(a)(iii) (see especially *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#)).

This Panel also concludes that the present passive holding of the disputed domain names, constitutes bad faith for the purposes of the requirement under paragraph 4(a)(iii), putting emphasis on the following:

- the Complainants' trademark ALDI is distinctive and in use globally with a strong Internet presence – ALDI is a well known trademark;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain names, without providing any plausible reason for good faith use with regard to the disputed domain names; and
- the disputed domain names incorporate the Complainants' trademark in its entirety, and is thus suited to divert or mislead potential Internet users from the website they are actually trying to visit (the Complainants' site).

Taking all these facts and evidence into consideration, this Panel finds that the disputed domain names have been registered and are being used in bad faith under paragraph 4(a)(iii) of the Policy.

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 names <aldiskunk.com> and <aldiweed.com> be transferred to the Second Complainant, Aldi Stores Limited.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: April 12, 2023