

## ADMINISTRATIVE PANEL DECISION

Luigi Lavazza S.p.A. v. Jordan Gallagher  
Case No. D2024-2283

### 1. The Parties

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

The Respondent is Jordan Gallagher, Albania.

### 2. The Domain Name and Registrar

The disputed domain name <lavazzasconti.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 4, 2024. On June 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 6, 2024, 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 June 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 28, 2024.

The Center appointed Purvi Patel Albers as the sole panelist in this matter on July 5, 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 was established in 1895 in Turin. By 1910, the company was a top Italian coffee importer and roaster. With more than 4,000 employees worldwide, direct subsidiaries and a wide distribution network, the Complainant today operates in over 140 countries, including Albania, where the Respondent is reportedly based. The Complainant is known internationally, for example, because of worldwide marketing, TV advertisements, and its well-known calendar. In 2023, the Complainant achieved revenues of EUR 3.1 billion.

The Complainant owns several trademark registrations for the LAVAZZA mark alone or in combination with other descriptive terms and/or figurative elements, including the following: European Union Trade Mark No. 000317057 for LAVAZZA (word mark), registered on May 25, 1998; International Trademark Registration No. 317174 for LAVAZZA (word mark), registered on July 18, 1966; and International Trademark Registration No. 1186133 for LAVAZZA (word mark), registered on July 29, 2013 (“the Mark”). The Complainant manufactures and sells coffee, which encompasses a broad range of espresso blends, capsules, and coffee machines, which it sells under its marks including the Mark.

The Complainant has registered more than 600 domain names containing the Mark, including <lavazza.com>, which was registered on May 19, 1996. Through its website at “www.lavazza.com”, the Complainant promotes its company and coffee products as well as provides information about Italian espresso and the Italian culture internationally.

The disputed domain name was registered on April 19, 2024, without any authorization from the Complainant, and at the time of filing the Complaint redirected to a website in Italian, where the Mark is being displayed without permission, advertising unauthorized promotions related to the Mark, offering purported LAVAZZA products for sale, and requesting personal and credit card number to finalize a purchase. There is no disclaimer of non-affiliation with the Complainant. Moreover, in the “Termini di utilizzo del sito” and “Cookie policy” sections of the website at the disputed domain name, the indicated postal address, fax number, and email addresses relate to the Complainant, and the website identifies itself as the Complainant, thus generating the false impression that the Complainant operates the website.

On May 31, 2024, the Complainant’s representative sent a cease & desist letter to the Respondent – addressing it to the email address disclosed in the Whois records of the disputed domain name. The Respondent failed to provide any response as of the filing of the Complaint.

#### **5. Parties’ Contentions**

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

The disputed domain name incorporates the whole of the Complainant’s Mark. The fact that the disputed domain name differs from the Complainant’s Mark by the addition of the element “sconti” (“discounts” in Italian) does not affect the confusing similarity. The Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Mark. The Complainant does not have any evidence demonstrating that the Respondent might be commonly known by a name corresponding to the disputed domain name as an individual, business, or other organization. The Respondent has not provided the Complainant with any evidence of use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before or after any notice of the dispute herein.

In light of the Complainant’s use of the Mark since as early as 1895, the amount of advertising and sales of the Complainant’s products in Europe and worldwide, the Respondent could not have ignored the existence of the Complainant’s well-known Mark at the time he registered the disputed domain name. Considering the distinctiveness and reputation of the Mark, the Respondent clearly acted in opportunistic bad faith, since it obviously registered the disputed domain name with full knowledge of the Complainant and its Mark for the purpose of taking commercial advantage of them.

## **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 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, with the addition of the term "sconti". Accordingly, the Panel finds the Mark is clearly recognizable within the disputed domain name and the disputed domain name is confusingly similar to the Mark.

The fact that the disputed domain name differs from the Complainant's Mark by the addition of the element "sconti" ("discounts" in Italian) does not prevent the finding of confusing similarity. [WIPO Overview 3.0](#), sections 1.7 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. There is no evidence that the Respondent is commonly known by the disputed domain name. The Respondent is also neither affiliated with the Complainant, nor has the Complainant granted the Respondent a license to use the Mark.

The Respondent has also not rebutted the Complainant's allegations on the Respondent's lack of rights and legitimate interests and has not provided the Panel with any explanations as to whether this is the case or not or whether there are indeed legitimate reasons for the choice of the disputed domain name. On the contrary, it appears to the Panel that the Respondent is unfairly capitalizing on the reputation and goodwill established by the Complainant. Moreover, the composition of the disputed domain name carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

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.

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 registered and has been using the disputed domain name that is confusingly similar to the Mark. When the Respondent registered the disputed domain name, the Complainant had been using the Mark for many years worldwide. Given the Complainant's widespread and long-standing use of the Mark worldwide, the Panel finds it is highly unlikely that the Respondent was unaware of the Mark when it registered the disputed domain name. The Respondent's bad faith registration and use is also evidenced by the facts that (1) the lack of the Respondent's own rights or legitimate interests in the disputed domain name; (2) the Respondent registering a domain name that includes the Mark in its entirety with the addition of the Italian term "sconti", which was likely chosen to suggest that discounted offerings of the Complainant's products will be offered on the website at the disputed domain name; and (3) the Respondent using a confusingly similar domain name to provide a website that is purportedly selling the Complainant's goods while prominently using the Mark and giving false contact information designed to impersonate the Complainant. On the uncontroverted evidence, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith.

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 <lavazzasconti.com> be transferred to the Complainant.

*/Purvi Patel Albers/*

**Purvi Patel Albers**

Sole Panelist

Date: July 19, 2024