

## **ADMINISTRATIVE PANEL DECISION**

Ferrero S.p.A. v. Covenant Simon, Jenerouszy Mechanism  
Case No. D2024-2757

### **1. The Parties**

The Complainant is Ferrero S.p.A., Italy, represented by Studio Barbero S.p.A.

The Respondent is Covenant Simon, Jenerouszy Mechanism, Nigeria.

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

The disputed domain name <notella.site> is registered with Namecheap Inc (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 08, 2024. On July 08, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 08, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 15, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on July 16, 2024.

The Center verified that the Complaint together with 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 July 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 12, 2024. The Respondent sent an email communication to the Center on July 18, 2024. The Center sent the Possible Settlement email to the Parties on July 18, 2024. However, the Complainant did not wish to request suspension for settlement talks. On August 26, 2024, the Center commenced the appointment of the panel.

The Center appointed Shwetasree Majumder as the sole panelist in this matter on September 06, 2024. 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 is a leading chocolate producer and a confectionery company. The Complainant is the owner of the mark NUTELLA, under which it produces and sells hazelnut and chocolate products in several countries in the world.

The Complainant holds several registrations for the trademark NUTELLA, the details of some of which are as below:

- International Trademark Registration No. 281788 for **NUTELLA**, registered on March 31, 1964;
- International Trademark Registration No 1073241 for **nutella**, registered on January 27, 2011; and
- European Union Trademark Registration No. 009316878 for NUTELLA, registered on January 27, 2011

The Complainant's business website for its NUTELLA brand is at "www.nutella.com". The Complainant's domain name <nutella.com> was registered on April 2, 1997.

The disputed domain name was registered on May 23, 2024. The Respondent named Covenant Simon, is supposedly based in Nigeria. The disputed domain name resolves into a website where the Respondent promotes the sale of a cryptocurrency meme coin called \$NOTELLA. An altered version of the Complainant's NUTELLA chocolate jar can be seen on the Respondent's website. The Respondent's website also contains the text "*Ever wished your crypto could be as fun and tasty as Nutella?*" in conjunction with the word "notella".

On June 13, 2024, the Complainant had sent a cease and desist notice to the Respondent and demanded the transfer of the disputed domain name. The Respondent did not respond to the Complainant's letter.

#### 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 name.

Notably, the Complainant contends that that disputed domain name is identical/confusingly similar to its prior registered trademark NUTELLA. The Complainant contends its mark NUTELLA has been in use since 1964 and had acquired goodwill and reputation worldwide. Accordingly to the Complainant, the Respondent has indulged in typosquatting. The Complainant states that the Respondent has merely replaced the letter "U" in the mark NUTELLA with the letter "O", and has registered the disputed domain name.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the Respondent is attempting to create confusion in the minds of customers by representing itself as a person authorized to do business in the name of the Complainant or otherwise affiliated with the Complainant. According to the Complainant, the Respondent has no valid and subsisting rights in the mark NUTELLA. The Complainant argues that there is no justification on the Respondent's part to adopt the disputed domain name and that the Respondent cannot have been commonly known by the disputed domain name before any notice of the dispute. The Complainant argues that the Respondent's intent is to piggyback on the Complainant's goodwill and reputation. The Complainant has highlighted the fact that the Respondent's website uses an altered version of the NUTELLA jar to promote cryptocurrency

meme coin called \$NOTELLA, without providing a disclaimer on the lack of affiliation with the Complainant. The Complainant argues that such actions do not amount of a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name.

The Complainant claims that its mark NUTELLA is a well-known mark. In support of this contention, the Complainant has cited past UDRP decisions where the Complainant's mark NUTELLA was held to be a well-known mark.

On the third element of bad faith, the Complainant argues that the very adoption of the disputed domain name which is confusingly similar to the well-known mark NUTELLA constitutes bad faith on the Respondent's part. The Complainant argues that the Respondent clearly acted in opportunistic bad faith, by registering the disputed domain name with full knowledge of the Complainant's trademark for the purpose of taking commercial advantage of the Complainant's trademark. The Complainant asserts that the tagline "*Ever wished your crypto could be as fun and tasty as Nutella?*" on the Respondent's website, makes it clear that the Respondent was well aware of the Complainant's famous mark NUTELLA. According to the Complainant, the Respondent has knowingly attempted to attract Internet users to its website for commercial gain, by intentionally creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website and the business promoted on its website.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions. However, the Respondent sent an email dated July 18, 2024, which queried "*So what exactly do you want from me? Do you want to buy the domain?*"

## **6. Discussion and Findings**

As per paragraph 5(f) of the Rules where a respondent does not submit a formal response, in the absence of exceptional circumstances, the panel may decide the dispute based upon the Complaint. The Panel does not find any exceptional circumstances in this case preventing it from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a formal response. A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3.

It remains incumbent on the Complainant to make out its case in all respects under paragraph 4(a) of the Policy. Under paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements required under by a preponderance of evidence:

- i. the disputed domain name is 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 respect of the disputed domain name; and
- iii. the disputed domain name has been registered and is being used in bad faith.

### **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.

The Complainant has shown rights in respect of a trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7 and section 1.9.

The Panel agrees with the Complainant that the Respondent's conduct of registering the disputed domain name which is a misspelling of the Complainant's mark NUTELLA, constitutes as typosquatting.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. 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 name such as those enumerated in the Policy or otherwise.

The Panel has perused the past UDRP decisions cited by the Complainant in *RELX Group PLC v. Privacy service provided by Withheld for Privacy ehf / William brentjens, Blockchain*, WIPO Case No. [D2021-1137](#) and *Stefani Germanotta, Ate My Heart Inc. v. Super Privacy Service LTD c/o Dynadot / Asep Candra*, WIPO Case No. [D2022-1769](#). In these cases, the respondents' websites were offering cryptocurrency featuring the complainants' marks and the panel had held that such conduct is not legitimate and does not give rise of rights and legitimate interests to the concerned respondents. Similar facts exist in the present case. The Respondent is offering a cryptocurrency under a confusingly similar NOTELLA designation (and without a disclaimer on the lack of affiliation with the Complainant). The Complainant's mark NUTELLA is also seen to be used on the Respondent's website. The Panel finds that the Respondent's conduct is such that it cannot give them rights or legitimate interests in the disputed domain name.

In the absence of a response from the Respondent and its failure to counter the allegations of the Complainant coupled with its offer to sell the disputed domain name, the Panel cannot see how the Respondent can have rights or legitimate interests in the disputed domain name. The Panel has considered even in the absence of a Response whether the Respondent may seek to make a claim of some kind of fair use or parody, and determines that this is not the case, but rather finds that the Respondent is trying to draw people to its site by seeking to create some sort of association with the famous NUTELLA mark, thereby seeking to unfairly freeride on the Complainant's reputation and goodwill.

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 Respondent was well aware of the Complainant's well-known trademark at the time of registration and clearly acted in opportunistic bad faith, by registering the disputed domain name for the purpose of taking commercial advantage of the Complainant's trademark by intentionally creating a likelihood of confusion with the Complainant's trademark.

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.

The Panel finds that the Complainant's mark NUTELLA is a well-known mark. Further, the Respondent's website content makes it clear that the Respondent is aware of the Complainant's mark NUTELLA. [WIPO Overview 3.0](#), section 3.1.4. Therefore, the Panel finds that the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

### **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 name <notella.site> be transferred to the Complainant.

*/Shwetasree Majumder /*

**Shwetasree Majumder**

Sole Panelist

Date: September 20, 2024