

ADMINISTRATIVE PANEL DECISION

Deoleo Global, S.A.U., Carapelli Firenze, S.p.A. v. Swiss Domain Trustee AG, SILVAN PETER BRUN
Case No. D2023-0554

1. The Parties

The Complainants are Deoleo Global, S.A.U., Spain (“First Complainant”), and Carapelli Firenze, S.p.A., Italy (“Second Complainant”), represented by Elzaburu, Spain.

The Respondents are Swiss Domain Trustee AG, and SILVAN PETER BRUN, both of Switzerland.

2. The Domain Names and Registrars

The disputed domain names <bertolli.blog>, <bertolli.store>, <carapelli.blog>, <carapelli.online>, <carapelli.shop>, <carapelli.store>, <carbonell.blog>, <carbonell.info>, <carbonell.shop>, <carbonell.store>, <deoleo.blog>, <deoleo.cloud>, <deoleo.store>, <oliosasso.blog>, <oliosasso.online>, <oliosasso.shop>, <oliosasso.store> (“Domain Names”) are registered with Ascio Technologies Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 6, 2023. On February 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On February 7, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (Swiss Domain Trustee AG and Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainants on February 9, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint or to file a separate Complaint for each of the Domain Names. The Complainants filed an amended Complaint on February 13, 2023.

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 Respondents of the Complaint, and the proceedings commenced on February 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 13, 2023. The Respondents did not submit any substantive response but sent informal communications on March 1 and 2, 2023. Accordingly, the Center notified the Respondents' default on March 17, 2023.

The Center appointed Nicholas Smith as the sole panelist in this matter on March 23, 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.

On April 12, 2023, the Panel issued Procedural Order 1 to the parties asking about the trade mark rights for BERTOLLI mark or any related mark.

On April 14, 2023, following a request by the Complainants for more time to comply with the Administrative Panel Order, the Panel extended the period for compliance until April 24, 2023, with the Respondent having until April 29, 2023 and the Panel having until May 11, 2023 to issue a decision. On April 24, 2023, following a request by the Complainants for even more time to comply with the Administrative Panel Order, the Panel extended the period for compliance until May 1, 2023, with the Respondent having until May 6, 2023 to respond and the Panel having until May 18, 2023 to issue a decision.

Notwithstanding the request for more time, on April 24, 2023, 2 hours after the Panel had granted the Complainants' request, the Center received a response from the Complainants being a signed letter from Mizkan America, Inc. confirming that the First Complainant is an exclusive worldwide Licensee of the BERTOLLI mark and that it was authorized to commence these proceedings in respect of the Domain Names corresponding to the BERTOLLI Mark. There was no response from the Respondent and the Panel has proceeded to issue its decision.

4. Factual Background

The Complainants are corporations that are part of the broader business group operated by Deoleo S.A ("Deoleo Group"). The Deoleo Group is a multinational food group focused on the production and sale of edible oils, vinegar, sauces and table olives. It owns a portfolio of leading olive oil brands around the world, a number of which are the subject of the proceeding. In 2019 the Deoleo Group held a 17% market share in the olive oil market in the United States.

The Complainants are the owner of trademark registrations for:

- trademarks consisting of the word "Deoleo" (the "DEOLEO Mark"), including (amongst other registrations) European Union Trade Mark Registration number 009821117 registered on July 7, 2011 for foodstuffs in classes 29, 30 and 31;
- trademarks consisting of the word "Carbonell" (the "CARBONELL Mark"), including (amongst other registrations) European Union Trade Mark Registration number 003178555 registered on August 2, 2004 for foodstuffs in classes 29, 30 and 31;
- trademarks consisting of the word "Carapelli" (the "CARAPELLI Mark"), including (amongst other registrations) International Registration number 546560 registered on January 15, 1990 for foodstuffs in classes 29, 30 and 31 and beverages in classes 32 and 33 and designating a variety of jurisdictions including Spain, France and Russian Federation; and
- trademarks consisting of the words "Sasso" (the "SASSO Mark"), including (amongst other registrations) European Union Trade Mark Registration number 006412944 registered on August 20, 2008 for foodstuffs in classes 29, 30 and 31.

The First Complainant is the authorized exclusive licensee worldwide for trademarks consisting of the word "Bertolli" (the "BERTOLLI Mark") owned by Mizkan America, Inc, including European Union Trade Mark Registration number 001471846 registered on April 19, 2001 for foodstuffs in classes 29 and 30.

In this decision the DEOLEO Mark, CARBONNELL Mark, CARAPELLI Mark, SASSO Mark and BERTOLLI Mark are collectively referred to as the “Complainant’s Marks”.

The Domain Names were all registered on either May 6, 2022 or June 10, 2022. The Domain Names each resolve to essentially identical websites (the “Respondent’s Websites”) maintained by the Respondents’ hosting provider and are otherwise inactive. On May 19, 2022 the Complainants sent a cease and desist letter to the Respondents in respect of the Domain Name <deoleo.blog>. The Respondents replied on May 31, 2022 indicating that they had registered the Domain Name <deoleo.blog> for the purpose of establishing a business relationship with the Complainants and asking the Complainants to make a proposal to purchase the Domain Name <deoleo.blog> from them.

Following the absence of any reply from the Complainants, the Respondents registered further Domain Names on June 10, 2022 and on September 26, 2022 sent an email to the Complainants offering the sale of all 17 Domain Names, each for EUR 50,000, a sum well in excess of any likely out of pocket costs incurred by the Respondents in respect of the Domain Names.

5. Parties’ Contentions

A. Complainants

The Complainants make the following contentions:

- (i) that the Domain Names are each identical or confusingly similar to the one of the Complainants’ Marks;
- (ii) that the Respondents have no rights nor any legitimate interests in respect of the Domain Names; and
- (iii) that the Domain Names have been registered and are being used in bad faith.

The Complainants are the owner of the DEOLEO Mark, CARBONNELL Mark, CARAPELLI Mark and SASSO Mark, having registered these marks in numerous jurisdictions, including in the European Union. The First Complainant is the exclusive licensee worldwide of the BERTOLLI Mark, which it uses for, amongst other things, olive oil. The Domain Names are identical or confusingly similar to the Complainant’s Marks as each of them reproduces one of the Complainants’ Marks in its entirety (along with a Top-Level Domain (“TLD”)).

There are no rights or legitimate interests held by the Respondents in respect of the Domain Names. The Respondents are not commonly known as any of the Domain Names, nor do the Respondents have any authorization from the Complainants to register any of the Domain Names. The Respondents are not making a legitimate noncommercial or fair use of the Domain Names. Rather the Domain Names resolve to parking pages and the Respondents are simply offering Domain Names for sale without any other use. Such use of the Domain Names cannot and does not constitute *bona fide* commercial use, sufficient to legitimize any rights and interests the Respondents might have in the Domain Names and therefore the Respondents have no rights or legitimate interests in the Domain Names under paragraph 4(c)(ii) of the Policy.

The Domain Names were registered and are being used in bad faith. The only possible motive held by the Respondents in registering the 17 Domain Names is for the purpose of selling, renting, or otherwise transferring the Domain Names to the Complainants or to a competitor of the Complainants, for valuable consideration in excess of the Respondents’ documented out-of-pocket costs directly related to the Domain Names. The Domain Names were registered with the Complainant in mind, in that they each correspond to a separate mark registered by the Complainant and indeed several of the Domain Names were registered after the receipt of a response to a cease-and-desist letter sent by the Complainants. The Respondents have engaged in a pattern of conduct, having registered 17 Domain Names corresponding to the Complainants’ Marks in order to prevent the Complainants from reflecting those marks in a domain name. Such conduct constitutes bad faith registration and use under paragraph 4(b)(i) of the Policy.

B. Respondents

On March 1 and 2, 2023, the Respondents provided informal replies to the Notice of Complaint requesting notice be sent by postal service. The Respondents did not reply to the Complainants' contentions. The Panel notes that the Notification of the Complaint was sent to the Respondents' addresses by postal service and no formal Response has been received.

6. Discussion and Findings

6.1. Preliminary Matters

A. Consolidation of Complainants

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) provides at section 4.11.1, in respect of the issue “Multiple complainants filing against a single respondent” that:

“Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.”

The present proceeding involves two Complainants bringing a single complaint in respect of 17 Domain Names corresponding to five different trademarks that they claim to have rights in. The Complainants have made a request for consolidation and bear the onus of establishing that such a consolidation is justified.

The Panel is satisfied, based on the material filed, that the Complainants have a specific common grievance against the Respondent, in that the Complainants are related entities that are part of the same business group that have a specific common grievance against the Respondent, namely that the Respondent has registered Domain Names corresponding to various trademarks that they have rights to and has made a collective offer to the Complainants to sell the Domain Name to the Complainants for a significant sum.

The Panel has considered whether it would be equitable and procedurally efficient to permit the consolidation. The Panel finds that it is equitable and procedurally efficient to grant the Complainants' request for consolidation and grants the request. As such, for the remainder of the decision, the Panel will refer to the entities bringing the Complaint as a single Complainant.

B. Consolidation of Respondents

As identified in section 1 above there are two named registrants of the Domain Names. UDRP proceedings are normally brought against a single respondent. However, paragraph 10(e) of the Rules states that in certain circumstances a panel may consolidate multiple domain name disputes. The [WIPO Overview 3.0](#), section 4.11.2, states:

“Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

UDRP Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of

- (i) the registrants' identity(ies) including pseudonyms,
- (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities,
- (iii) relevant IP addresses, name servers, or webhost(s),
- (iv) the content or layout of websites corresponding to the disputed domain names,
- (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector),
- (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>),
- (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue,
- (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s),
- (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s),
- (x) any (prior) pattern of similar respondent behaviour, or
- (xi) other arguments made by the complainant and/or disclosures by the respondent(s)."

Based on the information before it, the Panel is prepared to allow the consolidation of the proceedings against the named registrants on the basis that the Domain Names are under common control. The Domain Names were registered on the same 2 days, with the same Registrar. They share the same name servers and resolve to essentially identical Respondent's Websites. It would be implausible for two unconnected entities to register 17 domain names corresponding to 5 separate trademarks that an entity has rights in with the same set of TLDs with the same Registrar. Furthermore, the Panel notes that a single entity contacted the Complainant seeking to sell all 17 Domain Names.

Finally, the Panel notes that none of the named registrants have denied any association with the other or objected to the consolidation of the proceedings requested by the Complainant. The Panel finds that, on the balance of probabilities, the Domain Names are subject to common control and that the consolidation would be fair and equitable to all the Parties. As such, for the remainder of the Decision, the Panel will refer to the named registrants of the Domain Names as a single Respondent.

6.2. Substantive Matters

A. Identical or Confusingly Similar

To prove this element the Complainant must have trade or service mark rights and each Domain Name must be identical or confusingly similar to the Complainant's trade or service mark.

The Complainant is the owner of the Complainant's Marks save the BERTOLLI Mark, having registrations for the Complainant's Marks (save the BERTOLLI Mark) as a trademark in the European Union as well as in various other jurisdictions.

The First Complainant is the licensee of the BERTOLLI Mark. Section 1.4. of [WIPO Overview 3.0](#) provides in response to the question: Does a trademark owner's affiliate or licensee have standing to file a UDRP complaint? that:

"A trademark owner's affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint.

While panels have been prepared to infer the existence of authorization to file a UDRP case based on the facts and circumstances described in the complaint, they may expect parties to provide relevant evidence of authorization to file a UDRP complaint.

In this respect, absent clear authorization from the trademark owner, a non-exclusive trademark licensee would typically not have standing to file a UDRP complaint.”

In the present case, as the Panel has clear evidence that the Complainant is the exclusive worldwide licensee of the BERTOLLI Mark and has written authorization to file these UDRP proceedings concerning the Domain Names corresponding to the BERTOLLI Mark, the Panel finds that the Complainant has satisfied this requirement of the Policy.

Disregarding the TLD as a necessary element of a domain name, the Domain Names other than <oliosasso.blog>, <oliosasso.online>, <oliosasso.shop>, <oliosasso.store> are identical to one of the Complainant’s Marks. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied for the Domain Names other than <oliosasso.blog>, <oliosasso.online>, <oliosasso.shop>, <oliosasso.store>.

In considering <oliosasso.blog>, <oliosasso.online>, <oliosasso.shop>, <oliosasso.store>, the Panel finds that, disregarding the TLD as a necessary element of a domain name, each of these domain names is confusingly similar to the SASSO Mark as each domain name reproduces the SASSO Mark in its entirety along the term “olio”, which is the Italian word for “oil”, a product sold by the Complainant under the SASSO Mark. Other UDRP panels have repeatedly held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element; see section 1.8 of the [WIPO Overview 3.0](#).

The Panel finds that each of the Domain Names is identical or confusingly similar to one of the Complainant’s Marks. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

“Any of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (1) 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
- (2) 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
- (3) 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.” (Policy, paragraph 4(c)).

The Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the Domain Names or to seek the registration of any domain name incorporating the Complainant’s Marks or a mark similar to any of the Complainant’s Marks. There is no evidence that the Respondent is commonly known by the Domain Names or any similar names. There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Names in connection with a legitimate noncommercial fair use or a *bona fide* offering of goods and services; the use of the Domain Names for the Respondent’s Websites, being parking pages maintained by the hosting provider,

does not, in the absence of other evidence, amount to use for a *bona fide* offering of goods and services. Nor does holding the Domain Names and making offers to sell the Domain Names for sums greater than out-of-pocket costs. Moreover, the identical replication of the Complainant's Marks in a number of the Domain Names, without modification, carries high risk of implied affiliation, which cannot constitute fair use.

The Complainant has established a *prima facie* case that the Respondent lacks rights or interests in the Domain Names. The Respondent has had an opportunity to rebut the presumption that it lacks rights or legitimate interests but has chosen not to do so. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Names under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

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 or use of a domain name in bad faith:

- (i) "circumstances indicating that you have registered or you have 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 that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of the complainant; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location." (Policy, paragraph 4(b)).

The Panel finds that it is likely that the Respondent was aware of the Complainant and its reputation in the Complainant's Marks at the time each of the Domain Names was registered by the Respondent. It is improbable that an entity would register 17 Domain Names that each incorporate one of the Complainant's Marks without having some awareness of the Complainant's mark rights. This is especially the case given that the majority of the Domain Names were registered after the receipt of a cease-and-desist letter sent by the Complainant. The Respondent has provided no explanation, nor is one apparent to the Panel, as to why an individual would register the 17 Domain Names other than by reason of their resemblance to the Complainant's Marks. In the circumstances, the registration of the Domain Names in awareness of the Complainant's Marks and in the absence of rights or legitimate interests amounts to registration in bad faith.

Furthermore, since registration the Respondent has made a series of communications to the Complainant either prompting an offer to purchase the Domain Names or offering to sell the Domain Names to the Complainant for significant sums far greater than any out-of-pocket costs. The existence of those offers, along with the lack of any evidence supporting any other explanations as to the possible (legitimate) use of the Domain Names, leads the Panel to conclude that the Respondent registered the Domain Names for the purpose of selling them for an amount in excess of its out-of-pocket costs. Pursuant to 4(b)(i) of the Policy the Respondent has registered and used the Domain Names in bad faith.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Names in bad faith under paragraph 4(a)(iii) 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 Domain Names, <bertolli.blog>, <bertolli.store>, <carapelli.blog>, <carapelli.online>, <carapelli.shop>, <carapelli.store>, <carbonell.blog>, <carbonell.info>, <carbonell.shop>, <carbonell.store>, <deoleo.blog>, <deoleo.cloud>, <deoleo.store>, <oliosasso.blog>, <oliosasso.online>, <oliosasso.shop>, <oliosasso.store> be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: May 10, 2023