Decision for dispute CAC-UDRP-106322

Case number	CAC-UDRP-106322
Time of filing	2024-03-08 11:18:48
Domain names	ghirardelli.online

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	ghirardelli.online

Complainant representative

Organization	SILKA AB

Respondent

Organization	Domain Name Privacy Inc.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registrant of several trademarks, including "Ghirardelli" Word Trade mark (EU #003716453, reg. 27/7/2005 for classes 30, 35, 42 and 43).

FACTUAL BACKGROUND

The Complainant, founded in 1845, is a Swiss chocolate manufacturer. With 11 production facilities in Europe and the U.S., the company employs over 14,000 people and reported revenues of CHF 5.2 billion in 2023. Its product range includes over 2,500 items sold in more than 120 countries through 500 retail stores and a network of subsidiaries and distributors.

The company has expanded by acquiring several chocolate companies, such as Hofbauer and Küfferle in 1994, Caffarel in 1997, Ghirardelli in 1998, and Russell Stover in 2014. Ghirardelli itself, purchased in 1998, is a historic U.S. chocolate brand established in 1852 in San Francisco, generating USD 727 million in sales in FY 2022.

The Complainant holds multiple trademarks for "GHIRARDELLI" in various jurisdictions worldwide, with significant trademark registrations in the U.S., the European Union, and internationally, covering a wide range of classes.

Ghirardelli products are marketed online, notably through ghirardelli.com, established in 1998, and several other domain names. The

brand has a strong social media presence, with around 1.4 million Facebook followers, 149 thousand on Instagram, and 32 thousand on LinkedIn.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

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 name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

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

PROCEDURAL FACTORS

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.

PRINCIPAL REASONS FOR THE DECISION

FIRST CONDITION

The Panel shall disregard the '.online' extension of the disputed domain name. This approach aligns with previous rulings concerning generic and country top-level domains (gTLDs and ccTLDs). After doing so, the disputed domain name appears identical to the "GHIRARDELLI" mark, containing the mark in full without any alterations or additions.

SECOND CONDITION

The consistent jurisprudence of panels requires the Complainant to present probable and coherent elements supported by evidence that at least make the lack of rights or legitimate interest plausible. Once this plausibility is established, it is up to the Respondent to provide evidence that overturns this presumption. Naturally, when the Respondent decides not to respond, they risk having the Panel decide based solely on the plausible elements presented by the Complainant.

In this case, the Panel considers the following plausible, uncontested elements:

- The Complainant states that to their knowledge, the Respondent does not hold any registered or unregistered trademark rights for 'ghirardelli' or any similar term. Furthermore, the Respondent has not been authorized by the Complainant to use the GHIRARDELLI mark or any similar variant in any domain names.
- The Respondent is not commonly known by the disputed domain name, nor have they acquired any trademark or service mark rights.
- The disputed domain name redirects users to other websites which involve potentially deceptive activities like misleading captchas leading to spam and malware. This usage has been flagged by security vendors as malicious and does not constitute a bona fide offering of goods or services, nor a legitimate noncommercial use.

- The Complainant also notes that the combination of the GHIRARDELLI mark with the '.online' gTLD suggests a misleading affiliation with the Complainant, implying that the disputed domain name could be perceived as an official online site of the Complainant, which it is not. This does not constitute fair use.

THIRD CONDITION

In the absence of a response from the Respondent, the Panel considers the following elements to be particularly troubling and likely (and sufficient due to the absence of a response) to establish the Respondent's bad faith.

- The Respondent's registration of the disputed domain name combining the GHIRARDELLI mark with the '.online' TLD suggests an intent to commercially capitalize on the brand's recognition, potentially misleading users into thinking the site is an official online location for the Complainant's goods.
- The Complainant argues that the Respondent's use of the disputed domain name to redirect to unrelated sites that distribute malicious content indicates bad faith. This is further supported by past UDRP decisions, where using a domain to distribute malware was considered an indication of bad faith.
- Additionally, the configuration of the disputed domain name with an MX record poses a risk of phishing, as e-mails from the domain may be perceived as being from the Complainant, increasing the likelihood of internet-user confusion.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ghirardelli.online**: Transferred

PANELLISTS

Name	**Mr. Etienne Wéry**

DATE OF PANEL DECISION 2024-04-12

Publish the Decision