Decision for dispute CAC-UDRP-102847

Case number	CAC-UDRP-102847
Time of filing	2020-01-15 13:06:54
Domain names	mutti.onl

Case administrator

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

Complainant

Organization	MUTTI S.P.A.

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Organization	Rocha e.U. Online & Product Services

OTHER LEGAL PROCEEDINGS

None that the Panel has been made aware of.

IDENTIFICATION OF RIGHTS

The Complainant has supplied evidence that it is the owner of the following trade mark rights:

- European Union Trade Mark No. 003492402, MUTTI, registered on 6 June 2005; and

- European Union Trade Mark No. 003502391, MUTTI PARMA (figurative), registered on 14 April 2005.

FACTUAL BACKGROUND

Founded in 1899, the Complainant is an Italian company operating in the food industry. In particular, the Complainant's products include canned tomatoes, tomato sauce, and other tomato-based products. The Complainant is the registrant of the domain name <mutti-parma.com>, from which it operates its official website. The Complainant also promotes its business through various social media accounts.

The Respondent is Kelly Rocha Campezzi, Rocha e.U. Online & Product Services, based in Austria.

The disputed domain name was registered on 6 December 2019 through a privacy registration service. Based on the

evidence provided by the Complainant, the disputed domain name previously resolved to a parking page displaying pay-per-click ("PPC") links, including various links related to the Complainant's tomato-based products, and advertising the disputed domain name for sale for EUR 10,000. At the time of this decision, the disputed domain name redirects to a Sedo webpage offering the disputed domain name for sale.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Identical or confusingly similar

The Complainant produces evidence of its trade mark rights in MUTTI and MUTTI PARMA, as listed in the "Identification of Rights" section above. The Complainant submits that the disputed domain name is identical to its MUTTI trade mark. It further submits that the disputed domain name is confusingly similar to the textual elements of its MUTTI PARMA trade mark, as the term "mutti" constitutes the prominent and central component of this mark.

The Complainant notes that the generic Top-Level Domain ("gTLD") should be disregarded for the purpose of assessment under the first element of the Policy.

No rights or legitimate interests

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant states that the Respondent is not a dealer, agent, distributor, wholesaler or retailer of the Complainant. Furthermore, the Complainant's internal policies do not allow for its affiliates to register domain names containing its MUTTI trade mark.

According to the Complainant, it is unlikely that the Respondent could be commonly known by the disputed domain name as the term "mutti" corresponds to the name of the Complainant's founder, and has been strictly associated with the Complainant's business since 1899. The Complainant further notes that the Respondent's name as listed in the WhoIs data for the disputed domain name is not similar to the disputed domain name.

The Complainant notes that at the time of filing of the Complaint, the disputed domain name resolved to a parking page displaying PPC links, including links related to the Complainant's products. The Complainant submits that such use of the disputed domain name to capitalize on its reputation and the goodwill associated with its trade marks cannot be considered a bona fide offering of goods or services, nor can it constitute legitimate noncommercial or fair use.

In this regard, the Complainant submits that parked pages displaying PPC links may support a finding of rights or legitimate interests in a domain name in exceptional circumstances (e.g., where the links are related to the dictionary meaning of the word comprising the domain name). The Complainant asserts that this is not the case here, as the disputed domain name clearly seeks to trade off of the Complainant's trade marks.

Registered and used in bad faith

The Complainant contends that it has been active since 1899, and that its MUTTI trade mark dates from well before the registration date of the disputed domain name. The Complainant restates that "Mutti" is the name of the Complainant's founder, and asserts that it is strictly associated with the Complainant's business. The Complainant further notes that the PPC links displayed on the website at the disputed domain name relate to the Complainant's products. As such, the Complainant submits that it is inconceivable that the Respondent was not aware of its MUTTI trade mark at the time of

registration of the disputed domain name.

The Complainant submits that the Respondent is using the disputed domain name to generate click through revenue from the PPC links displayed on the website at the disputed domain name by attracting Internet users by virtue of the reputation of the Complainant's trade mark.

The Complainant requests transfer of the disputed domain name.

RESPONDENT:

The Respondent filed a brief Response, which is reproduced verbatim as follows:

"I don't know what that person wants.

'Mutti' in my language (German) is the regular word for 'mother'! We bought this domain for a german-speaking project (Mother's Day) and temporarily parked it at sedo.de (where he can buy this domain now if it is so important for him).

Why didn't he register the domain when it was available (for years)?

Does he really believe that all 'mutti domains' on earth should belong to him? Other mutti domains (at/de/ch/it/com/...) are not in his possession either.

He should get up a little earlier and register domains regularly and not this way."

The Respondent did not submit any evidence in support of its assertions set out above.

RIGHTS

The Complainant has shown, to the satisfaction of the Panel, that the disputed domain name is identical to a trade 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 shown, to the satisfaction of the Panel, that the Respondent has 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 shown, to the satisfaction of the Panel, that 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

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following for a panel to order transfer of the domain name at issue:

(i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in 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

Based on the evidence put forward by the Complainant, the Panel finds that the Complainant has established trade mark rights in MUTTI, by virtue of its registrations and longstanding use in commerce.

The disputed domain name reproduces the Complainant's MUTTI trade mark without addition or alteration.

It is widely accepted that the gTLD, in this case ".onl", may be disregarded for the purpose of assessing identity or confusing similarity between a trade mark and a domain name under the first element.

The Panel finds that the disputed domain name is identical to the Complainant's MUTTI trade mark. The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

As noted in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 2.1:

"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 Complainant has asserted that the Respondent is not authorised by the Complainant to register any domain name incorporating the Complainant’s MUTTI trade mark. Indeed, there appears to be no relationship between the Parties whatsoever.

The Panel notes that the disputed domain name previously resolved to a parking page displaying PPC links, including several that refer to the Complainant or to the Complainant's products ("pelati", "Parma", "Mutti passata", "passata", pomodoro", etc.).

The Respondent has alleged that the disputed domain name was registered in light of its meaning ("mother" in German), that it was intended to be used in connection with a German speaking (Mother's Day) project, and that it was only temporarily parked.

Prior UDRP panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the Policy – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant’s (or its competitor's) trade mark; see WIPO Overview 3.0, section 2.9.

In the present case, the links on the concerned website relate predominantly to the Complainant or the Complainant's products. As noted by previous UDRP panels, the use of a domain name to host a parked page comprising PPC links does

not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users; see WIPO Overview 3.0, section 2.9. Furthermore, prior UDRP panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests). Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith; see WIPO Overview 3.0, section 3.5. As such, the Panel finds that the Respondent's documented use of the disputed domain name does not represent a bona fide offering of goods or services as contemplated by paragraph 4(c)(i) of the Policy.

The Panel further notes that the Respondent has not produced any evidence of its alleged intended use for the disputed domain name that would otherwise support a finding of rights or legitimate interests in the disputed domain name. There is no evidence of credible investment in website development or promotional materials such as advertising, letterhead, or business cards, nor is there proof of a genuine (i.e., not pretextual) business plan utilizing the disputed domain name, or any credible signs of pursuit of such a business plan; see WIPO Overview 3.0, section 2.2.

While it may be the case that the Respondent is engaged in the business of registering domain names that correspond to dictionary terms (the Panel's review of the Respondent's website would tend to support such a finding), the Respondent nevertheless warranted that its registration and use of the disputed domain name would not interfere with the rights of a third party. As noted above, the Respondent appears to have either intentionally or inadvertently attempted to profit from the goodwill associated with the Complainant's trade mark by placing PPC links on the website to which the disputed domain name resolved.

Moreover, the fact that the disputed domain name has at all times been advertised for sale (at the time of filing the disputed domain name was listed for sale for EUR 10,000), appears to be at odds with the Respondent's claim that it had intended to use the disputed domain name for such a project. Rather, the available evidence tends to suggest that the Respondent's intent when registering the disputed domain name was to sell it at a profit (as discussed in further detail in relation to bad faith).

There is no evidence on record to suggest that the Respondent is commonly known by the disputed domain name in accordance with paragraph 4(c)(ii) of the Policy.

The Respondent cannot be said to be making a legitimate noncommercial or fair use of the disputed domain name pursuant to paragraph 4(c)(iii) of the Policy.

The Panel considers that the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Panel has duly considered the Respondent's assertions, and finds, on balance, that the Respondent has failed to produce sufficient evidence of a nature to rebut the Complainant's prima facie case.

The Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant asserts that the Respondent registered the disputed domain name with the Complainant's MUTTI trade mark in mind. In support of this, the Complainant makes reference to its longstanding association with the Mutti name and brand.

In the Panel's view, the Complainant's evidence in support of its assertions, on its own, falls somewhat short of clearly establishing that the Respondent knew or should have known of the Complainant and its rights at the time of registering the disputed domain name. However, a review of the Complainant's website, social media accounts, and a cursory Internet search for the term "mutti" indicates that the Complainant has indeed been in business for well over a century, enjoys a substantial following on social media, where it promotes its products and provides recipes to its followers, and that it

supplies its tomato-based products to consumers and professionals in the food industry in the European Union, the United States, and elsewhere. Moreover, the registration of the Complainant's European Union Trade Mark MUTTI predates the registration of the disputed domain name by over 10 years.

The Panel infers from the presence of PPC links on the website to which the disputed domain name previously resolved that the Respondent either knew, or should have known of the Complainant and its mark at the time of registering the disputed domain name. Indeed, the Respondent has not denied knowledge of the Complainant, nor has it taken any active steps to avoid the attraction of Internet users to its PPC page, such as by applying negative keywords. As noted above, the Respondent's assertions that it had intended to use the disputed domain name in connection with a Mother's Day project are not supported in evidence.

The Panel notes that at 14 January 2020, the disputed domain name was parked with an advertisement in the header of the parking page stating that the disputed domain name was for sale for the price of EUR 10,000. At the time of this decision, the disputed domain name redirects to a web page at "www.sedo.com" soliciting offers to purchase the disputed domain name.

The question before the Panel is whether the Respondent can be said to have registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs, as contemplated by paragraph 4(b)(i) of the Policy, or whether the Respondent simply registered the disputed domain name in light of its dictionary meaning in German (i.e., "mother" or "mummy").

It is well established that simply registering a domain name for the purpose of subsequent resale (including for a profit) would not by itself support a claim that a respondent registered the domain name in bad faith with the primary purpose of selling it to a trade mark owner; see WIPO Overview 3.0, section 3.1.1. The Panel also notes that the Policy was not intended to permit a party who elects to register or use a common term or terms as a trade mark to bar others from using the common term in a domain name, unless it is clear that the use involved is seeking to capitalize on the goodwill created by the trademark owner; see Uovo Art LLC v. Mira Hold, Mira Holdings, Inc., WIPO Case No. D2016-0214.

Despite the Respondent's vague assertions that it intended to use the disputed domain name in connection with a Mother's Day project, within one month after registering the disputed domain name, the Respondent parked the disputed domain name and placed an advertisement on the web page to which it resolved, offering the disputed domain name for sale at the inflated price of EUR 10,000. According to the evidence on record, the price of EUR 10,000 would appear clearly to exceed the Respondent's documented out of pocket costs associated with the registration of the disputed domain name, and the significant amount would strongly suggest that the Complainant is being targeted, as opposed to a buyer simply wishing to register a common term under ".onl", a new gTLD that has not typically sold for high amounts. The Respondent continues to offer the disputed domain name for sale, and even reiterated its offer to sell the disputed domain name to the Complainant in its Response. The Panel finds the Respondent's registration of the disputed domain name using a privacy service to mask its identity to be an additional factor supporting a finding of bad faith.

In the totality of the circumstances of the present case, the Panel concludes that the Respondent registered the disputed domain name with a view to potentially profiting from its sale to the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the disputed domain name, in bad faith as contemplated by paragraph 4(b)(i) of the Policy.

By parking the disputed domain name, which consists of an identical match with the Complainant's MUTTI trade mark, and displaying PPC links on the website to which the disputed domain name resolved, including links relating to the Complainant and the Complainant's products, the Panel finds that the Respondent has further sought to capitalize on Internet traffic attracted to the web page at the disputed domain name resulting from a perceived association between the disputed domain name and the Complainant's trade mark. Notably absent from the record is any credible evidence of preparations to use the disputed domain name in a manner that did not seek to somehow profit from any association with the Complainant, e.g., in connection with the dictionary meaning that can be ascribed to the term "mutti". The Panel finds that by using the

domain name in such a manner, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website and the links displayed therein, in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

The Panel finds that the disputed domain name was registered and is being used in bad faith. The Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MUTTI.ONL**: Transferred

PANELLISTS

Name	**Jane Seager**

DATE OF PANEL DECISION 2020-02-27

Publish the Decision