Decision for dispute CAC-UDRP-107226

Case number	CAC-UDRP-107226
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Domain names	ghiraradelli.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Chocoladefabriken Lindt & Sprüngli AG

Complainant representative

Organization	SILKA AB

Respondent

Organization	GCC- .AccountsReceivable

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

US TM Registration No. 205776 GHIRARDELLI registered from 17 November 1925 for various goods in class 30.

FACTUAL BACKGROUND

The Complainant, founded in 1845, is a well-known chocolate maker based in Switzerland.

In 1998 the Complainant acquired the Ghiradelli Chocolate Company, one of the oldest US-based chocolate companies which was founded in 1852. In 2022 the gross sales for "Ghiradelli" branded chocolates were approximately USD 727 million dollars. These chocolates are sold through numerous stores, retail partners, and wholesale distributors.

The Complainant holds numerous trademark registrations that contain, or consist, of the word GHIRADELLI, including the above-mentioned US TM registration. It also holds numerous domain names containing the word GHIRADELLI, including <ghirardelli.com> which has been registered since 1998 and is used to host a website that advertises and sell GHIRADELLI confectionary. The Complainant also promotes the GHIRADELLI brand extensively through various social media platforms.

The disputed domain name was registered on 22 October 2024. It does not resolve to an active webpage.

In November 2024 the Complainant's representatives sent correspondence to the Respondent requesting a transfer of the domain name. The Complainant did not receive any response to this correspondence from the Respondent.

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

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

1) the disputed domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and

2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

3) the disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant asserts it has, among other registrations, a US TM registration for the word GHIRADELLI. This registration is almost 100 years old and therefore well and truly predates the registration date of the disputed domain name.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark GHIRADELLI.

The next question is whether the disputed domain name is confusingly similar to the GHIRADELLI trademark.

The Panel disregards the gTLD suffix ".com" for the purpose of this comparison. However, the Panel further notes that if such a suffix were to add anything it would only make the disputed domain name more similar to the Complainant's well-used <ghiradelli.com> domain name, which has the same suffix.

Turning to the remaining elements of the disputed domain name, the GHIRARADELLI element is almost identical to the GHIRADELLI trademark. The former merely repeats the letters "RA" appearing in the center of the trademark. The similarities between the two are striking and it is of concern that the only difference is in letters positioned in the center of the words where such an alteration is less likely to be noticeable to an internet user perusing the disputed domain name quickly and with limited care and attention.

The disputed domain name is confusingly similar to the GHIRADELLI trademark.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests (Croatia Airlines d. d. v. Modern Empire Internet Ltd. WIPO Case No. D2003-0455). Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

As mentioned above, the Complainant asserts, and the Respondent does not deny, that the disputed domain does not resolve to an active webpage. Further, the Respondent's name bears no resemblance to the disputed domain name. In such circumstances the Complainant has made out its prima facie case the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has no rights or interests in the disputed domain name.

BAD FAITH

The fact that the disputed domain name has been registered for many months and still does not resolve to an active webpage or appear to be otherwise used also warrants consideration for the bad faith element under the Policy.

Failing to redirect a domain name to an active website or merely directing the domain name to a basic parking page that contains links to other websites can be legitimate conduct. It is commonly referred to as 'passive holding'. Whilst it is true that the passive holding of a domain name may, in appropriate circumstances, be indicative of bad faith. It will only be so indicative when all the circumstances of the Respondent's behaviour indicate he or she is acting in bad faith (Telstra Corporation Ltd v. Nuclear Marshmallows D2000-0003 (WIPO 18 February 2000). There is no law or rule that a domain name cannot be parked or that it must be used to redirect to an active website within a specific period of time.

However as the disputed domain name has not been used for many months the Panel does regard such unexplained passive holding, by itself, as of some concern. But what is of far greater concern to the Panel in this present proceeding is that GHIRARADELLI is a well known and highly distinctive trademark.

It is entirely unforeseeable that a reasonable person could register the strikingly similar disputed domain name without knowledge of the Complainant's rights.

The Panel finds that the Respondent had such prior knowledge at the time of registering the disputed domain name and therefore its only purpose in registering the disputed domain name was to opportunistically profit from confusing similarity. The Respondent clearly targeted the Complainant's well-known trademark for this purpose. And this elevates the Panel's overall concern over the passive holding of the disputed domain name.

Therefore, in consideration of all the circumstances the disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ghiraradelli.com**: Transferred

PANELLISTS

Name	**Andrew Sykes**

DATE OF PANEL DECISION 2025-02-07

Publish the Decision