

## **ADMINISTRATIVE PANEL DECISION**

Aldi GmbH & Co. KG and Aldi Stores Limited v. Hulmiho Ukolen, Poste restante

Case No. D2022-4285

### **1. The Parties**

The Complainants are Aldi GmbH & Co. KG, Germany, and Aldi Stores Limited, United Kingdom (“UK”), represented by Freeths LLP, UK.

The Respondent is Hulmiho Ukolen, Poste restante, Finland.

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

The disputed domain name <aldimixxer.com> is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 10, 2022. On November 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which the Complainant was not able to identify in the Complaint. The Center sent an email communication to the Complainant on November 15, 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 amendment to the Complaint on November 21, 2022.

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 November 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 15, 2022.

The Center appointed Zoltán Takács as the sole panelist in this matter on December 20, 2022. 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 Complainants in this administrative proceeding are Aldi GmbH & Co. KG, hereinafter referred to as First Complainant, and Aldi Stores Limited, hereinafter referred to as Second Complainant (collectively referred to as “the Complainants”).

The First Complainant owns a number of trademarks consisting of or comprising the term ALDI, including:

- UK Trademark Registration No. 00002250300 for the word mark ALDI, registered since March 30, 2001, for variety of goods and services of the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks (“the Nice Classification”), and
- European Union Trademark Registration (“EUTM”) No. 002071728 for the word mark ALDI, registered since June 20, 2005, for variety of goods and services of the Nice Classification.

The Second Complainant is a well-known UK supermarket chain under common control with the First Complainant and is the exclusive licensee in the UK of various registered trademarks which comprise and/or include the sign ALDI.

The Complainants and their connected companies trade under the name ALDI, and are recognized as international leaders in grocery retailing. They have more than 5,000 stores across the world, including Australia, Austria, Belgium, Denmark, France, Germany, Hungary, Ireland, Luxembourg, the Netherlands, Poland, Portugal, Spain, Switzerland, the UK, and the United States of America.

The disputed domain name was registered on March 31, 2022, and resolved to a website hosting various sponsored links.

#### **5. Parties’ Contentions**

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

The Complainants contend that the disputed domain name is confusingly similar to the ALDI trademark because it reproduces the trademark in its entirety with the addition of the term “mixxer”.

The Complainants allege that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainants submit that the disputed domain name was registered and is being used in bad faith. Given the similarity between the ALDI trademark and the disputed domain name, Internet users accessing the website at the disputed domain name are likely to be mistaken into believing that its content is endorsed or otherwise authorized by the Complainants.

The Complainants request that the disputed domain name be transferred from the Respondent to the First Complainant, Aldi GmbH & Co. KG.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a nationally or regionally registered trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainants rely upon the ALDI trademarks owned by the First Complainant, in which the Second Complainant has exclusive license rights in the UK.

The Complaint is also stated to be filed by the Complainants under common control, and although no documentary evidence was produced, the Panel accepts these statements certified in the Complaint to be accurate and finds that the Complainants have rights in the trademark under the UDRP for purposes of standing to file this Complaint (see section 1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Complainants produced proper evidence of having registered rights in the ALDI trademark and for the purpose of this proceeding the Panel establishes that the UK Trademark Registration No. 00002250300 and the EUTM No. 002071728 satisfy the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainants' trademark rights, the Panel next assessed whether the disputed domain name is identical or confusingly similar to the trademark.

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. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. If so, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see sections 1.7 and 1.8 of the [WIPO Overview 3.0](#)).

The disputed domain name fully incorporates the ALDI trademark. The addition of the term "mixxer" to the trademark does not avoid a finding of confusing similarity.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable generic Top-Level Domain (“gTLD”) in a domain name (in this case “com”) is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The Panel finds that the disputed domain name is confusingly similar to the Complainants’ trademark and that requirement of paragraph 4(a)(i) of the Policy is satisfied.

## **B. Rights or Legitimate Interests**

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

In the present case, the Complainants have submitted sufficient and uncontested evidence of having well-established rights in the ALDI trademark.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible 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 the relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Respondent chose not to respond to the Complaint brought forward by the Complainant. By doing so, the Respondent failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant’s *prima facie* case.

The Complainants assert that the Respondent is not their licensee or distributor. The Respondent is not affiliated with the Complainants in any way and the Complainants have not granted any authorization for the Respondent to make use of the ALDI trademark, in a domain name or otherwise.

The disputed domain name was parked with the Registrar, and the corresponding website comprised pay-per-click (“PPC”) links, some of which, like “Food Store” were in direct competition with the Complainants. UDRP 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 either compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users (see section 2.9 of the [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

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

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The ALDI trademark, which the disputed domain name incorporates in its entirety, has no dictionary meaning and is highly distinctive for the corresponding services.

The well-known status of the ALDI trademark has been recognized by previous UDRP panels (see *Aldi GmbH & Co. KG v. bestview GmbH netsolutions*, WIPO Case No. [D2011-1383](#), and *Aldi GmbH & Co. KG, Aldi Stores Limited v. Cja Jeansson*, WIPO Case No. [D2017-0012](#)).

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

Also, given the well-known status of the ALDI trademark, it is implausible to presume that the Respondent chose to incorporate it in the disputed domain name for any other reason than to create a false impression of an association with the Complainants and trade off of the goodwill the Complainants have established in the ALDI trademark. This qualifies as bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

The fact that the disputed domain name at the time of rendering of the decision appears not to resolve to an active website does not alter the Panel’s conclusions. According to section 3.3 of the [WIPO Overview 3.0](#), passive holding of a domain name does not necessarily prevent a finding of bad faith when weighing the totality of the circumstances. Considering the distinctiveness of the Complainant’s trademark, the prior use of the disputed domain name for sponsored commercial links, and the Respondent’s pattern of bad faith conduct (see, e.g., *Bureau Veritas v. Whois Protection / Hulmiho Ukolen, Poste Restante*, WIPO Case No. [D2017-1557](#), and *Sodexo v. Hulmiho Ukolen, Poste Restante*, WIPO Case No. [D2022-0199](#)), the Panel cannot conceive of any legitimate use of the disputed domain name by the Respondent other than targeting the Complainants’ business and the ALDI trademark, which establishes bad faith.

For the reasons set out above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

## **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 <aldimixxer.com> be transferred to the First Complainant, Aldi GmbH & Co. KG.

*/Zoltán Takács/*

**Zoltán Takács**

Sole Panelist

Date: January 3, 2023