

ADMINISTRATIVE PANEL DECISION

Illycaffè S.p.A. v. Alexandru Stanica

Case No. DRO2023-0009

1. The Parties

The Complainant is Illycaffè S.p.A., Italy, represented by Kivial s.r.l., Italy.

The Respondent is Alexandru Stanica, Romania.

2. The Domain Names and Registry

The disputed domain names <illycaffè.ro> and <illy.ro> are registered with ROTLD (the “Registry”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on August 4, 2023. On August 7, 2023, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain names. On August 8, 2023, the Registry transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Private Person) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 9, 2023, providing the registrant and contact information disclosed by the Registry, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 11, 2023.

On August 9, 2023, the Center informed the parties in Romanian and English, that the language of the registration agreement for the disputed domain names is Romanian. On August 11, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent objected to the Complainant’s request in an email communication sent on August 13, 2023.

The Center verified that the Complaint together with the amendment to the Complaint and the amended 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 the Respondent of the Complaint, and the proceedings commenced on August 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 4, 2023. The Respondent did not submit any formal response. Accordingly, the Center notified Commencement of Panel Appointment on September 6, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on September 12, 2023. 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

The Complainant, Illycaffè S.p.A., headquartered in Trieste, Italy and founded in 1933, is a coffee company specializing in espresso. The Complainant's goods are marketed in 140 countries, on all 5 continents and are served in more than 100,000 commercial businesses. In 2022, the Complainant's group, which employs more than 2,700 people, had a consolidated turnover of EUR 567 million.

The Complainant's ILLY trademark has received various recognitions, such as the most beloved Italian brand worldwide, according to the "Love Brands 2022" rankings by Talkwalker.

The Complainant owns trademark registrations for ILLY and ILLYCAFFÈ across various jurisdictions, such as the following:

- the European Union trade mark registration number 001273044 for the word ILLY, filed on August 6, 1999, and registered on April 8, 2005, covering goods and services in Nice classes 7, 8, 9, 11, 16, 21, 24, 30, 33, 35, 41, 42;
- the European Union trade mark registration number 00389494 for ILLY with figurative elements, filed on October 7, 1996, and registered on May 4, 1999, covering goods and services in Nice classes 11, 30, 42; and
- the European Union trade mark registration number 008457814 for the word ILLYCAFFÈ, filed on July 29, 2009, and registered on January 31, 2010, covering goods and services in Nice classes 30 and 43.

The Complainant is the owner of numerous domain names incorporating its trademark ILLY / ILLYCAFFÈ, such as <il.ly.com>, <il.ly.coffee>, <il.ly.com.au>, <il.ly.shop>, <il.ly.eu>, <il.lycaffe.au>, <il.lycaffe.com>, <il.lycaffe.eu>, <il.lycaffe.es>, or <il.lycaffe.info>.

The disputed domain name <il.lycaffe.ro> was registered on September 29, 2018, and the disputed domain name <il.ly.ro> was registered on October 1, 2018. At the time of filing the Complaint, both disputed domain names resolved to error pages.

Before commencing the present proceeding, on July 13, 2023, the Complainant sent an approach letter to the Registrar listed in the Whois. A person signing with an identical name as the Respondent (and using a different email address) replied and mentioned that he will forward the request to the owners of the disputed domain names. The Parties conducted email correspondences between July 14, 2023, and July 28, 2023, regarding a potential transfer of the disputed domain names to the Complainant. Evidence is submitted as Annexes 7 and 10 to the Complaint.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the disputed domain names are identical to its extremely distinctive and reputable trademarks ILLY and ILLYCAFFÈ, "Illy" being the Complainant's founder family name; that the Respondent has no rights or legitimate interests in the disputed domain names; and that the Respondent registered and is using the disputed domain names in bad faith, keeping the disputed domain names passively since 2018.

Further, the Complainant claims that, following the Parties' email correspondence mentioned in section 4 above and its request for a final offer to negotiate the transfer of the disputed domain names, a phone conversation took place with "a colleague of Mr. Stanica", who spoke Italian, and were advised that the disputed domain names were acquired because the Respondent was initially interested in opening a business connected with the ILLY brand in Romania but their approaches, to different non-existing collaborators of the Complainant, failed. Finally, such person mentioned that it will be willing to transfer the disputed domain names to the Complainant at a cost of EUR 50,000. No written confirmation was provided by the Respondent.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

According to Annex 7 to the Complaint, the Respondent claimed, in its pre-Complaint correspondence with the Complainant, *inter alia*, that "Unfortunately for you client, the word illy is a person's name and as long as the legal owner (my client) is not infringing the commercial brand there are no legal grounds for any authority to take away their domain."

The Respondent did not formally respond to the Complainant's allegations but, when responding to the Center's communication regarding the language of the proceeding, the Respondent asserted that its effort to communicate in English led to ambiguity and misunderstandings.

6. Discussion and Findings

In view of the absence of a formal Response, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

6.1. Preliminary Matter: Language of the Proceeding

The Complaint was filed in English. The language of the Registration Agreement is Romanian.

The Complainant requests the language of the proceeding be English based on the pre-Complaint correspondence between the parties; the Respondent's LinkedIn account available in English and suggesting that the Respondent attended a Romanian-British University; as well as the fact that the Respondent seems to be the owner of a company having a website available only in English.

The Respondent, having been notified of the present proceeding in both English and Romanian, requested the language of the proceeding be Romanian, based on his nationality, the fact that the country code Top-Level Domain ".ro" is the extension for Romania and his English skills would be inadequate.

Under paragraph 11 of the Rules, the language of the proceeding is the language of the registration agreement of the disputed domain name, unless both parties agree otherwise, or the panel determines otherwise based on one party's request. A panel may decide that the proceeding should be conducted in another language than that of the registration agreement when it is necessary due to the specific circumstances of the case, such as for example when the complainant does not understand the language of the registration agreement and it would therefore be unfairly disadvantaged by the fact that it must translate the complaint in such proceeding.

Noting the aim of conducting the proceeding with due expedition, paragraph 10 of the UDRP Rules vests the Panel with authority to conduct the proceeding in a manner it considers 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.

The Panel is familiar with both languages and therefore is able to understand the submissions made by the Parties in either of these two languages. The Panel would have accepted a response in Romanian, but the Respondent did not file a formal response.

From the documents before it, the Panel considers that the Respondent has satisfactory knowledge in English language to understand the claims brought in this procedure and that the Complainant will be disadvantaged if required to translate the Complaint into Romanian and the proceeding will be unduly delayed. See section 4.5.1. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

For all the above, the Panel decides that English is the language of the proceeding.

6.2. Substantive Matters

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the marks are reproduced within the disputed domain names. Accordingly, the disputed domain names are identical to the marks (ILLY and ILLYCAFFÈ) for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The Respondent did not submit a Response in this proceeding but, in its prior correspondence with the Complainant, he claimed that the disputed domain names represent the name of a person, while the Respondent’s name does not contain “illy” and without indicating a particular person. At the same time, “illy” is the family name of the Complainant’s founder and, according to Panel’s knowledge, it is not a Romanian common name. Furthermore, the Respondent included the term “caffe” in the disputed domain name <illycaffe.ro>. The term “caffe” means coffee in Italian, which is related to the Complainant’s business, while at the same time reproducing the entirety of the Complainant’s ILLYCAFFÈ trademark. Considering all of the above, it’s highly unlikely that the Respondent intended to use the disputed domain names with *bona fide* intentions.

Furthermore, the composition of the disputed domain names, in this case being the reproductions of the Complainant’s well-known trademarks, carries a risk of implied affiliation. Prior UDRP panels have held that domain names identical to a complainant’s trademark carry a high risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the disputed domain names were registered in bad faith, with knowledge of the Complainant and its trademarks particularly because the Complainant, founded in 1933, uses in commerce the ILLY and ILLYCAFFÈ trademarks and domain names since at least 1996; and, the disputed domain names reproduce the Complainant’s trademarks exactly and were registered within a short timeframe one from another.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

At the time of filing the Complaint, both the disputed domain names resolved to error pages.

UDRP panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain names do not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of

distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the misleading domain name may be put. [WIPO Overview 3.0](#), section 3.3.

The Panel notes the distinctiveness and international reputation of the Complainant's trademarks; the nature of the disputed domain names, namely the identical reproduction of internationally known trademarks; the Respondent's failure to provide a formal response in this procedure; the implausibility of any good faith use to which the disputed domain names may be put and finds that, in the circumstances of this case, the passive holding of the disputed domain names do not prevent a finding of bad faith under the Policy.

Further (i) in the negotiations between parties before the present proceeding, the Complainant's undisputed assertions that the Respondent claiming to be the representative of the disputed domain names holders; (ii) the oral offer made to the Complainant's representative to transfer the disputed domain names for an amount exceeding the documented out-of-pockets costs related to the registration of the disputed domain names; and (iii) the Respondent's failure to provide a substantive response in the present proceeding in order to put forward any arguments in its favor. Such facts, together with all the other elements in this case, in the eyes of this Panel, supports a finding of bad faith behavior.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <illycaffe.ro> and <illy.ro> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: September 26, 2023