

ADMINISTRATIVE PANEL DECISION

Luigi Lavazza S.p.A. v. Domain Admin, Privacy Protect LLC PrivacyProtect org, Artem Eygarov, Jordan Gallagher
Case No. D2024-0178

1. The Parties

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

The Respondents are Domain Admin, Privacy Protect LLC PrivacyProtect org, United States of America (“United States”), Artem Eygarov, Ukraine, and Jordan Gallagher, Albania.

2. The Domain Names and Registrars

The disputed domain names <gustolavazza.com>, and <offertelavazza.com> are registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “First Registrar”); the disputed domain name <lavazzaofferte.com> is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Second Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 16, 2024, regarding the disputed domain names <lavazzaofferte.com> and <offertelavazza.com>. On January 17, 2024, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names <lavazzaofferte.com> and <offertelavazza.com>. On January 18, 2024, the First Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <offertelavazza.com> confirming that the Respondent Domain Admin, Privacy Protect LLC PrivacyProtect org is listed as the registrant and providing the contact details. On January 18, 2024, the Second Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <lavazzaofferte.com> which differed from the named Respondent (Domain Admin, Whois protection, this company does not own this domain name s.r.o) and contact information in the Complaint.

The Center sent an email communication to the Complainant on January 19, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that the disputed domain names are under common control. The Complainant filed an amendment to the Complaint on January 22, 2024.

On January 24, 2024, the Complainant requested to add the disputed domain name <gustolavazza.com> to the current proceeding. On January 24, 2024, the Center transmitted by email to the First Registrar a request for registrar verification in connection with the disputed domain name <gustolavazza.com>. On January 25, 2024, the First Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <gustolavazza.com> which differed from the named Respondent and contact information in the Complaint and the amendment to the Complaint. On the same day, the Center sent an email communication to the Complainant with the newly disclosed registrant and contact information, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that the disputed domain names are under common control. The Complainant filed an amended Complaint on January 26, 2024.

The Center verified that the Complaint together with the amendment to the Complaint and 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 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on February 26, 2024.

The Center appointed Mihaela Maravela as the sole panelist in this matter on February 29, 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.

4. Factual Background

According to information in the Complaint, the Complainant manufactures and sells a coffee product which encompass a broad range of espresso blends, capsules and coffee machines. It was first established in 1895 in Italy, as a shop producing and supplying soap, spirits, oil, spices and coffee, and then its owner decided to focus its sales offer mainly on coffee. In 1910 the Complainant was already the top Italian coffee importer and roaster. It was incorporated in the current company form in 1927. The Complainant is one of the top 50 brands in terms of presence and recognition in Europe. With more than 4,000 employees worldwide, direct subsidiaries and a wide distribution network, the Complainant today operates in over 140 countries.

The Complainant is the holder of a number of trademarks for LAVAZZA, including the International trademark LAVAZZA No. 317174, registered on July 18, 1966, duly renewed and designating goods in international classes 29, 30, and 31, the European Union trademark LAVAZZA No. 000317057, registered on May 25, 1998, duly renewed and designating goods and services in international classes 21, 30, and 42, the Ukrainian trademark LAVAZZA No. 275473, registered on May 12, 2020, designating goods and services in international classes 11, 30, and 43, the United States trademark LAVAZZA No. 1201336, registered on July 13, 1982, duly renewed and designating goods and services in international class 30. The Complainant has registered numerous domain names incorporating the trademark LAVAZZA, including the domain name <lavazza.com> since May 19, 1996, that it uses as its official website.

The disputed domain names <offertelavazza.com> and <lavazzaofferte.com> were registered on January 10, 2024 and the disputed domain name <gustolavazza.com> was registered on January 22, 2024. According to un rebutted evidence submitted with the Complaint, the disputed domain names previously resolved (or redirected between each other) to active websites reproducing the Complainant's trademarks and official advertising images, advertising promotions related to LAVAZZA products and purportedly offering

for sale LAVAZZA products – requesting Internet Users to provide their personal and financial information to finalize the purchase – without providing any disclaimer of non-affiliation with the Complainant and displaying the Complainant’s company information in the copyright line. The Respondents identified themselves as “Luigi Lavazza S.p.A.” and indicated the postal address, fax number and email address of the Complainant on the websites at the disputed domain names. At the date of the Decision the disputed domain names do not resolve to active websites.

The Complainant has sent a cease-and-desist letter to the Respondents on January 12, 2024 with respect to the disputed domain names <offertelavazza.com> and <lavazzaofferte.com>, at which the Respondents answered on January 13, 2024 that “the best we can do is selling to you our domains lavazzaofferte.com and offertelavazza.com; Price starts at 15,000 USD each.”

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to its trademarks, as they incorporate the entirety of the Complainant’s LAVAZZA trademark. The addition of the non-distinctive elements “offerte” (“offers” in Italian) and “gusto” (“taste” in Italian) does not affect the confusing similarity.

As regards the second element, the Complainant argues that the Respondents are not licensees, authorized agents of the Complainant or in any other way authorized to use the Complainant’s trademark LAVAZZA. The Respondents have not been authorized to register and use the disputed domain names. Also, the Complainant is not in possession of, nor aware of, the existence of any evidence demonstrating that the Respondents, whose name are Jordan Gallagher, Artem Eygarov, and Domain Admin, Privacy Protect LLC PrivacyProtect.org might be commonly known by a name corresponding to the disputed domain names as an individual, business, or other organization. In addition, the Respondents have not provided the Complainant with any evidence of their use of, or demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services before any notice of the dispute. Moreover, there is no evidence that the Respondents might have used the disputed domain names in connection with a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademark. Rather, the disputed domain names have been redirected by the Respondents to websites used to impersonate the Complainant, by misappropriating the Complainant’s trademarks and official advertising images, advertising unauthorized promotions related to LAVAZZA and offering for sale purported LAVAZZA products – requesting users to provide their personal and financial data to submit orders – without providing any disclaimer of non-affiliation with the Complainant and displaying the Complainant’s company information in the copyright line. In addition, the Respondents indicated the postal address, fax number and email address of the Complainant, also identifying themselves as the Complainant, thus clearly generating the false impression that the websites have been operated by the Complainant. As to the current redirection of the disputed domain name <lavazzaofferte.com> to an inactive website, said passive use is to be considered neither as a *bona fide* offering of goods or services nor as a legitimate noncommercial or fair use of the disputed domain names.

Furthermore, the disputed domain names, being highly confusingly similar to the Complainant’s well-known trademark LAVAZZA, from which they differ only by the addition of the generic terms “offerte” (“offers” in Italian) and “gusto” (“taste” in Italian), carry a high risk of implied affiliation. Lastly, the Respondents’ intention to sell the disputed domain names <offertelavazza.com> and <lavazzaofferte.com> to the Complainant for more than their out-of-pocket costs further demonstrates that they have no rights or legitimate interests in the disputed domain names.

With respect to the third element, the Complainant argues that in light of the Complainant's use of the trademark LAVAZZA since as early as 1895 and of the amount of advertising and sales of the Complainant's products in Europe and worldwide, the Respondents could not have possibly ignored the existence of the Complainant's well-known trademark LAVAZZA at the time of registration of the disputed domain names, with which they are confusingly similar. Moreover, the actual knowledge of the LAVAZZA trademark by the Respondents at the time of the registration of the disputed domain names is clearly demonstrated by the fact that the Complainant's trademarks are featured prominently on the websites to which they resolve/resolved, products bearing the Complainant's trademarks are/were advertised and offered for sale and the Complainant's company details and contact information are/were published. The disputed domain names have been pointed to websites impersonating the Complainant, by misappropriating the Complainant's trademarks, advertising unauthorized promotions related to LAVAZZA and offering for sale LAVAZZA products – requesting users to provide their personal and financial information to finalize orders – without providing any disclaimer of non-affiliation with the Complainant and displaying the postal address, the fax number and email address of the Complainant as contact information. Also, the amount requested by the Respondents to transfer the disputed domain names <offertelavazza.com> and <lavazzaofferte.com> to the Complainant is certainly well in excess of the out-of-pocket costs directly related to the disputed domain names. Furthermore, the Respondents registered the disputed domain names to prevent the Complainant from reflecting its trademarks in corresponding domain names and have clearly engaged in a pattern of such conduct according to paragraph 4(b)(ii) of the Policy (as they registered three of the disputed domain names and another domain name incorporating the Complainant's LAVAZZA mark not subject to this proceeding).

B. Respondents

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

6. Discussion and Findings

6.1. Procedural Considerations

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Noting the Respondent Artem Eygarov's mailing address is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should.

The Panel notes that the Written Notice was not delivered to the Respondent Artem Eygarov's address in Ukraine. However, the Notification of Complaint emails were apparently delivered to the Respondent Artem Eygarov's email address provided by the Registrar, and the Respondent Artem Eygarov has not opposed to the continuation of the proceeding.

Further, the Panel notes that the Complainant received a reply on January 13, 2024, offering for sale the disputed domain names <offertelavazza.com> and <lavazzaofferte.com> sent from the email address associated with the Respondents Artem Eygarov and Jordan Gallagher.

Moreover, the Panel finds that the disputed domain names are subject to common control as explained in details in section 6.2. below and the disputed domain name <gustolavazza.com> was registered after the commencement of the proceeding.

Considering the above, the Panel therefore concludes that the Parties have been given a fair opportunity to present their case, and that the administrative proceeding should take place with due expedition, and that the Panel will proceed to a Decision accordingly.

6.2. Consolidation: Multiple Respondents

The amendment to the Complaint and the amended Complaint were filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states 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 addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that (i) the disputed domain names were registered in a short period, between January 10, 2024 and January 22, 2024, namely the disputed domain names <offertelavazza.com> and <lavazzaofferte.com> were registered on the same date, i.e. on January 10, 2024, while the disputed domain name <gustolavazza.com> was registered on January 22, 2024, i.e., three days after the Center sent the initial email of Notice of the Registrant Information; (ii) the disputed domain names <offertelavazza.com> and <gustolavazza.com> have been registered via the same Registrar and share the same name servers; (iii) the disputed domain names <gustolavazza.com> and <lavazzaofferte.com> share the same registrant's e-mail address, which was also used by the Respondents to reply to the cease-and-desist letter from the Complainant, offering to sell the disputed domain names <lavazzaofferte.com> and <offertelavazza.com> for a price starting at USD 15,000 each; (iii) the close similarity of the disputed domain names, which all incorporate the Complainant's trademark LAVAZZA in its entirety with the addition of a generic term; (iv) the disputed domain names were registered under the same Top-Level Domain ("TLD") (i.e. ".com"); (v) all disputed domain names have been redirected by the Respondents to similar websites, as described in the factual section above. Moreover, none of the named Respondents have challenged the Complainant's contention that the underlying registrants of all of the disputed domain names are in fact the same person and/or that all of the disputed domain names are under common control.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

6.3. Substantive matters

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2 of the [WIPO Overview 3.0](#).

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names, and (iii) the disputed domain names have been registered and are 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 trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is reproduced in its entirety within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "offerte" or "gusto") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is the settled view of panels applying the Policy that the TLD (here ".com") should be disregarded under the first element test.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

From the evidence put forward by the Complainant, the websites to which the disputed domain names resolved were used for allegedly selling products under the Complainant's LAVAZZA trademark, and included the Complainant's trademark and product images, as well as a copyright notice with no disclaimer as to the relationship or lack thereof with the Complainant. The Complainant contends that it has never licensed or otherwise permitted the Respondent to use the trademark LAVAZZA. Irrespective of whether the goods offered for sale are genuine or not, the Respondent's use of the disputed domain names in the above circumstances is not in connection with a *bona fide* offering of goods or services as contemplated by the first circumstance of paragraph 4(c) of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), and section 2.8 of the [WIPO Overview 3.0](#).

Moreover, the Respondent has attempted to pass off as the Complainant by using the Complainant's contact details on the websites at the disputed domain names.

Panels have held that the use of a domain name for illegal activity, such as impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Also, there is no evidence that the Respondent is commonly known by the disputed domain names in the meaning of the second circumstance of paragraph 4(c) of the Policy.

Furthermore, the nature of the disputed domain names, which include the terms pertaining to the Complainant's industry, such as "offerte" or "gusto" carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

On the date of this Decision, the disputed domain names do not resolve to active websites. The Panel finds that holding domain names passively, without making any use of them, also does not confer any rights or legitimate interests in the disputed domain names on the Respondent under the circumstances of this case.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

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

The disputed domain names were registered many years after the Complainant had obtained registration of its LAVAZZA trademarks. The disputed domain names incorporate the Complainant's trademark and the words "offerte" ("offers" in Italian) and "gusto" ("taste" in Italian) in addition to the TLD ".com". The website at the disputed domain names included the Complainant's trademark, product images, and used the Complainant's contact details. Under these circumstances, the Panel considers that the Respondent has registered the disputed domain names with knowledge of the Complainant and its trademark and that it targeted that trademark.

As regards the use of the disputed domain names, paragraph 4(b)(iv) of the Policy has direct bearing to the present case: (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to his website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the said website location or of a product or service on that website location. The conduct of the Respondent falls under the above provisions. The disputed domain names are confusingly similar to the LAVAZZA trademark of the Complainant and are inherently misleading. The websites to which the disputed domain names resolved used the Complainant's contact details and offered for sale products purporting to be under LAVAZZA trademark with no disclaimer regarding the lack of a relationship between the Respondent and the Complainant. Internet users were likely confused as to the source of the products offered for sale on such website. The websites at the disputed domain names also contained a payment form designed to obtain personal data from Internet users.

Panels have held that the use of a domain name for illegal activity, such as impersonation/passing off like the case here, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

The Panel further notes that according to the un rebutted evidence put forward by the Complainant, the disputed domain names <offertelavazza.com> and <lavazzaofferte.com> were offered for sale to the Complainant for a price starting at USD 15,000 each. This is an additional element that sustains the Panel's finding of bad faith registration and use of the disputed domain names.

In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain names. The Respondent failed to bring evidence as to the contrary. Although at the time of drafting the Decision, the disputed domain names are inactive, considering the circumstances of this case, the Panel finds that such non-use of the disputed domain names does not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)).

The Panel finds that the Complainant has established the third element 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 names <gustolavazza.com>, <lavazzaofferte.com>, and <offertelavazza.com> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: March 14, 2024