

## **ADMINISTRATIVE PANEL DECISION**

Marchesi 1824 S.r.l. v. Yan Song  
Case No. D2023-2778

### **1. The Parties**

The Complainant is Marchesi 1824 S.r.l., Italy, represented by Studio Barbero S.p.A., Italy.

The Respondent is Yan Song, China.

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

The disputed domain name <marchesi1824.com> is registered with 22net, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 29, 2023. On June 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 3, 2023, 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 (Not available) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 3, 2023, 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 in English on July 4, 2023.

On July 3, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On July 3, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on July 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 4, 2023.

The Center appointed Andrew Sim as the sole panelist in this matter on August 21, 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 is an Italian company that operates Italian patisseries serving handmade confections, including desserts, cakes, pastries, chocolate and other traditional delicacies. Originally founded in Milan, Italy in 1824, the Complainant has in recent years expanded its business and has opened additional locations in Milan and London, as well as temporary pop-up sites in Miami.

The Complainant is the owner of various marks for MARCHESI and MARCHESI 1824 (the “Marks”), including the following:

Mark	Registration Details
	<ul style="list-style-type: none"> <li>- European Union Trademark No.001748284, in class 30, filed on July 10, 2000, and registered on November 20, 2001.</li> </ul>
	<ul style="list-style-type: none"> <li>- European Union Trademark No. 000779884, in the same class, filed on March 23, 1998, and registered on December 15, 1999;</li> <li>- European Union Trademark No. 013976337, in classes 8,11,16, 21, 29, 30, 35, and 43, filed on April 22, 2015, and registered on September 10, 2020; and</li> <li>- Chinese Trademark Registration No.16582736 in class 30, filed on March 27, 2015, and registered on May 14, 2016 (collectively, the “Marks”).</li> </ul>

The Complainant also owns several domain names consisting of or comprising MARCHESI and MARCHESI 1824 marks, including <marchesi1824.it>, registered on October 25, 2000. It also owns the domain name <pasticceriamarchesi.com>, registered on October 14, 1999, which it uses to host its primary website “www.pasticceriamarchesi.com”.

The disputed domain name was registered on May 29, 2019, which previously resolved to a parking page with sponsored links. At the time of the Complaint and this Decision, the disputed domain name redirects the Internet users to a website where the disputed domain name is offered for sale and it is possible to submit an offer for it.

Upon becoming aware of the disputed domain name, the Complainant instructed a web agency in December 2020 to investigate the disputed domain name, during which the web agency received a request from the Respondent (through a user signing as “Peter”) for a sum of EUR 9,500 for the disputed domain name. Upon further exchanges of correspondence, the Respondent rejected the web agency’s offer of a sum in line with the out-of-pocket costs of the disputed domain name, and requested not less than EUR 8,000 for the transfer of the disputed domain name. Subsequent to these contacts, the Complainant sent Cease and Desist letters to the Respondent on ten occasions throughout January 2021 to June 2023 through the email address at the time indicated in the public Whois records of the disputed domain name, as well as the email address used in responding to the web agency, to which there has been no reply.

## 5. Parties' Contentions

### A. Complainant

The Complainant contends that (i) the disputed domain name is identical or confusingly similar to the Marks 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 was registered and is being used in bad faith.

Firstly, the Complainant contends that the disputed domain name is identical or at least confusingly similar to each of the Marks in which the Complainant has rights. For the MARCHESI 1824 mark, the disputed domain name entirely reproduces its dominant portion consisting of the denominative element "marchesi 1824" and without any alteration which might distinguish the disputed domain name from the core of the Marks. As for the MARCHESI marks, the disputed domain name is again confusingly similar as it entirely reproduces the denominative element "marchesi" with the mere addition of the numbers "1824". The Complainant further submits that the addition of the generic Top-Level Domain ("gTLD") suffix ".com" should be disregarded in the assessment of confusing similarity.

Secondly, the Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name as the Complainant has not licensed nor allowed the Respondent to use the Mark.

The Complainant also believed that the Respondent has no registered trademarks using the term "marchesi 1824" or "marchesi" or any other legitimate connections to these terms. Further, there is no evidence to suggest that the Respondent is using the disputed domain name in connection with any *bona fide* offering of goods or services or any other legitimate noncommercial or fair use. Instead, the disputed domain name was originally redirected to a webpage displaying sponsored links, which would generate revenues to the domain holder via the pay-per-click system. As further submitted by the Complainant, the finding that there is no *bona fide* offering of goods or services or any other legitimate noncommercial or fair use is reinforced by the fact that the disputed domain name currently redirects to a platform where it is offered for sale and such offers made to the Complainant exceeded the out-of-pocket costs.

Thirdly, the Complainant contends that the disputed domain name was registered and is being used in bad faith. As the disputed domain name encompasses MARCHESI mark in combination with the Complainant's year of foundation (namely, 1824), this could not have been a mere coincidence and in view of the extensive use and publication of the Marks throughout the years, the Respondent could not have possibly ignored the existence of the Marks at the time of registration. With respect to bad faith use, the disputed domain name previously pointed to a webpage with several sponsored pay-per-click links, which redirected Internet users to third parties' websites. As a result, the Respondent may have gained commission whenever an Internet user visited the website and clicked on one of the sponsored links. Further, the disputed domain name currently redirects to a webpage where it is offered for sale and it is possible to submit an offer. In this regard, the previously requested sum of not less than EUR 8,000 for transferring the disputed domain name to the Complainant was well in excess of the out-of-pocket costs directly related to the disputed domain name. Based on the above, the Complainant considers that the Respondent registered the disputed domain name for commercial gain and with the purpose of selling it, in all likelihood to the legitimate trademark owner, for valuable consideration. The Respondent's failure to respond to the Complainant's Cease and Desist letters further supports a finding a bad faith.

### B. Respondent

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

## 6. Discussion and Findings

### 6.1 Procedural Matter - Language of the Proceeding

The Rules, in paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement between the respondent and the registrar in relation to the disputed domain name, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. According to the information received from the Registrar, the language of the Registration Agreement for the disputed domain name is Chinese.

The Complainant submits that the language of the proceeding should be English. The Complainant contends that the Complainant communicates in English and requiring the Complainant to translate the Complaint into Chinese would cause delay. Further, during the previous recovery activities by the Complainant, the Respondent had replied in English to the communications sent by the web agency instructed by the Complainant, which showed the Respondent's familiarity with English and its ability to communicate in the language. The Complainant also noted other factors, including that the disputed domain name is registered in Latin characters and its redirection to an English webpage offering it for sale. Further, the Respondent also registered the disputed domain name with the gTLD ".com", revealing an intention to target an audience of English-speaking users.

In exercising its discretion to use a language other than that of the Registration Agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time, and costs.

The Panel accepts the Complainant's submissions regarding the language of the proceeding. The Complainant may be unduly disadvantaged by having to conduct the proceeding in Chinese. The Panel further notes that the Center has notified the Respondent in both Chinese and English of the language of the proceeding and the commencement of the proceeding. The Respondent chose not to comment on the language of the proceeding or respond to the Complaint in either English or Chinese. Having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

### 6.2 Substantive Matter – Three Elements

Under the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which it 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

The Complainant has established that it has registered trademark rights in the Marks.

As relied upon by the Complainant in the Complaint, the test for confusing similarity involves a reasoned but relatively straightforward comparison between the Marks and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the Marks to assess whether the Marks are recognizable within the disputed domain name. As indicated in section 1.10 of the WIPO Overview of the WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), design elements incapable of representation in domain names would be largely disregarded for purposes of assessing identity or confusing similarity.

The Panel agrees with the Complainant's submissions. The disputed domain name incorporates the whole of the denominative element of the MARCHESI 1824 mark. As for the MARCHESI mark, it also reproduces the denominative element in the mark of with the mere addition of numbers "1824". The addition of the numbers "1824" does not prevent a finding of confusing similarity. See *International Business Machines Corporation v. Yang Yang*, 657668, WIPO Case No. [D2020-3158](#).

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

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

The Complainant has confirmed that it is not associated with the Respondent in any way, nor has it licensed nor allowed the Respondent to use the Marks. The Respondent is also not known to be associated with the Marks. Moreover, there is no evidence showing that the Respondent has been commonly known by the disputed domain name in any manner.

In addition, the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. As submitted by the Complainant, the disputed domain name initially directed to a webpage displaying sponsored links to third-party websites which would generate revenues via the pay-per-click system to the disputed domain name holder. In this regard, section 2.9 of the [WIPO Overview 3.0](#) provides that unless "genuinely related to the dictionary meaning" of the disputed domain name, "[pay-per-click] links do not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users". The Panel considers that this principle applies in this case and there is no evidence that the pay-per-click links in question fall within the exception stated in section 2.9 of the [WIPO Overview 3.0](#).

Further, at the time of filing the Complaint, the disputed domain name redirects to a platform where it is offered for sale and it is possible for a user to submit an offer for the disputed domain name. This cannot be considered a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name, particularly where the Marks are fully incorporated in the disputed domain name. See, e.g., *Hertz System, Inc. v. Super Privacy Service LTD c/o Dynadot / domain admin*, WIPO Case No. [D2021-3419](#).

The Panel considers that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and accordingly, the burden of production shifts to the Respondent to establish its rights or legitimate interests in the disputed domain name. (See, e.g., *Nakheel PJSC v. Shabina Ghani Aqeel*, WIPO Case No. [DAE2019-0003](#)). Since the Respondent failed to submit a response, the Panel concludes that the Respondent has not rebutted the Complainant's *prima facie* case to answer to these allegations.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

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

The Complainant has had registered rights in the Marks since 1999, whereas the Respondent registered the disputed domain name in 2019. As submitted by the Complainant and also noted by the Panel in section 6.2A above, the disputed domain name comprises the Marks and since the Marks are not a generic or descriptive term, the Panel finds it more likely than not that the Respondent was aware of the Marks at the time the disputed domain name was registered. The Panel therefore considers that the Respondent's likely awareness of the Complainant's rights in the Marks at the time of registration suggests bad faith. See, e.g., *Accor, So Luxury HMC v. Youness Itsmail*, WIPO Case No. [D2015-0287](#).

Separately, the disputed domain name has also been used for competing pay-per-click links and was offered for sale. In the recovery efforts by the Complainant, the Respondent offered to sell it to the Complainant at a

price of not less than EUR 8,000. The Panel agrees with the Complainant's observation that this was likely far in excess of the out-of-pocket costs directly related to the disputed domain name. Applying paragraph 4(b)(i) of the Policy, registering or acquiring a domain name for the purpose of selling, renting, or otherwise transferring the domain name registration to a trademark owner for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name is an indication of registration and use of the relevant domain name in bad faith.

Having considered the circumstances above, the Panelist believes that the Complainant has made out its case that the disputed domain name was registered and is being used 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 disputed domain name <marchesi1824.com> be transferred to the Complainant.

*/Andrew Sim/*

**Andrew Sim**

Sole Panelist

Date: September 4, 2023