

## Decision for dispute CAC-UDRP-106186

Case number	CAC-UDRP-106186
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Domain names	lavazzaid.com, lavazzaidn.com, lavazzaldn.com, lavazzain.com, lavazzain.club, lavazzain.vip

### Case administrator

Name	Olga Dvořáková (Case admin)
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### Complainant

Organization	Luigi Lavazza S.p.A.
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### Complainant representative

Organization	Convey srl
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### Respondent

Organization	jinm niw wam
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#### OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the domain names <lavazzaid.com>; <lavazzaidn.com>; <lavazzaldn.com>; <lavazzain.com>; <lavazzain.club>; and <lavazzain.vip> (collectively, 'the disputed domain names').

#### IDENTIFICATION OF RIGHTS

The Complainant is the holder of the following registered trade marks, amongst others:

- International trade mark registration no. 450754, filed on 10 March 1980, for the figurative mark LAVAZZA, in class 21 of the Nice Classification;
- International trade mark registration no. 644146, designating, inter alia, China, filed on 23 October 1995, for the figurative mark LAVAZZA, in class 42 of the Nice Classification; and
- EU trade mark registration no. 000317057, filed 18 July 1996, for the word mark LAVAZZA, in classes 21, 30 and 42 of the Nice Classification.

(Hereinafter, collectively or individually, 'the Complainant's trade mark', 'the Complainant's trade mark LAVAZZA, or '(LAVAZZA) the trade mark (LAVAZZA)' interchangeably).

The disputed domain names were registered on the following dates:

- <lavazzaid.com>: 10 October 2023

- <lavazzaidn.com>: 10 December 2023
- <lavazzaldn.com>: 10 December 2023
- <lavazzain.com>: 16 December 2023
- <lavazzain.club>: 16 December 2023
- <lavazzain.vip>: 16 December 2023

At the time of writing, the disputed domain names do not resolve to active websites (for present purposes, 'the Respondent's websites').

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## FACTUAL BACKGROUND

### A. Complainant's Factual Allegations

The Complainant's contentions can be summarised as follows:

The Complainant, Luigi Lavazza S.p.A., was founded in Turin, Italy, in 1895, and has become one of the global leading stakeholders in the field of coffee business. The Complainant is the world's seventh-ranking coffee roaster, with operations (through affiliated companies and distributors) in more than 90 countries, and it has reported a turnover of EUR 2.24bn in 2019.

In addition to the trade marks mentioned in the above section 'Identification of Rights', and other trade marks in its portfolio, the Complainant operates its official website at <www.lavazza.com> (registered in 1996).

The Complainant seeks to obtain the transfer of the disputed domain names on the grounds set out in section A.3 below.

### B. Respondent's Factual Allegations

The Respondent has defaulted in this UDRP administrative proceeding and has therefore made no factual allegations.

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## PARTIES CONTENTIONS

### A. Complainant

#### A.1 Preliminary Matter: Application for Consolidation

The Complainant has submitted an application for consolidation pre-emptively.

The Complainant avers that the disputed domain names are subject to a common control or a single individual/entity or, at least, by a group of individuals acting in concert, thereby making the consolidation of the proceedings equitable and procedurally efficient ('the Complainant's Application for Consolidation').

The Complainant's Application for Consolidation is grounded on the following factors:

- i) the dispute domain names contain the same pattern, ie trade mark + generic suffix + extension;
- ii) the disputed domain names share the same registrar (Gname.com Pte. Ltd.);
- iii) the websites corresponding to the disputed domain names contain identical layouts, except for <lavazzaldn.com> which is inactive;
- iv) the disputed domain names share the same hosting provider (CloudFlare Inc.); and
- v) the registrants of the disputed domain names are from the same country and/or state/province: as per the references to 'HK', 'CN' and 'Hong Kong' in the Whois.

For the foregoing reasons, the Complainant requests that the disputed domain names and the named Respondents be consolidated into a single UDRP administrative proceeding.

For present purposes, the registrants/holders on record of the disputed domain names are hereinafter collectively referred to as 'the Respondent'.

#### A.2 Preliminary Matter: Language of the Proceeding

With respect to the language of the proceedings, the Panel notes the following:

- The Complaint is written in English and the Complainant has made a pre-emptive request that English be the language of this UDRP administrative proceeding;
- The registrar's verification response provided that the language of the registration agreements for the disputed domain names is Chinese; and
- The Complainant's grounds for English to be the language of this UDRP administrative proceeding can be summarised as follows: (i) the disputed domain names contain Latin characters and English words; (ii) the disputed domain names resolve to websites which display content in English; and (iii) it would be unfair to proceed in Chinese owing to the delay and costs associated with translations.

### **A.3 Substantive grounds**

#### **A.3.1 The disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights**

The Complainant submits that the disputed domain names are confusingly similar to the Complainant's trade mark to the extent that they reproduce the trade mark LAVAZZA in its entirety. The non-distinctive elements 'id', 'idn', 'ldn' and 'in', as well as the generic Top-Level Domains ('gTLDs'), in this case <.com>, <.vip> and <.club>, have no bearing on the confusing similarity test.

#### **A.3.2 The Respondent has no rights or legitimate interests in respect of the disputed domain names**

The Complainant submits that the disputed domain names are not being used in connection with a bona fide offering of goods or services. The disputed domain names resolve to login webpages which bear the Complainant's trade mark LAVAZZA, such that the Respondent's websites may well be used to obtain sensitive or confidential personal information from Internet users.

The Complainant further submits that the Respondent is not licensee, authorised agent of the Complainant or in any other way authorised to use the Complainant's trade mark. Moreover, the Respondent is not an authorised reseller of the Complainant and has not been authorised to register or use the disputed domain names. In addition, there is no disclaimer as to the Respondent's lack of relationship with the Complainant on the Respondent's websites.

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the dispute domain name.

#### **A.3.3 The Respondent registered and is using the disputed domain names in bad faith**

##### **Registration**

The Complainant contends that the trade mark LAVAZZA long predates the registration of the disputed domain names, and that the Complainant's worldwide reputation as a leading coffee importer and roaster makes it reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's trade mark.

The Respondent's actual knowledge of the Complainant is furthermore demonstrated by the use of the Complainant's trade mark LAVAZZA on the Respondent's websites.

##### **Use**

Under this UDRP Policy ground, the Complainant avers that the use of the disputed domain names (in particular the misappropriation of the Complainant's trade mark and the login webpages) evidences the Respondent's underlying intention to capitalise on the reputation of the LAVAZZA trade mark by diverting Internet users seeking LAVAZZA products to the Respondent's websites, for financial gain, by intentionally creating a likelihood of confusion with the LAVAZZA trade mark as to the source, sponsorship, affiliation, or endorsements of the Respondent's websites and/or the goods offered or promoted through the Respondent's websites (paragraph 4(b)(iv) of the UDRP Policy).

Furthermore, the inactive status of the disputed domain name <lavazzaldn.com> would not prevent a finding of bad faith use under the UDRP Policy in accordance with the Telstra test and paragraph 3.3 of the WIPO Panel Views on Selected UDRP Questions, Third Edition ('the WIPO Jurisprudential Overview 3.0').

Lastly, the Complainant informs that it has sent a cease-and-desist letter to the Respondent which remains unanswered, the consequence of which being that the Panel is also entitled to draw adverse inferences therefrom.

The Complainant therefore concludes that the Respondent has registered and is using the disputed domain names in bad faith.

### **B. Respondent**

The Respondent has defaulted in this UDRP administrative proceeding and has therefore failed to advance any substantive case on the merits.

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#### **RIGHTS**

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a

trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP Policy).

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#### NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the UDRP Policy).

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#### BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the UDRP Policy).

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#### PROCEDURAL FACTORS

##### 1. Complainant's Application for Consolidation

The registrar's verification response has confirmed that the disputed domain names are owned by the same Registrant/Respondent. Therefore, the Complainant's Application for Consolidation has been superseded owing to the supervenient lack of cause of action.

##### 2. Complainant's Language Request

The Panel is given discretion under Rule 11 of the UDRP Rules to determine the appropriate language of the UDRP administrative proceeding. The Panel notes Rule 10 of the UDRP Rules, which vests the Panel with authority to conduct the proceedings in a manner it deems appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

With regard to this particular matter, the Panel takes the liberty to adopt the language of proceeding test applied in CAC Case no. 104144, *Writera Limited v. alexander ershov*, which helpfully sets out the following six guiding factors:

**(i) the language of the domain name string:** the Panel considers that English words/abbreviations are the only identifiable language in the string of each of the six disputed domain names;

**(ii) the content of the Respondent's website:** while the Respondent's websites are presently inactive, the Complainant has supplied evidence that the websites at the disputed domain names <lavazzain.com>, <lavazzain.club>, and <lavazzain.vip> hosted content in English only. The Respondent would therefore appear to have knowledge of the English language;

**(iii) the language(s) of the Parties:** the Complainant is incorporated in Italy and the Respondent appears to be an individual/entity resident or incorporated in China. The English language would therefore be considered neutral for both Parties;

**(iv) the Respondent's behaviour:** the Panel notes that the Respondent has shown no inclination to participate in this UDRP administrative proceeding;

**(v) the Panel's overall concern with due process:** the Panel has discharged its duty under Rule 10 (c) of the UDRP Rules; and

**(vi) the balance of convenience:** while determining the language of the UDRP administrative proceeding, the Panel has a duty to consider who would suffer the greatest inconvenience as a result of the Panel's determination. On the one hand, the determination of English as the language of this UDRP administrative proceeding – a widely spoken language – is unlikely to cause the Respondent any inconvenience, not least given that three of the Respondent's websites hosted content in English only. The determination of Chinese as the language of this UDRP administrative proceeding, on the other hand, is very likely to cause the Complainant inconvenience, and to interfere with the overall due expedition of the proceedings under the UDRP Rules.

In view of the above factors, the Panel has decided to accept the Complainant's language request, such that the decision in the present matter will be rendered in English.

##### 3. Miscellaneous

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

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#### PRINCIPAL REASONS FOR THE DECISION

##### A. UDRP Threshold

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy sets out the grounds which the Complainant must establish to succeed:

- i) The disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- ii) The Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- iii) The disputed domain names have been registered and are being used in bad faith.

It is incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP administrative proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three UDRP Policy grounds in turn.

#### **B. Identical or Confusingly Similar**

The Panel is satisfied that the Complainant owns trade mark rights in 'LAVAZZA' since at least 1980.

The disputed domain names were registered in 2023, and all of them incorporate the Complainant's trade mark LAVAZZA in their string.

The additional letters/abbreviations 'id', 'idn', 'ldn' and 'in' are immaterial to produce any distinctive character and, in turn, insufficient overall to dispel the textual, auditory, and visual confusion with the trade mark LAVAZZA. Moreover, and as rightly articulated by the Complainant, the gTLD (in this case <.com>, <.vip> and <.club>) is typically disregarded by UDRP panels under this Policy ground given that the gTLD is part of the domain name's anatomy.

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

#### **C. Rights or Legitimate Interests**

The Respondent has defaulted in this UDRP administrative proceeding. Nevertheless, the Panel is empowered to draw adverse inferences from the Respondent's silence (Rule 14 (b) of the UDRP Rules).

The Panel notes that the Complainant denies any affiliation and/or association with, or authorisation for, the Respondent of any nature. There is no contractual arrangement between the Parties to that effect, nor has the Complainant otherwise authorised the Respondent to make any use of the Complainant's trade mark. Moreover, there is no evidence on the record to suggest that the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain names.

The Complainant claims that the Respondent is not an authorised reseller of the Complainant and that the Respondent's websites do not contain disclaimers regarding the parties' lack of relationship.

On this point, the Panel alludes to the jurisprudential view formed by domain name disputes under the UDRP Policy and UDRP Rules (see WIPO Jurisprudential Overview 3.0, paragraph 2.8), according to which resellers and distributors using a domain name containing a complainant's trade mark to undertake sales related to the complainant's goods or services may be making a bona fide offering of goods and services, and thus have a legitimate interest in such domain name. UDRP panels have termed this as the 'Oki Data test' (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903), which comprises the following four cumulative requirements:

1. The Respondent must actually be offering the goods or services at issue;
2. The Respondent must use the website associated with the disputed domain names to sell only the trade marked goods or services;
3. The Respondent's website must accurately and prominently disclose its relationship with the Complainant; and
4. The Respondent must not try to 'corner the market' in domain names that reflect the trade mark.

The Parties are reminded that the above requirements are cumulative, so that the failure to satisfy any of them would result in a finding for the Complainant regarding this UDRP Policy ground.

The Panel has considered the evidence on the record and notes that the Respondent would have failed to meet the Oki Data test, the Panel being unable to locate a disclaimer regarding the relationship between the Respondent and the Complainant (requirement 3 above).

Furthermore, the Panel is unconvinced that, before any notice of the dispute, the Respondent used, or made demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a bona fide offering of goods or services.

Lastly, there is evidence on the available record suggesting that the Respondent has attempted to impersonate the Complainant, as discussed in section D. below.

For the foregoing reasons, and noting that the Respondent has not provided a Response to refute any of the allegations and evidence adduced by the Complainant in this UDRP administrative proceeding, the Panel finds that the Complainant has made prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain names under the UDRP Policy.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(ii) of the UDRP Policy.

## D. Registered and Used in Bad Faith

### D.1 Registration in Bad Faith

The following factors are compelling evidence to this Panel that the disputed domain names were registered in bad faith:

- The Complainant has been using the trade mark LAVAZZA since at least 1980;
- The Complainant owns trade mark rights in China - the Respondent's country of residence or incorporation - since 1995;
- The Complainant operates its activities through the domain name <lavazza.com>, which was registered in 1996;
- The disputed domain names were registered in 2023;
- The disputed domain names incorporate the Complainant's trade mark LAVAZZA entirely; and
- UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trade mark can by itself create a presumption of bad faith (paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0), and the Panel accepts that the Complainant's trade mark is widely known in its segment of business.

### D.2 Use in Bad Faith

The Complainant alleges that the Respondent has engaged in the conduct described in paragraph 4(b)(ii) of the UDRP Policy, which provides as follows:

'(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line 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'.

As mentioned earlier (section 'Identification of Rights'), the disputed domain names do not presently resolve to active websites.

Notwithstanding the above, the Panel has considered the available record and found compelling indicia that the Respondent would have attempted to impersonate the Complainant by using login webpages headed with the LAVAZZA trade mark and seeking to obtain confidential/ sensitive data from Internet users. The Respondent's behaviour would therefore fall into the remit of circumstance (iv) of paragraph 4(b) of the UDRP Policy.

For the sake of completeness, the Panel has also taken stock of paragraph 3.3 (passive holding) of the WIPO Jurisprudential Overview 3.0, according to which UDRP panels have recognised various types of evidence to support a finding of bad faith on the basis of the non-use of a domain name. In the case at hand, the Panel considers the most conducive factors to a ruling in favour of the Complainant under this UDRP Policy ground to be (i) the degree of distinctiveness or reputation of the Complainant's trade mark; (ii) the Respondent's default; and (iii) the implausibility of any good faith use to which the disputed domain names may be put.

In view of the above, the Panel finds that the Complainant has succeeded under paragraph 4(a)(iii) of the UDRP Policy.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **lavazzaid.com**: Transferred
2. **lavazzaidn.com**: Transferred
3. **lavazzaldn.com**: Transferred
4. **lavazzain.com**: Transferred
5. **lavazzain.club**: Transferred
6. **lavazzain.vip**: Transferred

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## PANELLISTS

Name **Yana Zhou**

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DATE OF PANEL DECISION 2024-02-23

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**Publish the Decision**

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