Decision for dispute CAC-UDRP-102338

Case number	CAC-UDRP-102338
Time of filing	2019-02-12 10:20:34
Domain names	giallo-zafferano.com

Case administrator

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

Complainant

Organization	Arnoldo Mondadori Editore S.p.a.

Complainant representative

Organization	Dragotti & Associati S.r.l.

Respondent

Name	Mourad Lougmihy

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns, inter alia, the European Union trademarks

-- GIALLO ZAFFERANO (word) no. 016362171, filed on February 13, 2017, and registered on March 21, 2018, for goods and services in classes 9, 16, 35, 38 and 41; and
-- Giallo Zafferano (device) no. 016362204, filed on February 13, 2017, and registered on July 6, 2017, also for goods and services in classes 9, 16, 35, 38 and 41

(collectively the "Trademarks").

The disputed domain name was registered on March 10, 2018, i.e. (i) both of the Complainant's Trademark applications and (ii) one of the Trademark registrations cited above predate the registration of the disputed domain name.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a reputed and worldwide leading publishing house for books, magazines, media production and distribution.

Among the print magazines published by the Complainant is the Italian magazine GIALLO ZAFFERANO about food and cooking, which is published since 2017. The magazine originally started as a website cooking blog under <giallozafferano.it> in 2006 and quickly became well known in the market. GIALLO ZAFFERANO is also a reputed App for iOS and Android as well as a reputed "skill" for Amazon Alexa.

The Respondent uses the disputed domain name for an apparently active blog on cooking and food recipes in Italian language. No contact details of the Respondent are provided on this website.

When the Complainant became aware of the disputed domain name its representatives sent a formal warning letter to both the Registrar and the ISP hosting the Respondent's website, requesting a shutdown of the website connected to the disputed domain name as well as disclosure of the Respondent's contact details. Neither Registrar or ISP nor the Respondent reacted to this letter in any way.

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 UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain name wording fully contains the Complainant's registered Trademark GIALLO ZAFFERANO. Except for the hyphen between the words "GIALLO" and "ZAFFERANO" and the technical gTLD suffix ".com" the disputed domain name is practically identical, but at least confusingly similar, to the Complainant's Trademarks pursuant to paragraph 4(a)(i) of the Policy.

The Panel further finds that the Complainant successfully submitted prima facie evidence that Respondent has neither made any use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent. As discussed in more detail below the Panel considers the Respondent's active use of the disputed domain name for a food and cooking website neither "bona fide" nor "legitimate".

Furthermore, the Panel finds that by using the domain name the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's Trademarks as

to the source, sponsorship, affiliation, or endorsement of this website. This is evidence of registration and use in bad faith pursuant to paragraphs 4(a)(iii) and 4(b)(iv) of the Policy. The Panel notes that the words “giallo zafferano” are Italian for “yellow saffron”, which is a well-known cooking ingredient. One might try to argue that “yellow saffron” is a descriptive (and therefore legitimate) use for the Respondent’s website content. This argument would be misleading, however, because (i) only some and by no means all of the recipes published by the Respondent use saffron and (ii) this particular ingredient is in no way highlighted on the website. Given the Italian language used throughout the Respondent’s website and the Complainant’s well-known and long-established cooking and food website with more or less identical content the Respondent must have had the Complainant in mind when registering the disputed domain name and starting its own website project.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GIALLO-ZAFFERANO.COM**: Transferred

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2019-03-20

Publish the Decision