Decision for dispute CAC-UDRP-106851

Case number	CAC-UDRP-106851
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Domain names	ghlirardelll.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Chocoladefabriken Lindt & Sprüngli AG

Complainant representative

Organization	SILKA AB

Respondent

Name	Honey Saedi

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 claims to be the owner of the GHIRARDELLI trademark since at least 1925, including but not limited to the followings:

- United States Trademark No. 205776, registered on 17 November 1925 in Classes 30;
- United States Trademark No. 1645206, registered on 21 May 1991 in Classes 16, 18, 21, 25, 30, 42;
- United States Trademark No. 3508893, registered on 30 September 2008 in Classes 6, 16, 18, 21, 25, 28;
- European Union Trademark No. 003716453, registered on 27 July 2005 in Classes 30, 35, 42, 43;
- International Trademark No. 826074, registered on 30 March 2004 in Classes 30, 35, 43;
- International Trademark No. 936941, registered on 27 July 2007 in Classes 6, 14, 16, 18, 21, 25, 28, 41;
- Canada Trademark No. TMA378615, registered on 18 January 1991 in Classes 30;
- Canada Trademark No. TMA763505, registered on 18 April 2010 in Classes 16, 18, 21, 25, 30, 35, 43.

The Complainant advertises and sells its confectionery offerings to consumers online via its primary domain name <ghirardelli.com> which was registered in 1998. The Complainant also holds many other domain names which exactly comprise the GHIRARDELLI mark, across both gTLD and ccTLD extensions, i.e. <ghirardelli.biz>, <ghirardelli.info>, <ghirardelli.shop>, <ghirardelli.us> and <ghirardelli.com.mx>.

The Complainant's GHIRARDELLI brand enjoys a strong social media presence with, for example, ~1.5 million likes on Facebook (https://www.facebook.com/Ghirardelli/), ~150 thousand followers on Instagram (https://www.instagram.com/ghirardelli/), and

over 30 thousand followers on LinkedIn (https://www.linkedin.com/company/ghirardelli-chocolate-company).

FACTUAL BACKGROUND

The Complainant claims to be a well-known chocolate maker based in Switzerland founded in 1845. As a leader in the market of premium quality chocolate, the Complainant has 11 production sites in Europe and the United States and its more than 2,500 products are distributed via 28 subsidiaries, 500 own retail shops and a comprehensive network of over 100 distributors in more than 120 countries. The Complainant has more than 14 thousand employees and made a revenue of CHF 5.2 billion in 2023. Over the years, the Complainant has expanded its brand portfolio abroad and acquired chocolate businesses including Hofbauer and Küfferle (1994), Caffarel (1997), Ghirardelli (1998) and Russell Stover (2014).

As referred to above, the Complainant acquired the Ghirardelli Chocolate Company ('Ghirardelli') in 1998. Ghirardelli, one of the oldest US-based chocolate companies, was founded in 1852 and is headquartered in San Francisco, California. In FY 2022, Ghirardelli generated sales of USD 727 million. Ghirardelli chocolates are sold through numerous stores, retail partners and wholesale distributors.

The Respondent appears to be an individual based in California, United States.

The disputed domain name was registered on 2 July 2024.

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. Main contentions of the Complainant are summarised below.

No administratively compliant Response has been filed. The communication with the Respondent is summarised below.

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).

The Complainant claims rights in the GHIRARDELLI mark through its trademark registrations. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

The Complainant further claims that the disputed domain name's second level consists of a misspelt variation of the Complainant's GHIRARDELLI mark. It involves both the addition of a character (an 'l' between the 'h' and first 'i') and the substitution of another character (the final 'i' with an 'l'):

- Complainant's trademark: GHIRARDELLI
- Complainant's primary domain name: <ghirardelli.com> (GHIRARDELLI.COM)
- The disputed domain name: <ghlirardelll.com> (GHLIRARDELLL.COM)

By doing side-by-side comparisons, the Panel accepts that the change of the characters do not alter the overall impression of the designation as being connected to the Complainant and its trademark, and the ".com" generic top-level domain ("gTLD") is irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of paragraph 4(a)(i) of the Policy. See BOLLORE SE vs. shem gitahi, 104590 (CAC 2022-06-24) ("The Panel finds that that this can be considered as typosquatting. In the Panel's view, the substitution of one letter by a visually similar number and the addition of a second "r" does not prevent the disputed domain name from being confusingly similar to the Complainant's trademark."). See also Intesa Sanpaolo S.p.A. vs. Milen Radumilo, 103410 (CAC 2020-12-17).

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the

considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

The Complainant claims that to the best of it's knowledge, the Respondent does not have trademark rights for, nor is it known by, 'ghlirardelll' or any similar term. The Respondent is not connected to nor affiliated with the Complainant and has not received license or consent to use the GHIRARDELLI mark in any way. The Complainant further submits that the Respondent has not used, nor prepared to use, the disputed domain name in connection with a bona fide offering of goods or services, nor a legitimate noncommercial or fair use. To the best of the Complainant's knowledge, the disputed domain name has only been used to resolve to a parked page of the Registrar; it has not been used to resolve to an active website.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name. However, the Respondent has not submitted a compliant response to rebut the assertions within the required period of time.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

The Complainant reiterates that the Complainant has accrued substantial goodwill and recognition in the GHIRARDELLI brand, which has been used to distinguish its offerings for over a century. The Complainant holds many trademarks for the GHIRARDELLI term that cover numerous jurisdictions; the Complainant's oldest trademark registration predates the disputed domain name's registration by almost 100 years. The Complainant further submits that the Respondent's selection of a typosquatting domain name string reflects the Respondent's prior awareness and targeting of the Complainant through its registration of the disputed domain name.

The Complainant's representatives sent a cease-and-desist letter to the Respondent requesting the Domain Name's transfer in July 2024. The Respondent failed to respond to this correspondence. The failure to respond is a further indication that the Respondent registered the disputed domain name with a view to capitalising on the Complainant. There is no evidence of the Respondent having made any good faith, legitimate non-commercial or fair use of the disputed domain name, nor of being commonly known by such. It is also clear, given the renown of the GHIRARDELLI mark and composition of the disputed domain name, that no good faith use could be made of it by the Respondent. There is no plausible explanation for the Respondent's selection and registration of the disputed domain name other than to capitalise on the trademark value of the GHIRARDELLI brand.

Having considered to totality of the circumstances and without receiving an administrative compliant response, the Panel is of the view that the Respondent is more likely than not to have actual knowledge of Complainant's GHIRARDELLI trademark during the registration of the disputed domain name and the passively holding of the disputed domain name also constitutes bad faith, see Intesa Sanpaolo S.p.A. v. Amir Mt, 103701 (CAC 2021-05-14) ("Panels have found that the non-use of a domain name could constitute registration and use of bad faith under the doctrine called as 'passive holding'.")

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

No administratively compliant response was filed in this proceeding. The CAC was contacted by the respondent via email communication. The Respondent stated:

In email from September 26, 2024 the following: " Hello, I received a dispute le er for a domain name: ghlirardelll.com

I'm not sure what needs to be done but this is not my domain name and there should be no dispute.

Please advise how to close this out."

In email from October 4, 2024 following: " Please transfer the domain name. I do not have any ownership of this domain and would like this claim to be closed out ASAP."

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

Having established all three elements required under the UDRP Policy, the Panel concludes that the disputed domain name should be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ghlirardelll.com**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2024-10-07

Publish the Decision