

ADMINISTRATIVE PANEL DECISION

Ferrero S.p.A. v. Mucahid Ungur
Case No. D2022-4672

1. The Parties

The Complainant is Ferrero S.p.A., Italy, represented by Studio Barbero, Italy.

The Respondent is Mucahid Ungur, Türkiye.

2. The Domain Names and Registrar

The disputed domain names <nutellago.com>, <nutellago.xyz>, <nutellahouse.com>, <nutellahouse.xyz>, <nutellahome.com>, <nutellahome.xyz> are registered with Nics Telekomunikasyon A.S. (the “Registrar”).

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 6, 2022. On December 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 8, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center sent an email communication in English and Turkish to the parties on December 9, 2022, regarding the language of the proceeding, as the Complaint has been submitted in English and the language of the registration agreement for the disputed domain names is Turkish. The Complainant sent an email to the Center requesting English to be the language of the proceeding on December 9, 2022. The Respondent did not comment on the language of the proceeding.

The Center verified that 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 December 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 6, 2023.

The Center appointed Emre Kerim Yardimci as the sole panelist in this matter on January 13, 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 Complainant is a chocolate producer and confectionery company.

Founded in 1946, the Complainant promotes and sells its products worldwide in over 160 countries. The entire group includes 38 operative companies, 18 production plants, over 36.000 employees and produces around 365.000 tons of Nutella each year.

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

- Italian trademark registration No. 302013902195326 filed on October 2, 2013 and registered on November 26, 2013, in class 30, last renewal of the trademark originally filed on March 28, 1983 and registered on April 14, 1985 with number 418059,
- - European Union Trade Mark registration No. 009316878 filed on August 16, 2010 and registered on January 27, 2011, in class 30,
- - International trademark registration No. 281788 registered on March 31, 1964, in classes 29 and 30,
- - International trademark registration No. 1073241 registered on January 27, 2011, in classes 16, 29, 30, 32, 33, 35, 41 and 43, designating, amongst others, Türkiye,
- - International trademark registration No. 1357583 registered on November 4, 2016 in classes 3, 5, 7, 8, 9, 11, 12, 14, 15, 16, 18, 20, 21, 24, 25, 26, 27, 28, 31, 34, 38, 39 and 43, designating, amongst others, Türkiye,
- - International Trademark Registration No. 1191051 registered on November 18, 2013, in classes 29 and 30, designating, amongst others, Türkiye.

The Complainant operates *inter alia* the website “www.nutella.com”.

The disputed domain names were all registered by the Respondent on May 21, 2022. At the time of the filing of the Complaint, all of the disputed domain names resolve to parking pages. Before filing the Complaint and in reply to a cease and desist letter sent by the Complainant, the Respondent requested USD 100.000 for the transfer of the disputed domain names to the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the disputed domain names are confusingly similar, and at the same time, incorporating the Complainant's well-known trademark NUTELLA and that the addition of the non-distinctive words “go”, “home” or “hause” (a misspelled version of the term “house”) does not affect the confusing similarity.

The Complainant considers that the Respondent has no rights or legitimate interests in respect of the disputed domain names, mainly because the Complainant has neither licensed nor otherwise authorized the

Respondent to use its marks. The Complainant further asserts that the Respondent is not using the disputed domain names for a *bona fide* offering of goods and services.

Finally, in addressing the question of registration and use of the disputed domain names in bad faith, the Complainant observes that the Respondent is well aware of the Complainant's trademark considering their trademark is so widely well-known that it is inconceivable that the Respondent ignored the Complainant or its earlier rights and that the Respondent requested USD 100,000 for the transfer of the disputed domain names to the Complainant, and such amount is in excess of out-of-pocket costs directly related to the disputed domain names.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (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 interest in respect of the disputed domain name; and
- (iii) The disputed domain name has been registered in bad faith and is being used in bad faith.

Paragraph 11(a) of the Rules provides that unless otherwise agreed by the parties or specified otherwise in the registration agreement between the respondent and the registrar in relation to the disputed domain names, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances.

The Complainant submitted its Complaint in English. According to the information received from the Registrar, the language of the registration agreement for the disputed domain names is Turkish. On December 9, 2022, the Complainant requested that the language of the proceeding should be English.

The Complainant contends that: (a) the Complainant would be disadvantaged by proceeding in the language of the registration agreement; (b) the Complainant would be prejudiced by undue expense, delay, or complication; (c) the Respondent is able to communicate in English; and (d) the disputed domain names consist of a combination of the Complainant's trademark NUTELLA with the English terms "go" and "home", as well as with the term "hause", which is a clear misspelling of the English term "house".

The Panel accepts the Complainant's submissions regarding the language of the proceeding. The Panel notes that the Center notified the Parties in Turkish and English of the language of the proceeding as well as notified the Respondent in Turkish and English of the Complaint. The Respondent chose not to comment on the language of the proceeding nor did the Respondent choose to file a Response. Therefore, having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain names are confusingly similar for the purpose of the Policy to the Complainant's trademark NUTELLA.

The disputed domain names wholly incorporate the Complainant's trademark and the terms "home", "go" or "hause" do not prevent a finding of confusing similarity. See WIPO Overview of WIPO Panel Views on

Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

As regards the generic Top-Level Domain, it is typically disregarded under the confusing similarity test.

For the reasons mentioned above, the Panel finds that the disputed domain names are confusingly similar to the Complainant's NUTELLA trademark. The Complainant has thus fulfilled paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The onus is upon the Complainant to make out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names, and it is then for the Respondent to rebut this case.

The Panel accepts the Complainant's submissions that the Respondent does not appear to have been known by the disputed domain names, has not made demonstrable preparations to use the disputed domain names and the Respondent is not making a legitimate noncommercial use of the disputed domain names.

The Respondent has not filed a Response.

It has no consent from the Complainant to register any domain name incorporating the Complainant's trademark, it has not used the disputed domain names for a *bona fide* offering of goods or services given the confusing use, as discussed below, and it is not commonly known by the disputed domain names, nor is it making noncommercial fair use of the disputed domain names.

In the Panel's view the Complainant has made out their *prima facie* case under this element of the Policy and the Respondent, who is in default, has failed to rebut this case.

In the circumstances of this case, and in view of the Panel's discussion below, the Panel finds that the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel accepts the Complainant's assertions that the trademark NUTELLA is a well-known trademark.

The incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so may be, in and of itself, an indication of bad faith (*Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#); *General Electric Company v. CPIC NET and Hussain Syed*, WIPO Case No. [D2001-0087](#); *Microsoft Corporation v. Montrose Corporation*, WIPO Case No. [D2000-1568](#)). See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 3.1.4.

The Respondent has registered the disputed domain names but has not put it to any material use other than resolving to a parking page.

The exchange of correspondence with the Respondent following the serving of the Complainant's cease and desist letter clearly shows in the Panel's view that the Respondent has the intention to have the disputed domain names registered primarily for the purpose of selling it to the right owner for valuable consideration exceeding out-of-pocket expenses. The fact that the Respondent did not approach the Complainant first does not change this evaluation, since the Respondent did not specify his own alleged business intentions but offered to sell the disputed domain names for apparently more than out-of-pocket expenses by requesting USD 100,000.

From the above behavior of the Respondent, the Panel concludes, without any doubt, that the Respondent has registered the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring the disputed domain names to the Complainant or to a competitor of the Complainant, for

valuable consideration presumably in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain names.

Therefore, in the view of these circumstances, the Panel finds that the requirement of registration and use in bad faith is satisfied, according to the Policy, paragraph 4(b)(i) and 4(a)(iii).

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, <nutellago.com>, <nutellago.xyz>, <nutellahause.com>, <nutellahause.xyz>, <nutellahome.com>, <nutellahome.xyz> be transferred to the Complainant.

/Emre Kerim Yardimci/

Emre Kerim Yardimci

Sole Panelist

Date: January 30, 2023