

ADMINISTRATIVE PANEL DECISION

Barilla G. e R. Fratelli S.p.A. v. Michael Nava, Brand Boogie LLC
Case No. DIO2023-0039

1. The Parties

The Complainant is Barilla G. e R. Fratelli S.p.A., Italy, represented Studio Barbero, United States of America.

The Respondent is Michael Nava, Brand Boogie LLC, United States of America.

2. The Domain Name and Registrar

The disputed domain name <barilla.io> is registered with Dynadot Inc (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 19, 2023. On October 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (REDACTED FOR PRIVACY, Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 23, 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 two amendments to the Complaint on October 24, 2023.

The Center verified that the Complaint together with the amendments to the Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the "Policy"), the Rules for .IO Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .IO 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 October 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 15, 2023.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on November 19, 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 an Italian food group founded in 1877 in Parma, Italy, by Pietro Barilla and specializing in the production of oven-baked products, pasta and ready-made sauces.

With 146 years of existence, the company has developed into a famous multi-national conglomerate under the name “Barilla Group”, incorporating a number of brands, operating in 26 countries, exporting its products in more than 100 countries and owning production sites across 10 countries. The Barilla Group employs more than 8,000 people and in 2020 had net sales of approximately EUR 3,890 billion worldwide.

The Complainant owns a number of registrations for the BARILLA word and design marks throughout the world, including the following:

- International Trademark Registration No. 349555 for BARILLA (word), registered on September 26, 1968, in connection with goods and services in classes 5 and 30;
- European Union Trademark Registration No. 008585747 for BARILLA (word) registered on February 22, 2010, in connection with goods and services in classes 5, 29, 30, 31, 32, 33, 35, and 43;
- United Kingdom Trademark Registration No. UK00909461468 for BARILLA (word) registered on March 28, 2011 (application filed on October 20, 2010), in connection with goods and services in classes 3, 5, 9, 11, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 35, 39, 41, 42, and 43.

The Complainant is the owner of numerous domain names consisting of its trademark BARILLA with multiple generic Top-Level Domains (“gTLDs”) and country code Top-Level Domains (“ccTLDs”) including <barilla.com> registered on December 15, 1995, <barilla.co.uk>, registered on December 14, 1999, and <barilla.uk> registered on April 1, 2015.

The Domain Name <barilla.io> was registered on January 7, 2021, and redirects to a webpage offering it for sale.

On December 16, 2021, the Complainant’s representative sent a cease-and-desist letter to the abuse e-mail address of the Registrar, requesting that this letter be forwarded to the Registrant and demanding cessation of all use of the Domain Name, as well as its transfer. In the absence of a reply, a reminder was sent on May 5, 2023, to the abuse email address of the Registrar again, and to the Registrar’s online contact form. No response was received.

5. Parties’ Contentions

A. Complainant

The Complainant’s arguments in support of its Complaint can be summarized as follows:

First, the Complainant indicates that the disputed domain name is identical to its trademark BARILLA. Indeed, <barilla.io> incorporates BARILLA in its entirety, without any alteration which might distinguish the Domain Name from the Complainant’s trademark. In addition, the ccTLD “.io” shall be disregarded for the determination of confusing similarity, as it is viewed as a standard registration requirement.

Second, the Complainant asserts that the Respondent is neither a licensee, nor an authorized agent, nor in any other way authorized to use its trademark BARILLA. The Complainant is not in possession of and is not aware of any evidence demonstrating that the Respondent could be commonly known by a name corresponding to the disputed Domain Name as an individual, company or other organization. Furthermore, the Respondent clearly registered the disputed domain name for the sole purpose of offering it for sale to the Complainant at a significant price. This cannot confer any rights of legitimate interest in the disputed domain name and clearly shows that the Respondent did not intend to use it in connection with a *bona fide* offering of goods or services or for any noncommercial or fair use. Last but not least, this disputed Domain name, identical to the Complainant's trademark, creates a risk of implied affiliation. And finally, the Respondent has not replied to the Complainant's letters, which amounts to an acknowledgement of the allegations detailed above.

Third, the Complainant states that it is inconceivable that the Respondent was unaware of the existence of the Complainant's trademark when registering the disputed domain name, in light of the prior registration and extensive use of the trademark BARILLA since 1877, as well as the amount of advertising and sales of the Complainant's products worldwide. The trademark BARILLA is distinctive and well known. The Respondent clearly acted in opportunistic bad faith, and took commercial advantage of the Complainant's trademark. The disputed domain name redirects, since its registration, to a webpage where it is offered for sale for amounts well in excess with the out-of-pocket costs associated with it. This use leads the Complainant to assume that the disputed Domain Name was registered with the primary purpose of reselling it to the legitimate owner of the trademark. Such conduct constitutes bad faith according to Paragraph 4(b)(i) of the Policy.

Also, the Complainant states that "Respondent registered the Domain Name in order to prevent Complainant from reflecting its trademark in the corresponding .io domain name and appears to have engaged in a pattern of conduct according to paragraph 4(b)(ii) of the Policy since it has registered several domain names corresponding to third-party trademarks". The Complainant further indicates that the Respondent identifies itself as "Top Domain Sellers" and offers for sale a number of domain names which incorporate famous brands, in particular famous Italian brands.

The Complainant requests the transfer of the disputed Domain Name.

B. Respondent

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

6. Discussion and Findings

The Panel notes that the .IO Domain Name Dispute Resolution Policy is substantially similar to the Uniform Domain Name Dispute Resolution Policy (the "UDRP")¹. As regards the third element, the notion of bad faith can alternatively be sought in the registration or in the use of the disputed domain name.

Thus, 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 or is being used in bad faith.

¹ Given the similarities between the .IO Policy and the UDRP and Rules, the Panel finds UDRP precedent and WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") to be relevant to this case. See *IOTA Foundation v. Privacy Service provided by Withheld for Privacy ehf /Super Green*, WIPO Case No. [DIO2022-0001](#).

Thus, the Panel will, where appropriate, apply principles that have been established in relation to the UDRP in deciding this dispute.

A. Identical or Confusingly Similar

According to Paragraph 4(a)(i) of the Policy, the Complainant needs to establish that the disputed domain name is identical or confusingly similar to the trademark in which it has rights. This is primarily a standing requirement.

The Complainant has demonstrated that it holds numerous rights in the trademark BARILLA, and that it has made substantial and continuous use of it. The Panel finds that the second level of the disputed domain name is identical to the trademark. Accordingly, the Complainant has proved this element.

The addition of the ccTLD “.io” has no impact on the assessment of confusing similarity, since it is only required for functional purposes.

Accordingly, the Panel considers paragraph 4(a)(i) of the Policy to be satisfied.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights or legitimate interests in the disputed domain name. These circumstances are:

- i. before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- ii. the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- iii. the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, who did not reply to the Complainant's cease and desist letters, nor to this Complaint, has not provided any information on the rights or legitimate interests it may have in the disputed domain name. This entitles the Panel to draw any inferences from such default as it considers appropriate, pursuant to paragraph 14(b) of the Rules.

The Complainant asserts the Respondent is not a licensee or an authorized agent of the Complainant or in any other way authorized to use the trademark BARILLA. With this assertion, the Panel considers that the Complainant has made a sufficient *prima facie* case against the Respondent.

The Respondent is not making a *bona fide* use of the disputed domain name, since it clearly registered this Domain Name in order to derive profits from its sale. This Domain Name has been redirected since its registration to a webpage where it is offered for sale, which in the circumstances of this case does not confer rights or legitimate interests.

Besides, the disputed domain name, given its composition (identical to the Complainant's trademark BARILLA and domain name <barilla.com>), carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and the Panel considers paragraph 4(a)(ii) of the Policy to be fulfilled.

C. Registered or Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of a domain name in bad faith:

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

In the present case, the Panel finds that the Respondent more likely than not elected a domain name consisting solely of the distinctive and well-known trademark BARILLA, with full knowledge of it. In doing so, it prevents the Complainant from reflecting the trademark in the extension ".io" and disrupts the Complainant's business.

In addition, given the redirection of the disputed domain name to a website offering it for sale, at a price likely beyond the out-of-pocket costs, the Respondent obviously acquired the disputed domain name to profit from selling that Domain Name to the Complainant or to a competitor of the Complainant.

Also, the Respondent has already been involved in several cases of cybersquatting. The Respondent was found to have registered and used domain names in bad faith in nearly 20 cases.

The above findings are sufficient for the Panel to confirm that the Complainant succeeds.

Accordingly, the Panel considers paragraph 4(a)(iii) of the Policy to be fulfilled.

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, <barilla.io> be transferred to the Complainant.

/Benjamin Fontaine/

Benjamin Fontaine

Sole Panelist

Date: December 1, 2023