

ADMINISTRATIVE PANEL DECISION

ALPI U.S.A., Inc. v. ALEXANDRO ANTINUCCI, MATINDUSTRIE
Case No. D2023-4413

1. The Parties

Complainant is ALPI U.S.A., Inc., United States of America (“United States”), represented by Herrick, Feinstein LLP, United States.

Respondent is ALEXANDRO ANTINUCCI, MATINDUSTRIE, United States of America, represented by Suero Law, PLLC, United States.

2. The Domain Name and Registrar

The disputed domain name <alpi-usa.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2023. On October 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 30, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on November 1, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on November 6, 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 Respondent of the Complaint, and the proceedings commenced on November 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2023. Upon request from the representative for Respondent, the Center extended the due date for filing the Response to December 24, 2023. The Center did not receive a formal response and notified the parties on January 2, 2024, of the panel commencement process.

The Center appointed Lorelei Ritchie as the sole panelist in this matter on January 8, 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.

The Decision due date was extended to January 29, 2024, due to exceptional circumstances.

4. Factual Background

Complainant is a company based in the state of New York, in the United States. For several decades, Complainant has used the marks ALPI and ALPI USA in connection with its freight forwarding services. Complainant owns several registered trademarks for its ALPI and ALPI USA marks. These include, among others, United States Trademark Registration No. 1,973,009 (registered May 7, 1996) for ALPI, and United States Trademark Registration No. 3,157,573 (registered October 17, 2006) for ALPI USA, and including a disclaimer of exclusive right to use the term “USA” apart from the mark as shown.

The disputed domain name was registered on November 21, 2020. The disputed domain name is linked to an active website through which Respondent advertises and communicates with consumers about its transportation services offered under the name ALPI USA in the state of Florida, in the United States. Respondent further has a business license, issued by the Florida Department of State, Division of Corporations on January 1, 2021, to operate under the trade name ALPI USA, LLC. Respondent has no affiliation with Complainant, nor any license to use its marks.

5. Parties’ Contentions

A. Complainant

Complainant contends that (i) the disputed domain name is identical or confusingly similar to Complainant’s trademarks, (ii) Respondent has no rights or legitimate interests in the disputed domain name; and (iii) Respondent registered and is using the disputed domain name in bad faith.

Specifically, Complainant contends that it owns registrations for the ALPI and ALPI USA marks, which Complainant uses in connection with its freight forwarding services, based in the United States, and which is included in Complainant’s own domain name <alpiusa.com>.

Complainant contends that Respondent has similarly incorporated Complainant’s ALPI and ALPI USA marks into the disputed domain name, with the addition only of a hyphen. Complainant submitted evidence that Respondent is using the disputed domain name to advertise the services of its business. Complainant further submitted evidence that Respondent’s business is registered under the name ALPI USA, LLC with the Florida Department of State, Division of Corporations. Complainant contends, nevertheless, that Respondent has no right or legitimate interest in use of the disputed domain name, but rather has registered and used it in bad faith to disrupt Complainant as a “competitor” in the business of freight forwarding.

B. Respondent

Respondent did not respond to the contentions in the Complaint.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel must first determine whether the disputed domain name <alpi-usa.com> is identical or confusingly similar to a trademark or service mark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

The Panel finds that it is. The disputed domain name effectively incorporates in full Complainant's registered ALPI and ALPI USA marks. With just the addition of hyphen, the disputed domain name is likely to be perceived by consumers as having a similar appearance, and an identical pronunciation, connotation, and commercial impression. Numerous UDRP panels have further agreed that supplementing or modifying a trademark with generic or descriptive words, including with the addition of a hyphen, does not make a domain name any less "identical or confusingly similar" for purposes of satisfying this first prong of paragraph (4)(a)(i) of the Policy. See, for example, *Microsoft Corporation v. Step Web*, WIPO Case No. [D2000-1500](#) (<microsofthome.com>); *Wal-Mart Stores, Inc. v. Horoshiy, Inc.*, WIPO Case No. [D2004-0620](#) (<walmartbenefits.com>); *General Electric Company v. Recruiters*, WIPO Case No. [D2007-0584](#) (<ge-recruiting.com>).

The Panel therefore finds that Complainant has satisfied the first UDRP element, in showing that the disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights in accordance with paragraph (4)(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel next considers whether Complainant has shown that Respondent has no "rights or legitimate interest" as must be proven to succeed in a UDRP dispute. Paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name. These examples include:

- (i) use of the domain name "in connection with a *bona fide* offering of goods or services";
- (ii) demonstration that respondent has been "commonly known by the domain name"; or
- (iii) "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".

Complainant has submitted evidence that Respondent is using the disputed domain name to advertise Respondent's services offered under its trade name, ALPI USA. Complainant has also submitted evidence that Respondent has a business license, issued by the Florida Department of State, Division of Corporations on January 1, 2021, to operate as ALPI USA, LLC, and that Respondent has further filed annual reports with regard to this business in the years 2022 and 2023.

Therefore, although Respondent has no license from, or other affiliation with, Complainant, the Panel finds that there is sufficient evidence in the record, as submitted by Complainant, of Respondent's "rights or legitimate interests" in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy. Complainant cannot prevail in this UDRP proceeding without establishing Respondent's lack of "rights or legitimate interests" in the disputed domain name. Nevertheless, for completeness, the Panel proceeds with an analysis of the third element.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides examples of evidence that may indicate "bad faith" registration and use of a disputed domain name. These include:

- (i) circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the disputed domain name; or
- (ii) that Respondent has registered the disputed 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Complainant has not carried its burden of proving that Respondent registered and used the disputed domain name in bad faith within the meaning of the Policy. By Complainant's own admission, Respondent uses the disputed domain name to advertise Respondent's ALPI USA transportation services, a business for which Respondent appears to operate via a valid license from the State of Florida. Complainant appears to allege that Respondent registered its very business name in order to disrupt the competitive services offered by Complainant. However, although Complainant has provided evidence of cease and desist letters sent to Respondent dated December 30, 2022, the correspondence is dated after the registration by Respondent of its business license with the State of Florida in 2021, and after the registration by Respondent of the disputed domain name in 2020.

In summary, while Complainant has established rights to its registered ALPI and ALPI USA marks, Complainant has conversely also established a legitimate use of the disputed domain name by Respondent. The record lacks evidence of bad faith in the registration and use of the disputed domain name. Whether Complainant could make out a case for trademark infringement against Respondent in a court of law or other forum based on prior use of a confusing mark is a separate inquiry, outside the contemplation of this UDRP proceeding.

The Panel finds that Complainant has failed to establish that Respondent registered and used the disputed domain name in bad faith under paragraph (4)(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Lorelei Ritchie/

Lorelei Ritchie

Sole Panelist

Date: January 23, 2024