

ADMINISTRATIVE PANEL DECISION

The Middleby Corporation v. Carolina Rodrigues, Fundacion Comercio Electronico

Case No. DCO2022-0099

1. The Parties

The Complainant is The Middleby Corporation, United States of America (“United States”), represented by Demys Limited, United Kingdom.

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Names and Registrar

The disputed domain names <levensmiddlebyworldwide.co>, <mervynmiddleby.co>, <middlebyadvantageparts.co>, <middlebyauction.co>, <middlebyaustralia.co>, <middlebybakerygroup.co>, <middlebyblog.co>, <middlebybrands.co>, <middlebycareers.co>, <middlebycelfrost.co>, <middlebycom.co>, <middlebyconstructions.co>, <middlebycorp.co>, <middlebycorporate.co>, <middlebydirect.co>, <middlebyerp.co>, <middlebyeurope.co>, <middlebyglobal.co>, <middlebyindia.co>, <middlebyinnovationkitchens.co>, <middlebyintegrate.co>, <middlebylab.co>, <middlebymarine.co>, <middlebymarshall.co>, <middlebymarshall.co>, <middlebymarshallkitchenofthefuture.co>, <middlebymarshallparts.co>, <middlebymarshallsecondhand.co>, <middlebymarshallused.co>, <middlebymarshell.co>, <middlebymedia.co>, <middlebyone.co>, <middlebyonline.co>, <middlebyoven.co>, <middlebyovens.co>, <middlebyparts.co>, <middlebypizzaequipment.co>, <middlebypizzaoven.co>, <middlebyqingdao.co>, <middlebyresidential.co>, <middlebysales.co>, <middlebys.co>, <middlebyservice.co>, <middlebyshop.co>, <middlebysite.co>, <middlebyspares.co>, <middlebysupplier.co>, <middlebytaylor.co>, <middlebytemp.co>, <middlebyworldwide.co>, <middlebyworldwideparts.co>, <mmiddleby.co>, <nmiddleby.co>, <rmiddleby.co>, <themiddleby.co>, <themiddlebycorp.co>, <themiddlebylink.co>, <thisismiddleby.co>, <thurnemiddleby.co>, and <usedmiddlebymarshall.co> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2022. On November 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 15, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for

the disputed domain names, which differed from the named Respondent and contact information in the Complaint (Registration Private, Domains By Proxy, LLC). The Center sent an email communication to the Complainant on November 16, 2022, 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 November 16, 2022.

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 November 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 13, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on January 3, 2023. 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 manufacturer of commercial restaurant equipment, residential appliances and systems for industrial processing, packaging and baking. Founded in 1888 in Chicago, it is currently present in 150 countries and has become known for its range of residential kitchen appliances under brands that include AGA, Rangemaster, Brava, La Cornue, Krüshr, Lynx, Stanley and others.

Either directly or through its operating subsidiary, Middleby Marshall Inc., the Complainant has rights in, amongst several others, the following trademark registrations:

- International Trademark Registration No. 1600332 for the word mark MIDDLEBY, registered on February 5, 2021, in international classes 35, 40, 42, and 43;
- Brazilian Trademark Registration No. 909269394 for the word mark MIDDLEBY, registered on March 13, 2018, in international class 11;
- United Kingdom Trademark Registration No. UK00001339056 for the word mark MIDDLEBY MARSHALL, registered on October 13, 1989, subsequently renewed, in international class 11; and
- United States Trademark Registration No. 1109952 for the word mark MIDDLEBY-MARSHALL, registered on December 26, 1978, subsequently renewed, in international class 11.

According to the evidence provided by the Complainant, the disputed domain names resolved to pay-per-click (PPC) advertising webpages. The disputed domain names are presently used in connection with:

Disputed Domain Name	Registration Date	Present Use
<levensmiddlebyworldwide.co>	July 15, 2022	Parked webpage with PPC links.
<mervynmiddleby.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyadvantageparts.co>	July 15, 2022	No active webpage.
<middlebyauction.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyaustralia.co>	July 15, 2022	Parked webpage with PPC links.

Disputed Domain Name	Registration Date	Present Use
<middlebybakerygroup.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyblog.co>	July 15, 2022	Parked webpage with PPC links.
<middlebybrands.co>	July 15, 2022	Parked webpage with PPC links.
<middlebycareers.co>	July 15, 2022	Parked webpage with PPC links.
<middlebycelffrost.co>	July 15, 2022	Parked webpage with PPC links.
<middlebycom.co>	July 21, 2022	Parked webpage with PPC links.
<middlebyconstructions.co>	July 15, 2022	Parked webpage with PPC links.
<middlebycorp.co>	July 15, 2022	Parked webpage with PPC links.
<middlebycorporate.co>	July 15, 2022	Parked webpage with PPC links.
<middlebydirect.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyerp.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyeurope.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyglobal.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyindia.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyinnovationkitchens.co>	July 15, 2022	No active webpage.
<middlebyintegrate.co>	July 15, 2022	Parked webpage with PPC links.
<middlebylab.co>	July 15, 2022	Parked webpage with PPC links.
<middlebymarine.co>	July 15, 2022	Parked webpage with PPC links.
<middlebymarshall.co>	July 15, 2022	Parked webpage with PPC links.
<middlebymarshallkitchenofthefuture.co>	July 15, 2022	Parked webpage with PPC links.
<middlebymarshallparts.co>	July 15, 2022	No active webpage.
<middlebymarshallsecondhand.co>	July 15, 2022	Parked webpage with PPC links.
<middlebymarshallused.co>	July 15, 2022	Parked webpage with PPC links.
<middlebymarshell.co>	July 15, 2022	No active webpage.
<middlebymedia.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyone.co>	July 21, 2022	No active webpage.
<middlebyonline.co>	July 15, 2022	No active webpage.
<middlebyoven.co>	July 15, 2022	No active webpage.
<middlebyovens.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyparts.co>	July 15, 2022	No active webpage.
<middlebypizzaequipment.co>	July 15, 2022	No active webpage.
<middlebypizzaoven.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyqingdao.co>	July 15, 2022	No active webpage.
<middlebyresidential.co>	July 15, 2022	No active webpage.
<middlebysales.co>	July 15, 2022	No active webpage.
<middlebys.co>	July 15, 2022	No active webpage.
<middlebyservice.co>	July 15, 2022	No active webpage.
<middlebyshop.co>	July 15, 2022	No active webpage.
<middlebysite.co>	July 15, 2022	Parked webpage with PPC links.
<middlebyspares.co>	July 15, 2022	No active webpage.
<middlebysupplier.co>	July 15, 2022	No active webpage.
<middlebytaylor.co>	July 15, 2022	No active webpage.
<middlebytemp.co>	July 15, 2022	No active webpage.
<middlebyworldwide.co>	July 15, 2022	No active webpage.
<middlebyworldwideparts.co>	July 15, 2022	Parked webpage with PPC links.
<mmiddleby.co>	July 15, 2022	No active webpage.

Disputed Domain Name	Registration Date	Present Use
<nmiddleby.co>	July 15, 2022	No active webpage.
<rmiddleby.co>	July 15, 2022	No active webpage.
<themiddleby.co>	July 15, 2022	No active webpage.
<themiddlebylink.co>	July 15, 2022	No active webpage.
<themiddlebycorp.co>	July 15, 2022	No active webpage.
<themiddlebylink.co>	July 15, 2022	No active webpage.
<thisismiddleby.co>	July 15, 2022	No active webpage.
<thurnemiddleby.co>	July 15, 2022	Parked webpage with PPC links.
<usedmiddlebymarshall.co>	July 15, 2022	No active webpage.

5. Parties' Contentions

A. Complainant

The Complainant asserts to have been founded as Middleby Marshall Oven Company in 1888 in Chicago, United States, by Joseph Middleby and John Marshall, having changed its name to The Middleby Corporation in 1985. The Complainant further asserts to presently employ over 10,000 employees in more than 150 countries, having achieved net sales of USD 2,513.3 million, with over USD 882 million gross profit in 2020.

According to the Complainant, the Respondent has been party to more than 550 previous disputes under the UDRP, the majority of which found against the Respondent, having registered the disputed domain names in bad faith and used them in connection with PPC advertising webpages containing third-party commercial advertising links related to the Complainant's business and activities.

The Complainant further observes that the disputed domain names are configured with Mail eXchanger ("MX") records as well as with Sender Policy Framework ("SPF") records which decreases the likelihood of emails sent from the specified server on the disputed domain names' behalf from being marked as spam by the recipients, what indicates, under the Complainant's view, that the disputed domain names have been configured with email communication in mind.

In addition to the aforementioned, the Complainant notes that the disputed domain names are listed for sale on an online domain name marketplace, "Sedo.com", with the asking price of USD 899 per the disputed domain name.

To make matters worse, the Complainant states that its agent wrote to the Respondent on August 25, 2022, using the Registrar's contact form on 10 randomly selected disputed domain names but did not receive any response.

Under the Complainant's view, all of the disputed domain names incorporate the Complainant's MIDDLEBY name and trademark in its entirety, with the addition of adornments such as "Australia", "blog", "oven", "shop", "global", and etc., which however do not distinguish the disputed domain names from the Complainant's trademark and are thus confusingly similar in terms of the Policy given that the Complainant's trademark is the most recognizable and dominant element in the disputed domain names, falsely suggesting affiliation between the Respondent and the Complainant.

Regarding the absence of the Respondent's rights or legitimate interests, the Complainant argues that:

- (i) the Respondent is not commonly known as "Middleby"; having the Complainant found no evidence that the Respondent owns any trademarks incorporating the term "Middleby";

- (ii) the Respondent is not a licensee of the Complainant and has not received any permission or consent from the Complainant to use its name or MIDDEBLY trademark; and
- (iii) the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services given that the disputed domain names resolve to PPC advertising webpages containing third-party commercial advertising links related to the Complainant's business and activities.

As to the registration and use of the disputed domain names, the Complainant states that:

- (i) the disputed domain names carry a high risk of implied affiliation as they incorporate the Complainant's name and trademark in its entirety and the additional adornments are closely associated with the Complainant and its activities, products, brands or subsidiaries what would lead Internet users into assuming that the disputed domain names are operated, sponsored, or endorsed by the Complainant;
- (ii) the use of the disputed domain names in connection with PPC advertising in association with a domain name that is confusingly similar to a complainant's trademark has already been found as sufficient on its own for a finding of registration and use in bad faith, regardless of whether it was directly placed by the respondent or the Registrar;
- (iii) the disputed domain names being listed for sale is strongly indicative that the Respondent had a bad faith intent when it registered the disputed domain names;
- (iv) the Respondent has engaged in a pattern of conduct within the meaning of paragraph 4(b)(ii) of the Policy by registering 60 domain names targeting the Complainant's trademark, in addition to have been named a party in 550 past UDRP cases;
- (v) the disputed domain names are configured with MX and SPF records and are therefore capable of effective email communication and potential phishing attacks; and
- (vi) the Respondent did not reply to the communication sent by the Complainant's agent, who used the Registrar's domain holder contact request form in an attempt to resolve the matter amicably.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain names to the Complainant:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (i) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (ii) the disputed domain names have been registered and are being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain names.

A. Identical or Confusingly Similar

The Complainant has established rights over the MIDDLEBY trademark.

All of the disputed domain names incorporate the trademark in its entirety.

The addition of other terms and letters, such as “levens”, “worldwide”, “mervyn”, “advantage”, “parts”, “auction”, “Australia”, “bakery”, “group”, “blog”, “brands”, “careers”, “celfrost”, “com”, “constructions”, “corp”, “corporate”, “direct”, “erp”, “europe”, “global”, “india”, “innovation”, “kitchens”, “integrate”, “lab”, “marine”, “marshal”, “marshall”, “kitchen of the future”, “secondhand”, “used”, “marshall”, “media”, “one”, “online”, “oven”, “ovens”, “pizza equipment”, “pizza oven”, “qingdao”, “residential”, “sales”, “s”, “service”, “shop”, “site”, “spares”, “supplier”, “taylor”, “temp”, “m”, “n”, “r”, “the”, “link”, “this”, “is”, and “thurne”, does not prevent a finding of confusing similarity with the MIDDLEBY trademark under the Policy, which, as recognized by UDRP panels involves a “comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name” (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7).

For the reasons above, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s trademarks.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent’s rights or legitimate interests in the disputed domain names. These circumstances are:

- (i) before any notice of the dispute, the Respondent’s use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain names, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names. This entitles the Panel to draw any inferences from such default as it considers appropriate, pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make at least a *prima facie* case against the Respondent under the second UDRP element.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent, which has not been commonly known by the disputed domain names and neither has been authorized or allowed by the Complainant to make any use of the MIDDLEBY trademark.

Also, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain names, or any possible link between the Respondent and the 60 disputed domain names that could be inferred from the details known of the Respondent or to webpages relating to the disputed domain names, corroborate with the Panel’s finding of the absence of rights or legitimate interests.

Another element to consider is the fact that the previous use of all of the disputed domain names in connection with PPC advertisements and the present inactive use of some of the disputed domain names make it even more difficult to conceive which rights or legitimate interests the Respondent would have in the 60 disputed domain names that reproduce the Complainant’s trademark in its entirety.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain names.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring them to the Complainant who is the owner of a trademark relating to the disputed domain names or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain names; or

(ii) the Respondent has registered the disputed domain names in order to prevent the owner of the trademark or service mark from reflecting the mark in corresponding domain names, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the disputed domain names primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's websites or other locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites or locations or of a product or service on the Respondent's websites or locations.

UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

According to the evidence provided by the Complainant, the disputed domain names resolved to PPC advertising webpages. Therefore, the Respondent has registered and used the disputed domain names in bad faith pursuant paragraph 4(b)(iv) of the Policy.

Although some of the disputed domain names do not currently resolve to any active website, UDRP panels have already dealt with the question of whether the "passive holding" of a domain name could constitute bad faith. Section 3.3 of the [WIPO Overview 3.0](#) states that "[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put."

In the present case, the Panel finds that the current passive holding of some of the disputed domain names by the Respondent amounts to the Respondent's bad faith, given that the Respondent has provided no evidence whatsoever of any actual or contemplated good-faith use of the disputed domain names. In addition to that, particularly considering the fame and reputation of the Complainant's MIDDLEBY trademark, it would not be possible to conceive any plausible actual or contemplated good-faith use of the 60 disputed domain names by the Respondent that would not be illegitimate.

Two other factors corroborate the finding of the Respondent's bad faith conduct in this case: the offer for sale of the disputed domain names and the lack of reply to the Complainant's agent's letter sent prior to this proceeding.

Moreover, the Panel also note that the Respondent has been involved in hundreds of cases under the Policy, the majority of which found against the Respondent.

For the reasons above, the Panel finds that the Respondent has registered and used the disputed domain names in bad faith.

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 names <levensmiddlebyworldwide.co>, <mervynmiddleby.co>, <middlebyadvantageparts.co>, <middlebyauction.co>, <middlebyaustralia.co>, <middlebybakerygroup.co>, <middlebyblog.co>, <middlebybrands.co>, <middlebycareers.co>, <middlebycelfrost.co>, <middlebycom.co>, <middlebyconstructions.co>, <middlebycorp.co>, <middlebycorporate.co>, <middlebydirect.co>, <middlebyerp.co>, <middlebyeurope.co>, <middlebyglobal.co>, <middlebyindia.co>, <middlebyinnovationkitchens.co>, <middlebyintegrate.co>, <middlebylab.co>, <middlebymarine.co>, <middlebymarshal.co>, <middlebymarshall.co>, <middlebymarshallkitchenofthefuture.co>, <middlebymarshallparts.co>, <middlebymarshallsecondhand.co>, <middlebymarshallused.co>, <middlebymarshell.co>, <middlebymedia.co>, <middlebyone.co>, <middlebyonline.co>, <middlebyoven.co>, <middlebyovens.co>, <middlebyparts.co>, <middlebypizzaequipment.co>, <middlebypizzaoven.co>, <middlebyqingdao.co>, <middlebyresidential.co>, <middlebysales.co>, <middlebys.co>, <middlebyservice.co>, <middlebyshop.co>, <middlebysite.co>, <middlebyspares.co>, <middlebysupplier.co>, <middlebytaylor.co>, <middlebytemp.co>, <middlebyworldwide.co>, <middlebyworldwideparts.co>, <mmiddleby.co>, <nmiddleby.co>, <rmiddleby.co>, <themiddleby.co>, <themiddlebycorp.co>, <themiddlebylink.co>, <thisismiddleby.co>, <thurnemiddleby.co>, and <usedmiddlebymarshall.co> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: January 17, 2023