Decision for dispute CAC-UDRP-103161

Case number	CAC-UDRP-103161
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Domain names	arenaofverona.com

Case administrator

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

Complainant

Organization	Fondazione Arena di Verona

Complainant representative

Organization	IP TWINS

Respondent

Name	Gennaro Cupo

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 is , inter alia, the owner of the following trademark registrations covering the Jurisdiction of the Registrar and that are the following:
- International trademark FONDAZIONE ARENA DI VERONA No. 812756 registered on September 01, 2003, duly renewed, and designating services in international class 39;
- International trademark FONDAZIONE ARENA DI VERONA No. 735465 registered on May 18, 2000, duly renewed, and designating goods and services in international classes 03, 09, 16, 18, 25, and 41;
- European trademark FONDAZIONE ARENA DI VERONA No. 001571470 registered on March 23, 2000, duly renewed, and designating goods and services in international classes 03, 09, 16, 18, 25, and 41;
- Italian trademark ARENA-VERONA No. 966341 registered on June 11, 2001, duly renewed, and designating services in international class 41.
- Italian trademark ARENADIVERONA No. 966342 registered on June 11, 2001, duly renewed, and designating services in international class 41;

Moreover, Fondazione Arena di Verona is the holder of numerous domain names incorporating its trademarks both within generic TLDs and geographical ones: <arenadiverona.it>, <arena-di-verona.com>, <arena-verona.it>, <fondazionearena.it>

and many others.

FACTUAL BACKGROUND

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

A. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

The Opera Festival at the Arena di Verona began on 10 August 1913, with the first performance of Aida organized by Verona tenor Giovanni Zenatello and impresario Ottone Rovato to commemorate the centenary of the birth of Giuseppe Verdi.

For over a hundred years (except for two short breaks during the two World Wars), every summer the Roman Amphitheatre is transformed into the world's largest open-air opera theatre.

The current organization is the result of the reform ratified by Decree-law n°134 of 1998, which transformed enti lirici (opera institutions) into private law foundations, thus creating the current Complainant "Fondazione Arena di Verona", and offering private members the possibility of joining.

The Complainant FONDAZIONE ARENA DI VERONA, founded in 1998 and located in Italy, is responsible for all spectacles, operas and shows presented at the Arenas of Verona. The Arenas are famous worldwide for the large-scale opera performances given and can welcome up to 15,000 people for each representation.

The Complainant's institutional objective is to carry out non-profit cultural activity of a public utility nature, pursuing the spread of musical art and the musical education of the community.

The Complainant as well as his trademarks are well-known worldwide. For example, Wikipedia mentions that "The Verona Arena is a Roman amphitheatre in Piazza Bra in Verona, Italy built in the first century. It is still in use today and is internationally famous for the large-scale opera performances given there." (https://en.wikipedia.org/wiki/Verona_Arena)

In WIPO Case No. D2001-0567 in 2001 (almost 20 years ago), the Panel confirmed that the Complainant's "ARENA-VERONA" trademark is widely known.

The Arena is listed as number 1 "top experience in Verona" by the Lonely Planet.

The Facebook page of the Complainant is "liked" by more than 400,000 people.

The Complainant contends that the disputed domain name is identical or similar to the point of confusion with its other earlier trademarks. Indeed, the name ARENA DI VERONA trademarked by the Complainant literally means "Arena of Verona". The only difference between the trademark and the domain names is the term Italian "di" replaced by the English term "of", both bearing the same meaning. From an intellectual point of view, the domain names are identical.

For the purposes of assessing identity and confusing similarity under paragraph 4(a)(i) of the Policy, it is typically permissible for the Panel to ignore the generic Top-Level Domain ("gTLD"). In any event, the gTLD ".com" does nothing to minimize the confusing similarity.

The first condition under the Policy should be deemed satisfied.

B. The Respondent has no rights or legitimate interests in respect of the domain name(s); (Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

The Respondent in these administrative proceedings is REDACTED FOR PRIVACY. The Respondent should be considered as

having no rights or legitimate interests in respect of the domain names that are the subject of the Complaint.

Firstly, results of the query on the WIPO Global Brand Database on the terms "ARENA DI VERONA" and “ARENA OF VERONA” do now show any trademark owned by any person other than the Complainant. . From this finding, the Complainant asserts that the Respondent has acquired no trademark in the terms "ARENA DI VERONA" or “ARENA OF VERONA” which could have granted the Respondent with rights in the disputed domain name.

Furthermore, the Complainant has found no evidence whatsoever that the Respondent is known by the disputed domain name. There is no evidence that the Respondent as an individual, business, or other organization has been commonly known by the disputed domain names before the time of original filing of the Complaint.

Secondly, the Respondent imitates the Complainant’s earlier trademarks ARENA DI VERONA in the disputed domain names without any license or authorization from the Complainant, which is a strong evidence of the lack of legitimate interest. As a consequence, the Complainant submits that it has not authorized the registration of the disputed domain name in any manner or form.

Thirdly, the Complainant puts forth that the Respondent has not, before the original filing of the Complaint, used or made preparations to use the disputed domain name in relation to a bona fide offering of goods or services. On the contrary, the disputed domain name resolves to a blank page.

Fourthly, since the adoption and extensive use by the Complainant of the trademark ARENA DI VERONA predates by far the first entry of arenaofverona.com as a domain name, the burden is on the Respondent to establish the Respondent's rights or legitimate interests the Respondent may have or have had in the domain name.

None of the circumstances which set out how a respondent can prove his rights or legitimate interests, are present in this case. In light of all the elements mentioned above, the Respondent should be considered as having no rights or legitimate interests in respect of the domain names that are the subject of the Complaint.

In light of the above, the Complainant submits that the burden shifts to the Respondent to establish the Respondent's rights or legitimate interests the Respondent may have or have had in the disputed domain name.

The second condition under the Policy should be deemed satisfied.

C. The domain name was registered and is being used in bad faith. (Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith, for the following reasons.

Firstly, the Complainant states that the Complainant and its trademarks are so widely well-known, as stated above, that it is inconceivable that the Respondent ignored the Complainant’s earlier rights on the terms ARENA DI VERONA. It is clear that the Respondent had the Complainant’s name and trademark in mind when registering the domain name. The Respondent’s choice of domain name cannot have been accidental and must have been influenced by the fame of the Complainant.

Indeed, a simple search on an online search engine yields results only related to the Complainant. The Complaint shows search results for “arena of verona” on an internet search engine. All results relate to the Complainant, and in particular the first result is www.arena.it. Therefore, at the very least, the Respondent knew or should have known that, when registering and using the domain name, he would do so in violation of the Complainant’s earlier rights.

Secondly, the Complainant sees no possible way whatsoever that the Respondent would use the domain name in connection with a bona fide offer of products or services. Indeed, any use of the ARENA DI VERONA trademark or signs similar thereto would amount to trademark infringement and damage to the repute of the trademark. The sole detention of the disputed

domain name by the Respondent, in an attempt to prevent the Complainant from reflecting its trademark and company name in a domain name, is a strong evidence of bad faith. Furthermore, any actual use of the domain name by the Respondent would de facto amount to bad faith active use as the Respondent would be trying to attract Internet users unduly.

Thirdly, the Complainant submits that it is very likely that the Respondent chose the domain name because of its high similarity to trademarks in which the Complainant has rights and legitimate interest. This was most likely done in the hope and expectation that Internet users searching for the Complainant's services and products would instead come across the Respondent's site(s). Such domain names do not provide a legitimate interest under the Policy. WIPO Case No. D2007-0583.

The Complainant thus states that the Respondent acquired the disputed domain name to prevent the Complainant from reflecting its earlier trademarks in the corresponding domain name and in full knowledge of the Complainant and its earlier rights.

Fourthly, the Complainant's ARENA DI VERONA trademark registrations significantly predate the registration date of the disputed domain names.

In this regard, previous Panels have established that knowledge of the Complainant's intellectual property rights, including trademarks, at the time of registration of the disputed domain name, proves bad faith registration WIPO Case No. D2008-0287.

A quick ARENA DI VERONA trademark search would have revealed to Respondent the existence of Complainant and its trademarks. Respondent's failure to do so is a contributory factor to its bad faith. Case D2008-0226.

Fifthly, WIPO Overview 3.0 explicitly states that panels have found that the apparent lack of so-called active use of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's concealment of its identity. Panels may draw inferences about whether the domain name was used in bad faith given the circumstances surrounding registration, and vice versa.

In light of all the elements above, the Complainant contends that the domain name was registered and is being used in bad faith by the Respondent. The combination of all the elements listed and detailed above unequivocally show that the Respondent has acted in bad faith when registering, in line with the Policy.

The third condition under the Policy is deemed satisfied.

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 UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that a complainant must prove each of the following to obtain transfer or cancellation of a domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

2. that respondent has no rights or legitimate interests in respect of the domain name; and

3. the domain name has been registered and is being used in bad faith.

1) The Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights (Para.4(a)(i) of the Policy).

The Complainant, Fondazione Arena di Verona (hereinafter also referred as "the Foundation"), is a non-for-profit private company with its registered seat in Verona (Italy), Via Roma 7/d. A
The Foundation is a private company which serves (according to the "purposes of the company") public purposes, and it has been a public body (under the name "Ente Lirico Arena di Verona") until March 1999. The Roman Anfitheatre is in Piazza Bra In verona built in the first Century.

The Complainant informs the Panel that the Foundation (and, before 1999, the Ente Lirico Arena di Verona) has been using the name Arena di Verona with regard to musical performances organized in the well-known theatre, since a very long time the Complainant is also owner of several trademark registrations as listed in the Factual Statement.

1) Domain Name identical or confusingly similar

The Complainant has provided evidence of ownership of the following registration and applications for the word mark "ARENA-VERONA": Italian trademark registration No. 966341; Italian trademark registration ARENADIVERONA; European trademark registration FONDAZIONE ARENA DI VERONA No. 1571470 and others. The said earlier trademark are registered in the Jurisdiction of the Respondent and on the Jurisdiction of this proceeding.

The Panel furthermore finds that the Policy's only requirement is that the Complainant should be entitled to rights in a mark which are identical or confusingly similar to the disputed domain names.

In view of the above, the Panel finds that the Complainant has proved that the Domain Names are confusingly similar to the trademark of the Complainant according to paragraph 4(a)(i) of the ICANN Policy.

6.2. Rights and legitimate interest

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the dispute domain name. The Respondent does not assume the burden of proof, but may establish a right or legitimate interest in a disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy:

(a) He has made preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services prior to the dispute;

(b) He is commonly known by the domain name, even if he has not acquired any trademark rights; or

(c) He intends to make a legitimate, non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Respondent has not provided any evidence of its legitimate interest and it has been declared by the Complaianat that the Respondent was never authorised to use the trademark ARENA DI VERONA or its quasi identical ARENA OF VERONA. It is not a Complainant's licensee and it is not known under the name ARENA OF VERONA

The Panel therefore finds that Respondent has no rights or legitimate interests in respect of the Disputed domain Name, according to paragraph 4(a)(ii) of the ICANN Policy.

6.3. Registration and Use in Bad Faith

For the purpose of Paragraph 4(a) (iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the Domain Names in bad faith:

(i) circumstances indicating that the holder has registered or 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 holders documented out-of-pocket costs directly related to the domain name; or

(ii) the holder 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 holder has engaged in a pattern of such conduct; or

(iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder'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 your website or location or of a product or service on the holder's website or location.

The Panel finds the fourth element of Paragraph 4(b) of the Policy applicable in the instant case. As the respondent was certainly aware of the existence of the Arena di Verona and of the rights of the Complainant, by registering and using the disputed domain name has intentionally attracted internet users by creating a likelihood of confusion with the Complainant's trademark

Pursuant to the interpretation of the Uniform Domain Name Dispute Resolution Policy in cases of passive holding of the domain name first provided in Telstra Corporation Limited v. Nuclear Marshmallows (WIPO Case No. D2000-0003) oin several cases of this Center the Panel in this case has taken into consideration the following particular circumstances that have leaded the Panel to find bad faith:

(a) Complainant's trademark it is widely known, at least, in Italy;

(b) Respondent knew or should have known of the existence of the Complainant trademark;

(c) Respondent is an Italian citizen and as such evidently more exposed to the renown trademark and tradename ARENA DI VERONA

In view of the above, the Panel finds that Respondent registered and used the Disputed Domain Name in bad faith, according to paragraph 4(a)(iii) of the ICANN Policy.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of the Disputed Domain Name in bad faith.

Massimo Cimoli

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARENAOFVERONA.COM**: Transferred

PANELLISTS

Name	**Massimo Cimoli**

DATE OF PANEL DECISION 2020-08-06

Publish the Decision