

ADMINISTRATIVE PANEL DECISION

**Aldi GmbH & Co. KG, Aldi Stores Limited v. Aldiana Kreso, Shopwithaldiana
Case No. D2023-0118**

1. The Parties

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

The Respondent is Aldiana Kreso, Shopwithaldiana, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <shopwithaldi.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 January 10, 2023. On January 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 11, 2023, 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 0164445054) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 16, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on January 19, 2023.

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 January 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 9, 2023. The Respondent sent an email communication to the Center on January 20, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on March 9, 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 first Complainant Aldi GmbH & Co. KG is the owner of various registered trademarks, which comprise the sign ALDI.

The second Complainant Aldi Stores Limited – incorporated in 1988 under the company name Aldi Limited, then changed to Aldi Stores Limited in 1989 – is the exclusive licensee of the first Complainant’s trademarks in the United Kingdom and operates a chain of well-known supermarkets under the trademark ALDI.

The Complainants and their connected companies are recognized as international leaders in grocery retailing. They have more than 5.000 stores across the world and are also active in Australia, Austria, Belgium, Denmark, France, Germany, Ireland, Luxembourg, the Netherlands, Poland, Portugal, Slovenia, Spain, Switzerland, and the United States.

The first Complainant is the owner, amongst others, of the following trademark registrations:

- United Kingdom trademark registration No. UK00002250300 for ALDI (word mark), filed on October 26, 2000, and registered on March 30, 2001, in classes 1, 3, 5, 6, 11, 16, 21, 24, 25, 29, 30, 31, 32, 33, 34, and 35;
- United Kingdom trademark registration No. UK00902714459 for ALDI (word mark), filed on May 27, 2002, and registered on September 5, 2003, in classes 35, and 36;
- European Union trademark registration No. 002714459 for ALDI (word mark), filed on May 27, 2002, and registered on September 5, 2003, in classes 35, and 36;
- United Kingdom trademark registration No. UK00902071728 for ALDI (word mark), filed on December 27, 2000, and registered on April 14, 2005, in classes 3, 4, 9, 16, 24, 25, 29, 30, 31, 32, 33, and 34.
- European Union trademark registration No. 002071728 for ALDI (word mark), filed on December 27, 2000, and registered on April 14, 2005, in classes 3, 4, 9, 16, 24, 25, 29, 30, 31, 32, 33, and 34;
- European trademark registration No. 003639408 for ALDI (word mark), filed on February 4, 2004, and registered on April 19, 2005, in classes 36, 39, 41, and 43.

The second Complainant operates a website at the domain name <aldi.co.uk>, which was registered on September 29, 1996, and is used by the Complainant to promote its services under the trademark ALDI.

The disputed domain name was registered on May 20, 2022, and is not pointed to an active website.

5. Parties’ Contentions

A. Complainant

The Complainants contend that the disputed domain name <shopwithaldi.com> is confusingly similar to the trademark ALDI in which the Complainants have rights as it reproduces the trademark in its entirety with the mere addition of the terms “shop” and “with” and the generic Top-Level Domain “.com”.

The Complainants contend that the addition of the terms “shop” and “with” only serves to enhance confusion

as it suggests that the disputed domain name will host a webpage relating to goods or services, which are specifically sold by the Complainants.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainants state that the Respondent was in no way licensed or otherwise authorized to use the trademark ALDI.

Furthermore, the Complainants underline that the Respondent has not (i) used the disputed domain name or any name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services, (ii) been commonly known by the disputed domain name or (iii) made any legitimate noncommercial or fair use of the disputed domain name.

With reference to the circumstances evidencing bad faith, the Complainants indicate that it is inevitable that Internet users will be confused into believing that the disputed domain name has some form of association with the Complainants and submit that the registration of the disputed domain name took unfair advantage of the Complainants' rights.

The Complainants emphasize that the disputed domain name makes unauthorized use of a sign confusingly similar to the Complainants' registered trademark ALDI, in direct contravention of the Complainants' trademark rights.

The Complainants also submit that the disputed domain name has been, or is planning to be, intentionally used to attract Internet users, for commercial gain, to any website hosted at the disputed domain name by creating a likelihood of confusion with the trademark ALDI as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

In view of the Complainants, it is also possible that the disputed domain name was registered by the Respondent to offer the same for sale to either the Complainants or their competitors at a price higher than the cost of registration.

B. Respondent

The Respondent did not file a formal Response but sent only an informal email communication to the Center from the Registrar-confirmed email address, on January 20, 2023, stating that it was totally unaware of the registration of the disputed domain name in its name.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint 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." Paragraph 4(a) of the Policy directs that the Complainants must prove each of the following:

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

A. Identical or Confusingly Similar

The Complainants have provided evidence of ownership of numerous trademark registrations for ALDI registered in the name of the first Complainant and of which the second Complainant is exclusive licensee, as mentioned under Section 4 above.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side 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.

The Panel finds that the disputed domain name is confusingly similar to the trademark ALDI as it reproduces the trademark in its entirety with the gTLD ".com", which can be disregarded when comparing the similarities between a domain name and a trademark, and the mere addition of the terms "shop" and "with".

As found in a number of prior cases decided under the Policy, where a trademark is recognizable within a domain name, the addition of generic or descriptive terms does not prevent a finding of confusing similarity under the first element. See section 1.8 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainants have proven that the disputed domain name is confusingly similar to a trademark in which the Complainants have established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

It is well-established that the burden of proof lies on the Complainants. However, satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the Complainants show a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainants are deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In the case at hand, by not submitting a formal Response, the Respondent has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainants. The Respondent is not a licensee of the Complainants, nor has the Respondent otherwise obtained an authorization to use the Complainants' trademarks.

"The Panel takes note of the composition of the Respondent's name, especially the registrant's organization name "Shopwithaldiana", which could refer to Respondent's first name "Aldiana", however, the Respondent has not come forward with any evidence of right or legitimate interests, and none are apparent on this record. Additionally, the Respondent stated "I never made this shopwithaldi account" in its informal communication sent to the Center on January 20, 2023, which seems to disclaim any relationship with the registration of the disputed domain name."

In view of the above-described use of the disputed domain name, the Panel finds that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainants' trademark.

The Panel notes that the disputed domain name is passively held. The Panel shares the view held in *Aldi Stores Limited, Aldi GmbH & Co. KG v. Domain Administrator, Registrant of aldisstore.com / Chen Xiansheng*, WIPO Case No. [D2022-1872](#) (<aldisstore.com>), in which the domain name was not actively used and the panel held that "There is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name or that before any notice of the dispute the Respondent

has made use of, or demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services” and that “the term “store” in the disputed domain name gives the idea that the disputed domain name refers to a website where the Complainants’ products can be purchased. Thus, the construction of the disputed domain name itself is such to carry a risk of implied affiliation that cannot constitute fair use. See section 2.5.1, [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainants have proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainants prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

The Panel notes that, in light of the prior registration and use of the trademark ALDI and the widely known character of such trademark in the field of grocery retailing, the Respondent was more likely than not aware of the Complainants and their trademark at the time of registration of the disputed domain name.

The disputed domain name is not pointed to an active website, *i.e.* is passively held. According to section 3.3 of the [WIPO Overview 3.0](#), “From 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 case at hand, in view of i) the distinctiveness and reputation of the Complainants’ trademark ALDI; ii) the composition of the disputed domain name, including the expression “shop with”, which may be referred to the Complainants’ provision of products to Internet users via their online supermarkets reinforcing the impression that the Respondent is affiliated with the Complainants, and sought to specifically target the Complainants; iii) the absence of any documented rights or legitimate interests of the Respondent in the disputed domain name; iv) the Respondent’s failure to formally respond to the Complaint and the informal email communication sent to the Center by the Respondent from the Registrar’s confirmed email address with the indication that the sender of the email was unaware of the registration of the disputed domain name in its name, the Panel finds that the current passive holding of the disputed domain name does not prevent a finding of bad faith.

Therefore, the Panel finds that the Complainants have also proven that the Respondent registered and are using the disputed domain name in bad faith according to paragraph 4(a)(iii) 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 <shopwithaldi.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: March 25, 2023