Decision for dispute CAC-UDRP-103028

Case number	**CAC-UDRP-103028**
Time of filing	**2020-04-30 16:04:13**
Domain names	**esselunga.blog**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Esselunga S.p.A.**

Complainant representative

Organization	**Barzanò & Zanardo Milano S.p.A.**

Respondent

Organization	**Stefano Breida**

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant adduced evidence showing that it is the owner the following trade marks, introduced as specimens from a larger portfolio that it asserts it maintains:

1. ESSELUNGA, Italian registration No.1290783 from 12 March to date in Nice Classification System classes 3, 6, 8, 9, 16, 21, 28, 29, 30, 31, 32, 33 and 42.

2. ESSELUNGA, EU registration No.013719745, registered on 8 July 2015 in classes 1, 3, 5, 6, 8, 9, 16, 21, 24, 25, 28, 29, 30, 31, 32, 33 and 35.

No evidence was adduced as to the Complainant's registration of a domain name incorporating the above trade mark. However, its website resolving to the domain name <esselunga.it> is mentioned in the Complainant's submissions, as is a further website it operates that resolves to <esselungaacasa.it> (see "Factual Background", below).

The Registrant registered the disputed domain name on 6 April 2020.

FACTUAL BACKGROUND

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

A) The Complainant

Esselunga S.p.A. is an Italian retail store, founded in 1957 by Nelson Rockefeller, Bernardo, Guido and Claudio Caprotti, Marco Brunelli, the Crespi family and other Italian associates. It is today the leader in Italy in the retail field, with total revenues amounting to €6.8 billion and more than 150 points of sale. Esselunga is also active through its online website at <www.esselunga.it> and offers a home delivery service at <www.esselungaacasa.it>.

B) The Respondent

Mr Stefano Breida is the Respondent, whose contact details were originally shielded under a privacy protection service but were revealed by the registrar of the disputed domain name after initiation of the present proceeding. The Complainant ascertained that the disputed domain name redirected to a domain parking page.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

A) Disputed domain name's identicality or confusing similarity relative to the Complainant's trademarks (UDRP Para. 4 (a)(i))

Citing well-known Decisions in past domain ADR proceedings, the Complainant claims that, disregarding the technically unavoidable addition of the TLD extension, the disputed domain name <esselunga.blog> is identical to its trade marks, as established above, because the disputed domain name stem is comprised solely of "ESSELUNGA".

B) Absence of the Respondent's rights or legitimate interests (UDRP Para. 4(a)(ii))

The Complainant argues that proving a negative fact is too onerous and is logically less feasible than establishing a positive one and that it suffices for a Complainant to produce only prima facie evidence, whereupon the burden of proof shifts to the Respondent. The examples of past domain name ADR Decisions the Complainant cites in support of its argument are: Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110; and Audi AG v. Dr. Alireza Fahimipour, WIPO Case No. DIR2006-0003.

The Complainant denies that the Respondent could have any right or legitimate interest in registering the disputed domain name. In particular, it asserts that Mr Breida is not the Complainant’s dealer, agent, distributor, wholesaler or retailer. Nor is

he an entity authorized to register and use ESSELUNGA as a domain name. A search by the Complainant of trade mark databases furthermore revealed no instance of ESSELUNGA having been registered to Mr Breida, while it is very improbable that he could be commonly known as “ESSELUNGA", considering the Complainant's trademarks, its company name and Mr Breida's own name.

The Complainant in addition states that the disputed domain name is currently inactive and thus not used in connection with a bona fide offering of goods and services and contends that the Respondent is not using it in a legitimate non-commercial or fair manner. It further points out that the brand "ESSELUNGA" is a fanciful word, which strengthens the circumstance that the disputed domain name was registered to mislead potential consumers, to tarnish the Complainant’s trade mark and to prevent the Complainant from reflecting its trade mark in a corresponding domain name.

The above thus sufficiently proves the absence of the Respondent's rights or legitimate interest in the disputed domain name.

C) Registration and use of the disputed domain name in bad faith (UDRP Paragraphs 4(a)(iii) and 4(b))

The Complainant reiterates that registration of the disputed domain name containing a well-known third party’s trade mark took place without authorization and argues that the Respondent could not have been unaware of this at the time of registration because ESSELUNGA is a well-known trade mark in Italy, where the Respondent is based, and because ESSELUNGA is a fanciful word. A use of the disputed domain name that is unrelated to the Complainant’s activities is therefore inconceivable, an assumption which is further proven by the fact that the disputed domain name is identical to the Complainant’s trade mark and which is supported by previous Panels' findings saying that this is an indicator of registration in bad faith.

Furthermore, the disputed domain name was registered long after the filing/registration of the Complainant’s trademarks.

As far as use in bad faith is concerned, the Complainant states that the Respondent passively holds the disputed domain name. Previous Panels have recognized that passive holding of a domain name can, in certain circumstances, constitute use in bad faith; see, in particular, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. The Panel noted there that the question of which circumstances of “passive holding” may constitute use in bad faith cannot be answered in the abstract but may only be determined on the basis of the particular facts of each case, giving close attention to all the circumstances of the Respondent's behaviour that show the Respondent's passive holding amounts to acting in bad faith. With this approach in mind, the Complainant advances the following circumstances as being material:

(i) the Complainant’s trade marks have a strong reputation, are highly distinctive and are widely known;

(ii) ESSELUNGA is a fanciful word and is strictly related to the Complainant's business (i.e. it is its company name). As a consequence, it is hard to conceive of a use of the disputed domain name which would not infringe the Complainant's rights;

(iii) the disputed domain name is not used and, to the best knowledge of the Complainant, it has never been used;

(iv) the Respondent's contact details are shielded by a privacy protection service. Previous panels have considered such a

circumstance as being an indicator of bad faith in combination with other elements.

The above thus sufficiently shows bad faith registration and use of the disputed domain name.

RESPONDENT: NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to a trade mark 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 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 that there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

This uncontested proceeding relates to a clear instance of cybersquatting that took advantage of the relatively recent availability of a new generic top level domain name (gTLD).

The Complainant is the leading retail store in Italy. It has been active there for over 60 years and has today extended its operations to e-commerce. Its company name is also its brand name, "ESSELUNGA", which is protected by longstanding trade marks. The Panel takes note from incidental indications in the Complaint of the Complainant's use of its trade marks in its own domain names.

The Complainant did not register a domain name under the <.blog> gTLD when it became available for use in 2016, among many other new gTLDs under ICANN's programme to add an unlimited number of gTLDs to the Domain Name System. But the Respondent, Mr Breidi, did register the disputed domain name <esselunga.blog> in April 2020. He did so while withholding his identifying details from view until the present proceeding.

Neither the Complainant nor this Panel can be sure exactly what Mr Breidi had in mind with this action. He has not entered a Response in this proceeding. All one has in this respect is the Complainant's submissions and evidence and the inferences that can legitimately be drawn from the circumstances consistent with the Uniform Dispute Resolution Policy, UDRP.

The UDRP provides recourse to those whose rights are transgressed by another's registration and use of a domain name governed by the Policy, provided that all parts of its three-prong test are met and none rebutted.

Applying that test to the facts of the present case, the Panel finds that:

(1) the Complainant has documented its rights in the sole constituent of the domain name stem, the name "ESSELUNGA", and that the technical gTLD suffix <.blog> in the disputed domain name must be disregarded, this being a factor independent of the Respondent and Complainant alike;

(2) the Complainant has shown compellingly the Respondent to have no rights and no legitimate interest in the disputed domain name. The Panel makes this finding particularly on the basis of the disputed domain name's identicality to the Complainant's (protected) brand, the fanciful character of the name "ESSELUNGA", which bears no resemblance to Mr Breida's name or apparent connection to him more generally, and the absence of any manifest circumstance which may indicate that the Complainant's allegation of lack of rights or legitimate interest is misconceived;

(3) the Complainant has provided sufficient grounds for the Panel to be able to infer the presence of bad faith registration and use, in particular the concatenation of the choice of a name for registration that is identical to distinctive, fanciful and longstanding trade marks of the Complainant for a brand which is moreover well known in the Respondent's own region, as well as the absence of any plausible alternative explanation from the Respondent or disclosed from the Case File that might contradict any of the several indications of bad faith shown here.

In regard to findings (2) and (3), the Panel makes the following observations:

- Concerning (2) as to the requirements for proof of the absence of the Respondent's rights or legitimate interest, the Complainant argued, with citations, that the burden of proof shifted to the Respondent after showing a prima facie case. The Complainant then nevertheless went on to make out a compelling case on this prong of the UDRP test on the basis of what it could ascertain and of reasoned inferences. The Panel notes this diligence with approval, as well as the approach adopted in Belupo d.d. v. WACHEM d.o.o. Case No. D2004-0110, which the Complainant cites and which also -- in contrast to some earlier Panel Decisions -- recognizes the responsibility of the Panel in regard to this prong of the UDRP test to take account of any manifest misconception in the Complainant's contentions, rather than to treat the process of proof in a mechanical fashion.

- Concerning (3) as to the aspect of passive use of the disputed domain name raised by the Complainant, the Panel cannot accept the Complainant's categorical assertion that the disputed domain name "is not used and ... has never been used". There is in fact some evidence in the Case File -- in the Whois data and a screenshot of the web page for <esselunga.blog> -- of a degree of operational activity. Specifically, the DNS server associated with the disputed domain name is not that of its US-based registrar, as one might expect, but that of a leading Italian ISP, while the "parking" web page is in Italian and asks visitors whether they are "interested in this domain name". Though not argued, the Panel cannot ignore the implication of this documentary evidence, which reinforces the general inference of bad faith in this proceeding as regards also the aspect of the disputed domain name's use.

Finally, as concerns the Complainant's contentions that the disputed domain name was registered to mislead potential consumers, to tarnish the Complainant’s trade mark and to prevent the Complainant from reflecting its trademark in a corresponding domain name, the Panel accepts on the basis of the proof before it that an intention to mislead potential consumers was probably present at the time of registration, but considers the other contentions to be speculative.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ESSELUNGA.BLOG**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2020-06-10

Publish the Decision