

ADMINISTRATIVE PANEL DECISION

Barilla G. e R. Fratelli S.p.A. v. Alexandr Chernishev
Case No. D2024-2499

1. The Parties

The Complainant is Barilla G. e R. Fratelli S.p.A., Italy, represented by Studio Barbero S.p.A., Italy.

The Respondent is Alexandr Chernishev, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <barillastore.shop> (the "Domain Name") is registered with Registrar of Domain Names REG.RU LLC (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on June 19, 2024. On June 19, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 21, 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 (Domain Admin, Privacy Protection Service INC d/b/a, PrivacyProtect.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 24, 2024 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 June 26, 2024.

On June 24, 2024, the Center informed the parties in English and Russian that the language of the registration agreement for the Domain Name is Russian. On June 26, 2024, the Complainant confirmed its request that English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in English and Russian of the Complaint, and the proceedings commenced on July 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 24, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 26, 2024.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on August 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 Complainant produces oven-baked products, pasta, and ready-made sauces. It was established in 1877. Currently, the Complainant operates directly in 28 countries, exports its products to over 100 countries and owns 30 production sites across 11 countries.

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

- the International Trademark Registration for BARILLA (figurative) No. 349555, registered on September 26, 1968;
- the International Trademark Registration for BARILLA (figurative) No. 517379, registered on December 2, 1987; and
- the International Trademark Registration for BARILLA (word) No. 1077405, registered on April 7, 2011, designating, inter alia, Russian Federation.

The Complainant is also the owner of numerous domain names incorporating its BARILLA trademark, such as the domain name <barilla.com>.

The Domain Name was registered on April 23, 2024.

According to the screenshots presented in the Complaint, as of April 24, 2024, the Domain Name resolved to a website featuring the Complainant's BARILLA trademark and inviting the Internet users to fill in an online survey with the personal information in order to allegedly obtain a free sample package of the Complainant's products (the "Website").

On May 21, 2024, the Complainant sent a cease-and-desist letter to the registrant of the Domain Name, as well as to the email address displayed at the footer of the Website. The Complainant sent a reminder on May 28, 2024.

On May 22, 2024, the Complainant received a reply from the email address displayed at the Website denying any involvement in the registration of the Domain Name. After the Complainant's subsequent reply, no further communication was received.

On May 24, 2024, the Complainant also sent a cease-and-desist letter to the hosting provider of the Website seeking its deactivation. The Complainant sent a reminder on May 28, 2024. On June 18, 2024, the Complainant received an email from the hosting provider indicating that the Domain Name was no longer pointed to an active website.

At the time of submitting the Complaint, the Domain Name did not resolve to any active website. As of the date of this Decision, the Domain Name also does not resolve to any active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

First, the Complainant contends that the Domain Name is confusingly similar to the trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

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

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Matters – Language of the Proceeding

The language of the Registration Agreement for the Domain Name is Russian. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons. First, the Complainant submits that it does not communicate in Russian. Thus, the Complainant would be prejudiced should it be required to translate the Complaint and participate in these proceedings in Russian. Second, the Complainant notes that the Domain Name consists of Latin characters and includes the English terms "store" and "shop". Third, the Complainant alleges that the Website displayed content in German and not in Russian. Fourth, the Complainant points out that the Website mentioned a British company Bluereen Media Ltd as its operator. Fifth, according to the Complainant, the Respondent registered the Domain Name using the generic Top-Level Domain ("gTLD") ".shop", which reveals the Respondent's intention to target an international audience. Sixth, the Complainant submits that it is not in possession of any evidence demonstrating that the Respondent cannot communicate in English. Seventh, the Complainant explains that it attempted to resolve this dispute by sending to the Respondent a cease-and-desist letter and a subsequent reminder in English language. No reply was received to this letter sent to the Registrant's email address. However, the Complainant received an email communication in English language from the company Bluereen Media Ltd mentioned on the Website as its operator. The Complainant exchanged with this company subsequent correspondence in English. Finally, the Complainant submits that requiring the Complainant to translate the Complaint and the annexes into Russian would delay the proceeding.

The Respondent did not comment on the Complainant's request for the language of the proceeding be English.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs. See section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

The Panel finds that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into Russian. Moreover, the Panel notes that the Respondent did not comment or let alone object to the Complainant's arguments concerning the language of the proceeding.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2. Substantive Matters – Three Elements

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 Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the Domain Name; and
- (iii) 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 3.0](#).

A. Identical or Confusingly Similar

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

The Complainant holds valid BARILLA trademark registrations. The Domain Names incorporate 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 “store” in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainant's BARILLA 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 gTLD “.shop” in the Domain Names 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](#).

In sum, the first element of the Policy has been established.

B. Rights or Legitimate Interests

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

The Respondent may establish a right or legitimate interest 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 Complainant's BARILLA trademark registration predates the Respondent's registration of the Domain Name. There is no evidence in the case record that the Complainant has licensed or otherwise permitted the Respondent to use the BARILLA 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, the Domain Name resolved previously to the Website prominently featuring the Complainant's BARILLA trademark and product images and inviting Internet users to fill in an online survey with their personal information in order to allegedly obtain a free sample package of the Complainant's products. Such use of the Domain Name does not confer rights or legitimate interests on the Respondent as the Website effectively suggests sponsorship or endorsement by the Complainant.

Also, the Panel finds that the composition of the disputed domain name (the addition of the term "store" after the Complainant's trademark) carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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 second element of the Policy has been established.

C. Registered and Used in Bad Faith

Under the third element, the Complainant 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 it is 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 Complainant's rights in the BARILLA trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration of the Domain Name. This finding is supported by the content of the Respondent's Website displaying this trademark and referring to the Complainant's products. Moreover, it has been proven to the Panel's satisfaction that the Complainant's BARILLA trademark is well known and unique to the Complainant. Thus, the Respondent could not reasonably have been unaware of the reputation of goods under this trademark. In sum, the Respondent in all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the Complainant's BARILLA trademark.

Furthermore, as previously noted, the Domain Name was used in bad faith by the Respondent to resolve to the Respondent's Website prominently displaying the Complainant's trademark and product images and inviting Internet users to fill in an online survey with the personal information in order to allegedly obtain a free sample package of the Complainant's products. The Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to this Website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Website.

The relationship between the Respondent and the Complainant (or a lack thereof) is not disclosed on the Website in a clear and sufficiently prominent manner. This further perpetuates the false impression of a relationship between the Respondent and the Complainant. While a clear and sufficiently prominent disclaimer could lend support to circumstances suggesting the Respondents' good faith, where the overall circumstances of a case point to the Respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith. Rather, panels have held that in such cases a respondent's use of a disclaimer could be considered as an admission by the respondent that users may be confused. See section 3.7 of the [WIPO Overview 3.0](#).

In the present case, the Respondent's Website contains the disclaimer stating that "this is a competition of Bluereen Media LTD. The brand depicted is neither the Bluereen organizer nor sponsor of this competition and has no business relationship with Media LTD. Bluereen Media Ltd". In the Panel's view, such disclaimer cannot be considered clear and sufficiently prominent. The overall impression of the Website effectively suggests sponsorship or endorsement by the Complainant.

As of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Name has not resolved to any active website. Considering the overall circumstances of this case, the Panel finds that the Respondent's current 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 Complainant's BARILLA trademark, the Respondent's failure to file a Response, and the previous use of the Domain Name, the Panel agrees with the above.

Finally, in the circumstances of the case, the Respondent's attempt to conceal its identity using a privacy protection service constitutes an additional indication of the Respondent's bad faith.

For the reasons discussed above, the Panel finds that the third element of the Policy has been established.

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 <barillastore.shop> be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: August 27, 2024