

ADMINISTRATIVE PANEL DECISION

Ferrero S.p.A. v. Contact Privacy Inc. Customer 0162059052 / Cristofaro Gazzilli

Case No. D2022-0524

1. The Parties

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

The Respondent is Contact Privacy Inc. Customer 0162059052, Canada / Cristofaro Gazzilli, Italy, represented by Amendolito & Associati, Italy.

2. The Domain Name and Registrar

The disputed domain name <nutella.cloud> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 15, 2022. On February 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 16, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 17, 2022 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 amendment to the Complaint on February 17, 2022.

The Center verified that the Complaint together with the amendment to 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 the Respondent of the Complaint, and the proceedings commenced on February 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 14, 2022. The Response was filed with the Center on March 11, 2022. The Center sent a possible settlement email to the Parties on March 11, 2022. The Complainant did not request a suspension of the proceeding for settlement discussion. The Center informed

the Parties of its commencement of Panel appointment process on March 15, 2022.

The Center appointed Edoardo Fano as the sole panelist in this matter on March 23, 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.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is Ferrero S.p.A., an Italian company operating in the confectionary field that owns several trademark registrations for NUTELLA, including the following:

- Italian Trademark Registration No. 418059 for NUTELLA, registered on April 14, 1986;
- European Union Trade Mark No. 009316878 for NUTELLA, registered on January 27, 2011;
- Canadian Trademark Registration No. TMA157098 for NUTELLA, registered on June 7, 1968.

The Complainant operates on the Internet at the main website "www.nutella.com", as well as with many other generic Top-Level Domains ("gTLDs") and country code Top-Level Domains ("ccTLDs") including the trademark NUTELLA.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain name was registered on July 6, 2021 and it resolves to an undeveloped website.

On October 12, 2021, the Respondent, contacted by a web agency instructed by the Complainant in order to ascertain the possible availability to consider transferring the disputed domain name, requested EUR 2,000 for handing over the disputed domain name.

On October 22, 2021, the Complainant's representative sent a cease-and-desist letter to the Respondent, followed by reminders on November 16 and December 27, 2021, without receiving any reply.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is identical to its trademark NUTELLA.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademark within the disputed domain name, it is not commonly known by the disputed domain name, nor it is making a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since

the Complainant's trademark NUTELLA is distinctive and internationally known. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain name and the Complainant contends that the passive holding of the disputed domain names qualifies as bad faith registration and use. Furthermore, the Complainant contends that the fact the disputed domain name was offered for sale for a price in excess of the out-of-pocket costs directly related to the disputed domain name constitutes evidence of the Respondent's bad faith registration and use of the disputed domain name. Finally, the Complainant suspects that the Respondent might also use the disputed domain name in connection with the sending of email communications pretending to be sent by the Complainant or one of its affiliated entities, since the MX records attached to the disputed domain name have been activated.

B. Respondent

The Respondent concedes that the disputed domain name is identical to the Complainant's trademark.

The Respondent asserts to have rights or legitimate interests in respect of the disputed domain name since the latter was bought without intent for commercial gain to divert consumers or to tarnish the trademark at issue: as stated by the Complainant, the disputed domain name has been redirected to an undeveloped website and the Respondent has set up MX records with the only purpose to use the disputed domain name for personal mail communication.

When contacted by a possible buyer, the Respondent refused to sell the disputed domain name asking for a price higher than the one offered by the web agency, by doing so showing the intention not to resell it to a Complainant's competitor.

As soon as the Respondent received the Complaint, the disputed domain name transfer to the Complainant was offered for free, but the Complainant's representative refused it and never communicated with the Respondent in Italian, the Parties' common mother tongue.

Finally, the Respondent agrees to transfer the disputed domain name to the Complainant.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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. Consent to transfer

The Respondent appears to be willing to reach an agreement for the transfer of the disputed domain name.

Section 4.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") considers the following possibilities for the Panel to issue a decision on cases involving a respondent's informal or unilateral consent for the transfer of the disputed domain name:

"Where parties to a UDRP proceeding have not been able to settle their dispute prior to the issuance of a panel decision using the 'standard settlement process' described above, but where the respondent has nevertheless given its consent on the record to the transfer (or cancellation) remedy sought by the complainant, many panels will order the requested remedy solely on the basis of such consent. In such cases, the panel gives effect to an understood party agreement as to the

disposition of their case (whether by virtue of deemed admission, or on a no-fault basis).

In some cases, despite such respondent consent, a panel may in its discretion still find it appropriate to proceed to a substantive decision on the merits. Scenarios in which a panel may find it appropriate to do so include (i) where the panel finds a broader interest in recording a substantive decision on the merits – notably recalling UDRP paragraph 4(b)(ii) discussing a pattern of bad faith conduct, (ii) where while consenting to the requested remedy the respondent has expressly disclaimed any bad faith, (iii) where the complainant has not agreed to accept such consent and has expressed a preference for a recorded decision, (iv) where there is ambiguity as to the scope of the respondent's consent, or (v) where the panel wishes to be certain that the complainant has shown that it possesses relevant trademark rights.”

In the present case, the Panel finds appropriate to issue a decision on the merits, noting that the Complainant is not accepting the Respondent's consent for the transfer and it is entitled to what it has paid for.

B. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademark NUTELLA both by registration and acquired reputation and that the disputed domain name is identical to the trademark NUTELLA.

It is also well accepted that a gTLD, in this case “.cloud”, is typically ignored when assessing the similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain name is identical to the Complainant's trademark, pursuant to the Policy, paragraph 4(a)(i).

C. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a 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.”

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy is potentially quite difficult, since proving a negative circumstance is always more complicated than establishing a positive one. As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the

Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not commonly known by the disputed domain name and is not making a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain name, and the Panel is unable to establish any such rights or legitimate interests on the basis of the evidence in front of it.

The Respondent claims to be making a legitimate noncommercial and fair use of the disputed domain name for personal mail communications, but has provided no evidence of such use or explanation for the choice of the identical disputed domain name, wholly incorporating the Complainant's well-known trademark NUTELLA. Even if the Respondent had come forward with evidence of use, the Panel does not consider the appropriation of the trademark NUTELLA by the Respondent for his own personal use without consent would amount to a legitimate fair use in these circumstances. In this regard, the Panel finds that the composition of the disputed domain name carries a high risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.1.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

D. Registered and Used in Bad Faith

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

(i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

(ii) that [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) that [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location".

Regarding the registration in bad faith of the disputed domain name, the reputation of the Complainant's trademark NUTELLA is clearly established and the Panel finds that the Respondent likely knew of the Complainant and deliberately registered the disputed domain name.

As regards the use in bad faith of the disputed domain name, pointing to an undeveloped website, the Panel considers that bad faith may exist even in cases of so-called "passive holding", as found in the landmark UDRP decision *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In the circumstances of this case, the Panel finds that such passive holding amounts to bad faith. See [WIPO](#)

[Overview 3.0](#), section 3.3.

Moreover, since the MX records attached to the disputed domain name have been activated, the Panel deems that there is a risk that the disputed domain name could be used for phishing activities. However, even if the disputed domain name is not used in a more typical case of passing off as the Complainant or being associated with the Complainant, it is clear the Respondent has appropriated the Complainant's well-known trademark NUTELLA for his own purposes without consent. That kind of unilateral conduct does not qualify as registration or use in good faith under the Policy.

Finally, the Panel considers that the nature of the disputed domain name, which is identical to the Complainant's trademark, further supports a finding of bad faith. See, [WIPO Overview 3.0](#), section 3.2.1.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain name in bad faith.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

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 <nutella.cloud> be transferred to the Complainant.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: March 31, 2022