

## **ADMINISTRATIVE PANEL DECISION**

Perfetti Van Melle S.p.A. v. zee porter, zeeimporters  
Case No. D2024-2944

### **1. The Parties**

The Complainant is Perfetti Van Melle S.p.A., Italy, represented by Studio Barbero S.p.A., Italy.

The Respondent is zee porter, zeeimporters, Norway.

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

The disputed domain name <perfettvanmelle.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2024. On July 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 18, 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 (Redacted for privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 19, 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 July 19, 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 July 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 12, 2024.

The Center appointed Gustavo Patricio Giay as the sole panelist in this matter on August 16, 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 formed in 2001 with the merger of the Italian-based company Perfetti S.p.A and the Dutch-based company Van Melle NV. Van Melle was the older of the two companies, tracing its origins back to 1900.

The Complainant is now one of the world's leading manufacturers in the candy and confectionery industry. In fact, in 2006, the Complainant acquired the Spanish Chupa Chups group and in 2023 acquired the Mondelez International's gum business.

Currently, the Complainant has more than 18,000 employees worldwide, 39 operating companies and 33 manufacturing facilities, distributing its products in over 150 countries. As evidenced in Annex 9 to the Complaint, in 2022 the sales metrics of the Complainant were close to 3 billion Euro worldwide.

The Complainant's most important brands include, inter alia, MENTOS, CHUPA CHUPS, ALPENLIEBE, FRISK, VIVIDENT, FRUITELLA, BIG BABOL, AIRHEADS, SMINT, GOLIA, DAYGUM, HAPPYDENT and MOROSITAS.

The Complainant is the owner of trademarks PERFETTI and PERFETTI VAN MELLE in many jurisdictions, including International Registration Reg. No. 775789 for PERFETTI VAN MELLE registered on November 8, 2011, for classes 5 and 30; European Union Intellectual Property Office (EUIPO) Reg. No. 89417 for PERFETTI registered on April 30, 1998, for class 30; United States Patent and Trademark Office (USPTO) Reg. No. 2857219 for PERFETTI VAN MELLE registered on June 29, 2004, for classes 5 and 30; and USPTO Reg. No. 2890724 for PERFETTI VAN MELLE registered on October 5, 2004 for classes 5 and 30.

Likewise, the Complainant claims to own an important domain names portfolio, including, among others, its primary website "www.perfettivanmelle.com" registered since July 3, 2002.

Lastly, the disputed domain name was registered on March 12, 2024, and resolved to a webpage under construction and then an error page, as evidenced by the Complainant in Annex 12 to the Complaint. The Complainant has also provided evidence showing that the disputed domain name has been used for sending fraudulent email communications (Annex 14 to the Complaint). Currently, it resolves to an inactive website.

#### **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.

The Complainant states that the disputed domain name is confusingly similar to its trademarks PERFETTI and PERFETTI VAN MELLE, and to its associated domain names.

The Complainant contends that the Respondent have no rights or legitimate interests in respect of the disputed domain name, nor is related in any way to the Complainant. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks PERFETTI and PERFETTI VAN MELLE or apply for the registration of the disputed domain name.

More specifically, the Complainant alleges that the Respondent has not used and/or has no demonstrable intention to use the disputed domain name except to create a likelihood of confusion with the Complainant's trademark. In fact, the Complainant claims that the disputed domain name has been used in connection with fraudulent emails impersonating the Complainant's employees and is now being passively held.

## B. Respondent

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

## 6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interest in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is 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 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 Panel finds the PERFETTI and PERFETTI VAN MELLE marks are recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The typosquatting practice of deleting the letter "i" from the Complainant's registered trademarks PERFETTI and PERFETTI VAN MELLE does not prevent this Panel to conclude that the disputed domain name is confusingly similar to the Complainant's trademarks under [WIPO Overview 3.0](#), section 1.9.

Moreover, the ".com" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element of the confusing similarity test, as set forth in section 1.11.1 of the [WIPO Overview 3.0](#).

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.

The Complainant has claimed not to have authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the PERFETTI and PERFETTI VAN MELLE trademarks nor is there any other evidence in the file suggesting that the Respondent has or could have rights or legitimate interests in the disputed domain name.

Even more, it does not seem that the Respondent made nor is making a legitimate noncommercial or fair use of the disputed domain name. On the contrary, the disputed domain name has active mail servers associated with it and has been used in connection with fraudulent emails impersonating the Complainant's employees, as evidenced by the Complainant. Panels have held that the use of a domain name for illegal activity as impersonating or passing off and phishing can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Additionally, the Respondent is currently passively holding the disputed domain name, therefore, this Panel considers that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services.

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 such connection, the Complainant has submitted evidence to support that the trademarks PERFETTI and PERFETTI VAN MELLE are widely known and were registered and used many years before the Respondent registered the disputed domain name. When registering the disputed domain name, the Respondent targeted the Complainant's trademarks to generate confusion among Internet users and intended to benefit from the Complainant's reputation.

The Complainant has proven that the Respondent has created email addresses based on the disputed domain name and used them for sending fraudulent email communications impersonating the Complainant. Panels have held that the use of a domain name for illegal activity constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

The Panel notes that the disputed domain name currently resolves to an inactive website. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademarks, the composition of the disputed domain name, and the use of the disputed domain name for sending fraudulent email communications, and finds that in the circumstances of this case although the disputed domain name resolves to an inactive website, it does not prevent a finding of bad faith under the Policy.

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 <perfettvanmelle.com> be transferred to the Complainant.

*/Gustavo Patricio Giay/*

**Gustavo Patricio Giay**

Sole Panelist

Date: August 30, 2024