

## **ADMINISTRATIVE PANEL DECISION**

### **Aldi GmbH & Co. KG, Aldi Stores Limited v. Domain Administrator Case No. D2023-0121**

#### **1. The Parties**

The Complainants are Aldi GmbH & Co. KG, Germany and Aldi Stores Limited, United Kingdom, represented by Freeths LLP, United Kingdom.

The Respondent is Domain Administrator, Nigeria.

#### **2. The Domain Name and Registrar**

The disputed domain name <aldibeneficts.com> is registered with Sav.com, LLC (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 10, 2023. On January 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 11, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Privacy Protection) and contact information in the Complaint. The Center sent an email communication to the Complainants on January 12, 2023 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 January 13, 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 January 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 7, 2023. Apart from auto messages stating “Our office is closed for a short time while we are on holiday. We will get back to you as soon as we can but there could be a delay. Please be patient with us”, the Respondent did not submit any response. Accordingly, the Commencement of Panel Appointment Process was sent on February 14, 2023.

The Center appointed Halvor Manshaus as the sole panelist in this matter on March 7, 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 Complainants are part of the same corporate group.

The Complainants operate in the supermarket field and has more than 5,000 stores across the world. Further, the Complainants are active in Australia, Austria, Belgium, Denmark, France, Germany, Ireland, Luxembourg, the Netherlands, Poland, Portugal, Slovenia, Spain, Switzerland, and the United States.

The Complainant Aldi GmbH & Co. KG owns and Aldi Stores Limited is the exclusive licensee in the United Kingdom of several trademark registrations in both the United Kingdom and the European Union for ALDI, including the following:

The United Kingdom registration no. UK00002250300, registered on March 30, 2001, for various goods and services in classes 1, 3, 5, 6, 11, 16, 21, 24, 25, 29, 30, 31, 32, 33, 34, and 35.

The United Kingdom registration no. UK00902071728, registered on April 14, 2005, for various goods and services in classes 3, 4, 7, 9, 16, 24, 25, 29, 30, 31, 32, 33, 34, and 36.

The European Union registration no. EU002071728, registered on April 14, 2005, for various goods and services in classes 3, 4, 7, 9, 16, 24, 25, 29, 30, 31, 32, 33, 34, and 36.

The Complainant Aldi Stores Limited owns the domain name <aldi.co.uk>, where Internet users can find the Complainant's main website.

The disputed domain name <aldibeneficts.com> was registered on May 5, 2022. As of the date of this decision, the disputed domain name resolves to a blank website with no content.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainants request that the disputed domain name be transferred to the Complainant. The Complainant's arguments can be summarized as follows:

The Complainants state that the disputed domain name is confusingly similar to the Complainant's trademark as it incorporates the ALDI trademark together with the word "beneficts". According to the Complainants, the addition of the word "beneficts" is likely read by Internet users as "benefits" which can create confusion among Internet users as it suggests that the disputed domain name hosts a webpage relating to the goods and services sold by the Complainants.

The Complainants argue that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainants submit that the Respondent has not received a license or authorization to use the ALDI trademark. Furthermore, as far as the Complainants are aware, the Respondent has not used the domain name in connection with a *bona fide* offering of goods or services, been commonly known for the domain name, or made any legitimate noncommercial or fair use of the disputed domain name.

The Complainants contend that the disputed domain name was registered and is being used in bad faith. The Complainants submit that Internet users will be confused into believing that the disputed domain name

is associated with the Complainants and that the Respondent takes unfair advantage of the Complainants' rights. Furthermore, the Complainants argue that the disputed domain name has been or is planned to be intentionally, used to attract Internet users to websites by creating a likelihood of confusion with the ALDI mark for commercial gain. The Complainants hold that the disputed domain name harms the distinctive character and the reputation of the ALDI trademark and impact the reputation and professional activities of the Complainants. Lastly, the Complainants hold that there is a distinct possibility that the Respondent registered the disputed domain name to offer it for sale to the Complainants at a higher price than the cost of registration.

## **B. Respondent**

The Respondent did not reply to the Complainants' contentions.

## **6. Discussion and Findings**

The Complainants have, in accordance with paragraph 4(a) of the Policy, requested that the disputed domain name be transferred to the Complainant.

In accordance with paragraph 4(a) of the Policy, in order to succeed in this proceeding and have the disputed domain name transferred, the Complainants must establish that the three following elements are satisfied for the disputed domain name:

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

Pursuant to paragraph 15(a) of the Rules, the Panel shall decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable. Furthermore, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

On the basis of the evidence submitted by the Complainants and, in particular, with regards to the content of the relevant provisions of the Policy (paragraph 4(a), (b), and (c)), the Panel concludes as follows:

### **A. Identical or Confusingly Similar**

For the Complainants to succeed under the first element of paragraph 4(a) of the Policy, the Complainants must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants has rights.

Considering the evidence submitted by the Complainants, the Panel finds that the Complainants indisputably holds numerous trademark registrations of ALDI, combined with words such as "talk" and "mobile". Based on the evidence submitted by the Complainants, describing the Complainants' trademark registrations and associated business, the Panel finds that the Complainants own rights to the trademark ALDI in several jurisdictions and that the ALDI mark is vested with significant goodwill.

The disputed domain name comprises the Complainants' trademark together with the word "beneficts" (a misspelling of the word "benefits") and the generic Top-Level Domain ("gTLD") ".com". As held in *Hoffmann-La Roche Inc. v. Andrew Miller*, WIPO Case No. [D2008-1345](#), it is well established that the gTLD part of a domain name may be disregarded when assessing whether the disputed domain name is confusingly similar to a complainant's trademark.

Furthermore, the Panel finds that the mere addition of the word “beneficts” does not avoid a finding that the disputed domain name is confusingly similar to the Complainants’ ALDI trademark. As held in *Sodexo v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2021-0472](#), adding other terms (whether descriptive, pejorative, meaningless or otherwise) to trademarks does not prevent a finding of confusing similarity. Further, it has been held in numerous cases that a domain name that wholly incorporates a complainant’s registered mark may be sufficient to establish confusing similarity.

The Panel therefore concludes that the Complainants have satisfied the requirements under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, the Complainants must establish a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. As held by the Panel in *Tick etmaster Corporation v. Global Access*, WIPO Case No. [D2007-1921](#), the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name when such *prima facie* case is made out.

In the Panel’s view, the presented evidence referred to by the Complainants is sufficient to establish *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The disputed domain name resolves to a blank website with no content, which neither, constitutes genuine use of a domain name nor a *bona fide* offering of goods and services.

Furthermore, the Respondent has not replied to the Complainant’s contentions, and the Panel has not been presented with, or otherwise discovered, any evidence showing (i) that the Respondent has received a license or other permission to use the Complainants’ trademark or any domain name incorporating or simulating this mark; (ii) that the Respondent is commonly known by the disputed domain name; (iii) that the Respondent has acquired trademark or service mark rights to use the disputed domain name; or (iv) that the Respondent is making legitimate noncommercial or fair use of the disputed domain name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the Complainants have satisfied the requirements under paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

In order to prevail under the third element of paragraph 4(a) of the Policy, the Complainants must demonstrate that the disputed domain name has been registered and is being used in bad faith.

The Complainants’ registration of the ALDI trademark predicates the registration date of the disputed domain name by at least 20 years. Furthermore, the Complainants have credibly shown that the ALDI mark is widely known within its sector and that significant goodwill is vested in it. The Panel therefore finds it unlikely that the Respondent was unaware of the Complainants’ rights to the ALDI trademark at the time of the registration of the disputed domain name. In any case, the Panel finds that the Respondent had or should have knowledge of the Complainants’ registration of the trademark.

In light of the evidence presented by the Complainant, the Panel finds that the ALDI trademark and the Complainants’ activities are well-known in Europe and other parts of the world. Furthermore, the disputed domain name does not resolve to an active website as of the date of this decision. However, as held in *LEGO Juris A/S v. Djuradj Caranovic*, WIPO Case No. [D2021-2641](#), the lack of so-called active use of the disputed domain name does not prevent a finding of bad faith. In such cases, panelists look at the totality of the circumstances in each case, see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 3.3.

Taken into consideration that the Respondent has not filed any Response in these proceedings and the distinctiveness of the ALDI trademark, the Panel is convinced that the overall circumstances of this case strongly suggest that the Respondent's non-use of the disputed domain name is in bad faith. The reputation of the Complainant's ALDI trademark and the misspelling of the term "benefit" suggesting that the disputed domain name is associated with the Complainants' business, are also circumstances from which the Panel draws the conclusion that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the Complainants have satisfied the requirement 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 name <aldibeneficts.com> be transferred to the Complainant.

*/Halvor Manshaus/*

**Halvor Manshaus**

Sole Panelist

Date: March 21, 2023