

ADMINISTRATIVE PANEL DECISION

Luigi Lavazza S.p.A. v. Matin Ghafourian Ramezan
Case No. DIR2022-0011

1. The Parties

The Complainant is Luigi Lavazza S.p.A., Italy, represented Studio Barbero, Italy.

The Respondent is Matin Ghafourian Ramezan, Iran (Islamic Republic of).

2. The Domain Name and Registrar

The disputed domain name <lavazzacafe.ir> is registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 8, 2022. On June 8, 2022, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain name. On June 11, 2022, IRNIC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details that were the same as in the Complaint.

The Center verified that the Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the “Policy” or “irDRP”), the Rules for .ir Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 16, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was July 6, 2022. The Response was received on June 16, 2022. On July 7, 2022, the Center commenced the panel appointment process.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on July 13, 2022. 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 was established in 1895 in Turin, Italy. Presently, it operates in over 140 countries and counts with more than 4,000 employees worldwide, direct subsidiaries and a wide distribution network in relation to a broad range of espresso blends, capsules and coffee machines.

The Complainant is the owner, amongst others, of the following trademark registrations:

- European Union Trademark Registration No. 000317057 for LAVAZZA, filed on July 18, 1996, registered on May 25, 1998, in classes 21, 30 and 42, successively renewed; and
- International Trademark Registration No. 317174 for LAVAZZA registered on July 18, 1966, in classes 21, 30 and 42, successively renewed.

The disputed domain name <lavazzacafe.ir> was registered on April 14, 2021. No active webpage resolves from the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant asserts to be a renowned coffee brand. According to it, on a European level, LAVAZZA is one of the top 50 brands in terms of presence and recognition, counting, in Italy, with 44.9% share of the coffee retail market in value.

Furthermore, under the Complainant's view, in light of its significant investments in R&D, marketing, sales and distribution channels, as well as the existence of a truly impressive client base for its products worldwide, LAVAZZA has become an indisputably famous and well-known trademark in Italy and several other countries in Europe and in the Middle East, occupying the 33rd position in the Reputation Institute "Global RepTrak 100" ranking in 2020.

As examples of the Complainant's innovative attitude, in 2015, it took Italian espresso onto the International Space Station, in collaboration with Argotec and the Italian Space Agency (ASI), as well as it has introduced the first LAVAZZA compostable capsule respectful of the environment.

The Complainant further asserts that the disputed domain name is confusingly similar to its renowned trademark since it incorporates entirely the LAVAZZA trademark, not affecting the addition of the non-distinctive element "cafe" the confusing similarity thereof.

As to the absence of rights or legitimate interests in the disputed domain name, the Complainant argues that:

(a) the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant's trademark;

(b) there is no evidence demonstrating that the Respondent, whose name is Matin Ghafourian Ramezan according to the Whois records, might be commonly known by a name corresponding to the disputed domain name as an individual, business, or other organization; not holding the Respondent any trademark registrations for LAVAZZA (Annex 10 to the Complaint);

(c) the Respondent has not provided any evidence of use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services before any notice of the dispute; and

(d) the disputed domain name has been used to redirect Internet users to a webpage where it was offered for sale (<<https://www.rond.ir/DomainInfo/1/ir/lavazzacafe>>) for 20,000,000 Iranian riyals, and in later correspondence between the Complainant's representatives and the Respondent, the Respondent asked for USD 11,000 and later at least EUR 2,000 (Annex 8 to the Complaint), which shows that the Respondent has no intention to use the disputed domain name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use.

According to the Complainant, the registration of the disputed domain name, more than a century after the use and promotion of the LAVAZZA trademark internationally was clearly done in bad faith given that the Respondent could not have possibly ignored the existence of the Complainant's trademark at the time of the registration of the disputed domain name.

The Complainant further asserts that in light of the distinctiveness and reputation of the Complainant's LAVAZZA trademark, the Respondent clearly acted in opportunistic bad faith, since it obviously registered the disputed domain name with full knowledge of the Complainant and its trademark for the purpose of taking commercial advantage of the Complainant's trademark as the Respondent's offer for sale of the disputed domain name for out-of-pocket costs directly related to its registration clearly indicate.

B. Respondent

The Respondent submitted an informal response where it states that “[u]nder NIC domain registration rules, the registrant reserves the right to cancel or transfer ownership if the registration is for illegal purposes similar to the sale of unbranded goods or for the purpose of misleading the visitor. Domain to the brand owner. Something similar to the Google.ir domain happened to him in 2005 But in the case of Lavaza Cafe, as its name suggests, it belongs to Lavaza Coffee Shop, which has several branches in Iran and does not sell any coffee under the Lavaza brand, and is merely a place for leisure or people-building.” The Respondent further states that the disputed domain name “has no content and there are no sales within it that would harm the Lavaza brand”, and that it registered the disputed domain name for personal gain, just as it has “registered 100 other domains in the same way”. Under the Respondent's view, “considering that [the disputed domain name] contents are not misleading and have no content, and there are cases bigger than this domain that are misleading, and as I told my dear friends before, if according to my very brief explanation, the order of the board of directors The domain registration center can perform the transfer process.”

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has established rights in the LAVAZZA trademark.

The disputed domain name includes the Complainant's trademark in its entirety. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name”. (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, “[WIPO Overview 3.0](#)”, section 1.7).¹

The addition of the term “cafe”, in this Panel's point of view, does not prevent a finding of confusing similarity between the disputed domain name and the trademark and, in this case, the “.ir” country code Top-Level Domain (“ccTLD”) is not to be taken into account as already established in case law under the Policy.

¹ Given the similarities between the Policy and the Uniform Domain Name Dispute Resolution Policy (“UDRP”), the Panel takes note of the applicable sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), where relevant. See, for example, *Société des Produits Nestlé S.A. v. Shahram Heidari*, WIPO Case No. [DIR2022-0001](#).

The first element of the Policy has therefore been established.

B. Rights or Legitimate Interests

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

- (i) before any notice of the dispute, the respondent's use of, or demonstrable 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; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if it has not acquired trademark or service mark rights; or
- (iii) the respondent 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 or service mark at issue.

While the Respondent states, *inter alia*, that the disputed domain name "has no content and there are no sales within it that would harm the Lavaza brand", the Respondent has failed to invoke or provide any evidence of circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy or otherwise, any rights to or legitimate interests in the disputed domain name.

In that sense, the Complainant states that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant's trademark.

Also, the absence of any trademarks or trade names registered by the Respondent corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name, that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name, corroborate with a finding as to the absence of a right or legitimate interest.

Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation. ([WIPO Overview 3.0](#), section 2.5.1).

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

C. Registered or Used in Bad Faith

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant who is the owner of a trademark relating to the disputed domain name or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed 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 engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other location, by creating a likelihood of

confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith ([WIPO Overview 3.0](#), section 3.1.4).

In light of the Respondent's lack of rights or legitimate interests in the disputed domain name, the nature of the disputed domain name (inherently misleading), and the Respondent's offer of the disputed domain name for amounts likely in excess of the out-of-pocket expenses to register the disputed domain name, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain name. Moreover, the fact that no active webpage resolves from the disputed domain name does not prevent a finding of bad faith.

The third element of the Policy has therefore 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 disputed domain name <lavazzacafe.ir> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: July 27, 2022