

## **ADMINISTRATIVE PANEL DECISION**

**Roberto Industria Alimentare S.r.l. v. Internet Administrator, Reflex Publishing, Inc.**  
**Case No. D2023-4528**

### **1. The Parties**

The Complainant is Roberto Industria Alimentare S.r.l., Italy, represented by Società Italiana Brevetti S.p.A., Italy.

The Respondent is Internet Administrator, Reflex Publishing, Inc., United States of America (“United States”), represented by John Berryhill, United States.

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

The disputed domain name <roberto.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 31, 2023. On October 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 2, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 November 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 5, 2023. The Response was filed with the Center on November 17, 2023.

The Center appointed Antony Gold, Ahmet Akgüloğlu, and Pablo A. Palazzi as panelists in this matter on December 11, 2023. The Panel finds that it was properly constituted. Each member of 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 long-established company, based in Italy, which specializes in bakery products. It has traded as ROBERTO since at least 1968, and it owns a number of trade marks to protect this trading style. These include, by way of example only, International Trade Mark registration number 547602, in class 30, registered on February 5, 1990, and designating 15 countries in Europe. It also owns and operates the domain name <robertoalimentare.com> which resolves to a website providing information about the Complainant and its products.

The Respondent is an Internet publishing business, based in the United States. It registered the disputed domain name on April 30, 1998, and it resolves to a website containing hypertext pay-per-click (“PPC”) links grouped under a number of categories such as “People Search”, “Public Records”, “Personalized Gifts”, and “Baby Names”.

On October 7, 2021, a representative of the Complainant sent an email to the Respondent noting that it was the owner of the disputed domain name and asking if it was possible to buy it. On October 14, 2021, the Respondent replied stating that the disputed domain name was not on the market for sale but, if the Complainant wished to put forward an offer, it would be put to the company’s ownership for consideration. The Complainant responded on the same day making an offer of USD 1,000 for the disputed domain name. The Respondent replied on the same October 21, 2021, stating that the offer would not move the Respondent to consider selling the disputed domain name.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant says that the disputed domain name is identical or confusingly similar to a trade mark in which it has rights. It refers to its portfolio of ROBERTO marks, full details of one of these marks having been set out above, and says that the disputed domain name reproduces entirely the Complainant’s ROBERTO mark and is therefore identical to it.

The Complainant asserts also that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Complainant has not given its consent to the Respondent’s registration or use of the disputed domain name. The Respondent does not own any trade mark applications or registrations for ROBERTO, nor is it making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain. The Respondent has chosen to use the Complainant’s well known trade mark in the disputed domain name in order to divert Internet users from the Complainant’s website by capitalizing on the association of ROBERTO with the Complainant’s products. The disputed domain name does not resolve to an active website and passive holding of the disputed domain name does not constitute a legitimate interest in it.

Lastly, the Complainant says that the disputed domain name was registered and is being used in bad faith. At the time of registration of the disputed domain name in 1998, the Complainant’s business was well-established and it is clear that the Respondent knew or should have known of the existence of the Complainant’s earlier trade marks. In fact, the Respondent could not have been unaware of it, given the Complainant’s reputation and the fact that the disputed domain name wholly incorporates its ROBERTO trade mark. “ROBERTO” is not a common or descriptive term but is obviously a trade mark in which the Complainant has rights. Moreover, the inactive status of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding.

##### **B. Respondent**

The Respondent acknowledges that the Complainant has satisfied the first element of the Policy, but notes that there are other owners in various jurisdictions of trade marks for ROBERTO. The Respondent says that

the disputed domain name is an exceptionally common male name. An Italian website states that it is the 19th most common name in Italy with 0.805 per cent of the population named “Roberto”. Another website states that approximately 95,000 people in the United States are named “Roberto”.

The Respondent asserts that it has rights or legitimate interests in the disputed domain name. It commenced using it 22 years ago to provide telephone directory services. The Respondent is well known as a registrant of domain names comprising common dictionary words and names, such as <bag.com>, <gradschool.com>, and <lampoon.com> and has successfully defended its registration of these domain names in proceedings under the Policy. The fact that “Roberto” is a common name is reinforced by the disambiguation page in the English version of Wikipedia which lists dozens of famous persons named “Roberto”. Contrary to the Complainant’s assertion, the Respondent is making active use of the disputed domain name. It submits archived webpages showing its use of the disputed domain name from the early 2000s to date, which establish that it has been making use of it in contexts which do not have any connection with the Complainant and, currently, are the same in nature as the use it is making of domain names it holds for other personal names such as <matthew.com>, <eliza.com>, and <helen.com>.

The mere registration and monetization of common words and personal names as domain names is not an illegitimate practice unless there is reason to infer some element of targeting of a complainant’s mark. “Roberto” is more well known as a male name than as a mark owned by the Complainant. There is no reason to believe that the Respondent had any purpose in mind other than registering and using the disputed domain name because of its characteristics as a common male name which had nothing to do with the Complainant and its small bakery business in Italy.

The Respondent denies that it has registered or used the disputed domain name in bad faith. The Respondent has been, and is, located in Florida, United States and has no duty or reason to be aware of the Complainant. The Complainant had no United States trade mark at the time, and the Respondent registered the disputed domain name for the obvious reason that it is a valuable common name. The Respondent’s only uses of the disputed domain name have been consistent with that fact. Nor is there anything improper in the Respondent’s rejection of the Complainant’s low offer for the disputed domain name. The inadequacy of the offer is evident from the fact that, in 2022, <laura.com> sold for USD 250,000 and <elmer.com> sold for USD 125,000. The institution of these proceedings following the Respondent’s rejection of the Complainant’s offer of USD 1,000 is a Plan B strategy which points towards a finding of Reverse Domain Name Hijacking (“RDNH”).

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy requires that the Complainant proves each of the following three elements in respect of the disputed domain name in order to succeed in its Complaint: (i) the disputed domain name is identical or confusingly similar to a trade mark 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. 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 trade mark and the disputed domain name. See the WIPO Overview of WIPO Panel View on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of its ROBERTO trade mark for the purposes of the Policy. See the [WIPO Overview 3.0](#), section 1.2.1. As a technical requirement of registration, the generic Top-Level Domain (“gTLD”) that is “.com” in the case of the disputed domain name, is usually disregarded when assessing identity or confusing similarity. The Complainant’s mark is reproduced in its entirety within the disputed domain name, and it contains no additional characters.

The disputed domain name is accordingly identical to the Complainant's mark.

For the above reasons, the Panel finds that the first element of the Policy has been established.

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

In the light of the finding made by the Panel below in relation to bad faith registration, it is unnecessary for the Panel to consider the second element of the Policy.

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

As at the date of registration of the disputed domain name in April 1998, the Respondent was (and it remains) a business located in the United States. The Complaint does not provide any information as to the extent of the Complainant's repute in its ROBERTO mark as at 1998, nor at any proximate date, save for the fact that, by that date, it had registered two International Trade Mark Registrations designating many countries in Europe. The mere existence of these marks, however, without any other evidence, does not serve to establish that the Complainant had a reputation in Europe for ROBERTO as at the material date. Moreover, the Complainant has not adduced any evidence at all to demonstrate that the Complainant had a repute in the United States as at the date of registration of the disputed domain name nor at any subsequent date.

Whether a respondent might have been expected to be aware of a complainant and its mark is discussed at section 3.2.2 of the [WIPO Overview 3.0](#) which explains that where a complainant's mark is widely known and a respondent cannot credibly claim to have been unaware of it (particularly in the case of domainers), panels have been prepared to infer that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Section 3.2.2 adds, however, that, "[...] where the complainant's mark is not inherently distinctive and it also corresponds to a dictionary term or is otherwise inherently attractive as a domain name [...], if a respondent can credibly show that the complainant's mark has a limited reputation and is not known or accessible in the respondent's location, panels may be reluctant to infer that a respondent knew or should have known that its registration would be identical or confusingly similar to the complainant's mark". See also, for example, *82 s.r.l. v. Chris Grivas*, WIPO Case No. [D2018-1918](#).

It follows that the consensus position reflected at section 3.2.2 of the [WIPO Overview 3.0](#) is not supportive of the Complainant's position. First, there is a complete absence of evidence that the Complainant's mark was so widely known so as to lead the Panel to infer that the Respondent either knew of it or should have found out about it. Second, as a known first personal name in many countries, it is open as to whether the Complainant's mark is inherently distinctive. There is no basis for finding that the Respondent should have known that its registration of the disputed domain name would be identical to the Complainant's mark. Furthermore, the Respondent's claim that it registered the disputed domain name because of its value in being a widely used personal name, both in Italy and also elsewhere, is plausible and is accepted, particularly having regard to the other personal names registered by it.

Additionally, it should be noted that rights in domain names would generally be considered as acquired on a first-come, first-served basis. See, for example, *GWG Holdings, Inc. v. Jeff Burgar, Alberta Hot Rods*, WIPO Case No. [D2016-1420](#). Accordingly, even if the Respondent had somehow been made aware of the Complainant's ROBERTO mark, it would not have prohibited the registration by it of the disputed domain name, having regard to its intended use for purposes which did not seek to take unfair advantage of the Complainant's mark or cause confusion to Internet users.

Whether the Respondent was under a positive duty to search for marks which might render its registration abusive is considered at section 3.2.3 of the [WIPO Overview 3.0](#), which explains that panels have held that registrants, especially domainers undertaking bulk purchases or automated registrations may have an affirmative obligation to avoid the registration of trademark-abusive domain names. But, as section 3.2.3 explains: "[n]oting the possibility of co-existence of trademarks across jurisdictions and classes of goods and services, and the fact that trademarks which may be inherently distinctive in one context may be generic in

another, the mere fact of certain domain names proving identical or confusingly similar to third-party trademarks pursuant to a search does not however mean that such registrations cannot as such be undertaken or would automatically be considered to be in bad faith”.

In the circumstances of these proceedings, it is not necessary to discuss the existence or precise extent of any duty on the part of the Respondent to search because, even if it had undertaken some form of search which had revealed the Complainant’s mark, having regard to the fact of its varied potential uses and the Respondent’s intended use non-infringing of the disputed domain name, registration of it by the Respondent, would not have been abusive. See, for example, *Intocable, Ltd. v. Paytotake LLC*, WIPO Case No. [D2016-1048](#); and *Delta Dental Plans Association v. Domains By Proxy, LLC / Kwangpyo Kim*, WIPO Case No. [D2022-0566](#).

In these circumstances, the Panel finds that the Complainant has not established its burden of showing that the Respondent’s registration of the disputed domain name was in bad faith and has therefore failed in respect of the second element. In the light of this finding, it is not necessary to consider the question of bad faith use.

#### **D. Reverse Domain Name Hijacking (“RDNH”)**

Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at RDNH or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

Reasons articulated by panels for finding RDNH include: (i) facts that demonstrate that the complainant knew or ought to have known that it could not succeed as to any of the required three elements, (ii) unreasonably ignoring established Policy precedent notably as captured in the [WIPO Overview 3.0](#), and (iii) basing a complaint on only the barest of allegations without any supporting evidence. See section 4.16 of the [WIPO Overview 3.0](#).

The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking and even where a complainant’s case is weak, a finding of RDNH is not necessarily made. However, the Panel notes the following features of the Complaint:

- the Complainant has been professionally represented and many panels will find that such a party should be held to a higher standard. See, for example, *Pick Enterprises, Inc. v. Domains by Proxy, LLC, DomainsByProxy.com / Woman to Woman Healthcare / Just Us Women Health Center f/k/a Woman to Woman Health Center*, WIPO Case No. [D2012-1555](#).
- this was a misconceived Complaint in that the Complainant had no credible basis for alleging that its mark had a reputation in the United States and consequently that the Respondent was, or should have been, aware of it. Moreover, it adduced scarcely any evidence to support its assertions and it produced no evidence at all in relation to the alleged repute of its ROBERTO mark in the United States as at the date of registration of the disputed domain name; and
- the record suggests that the Complainant bought these proceedings because its offer of USD 1,000 for the disputed domain name had been rejected by the Respondent. The Panel notes that the Complainant’s offer did not contain any allegation of wrongdoing on the part of the Respondent in its registration and use of the disputed domain name and was made some 23 years after the Respondent’s registration of it. Having recourse to proceedings under the Policy following an unsuccessful attempt to purchase a domain name is sometimes referred to as a “Plan B”. See for example, *BERNINA International AG v. Domain Administrator, Name Administration Inc. (BVI)*, WIPO Case No. [D2016-1811](#). This can be a further factor pointing towards a finding of RDNH.

In these proceedings, some of more egregious features associated with a finding of RDNH, such as manifestly untrue allegations against a respondent and attempts to mislead the panel, are absent. The overall impression is that the Complainant has simply not understood the Policy and the burden it has to meet. For this reason, by a very narrow balance, the Panel declines to make a finding of RDNH.

## 7. Decision

For the foregoing reasons, the Complaint is denied.

*/Antony Gold/*

**Antony Gold**

Presiding Panelist

*/Ahmet Akgüloğlu/*

**Ahmet Akgüloğlu**

Panelist

*/Pablo A. Palazzi/*

**Pablo A. Palazzi**

Panelist

Date: December 22, 2023