

## **ADMINISTRATIVE PANEL DECISION**

Luigi Lavazza S.p.A. v. he song  
Case No. D2022-3878

### **1. The Parties**

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

Respondent is he song, China.

### **2. The Domain Name and Registrar**

The disputed domain name <bj-lavazza.com> is registered with Heavydomains.net LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 17, 2022. On October 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 18, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

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

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on October 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 9, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 10, 2022.

The Center appointed Lorelei Ritchie as the sole panelist in this matter on November 15, 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**

Complainant is a multinational company based in Italy. For many decades prior to the registration of the disputed domain name, Complainant has offered coffee and other products under its LAVAZZA mark. Complainant owns numerous registrations for the LAVAZZA mark. These include, among others, European Union Registration No. 000317057 (registered May 25, 1998); International Registration No. 317174 (registered July 18, 1966), and Chinese Registration No. 3141188 (registered May 28, 2003).

In addition, Complainant owns the registration for numerous domain names that contain its LAVAZZA mark, including <lavazza.com> (registered May 19, 1996). Complainant uses the website associated with this domain name to connect with consumers, and to provide information about products offered under its LAVAZZA mark.

The disputed domain name was registered on June 29, 2022. Respondent has used the URL associated with the disputed domain name to resolve to a website that includes links to gambling websites. Complainant has not authorized any activities by Respondent, nor any use of its trademarks thereby.

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant contends that the (i) disputed domain name is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the disputed domain name; and (iii) Respondent registered and is using the disputed domain name in bad faith.

In particular, Complainant contends that it has established global renown for its well-known LAVAZZA mark, including in China, where Complainant has established a presence, registered trademarks, and registered the domain name <Lavazza.cn>. Complainant contends that Respondent has incorporated the LAVAZZA mark into the disputed domain name, and merely added the letters "bj" with a hyphen, which consumers will likely associate with Complainant's LAVAZZA products in the city of Beijing, China. Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain name registration or use of the disputed domain name. Rather, Complainant contends that Respondent has acted in bad faith in setting up links to gambling websites, for Respondent's own commercial gain.

##### **B. Respondent**

Respondent did not reply to Complainant's contentions.

#### **6. Discussion and Findings**

##### **A. Identical or Confusingly Similar**

This Panel must first determine whether the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy. The Panel finds that it is. The disputed domain name directly incorporates Complainant's registered LAVAZZA mark, with the addition of the letters "bj" and a hyphen.

Numerous UDRP panels have agreed that supplementing or modifying a trademark with added words or letters, regardless of meaning, does not prevent a finding of confusing similarity for purposes of satisfying this first prong of paragraph 4(a)(i) of the Policy. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.8.

The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

The Policy provides some guidance to respondents on how to demonstrate rights or legitimate interests in the domain name at issue in a UDRP dispute. For example, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name. These examples include: (i) use of the domain name “in connection with a *bona fide* offering of goods or services;” (ii) demonstration that Respondent has been “commonly known by the domain name;” or (iii) “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.”

Respondent did not submit a reply to Complainant’s contentions, and Respondent did not allege or otherwise provide any information that would support a finding that Respondent has rights or legitimate interests in the disputed domain name. Rather, the evidence demonstrates that Respondent uses the confusingly similar disputed domain name to resolve to a website with commercial links advertising gambling services, which does not constitute a *bona fide*, noncommercial offering or fair use. [WIPO Overview 3.0](#), section 2.5.3. Accordingly, the Panel finds that Complainant has made a *prima facie* showing of Respondent’s lack of rights or legitimate interests in the disputed domain name, which Respondent has not rebutted.

## **C. Registered and Used in Bad Faith**

There are several ways that a complainant can demonstrate that a domain name was registered and used in bad faith. For example, paragraph 4(b)(iv) of the Policy states that bad faith can be shown where “by using the domain name [respondent has] intentionally attempted to attract, for commercial gain, Internet users to [respondent’s] web site 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 [respondent’s] website or location or of a product or service on [the] web site or location.” As noted in Section 4 of this Panel’s decision, Respondent has used the URL associated with the disputed domain name to resolve to a website that includes links to gambling websites. Respondent is thus trading on the goodwill of Complainant’s well-known trademarks to attract Internet users, presumably for Respondent’s own commercial gain. See also *Luigi Lavazza S.p.A. v. Satoshi Shimoshita*, WIPO Case No. [D2011-1299](#); *Luigi Lavazza S.p.A. v. Flying Stingrays Ltd.*, WIPO Case No. [D2012-1391](#). Moreover, given the notoriety and extensive use of the Complainant’s distinctive mark, the Panel finds that Respondent’s incorporation of the mark in its entirety suggests Respondent’s awareness of and intent to target Complainant upon registering the disputed domain name. Additionally, UDRP panels have found that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

The Panel finds that Respondent registered and used the disputed domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy.

## **7. Decision**

For all 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 <bj-lavazza.com> be transferred to Complainant.

/Lorelei Ritchie/

**Lorelei Ritchie**

Sole Panelist

Dated: November 29, 2022