

ADMINISTRATIVE PANEL DECISION

Aldi GmbH & Co. KG, Aldi Stores Limited v. Rod Pennington
Case No. D2024-0899

1. The Parties

The Complainants are Aldi GmbH & Co. KG, Germany (the “Complainant 1”) and Aldi Stores Limited (the “Complainant 2”), United Kingdom, represented by Freeths LLP, United Kingdom.

The Respondent is Rod Pennington, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <realaldi.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 29, 2024. On February 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 29, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on March 4, 2024, 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 March 6, 2024.

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”).

On March 4, 2024, the Center informed the Parties that the Domain Name had expired on February 5, 2024. Moreover, the Center transmitted the communication received from the Registrar indicating the necessary actions to be taken upon the conclusion of the present dispute.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 8, 2024. In accordance with the Rules, paragraph 5,

the due date for Response was March 28, 2024. The Respondent sent an email communication to the Center on March 8, 2024. The Center informed the Parties of the commencement of Panel appointment process on April 5, 2024.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on April 12, 2024. 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 Complainants operate a discount supermarket chain with more than 5,000 stores across the world.

The Complainant 1 is the owner of numerous ALDI trademark registrations, including:

- the United Kingdom Trademark Registration for ALDI (word) No. UK00002250300, registered on March 30, 2001;
- the European Union Trademark Registration for ALDI (word) No. 002071728, registered on April 14, 2005; and
- the European Union Trademark Registration for ALDI (word) No. 002714459, registered on September 5, 2003.

The Complainants are also the owners of the domain names incorporating the ALDI trademark, including <aldi.co.uk>.

The Domain Name was registered on February 5, 2023.
The Domain Name does not resolve to any active website.

5. Parties' Contentions

A. Complainant

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the Domain Name.

First, the Complainants submit that the Domain Name is confusingly similar to the trademark in which the Complainants have rights.

Second, the Complainants argue that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainants contend that the Domain Name was registered and is being used in bad faith.

B. Respondent

The Respondent sent an email communication to the Center on March 8, 2024, stating that "this domain is for sale".

The Respondent did not reply to the Complainants' contentions submitted in the present dispute.

6. Discussion and Findings

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

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

The requested remedy may only be granted if the above criteria are met. At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

A. Identical or Confusingly Similar

Under the first element, the Complainants must establish that the Domain Name is identical or confusingly similar to the trademark in which the Complainants have rights.

The Complainant 1 holds valid ALDI trademark registrations. The Domain Name incorporates this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to that trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of the term “real” in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainants’ ALDI trademark. Panels have consistently held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See section 1.8 of the [WIPO Overview 3.0](#).

The Top-Level Domain “.com” in the Domain Name is viewed as a standard registration requirement and as such is typically disregarded under the first element test. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainants’ ALDI trademark for purposes of the Policy. Thus, the Complainants have satisfied the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element, the Complainants must prove that the Respondent has no rights or legitimate interests in the Domain Name.

The Respondent may establish rights or legitimate interests in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made 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 prior to the dispute; or
- (ii) that it is commonly known by the Domain Name, even if it has not acquired any trademark rights; or
- (iii) that it is making a legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence on record that the Complainants' ALDI trademark registrations predate the Respondent's registration of the Domain Name. There is no evidence in the case record that the Complainants have licensed or otherwise permitted the Respondent to use the ALDI trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it results from the evidence on record that the Respondent does not make use of the Domain Name in connection with a bona fide offering of goods or services, nor does it make a legitimate noncommercial or fair use of the Domain Name. On the contrary, it does not result from the case evidence that the Domain Name has been used in any other active way to date.

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainant's prima facie case. The Panel concludes that the Complainant has also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under the third element, the Complainants must prove that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1 of the [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainants' rights in the ALDI trademark predate the registration of the Domain Name. The Panel finds that the Respondent was or should have been aware of the Complainants' trademark at the time of registration, as it has been proven to the Panel's satisfaction that the Complainant's ALDI trademark is well known and unique to the Complainant. Thus, the Respondent could not ignore the reputation of goods and services under this trademark. Furthermore, the Panel notes from previous decisions under the Policy that the Complainants (and other companies of its group of companies) operate thousands of supermarkets in different jurisdictions, including in the United States, where the Respondent is purportedly located (see *Aldi Stores Limited, Aldi GmbH & Co. KG v. Jeancharles Rollin, Ecoclav Inc.*, WIPO Case No. [D2016-0677](#) "Complainants 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”, and *ALDI GmbH & Co. KG v. bestview GmbH netsolutions*, WIPO Case No. [D2011-1383](#) “[t]he reputation of the [ALDI] mark is not limited to one country but is widespread in Europe and also in the US and in Australia”).

In sum, the Respondent in all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the Complainants’ ALDI trademark.

Considering the overall circumstances of this case, the Panel finds that the Respondent’s passive holding of the Domain Name does not prevent a finding of bad faith. As numerous UDRP panels have held, passive holding, under the totality of circumstances of the case, would not prevent a finding of bad faith under the Policy. See section 3.3 of the [WIPO Overview 3.0](#). Here, given the well-known nature of the Complainants’ ALDI trademark, the composition of the Domain Name, and the lack of any reason for the registration of the Domain Name beyond the Respondent’s statement that the Domain Name “is for sale”, the Panel finds that the passive holding of the Domain Name does not prevent a finding of bad faith.

For the reasons discussed above, the Panel finds that the Complainant has satisfied the requirements 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 Domain Name <realaldi.com> be transferred to the Complainant 2.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: May 1, 2024