

## **ADMINISTRATIVE PANEL DECISION**

Badiani Ltd v. Khalifa Althani  
Case No. D2024-1070

### **1. The Parties**

The Complainant is Badiani Ltd, United Kingdom, represented by Lexico S.r.l., Italy.

The Respondent is Khalifa Althani, Qatar, represented by Bird & Bird Società tra Avvocati s.r.l., Italy.

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

The disputed domain name <buontalenti.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 March 11, 2024. On March 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 13, 2024, 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 amended Complaint on the same day.

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 Respondent of the Complaint, and the proceedings commenced on March 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 3, 2024. The Response was filed with the Center on April 3, 2024.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on April 10, 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.

On April 10, 2024 after the appointment of the Panel was notified, the Complainant submitted an unsolicited supplemental filing.

#### 4. Factual Background

The Complainant is incorporated in the United Kingdom and is a supplier of gelato ice creams. The Complaint is less than clear, but the ice cream may be made in Italy by a related company or business as, amongst other things, it appears that the first Badiani shop was opened in Florence, Italy in 1932.

One of the flavours of gelato provided by the Complainant is "Buontalenti". This is described in materials in the Complaint as the flavour for which "Badiani" is especially known and made from a secret recipe.

The name "Buontalenti" originates from a Bernardo Buontalenti who was an architect for the Medicis and is credited on the website "www.aboutflorence.com" as the inventor of the flavour and, according to the same website, the flavour may be "enjoyed today in all the best ice cream shops, especially in Florence." In an extract from the Complainant's website relied on by the Respondent, however, it is claimed that the Complainant's version was a secret recipe created by Paolo Pomposi (who took over Badiani in 1993) to win a prestigious contest with a simple yet unique flavour.

The Complainant is the owner of:

- (a) Italian Registered Trademark No. 740948 (renumbered as 302015000060289), BUONTALENTI (in a cursive script), which was filed on October 11, 1995 and registered on September 3, 1998 in respect of cream-based ice cream in International Class 30; and
- (b) European Union Trademark No. 012321618, BUONTALENTI, which was filed on November 18, 2013 and registered on March 5, 2014 in respect of a range of goods and services in International Classes 29, 30, and 43.

According to the Whois record, the disputed domain name was registered on October 31, 2012.

It is not clear from the Complaint or the Response whether the Respondent was the holder of the disputed domain name at that time.

The disputed domain name currently resolves to a website which promotes the sale of "Buontalenti Italian Style" gelati, cones, "Mixy" mixing powder, coffee, syrups and toppings in Qatar. The copyright notice states "Buontalenti | © 2024 All rights reserved".

In July and August 2022, Ahlem Khammassi and Mohamed Al Emadi from an enterprise known as Al Hazm negotiated with the Complainant with a view to opening a Badiani Gelato shop in Qatar before the FIFA World Cup later that year. Those negotiations were unsuccessful.

Shortly before those negotiations ceased, however, a company owned by the Respondent, Corona LLC, applied on August 8, 2022 to register BUONTALENTI (in both Latin and Arabic scripts) in respect of relevant services in International Class 43 – Application No. 160189. Corona LLC made a second application on November 14, 2022 for BUONTALENTI (in both Latin and Arabic scripts) in respect of relevant goods in International Class 30 – Application No. 162876.

According to the Response (and not disputed in the Complainant's unsolicited supplemental filing), the Complainant unsuccessfully opposed the registration of Corona LLC's application in class 30. An appeal to the Intellectual Property Rights Protection Department was dismissed on January 24, 2024. The Complainant has not appealed that decision. Following the expiry of the appeal period, Corona LLC paid the registration fees on March 31, 2024.

Materials submitted by Corona LLC in support of its trademark application in Qatar stated it is an Italian company with an address in Milan, Italy and ultimately owned by a Qatari company, Partners & Partners. (The attachments verifying those claims have not been included in the Complaint.) The website link, “www.gruppocorona.com/company.html”, presents a company selling coffee products.

The Complainant’s searches were unable to identify a company registered in Italy under the name Corona LLC selling gelati. The Complaint also states that the Complainant investigated the street address in Italy on the website at “www.buontalenti.com”. Corona LLC was not one of the companies identified as operating from there.

The Response includes evidence that the Respondent is the sole member of Corona LLC, a company registered in Qatar since January 2018, Registration No. 109651, trading in coffee and coffee and tea products.

## **5. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of a disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

### **A. Admissibility of Complainant’s Supplemental Filing**

Apart from documents requested by the Panel pursuant to paragraph 12 of the Rules, neither the Policy nor the Rules expressly provide for supplemental filings. Their admissibility is therefore in the discretion of the Panel bearing in mind the requirements under paragraph 10 of the Rules to ensure that the proceeding is conducted with due expedition and both parties are treated equally, with each party being given a fair opportunity to present its case.

In submitting its unsolicited supplemental filing, the Complainant invited the Panel “to take into account the enclosed correspondence which shows the blatant bad faith in developing its website BUONTALENTI after knowing its value from Badiani Ltd (the complainant).”

The Complainant, however, does not identify any connection or association between Al Hazm and the people the Complainant negotiated with on the one hand and, on the other, the Respondent or the Respondent’s company Corona LLC.

The Panel accepts that the timing of Corona LLC’s trademark first application and the negotiations raises suspicions but there is no obvious connection between the Al Hazm parties and the Respondent.

As the Panel has reviewed the material and taken it into account, and there has been no objection from the Respondent, it is appropriate that the Panel include the supplemental filing in the record of the proceeding.

## **B. 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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

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

In undertaking the comparison between that trademark and the disputed domain name, it is permissible in the present circumstances to disregard the generic Top Level Domain (gTLD) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".com" gTLD component of the disputed domain name, the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Therefore, the Panel finds the first element of the Policy has been established.

## **C. Rights or Legitimate Interests**

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

While 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 often impossible 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. 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.

The Respondent registered the disputed domain name after the Complainant began using its trademark and also after the Complainant had registered its trademark. It is also not in dispute that the Respondent is not associated in any way with the Complainant and has no licence or other permission from the Complainant in respect of the disputed domain name.

However, the Respondent has at least one trademark in Qatar which appears for all practical purposes to be a registered trademark for, amongst other things, ice cream and coffee products. That registration was achieved in the face of an opposition by the Complainant and from which the Complainant has not appealed. The Respondent appears to be using the disputed domain name in connection with the sale and promotion in Qatar of the goods covered by its registered trademark.

In these circumstances, the Panel finds that the Complainant has not shown that the Respondent does not have rights or legitimate interests in the disputed domain name at least in respect of its use in connection with the sale and promotion of the applicable goods in Qatar.

Accordingly, the Panel finds the second element of the Policy has not been established.

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

As the Complaint must fail, no good purpose would be served by considering this ground.

#### **E. Reverse Domain Name Hijacking**

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 Reverse Domain Name Hijacking 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. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

Having failed in its opposition to the registration of Corona LLC's trademark in Qatar, the Complainant should have known that that company would ordinarily be expected to be able to establish rights or a legitimate interest under the Policy. See e.g., [WIPO Overview 3.0](#), section 2.12.

In the present case, however, the disputed domain name was not registered in the name of Corona LLC and, moreover, the documents submitted by Corona LLC in defending the opposition claimed it was an Italian company. The Complainant's searches could not identify such a company nor a relevant entity at the address shown in Milan, Italy shown on the website when the Complaint was submitted and identified in Corona LLC's submissions to the Intellectual Property Rights Protection Department. The Response has not sought to explain these matters but has proceeded in a different basis.

In these circumstances, the Panel considers there is no basis to find that the Complainant has engaged in Reverse Domain Name Hijacking.

### **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: April 24, 2024