Decision for dispute CAC-UDRP-100659

Case number	CAC-UDRP-100659
Time of filing	2021-05-27 00:00:00
Domain names	conadgroup.com, conad01.com

Case administrator

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

Complainant

Organization	CONAD - CONSORZIO NAZIONALE DETTAGLIANTI - SOCIETA' COOPERATIVA IN SIGLA CONAD

Complainant representative

Organization	Convey srl

Respondent

Organization	ACE Realty Texas

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant claims rights on several trademark registrations, such as:

- The registered and renewed EU word mark CONAD No 004689584 of February 25, 2011 for goods and services in the classes 3, 4, 5, 8, 9, 10, 16, 21, 24, 25, 28, 29, 30, 31, 32, 33;

- The registered EU figurative mark CONAD No 017430893 of December 16, 2019 for goods and services in the classes 1, 3, 4, 5, 6, 8, 9, 10, 11, 16, 20, 21, 24, 25, 28, 29, 30, 31, 32, 33, 35, 43;

- The registered EU word mark CONAD CARD CARTA INSIEME PIU' No 016309619 of May 29, 2017 for goods and services in the classes 9, 16, 35, 36;

- The registered Albanian word mark CONAD No 010969 of December 20, 2006 for goods and services in the classes 3, 4, 5, 8, 9, 10, 11, 16, 21, 24, 25, 28, 29, 30, 31, 32, 33, 35, no information was provided on its renewal and actual status;
- The registered International word mark SAPORI E IDEE CONAD No 1544224 of February 11, 2020 for goods and services in

the classes 29, 30, 31, 32, 33*;

- The registered International word mark CONAD SAPORI E DINTORNI No 811005 of July 17, 2003 for goods and services in the classes 29, 30, 31, 32, 33.

The disputed domain names are:

• <conadgroup> created on December 22, 2016

• <conad01> created on February 7, 2017

FACTUAL BACKGROUND

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

According to Registrar verification on May 11, 2020, the holder of the domain name <conadgroup.com> is Lawrence Hunsucker, and the holder organization is ACE Realty Texas, based in 9920 Westpark, Suite E, Houston, Texas, US.

According to Registrar verification on May 11, 2020, the holder of the domain name <conad01.com> is Jonathan Wohlberg, based in 7514 Slade Ave, Baltimore, Maryland, 21208, US.

The Complainant is the Italian cooperative CONAD created on May 13, 1962. In 2019, CONAD became the major chain in the large-scale distribution industry of supermarkets in Italy.

The word CONAD is an acronym arising from the phrase “Consorzio Nazionale Dettaglianti”.

The scope of the cooperative is to organize jointly the supplies and the purchase of foods products, beverages and consumer goods. CONAD system has now more than 3.800 stores active in Italy, 2.400 members, 65.000 employees, 52 logistic centers and has reached of 15.7 billion in revenue.

The CONAD website www.conad.it has been launched in 1996.

Nowadays, the Complainant holds trademark registrations in Italy, European Union, Albany and Switzerland and CONAD trademark has been extensively promoted, without limitation, in print advertisements, promotional materials, Internet forums acquiring high recognition.

The Complainant has also registered more than 56 Domain Names under generic Top-Level Domains (“gTLDs”), including <conad.com> and 121 Domain Names under country code Top-Level Domains (“ccTLDs”) – among which are <conad.it> and <saporie.com>.

The disputed domain names <conadgroup.com> and <conad01.com> were respectively registered by the Respondent on December 22, 2016 and February 7, 2017.

The disputed domain names have been pointed to parking pages showing numerous pay-per-click ads using CONAD trademark and redirecting users to third party websites like Carrefour and Esselunga in unfair direct competition with respect to CONAD brand.

On October 27, 2020, the Complainant sent a Cease and Desist letter to the attention of the registrant of the disputed domain name <conadgroup.com> requesting to refrain using the disputed domain name and transfer it to the Complainant.

On October 27, 2020, the Complainant sent a Cease and Desist letter to the attention of the registrant of the disputed

domain name <conad01.com> requesting to refrain using the disputed domain name and transfer it to the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Consolidation

The Complainant requested that the disputed domain names <conadgroup.com> and <conad01.com> and the named Respondents shall be consolidated in a single UDRP proceeding.

The Complainant contends that both disputed domain names share similarities: both the Registrants are based in the U.S.; the disputed domain names share the same extension (.com), the same registrar GoDaddy.com, LLC, the same Hosting Provider Google LLC, the same servers; the dates of the registration are very near (2016-12-22 and 2017-02-07); both disputed domain names share a similar lay-out of the pay-per-click websites corresponding to the disputed domain names; both disputed domain names incorporate the CONAD trademark in their entirety, with the addition of a generic term or of numbers.

All these elements demonstrate that both the disputed domain names are under the control of a single individual or entity or, at least, reflective of a group of individuals acting in concert. Therefore, both disputed domain names are subject to a common control.

The Complainant requests that both the Respondents shall be referred as a unique “Respondent”.

Confusing similarity

The Complainant submits that the disputed disputed domain names <conadgroup.com> and <conad01.com> are confusingly similar to its CONAD trademarks.

The Complainant contends that the addition of both suffixes “01” and “group” does not reduce the high degree of similarity with the Complainant’s trademarks CONAD and is therefore undoubtedly confusingly similar. Plus, the disputed domain name reproduces the Complainant's CONAD trademark.

Right or legitimate interest

The Complainant contends that no evidence suggests that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name or by any CONAD trademark as an individual, business, or other organization.

The use of the word CONAD in the disputed domain name which is an acronym without meaning and completely original excludes any possibility of bona fide reference to Complainant’s services or legitimate non-commercial or fair use of the disputed domain name.

The Respondent intended to trade upon the reputation of Complainant’s trademark by intentionally diverting good faith internet visitors to websites patrolled by third party companies in direct competition with respect of the Complainant’s brand.
It asserts that it did not grant any license or authorization to the Respondent.

Bad faith

The Respondent uses the disputed domain name in bad faith by attempting to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's CONAD trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website or location or of a product or service on such web site or location.

The fact that the Respondent sought or realized commercial gain by redirecting customers to pay-per-click web sites hosting ads linking to third party websites managed by third companies indicates its bad faith.

The Respondent's registration and use of the disputed domain name indicates that such registration and use was done for the specific purpose of trading on the name and reputation of the Complainant and its CONAD trademark.

RIGHTS

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

Confusing similarity

The Complainant has submitted evidence of its prior registered CONAD trademarks which are protected in several countries worldwide.

The disputed domain names entirely incorporate the Complainant's CONAD trademark, which is a distinctive and invented word.

The addition of the suffixes "01" and "group" to the CONAD trademark is merely instrumental and does not exclude any likelihood of confusion.

The Complainant has, to the satisfaction of the Panel, shown that 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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent's use of, or demonstrable 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; or

(ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

The Respondent did not respond to the Complaint. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the disputed domain names.

The Respondent registered the disputed domain names in 2016 and 2017, long after the CONAD trademark became widely known.

The term “CONAD” is an acronym meaning “CONSORZIO NAZIONALE DETTAGLIANTI”.

The disputed domain names redirect customers to pay-per-click links related to companies in direct competition with the Complaint’s business and for which the Respondent will receive monetary commission.

The Respondent is not related in any way with the Complainant nor has ever been authorized by the Complainant to use the CONAD trademark to register the disputed domain names. There is no indication that the Respondent is commonly known by the term “CONAD”, or that the Respondent is using the disputed domain names in connection with a bona fide offering of goods or services.

In the circumstances of this case, the Panel finds that the Complainant has established a prima facie case of the Respondent’s lack of rights or legitimate interests in relation to the disputed domain names, which the Respondent has not rebutted.

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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a panel to be evidence of bad faith registration and use of a domain name. It provides that:

“For the purposes of paragraph 4(a)(iii), 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 a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or the respondent 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 respondent’s documented out-of-pocket costs directly related to the domain name; or

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

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on the respondent’s website or location.”

The Respondent uses the Complainant’s trademarks years after the Complainant obtained its trademark registrations.

Given the Complainant’s long established and widespread use of its CONAD trademark in several countries of the world since 1962, its wide known reputation in the sector of distribution in Italy and its presence on the Internet through its own websites such as <conad.it>, the Panel finds that the Respondent was well aware of the Complainant’s rights on the CONAD trademarks when they registered the disputed domain names.

The complaint remained unanswered.

They use the disputed domain names to redirect to pay-per-click web sites hosting ads linking to third party websites managed by third companies like among others Carrefour and Esselunga, which are direct competitors of CONAD in the sector of supermarkets of the large-scale distribution.

This use generates pay-per-click revenues to the benefit of the Respondent.

It cannot be regarded as a good faith use.

The Panel finds that, according to Par. 4(b) (iv) of the Policy "by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location."

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are 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.

Paragraphs 4(f) of the Policy and 10(e) of the Rules allow, at the discretion of the panel, for the consolidation of multiple UDRP disputes.

Consolidation of multiple registrants as respondents in a single administrative proceeding may in certain circumstances be appropriate under paragraphs 3(c) of the Policy or 10(e) of the Rules provided the complainant can demonstrate that the domain names or the websites to which they resolve are subject to common control, and the panel having regard to all of the relevant circumstances, determines that consolidation would be procedurally efficient and fair and equitable to all parties.

The Complainant has provided evidence referred to above to substantiate its case that the Respondent is either one and the same person, entity, or network, are somehow connected to each other, and are under common control aimed at intentionally infringing the Complainant's marks and harming consumers.

The Respondent failed to respond to the complaint.

Accordingly, applying the abovementioned principles to the facts in this case, and in the absence of any response from the Respondent, the Panel finds that the Complainant has established more likely than not that the disputed domain names are subject to common ownership or control. The Panel finds evidence of such common control to be appropriate to justify consolidation of the Complainant's claims against the registrants of the disputed domain names in this proceeding. The Panel further concludes in the circumstances of this case that consolidation would be fair and equitable to all parties and procedurally efficient, and therefore will allow the consolidation as requested by the Complainant pursuant to paragraph 10(e) of the Rules.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain names comprise of the CONAD trademark. The additional suffixes "01" and "group" do not avoid the likelihood of confusion.

In the absence of any response from the Respondent, the Complainant has established more likely than not that the disputed domain names are subject to common ownership or control. The Panel finds evidence of such common control to be appropriate to justify consolidation of the Complainant's claims against the registrants of the disputed domain names in this

proceeding.

The Respondent used the disputed domain names to trade upon CONAD trademark reputation, since it was redirected to pay-per-click web sites hosting ads linking to third party websites managed by third companies like among others Carrefour and Esselunga, which are direct competitors of CONAD.

Such a use does not constitute a bona fide offering goods and services or a legitimate non-commercial fair use.

Given the worldwide and undisputable reputation and presence of the Complainant's trademarks in the sector of the large-scale distribution and the use of the disputed domain names, the Panel finds that the Respondent was well aware of the Complainant's rights in the CONAD trademarks when they registered the disputed domain names. It constitutes bad faith registration.

Its use of the disputed domain names constitutes bad faith use in the meaning of Paragraph 4(b) (iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CONADGROUP.COM**: Transferred
2. **CONAD01.COM**: Transferred

PANELLISTS

Name	**Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2021-06-22

Publish the Decision