

ADMINISTRATIVE PANEL DECISION

Barilla G. e R. Fratelli S.p.A. v. hakki kazan
Case No. D2023-0003

1. The Parties

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

The Respondent is hakki kazan, Türkiye.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 2, 2023. On January 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 4, 2023, 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 Complainant on January 5, 2023, 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 January 5, 2023, naming the underlying registrant (hakki kazan) as the Respondent.

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 January 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 10, 2023.

The Center appointed Tony Willoughby as the sole panelist in this matter on February 21, 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 producer of oven-baked products, pasta, and other food products which it markets under the trade marks BARILLA and BARILLA FROZEN. The business was founded in 1877 in Parma, Italy by Pietro Barilla. Over the ensuing 146 years, the business has developed into a multi-national conglomerate incorporating a number of other brands and operating under the name “Barilla Group”. The Barilla Group employs 8,600 people and in 2020 had net sales of approximately 3,890 billion euros.

The Complainant is the registered proprietor of various trade mark registrations covering the BARILLA and BARILLA FROZEN trade marks including by way of example the following registrations:

International Trademark Registration No. 1077405 BARILLA (word) registered on April 7, 2011, for numerous goods and services in classes 29, 30, 31, 32, 33, 35, 41, 42, and 43. This registration covers Türkiye, the home jurisdiction of the Respondent, on the assumption that the address provided to the Registrar by the Respondent on registration of the Domain Name is accurate.

United States Trademark Registration No. 6814779 BARILLA FROZEN (standard character mark with “FROZEN” disclaimed) registered on August 9, 2022 (application filed on July 28, 2021) for pasta and other food products in class 30.

The Complainant operates its primary website at “www.barilla.com”, which features a Turkish language section. Noting that the Respondent claims to be resident in Istanbul, Türkiye, the Complainant has produced evidence to demonstrate that the Barilla Group has a production plant in Türkiye and an associate company (Barilla Gıda AS) based in Istanbul.

The Domain Name was registered on August 1, 2021, and is connected to a parking page hosted by dan.com, a GoDaddy Brand. The page features a notice stating that the Domain Name is for sale at a price of USD 4,995. On December 22, 2021, the Domain Name was connected to a parking page hosted by sedo.com indicating that the Domain Name was for sale at a price of USD 988.

On February 9, 2022, the Complainant’s representative emailed the Registrar a cease and desist letter drawing the Registrar’s attention to the Complainant’s trade mark rights and seeking *inter alia* transfer of the Domain Name. In the absence of a reply, the Complainant’s representative followed up with a “chaser” on June 6, 2022, but again without receiving a reply.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the Domain Name is identical or confusingly similar to the Complainant’s BARILLA and BARILLA FROZEN registered trade marks; that the Respondent has no rights or legitimate interests in respect of the Domain Name; and that the Domain Name has been registered and is being used in bad faith.

The essence of the Complainant's case is that the Respondent registered the Domain Name with full knowledge of the existence of the Complainant's trade marks and did so with a view to selling the Domain Name to the Complainant at a profit and/or using the Domain Name for fraudulent emails.

B. Respondent

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

6. Discussion and Findings

A. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

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

B. Identical or Confusingly Similar

The Domain Name comprises the name "barilla" followed by the word "frozen" and the ".com" generic Top-Level Domain identifier.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") explains the test for identity or confusing similarity under the first element of the Policy and includes the following passage:

"While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The trade marks upon which the Complainant relies are BARILLA and BARILLA FROZEN. The Complainant's trade marks are readily recognisable in the Domain Name. The Panel finds that the Domain Name is identical or confusingly similar to the said trade marks in which the Complainant has rights.

C. Rights or Legitimate Interests

The Complainant asserts that it has no connection with the Respondent and has granted the Respondent no permission to use its BARILLA trade mark. It contends on the basis of the fame of the BARILLA trade mark that the Respondent registered the Domain Name with knowledge of the Complainant's trade marks and intending to target the Complainant.

The Complainant refers to the circumstances set out in paragraph 4(c) of the Policy, any of which, if found by the Panel to be present, shall demonstrate rights or legitimate interests for the purposes of this element of the Policy, and contends that none of them is applicable. The Complainant contends that the parking pages to

which the Domain Name has been connected demonstrate that one of the Respondent's primary purposes in registering the Domain Name was to sell it at a profit (paragraph 4(b)(i) of the Policy), a bad faith purpose that cannot constitute a *bona fide* offering of goods and services for the purposes of paragraph 4(c)(i) of the Policy. Further, neither the Respondent's name nor the Respondent's uses of the Domain Name give any indication as to how the Respondent could claim to be commonly known by the Domain Name (paragraph 4(b)(ii) of the Policy). Finally, nothing about the use of the Domain Name can constitute a legitimate noncommercial or fair use of the Domain Name (paragraph 4(c)(iii) of the Policy).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name.

The Panel finds that the Complainant has made out a *prima facie* case under this element of the Policy; in other words, a case calling for an answer from the Respondent. On the evidence before the Panel, the Panel can conceive of no basis upon which the Respondent could be said to have rights or legitimate interests in respect of the Domain Name. Moreover, given that the Domain Name is identical to the Complainant's BARILLA FROZEN trade mark, the Panel finds that the Domain Name carries a high risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

In the absence of any response to the Complainant's contentions, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

D. Registered and Used in Bad Faith

For the reasons set out above, the Panel is satisfied on the evidence that the Respondent registered the Domain Name with knowledge of the Complainant's BARILLA and BARILLA FROZEN trade marks and with the primary intention of attracting offers from the Complainant to purchase it at a price in excess of the Respondent's documented out-of-pocket costs directly related to the Domain Name.

The Panel finds that the Domain Name has been registered and is being used in bad faith within the meaning of paragraphs 4(a)(iii) and 4(b)(i) of the Policy.

The Panel notes that the Complainant filed evidence to show that the Domain Name is configured to be used for email and contends that that is an additional basis for complaint (paragraph 4(b)(iv) of the Policy) irrespective of whether or not the Domain Name has been used for email purposes. The case cited in support of that proposition, *bioMérieux v. Registration Private, Domains By Proxy, LLC / Milton Bardmess*, WIPO Case No. [D2020-3499](#) ("bioMérieux") was a case in which no active use had been made off the domain name in dispute, leaving speculation as to the respondent's precise intentions in respect of the disputed domain name.

In this case there is no need for any speculation. The use to which the Domain Name has been put has left the Panel in no doubt as to the Respondent's primary purpose behind the registration, namely to sell it at a profit to the Complainant or a competitor of the Complainant. That said, the Panel agrees with the panel in *bioMérieux* that in configuring the Domain Name for email the Respondent has given himself the ability to impersonate the Complainant and thereby use the Domain Name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. Whether that configuration was an active step taken by the Respondent or an automated step at the Registrar's end, of which the Respondent was unaware, the Panel does not know. There is no need for the Panel to speculate.

Additionally, the Panel notes that the Complainant filed evidence to show that the Domain Name was previously used in connection with a website displaying sponsored pay-per-click links. Such use further reinforces the Panel's finding that the Respondent has sought commercial gain from the registration and use of the Domain

Name that incorporates the Complainant's BARILLA and BARILLA FROZEN trade marks.

For completeness, the Panel adds that while the Domain Name was registered only four days after the Complainant's United States Trade Mark application was filed for the BARILLA FROZEN trade mark (see section 4 above), and while the evidence does not inform the Panel as to when that trade mark was first used, the Panel is satisfied on the balance of probabilities that when registering the Domain Name the Respondent would have been aware of the Complainant's use of "Barilla frozen" as a trade mark. Even if the Panel is wrong on that, the decision holds good on the basis of the BARILLA trade mark, which would have been well-known to the Respondent in Türkiye, as contended for by the Complainant, a contention which the Respondent has not challenged.

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, <barillafrozen.com>, be transferred to the Complainant.

/Tony Willoughby/

Tony Willoughby

Sole Panelist

Date: March 6, 2023