

ADMINISTRATIVE PANEL DECISION

Brindisa Limited v. Jill Barrie
Case No. D2024-2102

1. The Parties

The Complainant is Brindisa Limited, United Kingdom, represented by Briffa Legal Limited, United Kingdom.

The Respondent is Jill Barrie, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <brindisa.shop> is registered with Web Commerce Communications Limited dba WebNic.cc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 21, 2024. On May 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 23, 2024, 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 Known) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 23, 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 May 23, 2024 and June 5, 2024.

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 June 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 27, 2024.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on July 1, 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

The Complainant is a company incorporated under the laws of England and Wales in 1988, to carry out the business of retailing Spanish food products.

The Complainant is the owner of several trademarks incorporating the term “brindisa” (hereinafter the “BRINDISA Trademarks”) including the following:

- the United Kingdom word mark BRINDISA No. UK00002398987, registered on January 27, 2006, for products and services in classes 29, 30, 35, and 43;
- the European Union word mark BRINDISA No. 007387401, registered on October 7, 2009, for products and services in classes 29, 30, 35, and 43; and
- the International word mark BRINDISA No. 1674088, registered on May 6, 2022, for products and services in classes 29, 30, 35, and 43.

The disputed domain name was registered on August 12, 2023, and resolves to a website purporting to offer goods that originate from Spain, including goods of the Complainant.

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 name.

Notably, the Complainant contends that the disputed domain name is similar to trademarks in which it has rights. The Complainant submits that the addition of the descriptive and generic “.shop” at the end of the disputed domain name does not alter the fact that the disputed domain name is confusingly similar to its BRINDISA Trademarks.

Then, the Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant explains that, to the best of its knowledge and belief, the Respondent has no rights or legitimate interests in respect of the disputed domain name and has never been authorized by the Complainant to use its BRINDISA Trademarks nor to sell the Complainant's goods. The Complainant adds that the Respondent, as an individual, business, or other organization, has not been commonly known by the disputed domain name. The Complainant also submits that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers and/or to tarnish the BRINDISA Trademarks at issue.

Finally, the Complainant asserts that the disputed domain name was registered and is used in bad faith by the Respondent. The Complainant argues that the disputed domain name was registered primarily for the purpose of diverting potential customers of the Complainant to the Respondent's website and hence disrupt the business of the Complainant. The Complainant also submits that the Respondent had the BRINDISA Trademarks in mind when registering the disputed domain name as the Respondent has used the Complainant's logo on its website without authorization. The Complainant indicates that the Respondent is using the disputed domain name intentionally to attract, for commercial gain, Internet users to its website by

creating a likelihood of confusion with the BRINDISA Trademarks as to the source, affiliation, or endorsement of the website. The Complainant indicates that it has not authorized the Respondent to use the BRINDISA Trademarks and nor has the Respondent ever been an authorized seller of the Complainant's goods. The Complainant also submits that there are reasonable beliefs to deduct that the disputed domain name generates revenue from the sale of counterfeit goods of the Complainant and the collect of consumer's personal information.

B. Respondent

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

6. Discussion and Findings

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 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 a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

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.

Although the addition of the generic Top-Level Domain ("gTLD") ".shop" is a standard requirement and not considered for the purposes of the 'confusing similarity test', the Panel finds the addition of the term shop does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.11.1 and 1.8.

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.

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 name. 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 name such as those enumerated in the Policy or otherwise.

Indeed, it appears that the Respondent has not received any authorization from the Complainant to use the BRINDISA Trademarks in any manner. Moreover, the Panel finds that the Respondent is not commonly known by the disputed domain name.

Panels have held that the use of a domain name for illegal activity here, claimed case: sale of counterfeit goods can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Indeed, the Panel finds that the Respondent has not demonstrated any intent to use the disputed domain name in connection with a bona fide offering of goods or services. On the contrary, the disputed domain name resolves to a website purporting to offer goods that originate from the Complainant although the Respondent is not an authorized seller of the Complainant's goods. Accordingly, it seems apparent to the Panel that the Respondent is using the disputed domain name to impersonate the Complainant and confuse Internet users. Such use does not represent a bona fide offering. [WIPO Overview 3.0](#), section 2.13.

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.

In the present case, the Panel notes that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the BRINDISA Trademarks. Regarding the distinctiveness of these trademarks and the fact that the Respondent sell on the website to which the disputed domain name resolves goods that originate from the Complainant although the Respondent has never been an authorized seller of the Complainant's goods, the Panel considers that the Respondent has registered and used the disputed domain name with full knowledge of the Complainant's trademarks, and with the intent to impersonate the Complainant and confuse Internet users.

Panels have held that the use of a domain name for illegal activity here, claimed sale of counterfeit goods 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 name constitutes bad faith under the Policy.

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 name <brindisa.shop> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: July 15, 2024