

ADMINISTRATIVE PANEL DECISION

Barilla G. e R. Fratelli S.p.A. v. RCL Systems
Case No. D2024-2294

1. The Parties

The Complainant is Barilla G. e R. Fratelli S.p.A., Italy, represented by Studio Barbero S.p.A., Italy.

The Respondent is RCL Systems, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <barillapasta.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 5, 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 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 (Domain Administrator, See PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 5, 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 amendment to the Complaint on June 7, 2024.

The Center verified that the Complaint together with the amendment to 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 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 30, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 3, 2024.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on July 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.

4. Factual Background

The Complainant was founded in 1877 and is a globally operating company in the field of oven-baked products, pasta and ready-made sauces.

The Complainant is the owner of numerous trade mark registrations (word and figurative marks) for the designation “Barilla” for various goods and services, including the following registrations:

Trade mark	Registration number	Country	Registration Date	Class(es)
	349555	International Registration	September 26, 1968	5, 30
BARILLA	675652	International Registration	June 20, 1997	29, 30
BARILLA	2005752	United States	October 8, 1996	30

The Complainant also owns, inter alia, the domain names <barilla.com>, registered on December 15, 1995, and <barillagroup.com>, registered on August 2, 2002. The Complainant uses the websites under the aforementioned domain names to promote and sell its goods and services.

According to Annex 1.4 of the Complaint, the disputed domain name was registered on July 21, 2004 in the name of “Old Ironside”. From February 2008 to November 2010 it was held by “Oakwood Services” and subsequently in the name of Whois privacy services, namely, “Domain Hostmaster, Customer ID: 47314129361736, Whois Privacy Services Pty Ltd” until February 4, 2018, then “Privacy.co.com, Inc Privacy ID# 760487” until July 2018, “Domain Protection LLC” until March 2020 and, as of June 2020, by “Domain Administrator, See PrivacyGuardian.org”. Based on the information provided by the Registrar, the actual registrant behind the current privacy service (Domain Administrator, See PrivacyGuardian.org) is the Respondent.

In 2011, the Complainant became aware of the disputed domain name. In 2011 and 2014, the representative of the Complainant was in contact with the prior owners of the disputed domain name, ascertaining that it had been subject to receivership, and was informed on March 27, 2014 that operational control over the disputed domain name had been transferred to a third person (see Annex 9 of the Complaint).

On May 30, 2019, the Complainant’s representative sent a cease and desist letter to the then registrant of the disputed domain name (Annex 10.1 of the Complaint). In absence of a reply, a reminder was sent on June 18, 2019. After a further change in the Whois records in July 2020 (Annex 1.3 of the Complaint), on July 7, 2020 and January 29, 2021, the Complainant’s representative sent further reminders of the cease and desist letter to the new shielded e-mail address indicated in the Whois records (see Annex 10.2 of the Complaint). On January 31, 2021, the Complainant’s representative received a reply from a person named “Dawn”, using the e-mail address “[...]@TrumpsIt.com”, who declared to have acquired the disputed domain name for “under USD 3,000” and requested the same amount to transfer it to Complainant. It also indicated that the disputed domain name had been registered for more than 15 years without having any issues with it and “passed review by counsel to confirm the term was used generically before the domain was acquired” (Annex 10.4 of the Complaint).

The Complainant’s representative replied requesting clarifications as to the mentioned acquisition of the disputed domain name and as to its alleged generic nature, receiving the following reply: “Counsel reviewed legality of use of name before we acquired. The name was part of a group of names seized by a United States federal court and group of attorneys working for the court reviewed before determining to continue registration, and was marked as generic based showing that the word ‘barilla’ is a generic term. see e.g., <https://www.dictionary.com/browse/barilla>. We have under \$3000 invested in the name and if your client wants it, they can have it at cost, we don’t want to be in conflict with anyone”.

The Complainant's representative replied highlighting that the disputed domain name does not correspond to a generic term and that the indicated amount was exceeding the out-of-pocket costs. The Respondent did not respond to this letter (Annex 10.4 of the Complaint).

After the shielded e-mail address of the registrant of the disputed domain name had been subsequently updated in the Whois records with the indication of the one currently displayed in the public Whois information (see Annex 1.1 of the Complaint), on September 1, 2022, the Complainant's representative sent a further cease and desist letter to that address. The Respondent did not provide any answer to such communications despite two subsequent reminders on December 1, 2023, and April 18, 2024 (Annex 11.3 of the complaint).

From February 2008 up to the filing of the Complaint, the disputed domain name has been used to direct to a parking page with commercial pay-per-click ("PPC") links, leading Internet users to third parties' websites. The links displayed on this website refer to food products and services and/or directly to the Complainant's trademark BARILLA (Complaint, pp. 13-15 and Annexes 8.1 and 8.2).

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.

First, the Complainant argues that the disputed domain name <barillapasta.com> is confusingly similar to the Complainant's earlier BARILLA trademarks. In this regard, the Complainant claims that the disputed domain name contains the BARILLA word mark in its entirety. The addition of the non-distinctive element "pasta" would not affect the confusing similarity. Also, the addition of the suffix ".com" should have no impact insofar as the top-level domain ("TLD") is merely instrumental to the use in the Internet and shall be disregarded for the determination of confusing similarity.

Secondly, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant claims that the Respondent is not a licensee or authorized agent of the Complainant or in any other way authorized. Further, it argues that the Respondent is not commonly known by the disputed domain name as an individual, business, or other organization, and "Barilla" is not its family name. As for an alleged generic use, the Complainant argues, that even though "Barilla" may have a meaning in English language (according to the Collins' dictionary, it may mean "an impure mixture of sodium carbonate and sodium sulphate obtained from the ashes of certain plants, such as the saltworts" or "either of two chenopodiaceous plants, Salsola kali (or soda) or Halogeton soda, formerly burned to obtain a form of sodium carbonate"), given the combination of BARILLA with the term "pasta", it would be clear that the disputed domain name is referring to the Complainant's trademark, which is distinctive and well-known in the food sector, specifically for pasta. The actual use of the disputed domain name would demonstrate that the Respondent and prior domain holders always intended to target the Complainant and its trademark. It further argues that even considering "Barilla" as a dictionary term, the Respondent failed to provide any evidence of use of, or demonstrable preparations to use, the domain name in connection with a bona fide offering of goods or services before or after any notice of the dispute herein. There is no evidence, so the Complainant, that the Respondent might have used the disputed domain name in connection with a legitimate non-commercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark. The use of the disputed domain name as a parking page with commercial links to food related offerings which generate revenues, via the PPC system, to the domain holder and/or the registrant would not amount to such bona fide offering of goods or services or to a legitimate non-commercial or fair use.

Thirdly, the Complainant claims that the disputed domain name has been registered and is being used in bad faith. It argues and puts forth evidence that the BARILLA trademark is well-known and reputed worldwide. Accordingly, the Respondent or the first domain registrant must have been aware of the Complainant and its

brand when registering the disputed domain name. It further argues that this would also be true when considering the registration date of the disputed domain name instead of the acquisition date, as BARILLA was already registered, used extensively and known in Italy and abroad, including United States, before 2004. It also cites various UDRP decisions recognizing the well-known character of the Complainant's trademarks.

The Complainant further argues that the Respondent's use of the mark was intended to draw the Internet users' attention to the Respondent's website, a parking website of commercial links relating to the Complainant's business in the food sector, leading users to other commercial websites not affiliated with the Complainant. The Complainant contends that thus the Respondent is deliberately taking undue advantage of the Complainant's trademarks to attract consumers and, more generally, to generate own profits through PPC advertisements.

Finally, with a view to the time elapsed between registration of the disputed domain name, knowledge of it by the Complainant and the filing of the present Complaint, the Complainant contends that the doctrine of laches would not be applicable.

B. Respondent

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

6. Discussion and Findings

A. Delay in bringing the Complaint

The Panel notes that the disputed domain name was registered in 2004, i.e. about 20 years ago, and the Complainant became aware of the disputed domain name in 2011, i.e. 13 years before the Complainant chose to bring the present Complaint. Panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits. The UDRP remedy is injunctive rather than compensatory, and that a principal concern is to halt ongoing or avoid future abuse/damage, not to provide equitable relief. Panels have furthermore noted that trademark owners cannot reasonably be expected to permanently monitor for every instance of potential trademark abuse, nor to instantaneously enforce each such instance they may become aware of, particularly when cybersquatters face almost no (financial or practical) barriers to undertaking (multiple) domain name registrations. Therefore, concepts such as laches or statute of limitation are, as a rule, not applicable in UDRP cases, absent specific circumstances of the case, particularly where a respondent can show detrimental reliance on the delay. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.17. The Panel agrees with this practice and considers it appropriate to apply it in the present case despite the substantial delay of 20 or 13 years, respectively. First of all, given the use of the disputed domain name merely as a parking page, and accepting the lack of obligation for monitoring, it is not detrimental for the Complainant's case that it became aware of it only seven years after registration. Further, the Complainant has demonstrated that it has not remained passive over all these years, but, on the contrary, was intermittently in contact and corresponded with the various persons consecutively in charge of the disputed domain name (Annexes 9, 10.1, 10.4, 11). Finally, the responses provided by the addressees of these communications prior to the opening of the present proceedings do not show any detrimental reliance on the delay. The statement of a person named "Dawn" - most likely attributable to the Respondent - that "under USD 3000 had been invested in the disputed domain name, that the disputed domain name had been registered for more than 15 years without having any issues with it, had passed review of legal counsel and was allegedly merely used generically may be interpreted as pointing to a claim for detrimental reliance on non-action by the Complainant. Nevertheless, given that the disputed domain name clearly had not been used generically for any type of subject or products within the dictionary meaning of "barilla", but rather targeted the products that the trademark of the Complainant is known for, the Panel takes the above contention of "Dawn" as a defensive lie which lacks any sufficient substantiation for such detrimental reliance. Also, the Respondent choose not to file any response to the Complaint as such, where it could have brought any relevant

arguments to that effect. For these reasons, the Panel holds that the delay in bringing the present Complaint does not negatively impact on the Complainant's cause.

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 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 Complainant's BARILLA trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is 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, pasta) may bear on assessment of the second and third elements, the Panel finds the addition of such term 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 1.8. In the Panel's view, the additional word element "pasta" is not enough to avoid a finding of confusing similarity with the Complainant's trademark BARILLA.

It is a well-established principle that additions of terms to a trademark, do not avoid confusing similarity of domain names and trademarks (as held in, inter alia, *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. [D2001-0110](#), <ansellcondoms.com>; *eBay Inc. v. ebayMoving / Izik Apo*, WIPO Case No. [D2006-1307](#), <ebaymoving.com>).

Moreover, the TLD ".com" does not affect the confusing similarity in any way due to the fact that it is a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Accordingly, the disputed domain name is confusingly similar to a trademark, in which the Complainant owns rights.

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

C. 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.

In particular, panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users. [WIPO Overview 3.0](#), section 2.9.

Exceptionally, the use of a domain name to host a page comprising PPC links may be permissible – and therefore consistent with respondent's rights or legitimate interests under the UDRP – where that domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant's (or its competitor's) trademark. [WIPO Overview 3.0](#), section 2.9. In the present case, the Panel concurs with the Complainant's argumentation that – even though “Barilla” may have a meaning in English language (which is probably rather unknown to the general public due to its chemical reference), it does not have such meaning with regards to pasta products, to which, however, the PPC links relate. On the contrary, the disputed domain name is not used to host PPC links in any way related to the dictionary meaning of the “barilla”.

Considering the above, the Panel finds that the Complainant has established a prima facie case that the Respondent lacks any rights and/or legitimate interests in the disputed domain name.

Hence, the burden of production on this element shifts to the Respondent. In such case, the Respondent must by substantial evidence demonstrate its rights or legitimate interests in the disputed domain name in order to refute the prima facie case. The Respondent has made no such showing.

Consequently, the Panel finds that the Respondent's default in refuting the prima facie case made by the Complainant is sufficient to establish a lack of rights or legitimate interests of the Respondent in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

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

D. 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 and agrees with the Complainant that already in 2004, when the disputed domain name was registered by the Respondent's predecessor in interest, the Complainant owned rights in the trademark BARILLA which enjoyed and continue to enjoy a high reputation in the food sector (Annexes 5.1-5.5 of the Complaint, see also *Barilla G. e R. Fratelli S.p.A. v. Super Privacy Service LTD c/o Dynadot / Ali Aslan*, WIPO Case No. [D2021-3054](#); *Barilla G. e R. Fratelli S.p.A. v. Michael Nava, Brand Boogie LLC*, WIPO Case No. [DIO2023-0039](#); *Barilla G. e R. Fratelli S.p.A. v. Sahand Consulting Inc.*, WIPO Case No. [D2012-2450](#)).

In view of the foregoing, it is inconceivable that either at the time of registration or of the presumed acquisition by the Respondent or its predecessor in interest were unaware of the BARILLA trademark. On the contrary, the composition of the disputed domain name shows that it was designed to directly target the Complainant and its trademark. The offer made by “Dawn” and attributable to the Respondent, to sell the disputed domain name for the rather high price of USD 3,000 indicates that the Respondent acquired the disputed domain name primarily for the purpose of selling it to the Complainant for a valuable consideration likely in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name.

As to use in bad faith, in addition to the aforementioned offer the Respondent was, in all likelihood, trying to attract traffic intended for the Complainant's website to its own for commercial gain. It is apparent from the evidence submitted that the disputed domain name resolved to a website containing apparent PPC hyperlinks to third-party websites featuring goods and services provided by third-parties, including Complainant's competitors. Presumably, these websites are an income source via click-through for the

Respondent (see *Arla Foods Amba and Mejeriforeningen Danish Dairy Board v. Mohammad Alkurdi*, WIPO Case No. [D2017-0391](#)).

In light of the above, the Panel concludes that the disputed domain name has been acquired and is being used in bad faith, and that the Complainant has thus satisfied the third element of paragraph 4(a) of the Policy.

Consequently, 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 <barillapasta.com> be transferred to the Complainant.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: July 24, 2024