Decision for dispute CAC-UDRP-102333

Case number	CAC-UDRP-102333
Time of filing	2019-02-04 09:15:57
Domain names	AMEDEI.TOP

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Amedei S.r.l.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	sun xin

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it is the owner of certain trademark registrations that consist of or contain the mark AMEDEI (the "AMEDEI Trademark"), including Int'l Reg. No. 879,334 for the mark AMEDEI (registered January 30, 2006) and EU Reg. No. 4,796,281 for the mark AMEDEI (registered November 29, 2006).

FACTUAL BACKGROUND

Complainant states that it is "one of the most appreciated Italian producers and distributors of chocolate"; that it "was founded in 1990 by Mrs Cecilia Tessieri, the first female maître chocolatier"; and that its "main export markets are Europe, United States, Australia, Hong Kong Singapore and Japan."

The disputed domain name was created on December 18, 2018, and is not being used in connection with an active website.

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant states that "[i]t is more than obvious that the domain name at issue is identical or at least

confusingly similar to the Complainant's trademark 'AMEDEI'" because "<amedei.top> is identical to the 'AMEDEI' trademark save for the fact it contains the gTLD suffix '.top'."

Paragraph 4(a)(ii): Complainant states that Respondent "has nothing to do with" Complainant; that "[n]obody has been authorized or licensed by [Complainant] to use the domain name at issue"; that the disputed domain name "does not correspond to the name of the Respondent and, to the best of [Complainant's] knowledge, [Respondent] is not commonly known as 'AMEDEI'"; and that "we do not find any use of the domain name at stake since said domain name has been never linked to an active website."

Paragraph 4(a)(iii): Complainant states that the disputed domain name was registered and is being used in bad faith because, inter alia, "[t]he fact that the Respondent has registered a domain name that is almost identical and at least confusingly similar to it clearly indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name"; that "if the Respondent had carried even a basic Google search in respect of the word 'AMEDEI', the same would have yielded obvious references to the Complainant"; that "[t]he contested domain name is not used for any bona fide offerings, even if it is not connected to any web site"; and that "[t]he consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith."

PARTIES CONTENTIONS

No administratively compliant response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the Policy were met and there is no other reason why it would be inappropriate to provide a decision.

The Panel notes that the Complaint was filed in English and that the Case Administrator informed the Complainant on February 5, 2019, "We were informed by the Registrar that the language of the Registration Agreement is Chinese." In the Amended Complaint, Complainant requested that the Complaint be accepted in English because "the Complainant is an Italian company, while the Respondent - according to the whois - is a Chinese organization"; English is "an international language comprehensible to a wide range of Internet users worldwide"; "the spirit of Paragraph 11 of the Rules seems to be to ensure fairness in the selection of language by giving full considerations to the parties' level of comfort with each language"; and "it is not possible to ignore that the present dispute has been started because the Respondent deliberately registered a domain name which is identical to a well-known registered trademark, legitimately owned and used by the Complainant from several years all around the world."

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.5, states: "panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios include (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant's mark, (iii) any content

on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, (v) prior correspondence between the parties, (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint, (vii) evidence of other respondent-controlled domain names registered, used, or corresponding to a particular language, (viii) in cases involving multiple domain names, the use of a particular language agreement for some (but not all) of the disputed domain names, (ix) currencies accepted on the webpage under the disputed domain name, or (x) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement."

Here, the language/script of the disputed domain name is the same as that of the Complainant's mark. Further, Respondent has not objected to English as the language of this proceeding. Accordingly, the Panel accepts the Complaint in English.

PRINCIPAL REASONS FOR THE DECISION

Identical or Confusingly Similar

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the AMEDEI Trademark.

As to whether the disputed domain name is identical or confusingly similar to the AMEDEI Trademark, the relevant comparison to be made is with the second-level portion of the disputed domain name only (i.e., "amedei") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview of WIPO Overview 3.0, section 1.11.1.

Here, the disputed domain name contains the AMEDEI Trademark (and only the AMEDEI Trademark) in its entirety. As set forth in section 1.7 of WIPO Overview 3.0, "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Rights or Legitimate Interests

Complainant states that Respondent "has nothing to do with" Complainant; that "[n]obody has been authorized or licensed by [Complainant] to use the domain name at issue"; that the Disputed Domain Name "does not correspond to the name of the Respondent and, to the best of [Complainant's] knowledge, [Respondent] is not commonly known as 'AMEDEI'"; and that "we do not find any use of the domain name at stake since said domain name has been never linked to an active website."

WIPO Overview 3.0, section 2.1, states: "While 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 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 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 Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

Registered and Used in Bad Faith

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the Policy: (i) circumstances indicating that the registrant has registered or the registrant has 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 the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has 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 the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's 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 the registrant's website or location or of a product or service on the registrant's website or location.

WIPO Overview 3.0, section 3.3, citing the landmark decision Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, states: "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."

Here, the Panel finds that the AMEDEI Trademark is distinctive and appears to have a notable reputation and Respondent did not submit a response.

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **AMEDEI.TOP**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2019-03-13

Publish the Decision