ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION

Luigi Lavazza S.p.A. v. Luther Nichols, Kyle Dickerson
Case No. D2024-5247

1. The Parties

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

The Respondent is Luther Nichols, Kyle Dickerson, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <lavazzacalendar.com> is registered with Tucows Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 20, 2024. On December 20, 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 (Contact Privacy Inc. Customer 0171094331) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 24, 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 December 27, 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 December 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 16, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 20, 2025.

The Center appointed Iris Quadrio as the sole panelist in this matter on January 28, 2025. 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 created in 1895 in Turin, Italy, and has grown to become one of the world's leading coffee brands. Renowned for its expertise in coffee blending, the Complainant pioneered the concept of mixing beans of different origins to achieve a balanced and flavorful product. Over the decades, the Complainant has continued to expand its presence and operations while maintaining its status as a family-owned business committed to quality and innovation.

The Complainant currently distributes its products through an extensive global network that includes direct subsidiaries and a broad distribution system across more than 140 countries. Its product range encompasses espresso blends, capsules, and coffee machines marketed under the marks A MODO MIO, LAVAZZA ESPRESSO POINT, and LAVAZZA BLUE. In Italy, the Complainant holds a 44.9% share of the retail coffee market in terms of value, and on a European level, it is among the top 50 most recognized brands.

The Complainant has launched highly successful international advertising campaigns and is widely recognized for the Lavazza Calendar, which has further solidified its brand identity worldwide. In fact, as evidenced by the Complainant in Annex 5.1, the latest edition of the Lavazza Calendar 2025 features personalities such as Big Mama and Jannik Sinner.

Additionally, the Complainant has been a pioneer in promoting Italian espresso culture, including taking its coffee to the International Space Station in collaboration with Argotec and the Italian Space Agency in 2015.

The Complainant's global reputation is reinforced by its significant financial performance, with revenues reaching 3.1 billion euros in 2023, reflecting a 13% growth compared to 2022 (As per Annex 5.9). This growth is further evidenced by strategic acquisitions, including the French brand Carte Noire, the Danish brand Merrild, and the U.S. brand Kicking Horse. The Complainant's extensive investments in research and development, marketing, sales, and distribution channels have solidified LAVAZZA as a globally recognized and well-known trademark.

In recognition of its strong brand presence and consumer trust, the Complainant has consistently ranked among the most reputable global brands. Specifically, it secured the 33rd position in the Reputation Institute's "Global RepTrak 100" ranking in 2020, the 47th position in 2022, and the 44th in 2023 (As per Annex 5.10).

The Complainant owns the trademark LAVAZZA in many jurisdictions including, the European Union Intellectual Property Office Reg. No. 000317057 for classes 21, 30 and 42, registered on May 25, 1998; International registrations Reg. No. 317174 for classes 29, 30 and 31, registered on July 18, 1966, Reg. No. 1186133 for classes 7 and 11, registered on July 29, 2013, and Reg. No. 1299219 for classes 11, 30 and 43, registered on February 23, 2016; and United States Patent and Trademark Office Reg. No. 5603887 for classes 11, 30 and 43, registered on November 13, 2018.

Likewise, the Complainant claims to own an important domain names portfolio, including, among others, its primary website "lavazza.com" registered since May 19, 1996.

As evidenced in Annexes 11.1 to 11.5, the Complainant tried to resolve this dispute outside of this administrative proceeding by sending a cease-and-desist letter to the Respondent on September 12, 2024, including reminders on September 25, and November 12, 2024, but did not receive a reply.

Finally, the disputed domain name was registered on May 6, 2024, and it currently resolves to an inactive website with the following notice: "This domain points to Shopify but isn't configured properly." Also, the disputed domain name has active Mail Exchange (MX) servers.

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 trademark LAVAZZA on which the Complainant has prior rights.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is not related to the Complainant in any way, nor has the Complainant established any activity and/or business with the Respondent.

More specifically, the Complainant alleged that the Respondent is passively holding the disputed domain name.

Finally, the Complainant requests the Administrative Panel appointed in this administrative proceeding that the disputed domain name be transferred to the Complainant.

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 entirety of the mark 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, the generic term "calendar", 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.

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 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 LAVAZZA trademark 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.

Additionally, as further discussed in Section C, the Respondent is passively holding the disputed domain name as it resolves to a parking Shopify website with the following text: "This domain points to Shopify but isn't configured properly" and, therefore, this Panel considers that the Respondent is not making any legitimate noncommercial or fair use of disputed domain name. Also, the disputed domain name incorporates the term "calendar", which is indeed clearly referred to the Complainant's famous LAVAZZA Calendar and therefore, carries a high risk of implied affiliation.

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 trademark LAVAZZA is widely known and was registered and used many years before the Respondent registered the disputed domain name. When registering the disputed domain name, the Panel finds that the Respondent has likely targeted the Complainant's trademarks to generate confusion among Internet users and benefit from the Complainant's reputation.

The disputed domain name resolves to an inactive page. Panels have found that the non-use of a domain name would not prevent the 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 trademark, and the composition of the disputed domain name, and considers that, in this case, the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Even more, the Respondent has ignored the cease-and-desist letter from the Complainant, which aimed at resolving this matter amicably outside of this administrative proceeding.

Besides, the Complainant proved that MX records have been set up for the disputed domain name, which would enable the Respondent to send emails under the disputed domain name that is confusingly similar to the Complainant's mark, and in view of the nature of the disputed domain name creates a risk that it may be used for misleading purposes. This affirms the Panel's finding of the Respondent's bad faith in both registering and using the disputed domain name.

The Panel therefore 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 <lavazzacalendar.com> be transferred to the Complainant.

/Iris Quadrio/
Iris Quadrio
Sole Panelist
Date: February 11, 2025