

Decision for dispute CAC-UDRP-103860

Case number	CAC-UDRP-103860
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Time of filing	2021-06-10 09:14:30
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Domain names	gamberorosso.com
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Case administrator

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

Organization	GAMBERO ROSSO BRANDS & CONTENTS S.R.L.
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Complainant representative

Organization	The Law Offices of Dr. Christos A. Theodoulou LLC
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Respondent

Organization	Anonymize, Inc.
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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 name.

IDENTIFICATION OF RIGHTS

The Complainant bases its Complaint, among others, on the US Trademark Registration no. 2061817 filed in 1994, EU Trade Mark Registration nos. 1085612 and 1975937 filed in 1999, EU Trade Mark Registration no. 1892645 filed in 2000, Italian National Registration no. 775628 filed in 1998 and WIPO Registration no. 718527 filed in 1999.

FACTUAL BACKGROUND

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

The Complainant is a renowned international food and wine magazine and publishing group founded in 1986. Although it is based in Italy, the magazine is also published in English and is sold worldwide, while it is accessible through the internet, as well. In parallel, the Complainant owns a popular TV and video channel under the same name. Through extensive use and marketing efforts, the Complainant's brand has acquired important goodwill and reputation in the field of food and wine.

The Complainant owns a portfolio of trademarks including the US Trademark Registration no. 2061817 filed in 1994, EU Trade Mark Registration nos. 1085612 and 1975937 filed in 1999, EU Trade Mark Registration no. 1892645 filed in 2000, Italian

National Registration no. 775628 filed in 1998 and WIPO Registration no. 718527 filed in 1999.

Furthermore, the Complainant is the owner of a numerous portfolio of domain names consisting in the wording “GAMBERO ROSSO”, including the domain names <gamberorosso.it> (1997), <gamberorossochannel.com> (2000) <gamberorosso.tv> (2002), <gamberorosso.org>, <gamberorosso.net>, <gamberorosso.eu>.

The disputed domain name <gamberorosso.com> has been registered on 27.03.2002 and renewed again earlier this year until on 27.03.2022.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant's contentions are the following:

The disputed domain name <gamberorosso.com> is identical/confusingly similar to its trademark “GAMBERO ROSSO” and its associated domain names, as well as to its company name, well-known in the marketplace.

The Complainant sustains that the disputed domain name incorporates in whole and consists exclusively of the Complainant's registered trademark “GAMBERO ROSSO”.

The Complainant contends that the addition of the gTLD “.com” to its trademark “GAMBERO ROSSO” is not sufficient to escape the finding that the domain name <gamberorosso.com> is confusingly similar to the Complainant's trademarks and it does not change the overall impression of the designation as being connected to the trademark “GAMBERO ROSSO”. The Complainant further states that previous panels have commonly stated that the gTLD is not relevant in the appreciation of confusing similarity and mentions to this end WIPO Case No. D2000-0493 – Pomellato S.p.A v. Tonetti: the panel stated that the domain name <pomellato.com> was identical to the complainant's mark because the generic top-level domain (gTLD) “.com” after the name POMELLATO is not relevant.

Moreover, the Complainant contends that, the phrase “GAMBERO ROSSO” does not have any meaning in English and therefore, it has an increased distinctiveness worldwide; thus, any eventual claim of the Respondent as to low distinctiveness of the phrase would be irrelevant.

The Complainant contends that, it is well-established that a domain name that wholly incorporates a Complainant's registered trademark is sufficient to establish confusing similarity for purposes of the UDRP. To this end, it mentions, for instance, WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin, as well as the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”), under the First UDRP Element.

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain name for a number of reasons.

First, the Complainant asserts that the Respondent is not known as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name.

Further, the Complainant asserts that the Respondent is not affiliated with nor authorized by the Complainant in any way.

The Complainant does not carry out any activity for, nor has any business with the Respondent. The Respondent is not a Complainant's licensee, nor has ever been authorised to make use of the Complainant's trademark or to apply for the

registration of the disputed domain name.

Further, the Complainant points out that the disputed domain name points to an inactive/parking webpage, which is further evidence of the Respondent's lack of rights or legitimate interests.

Lastly, the Complainant contends that, given the distinctiveness of the Complainant's trademarks and reputation, the Respondent has registered/renewed the disputed domain name, in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name.

The Complainant further argues that the disputed domain name has been registered, and is being used in bad faith.

The Complainant's maintains that its "GAMBERO ROSSO" trademark is well-known, that given the distinctiveness of the Complainant's trademark and reputation in the field of food and wine publications the Respondent has registered/renewed the domain name with full knowledge of the Complainant's trademarks, with the intention to make the disputed domain name confusingly similar with the Complainant's trademarks.

The Complainant's further sustains that, the Respondent does not use the domain name, but insists in keeping and renewing it, while the corresponding website is inactive / a parking page.

Furthermore, the Complainant contends that, by registering/renewing, but not using the domain name, it seems clear that the Respondent has maintained the domain name in order to prevent the Complainant to register its own trademark as a domain name, and to disrupt the Complainant's business, as a potential competitor.

Also, the Complainant contends that, the Respondent is at times trying to sell the domain name by considering "reasonable offers", which is a clear sign of bad faith.

Lastly, the Complainant contends that when the Respondent renewed the disputed domain name this year in 2021, by this he violated the requirement of paragraph 2 of the UDRP, which states: "By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that . . . (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights."

On these bases, the Complainant sustains that the Respondent has registered and is using the disputed domain name in bad faith.

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

I. Confusing Similarity

The Panel agrees that the disputed domain name <gamberorosso.com> is confusingly similar to the Complainant's earlier trademarks GAMBERO ROSSO.

Moreover, the extension “.com” is not to be taken into consideration when examining the similarity between the Complainant's trademarks GAMBERO ROSSO and the disputed domain name (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as “.com” is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L'Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. No rights or legitimate interests

The complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its trademark, nor of a confusingly similar trademark in the disputed domain name.

The disputed domain name points to an inactive/parking webpage. Such use does not amount to a bona fide offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name, as other UDRP panels have found.

The Panel notes that the Respondent had an opportunity to comment on the Complaint's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

The Complainant's trademarks GAMBERO ROSSO are distinctive trademarks. The Respondent has chosen to register the disputed domain name by incorporating in whole the GAMBERO ROSSO trademark in order to create a confusion with such trademark. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant's GAMBERO ROSSO trademarks and has intentionally registered one in order to benefit from the reputation of the Complainant's GAMBERO ROSSO trademarks.

In the present case, the following factors should be considered:

- (i) the Complainant's GAMBERO ROSSO trademarks are distinctive ones;
- (ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;

(iii) the Respondent registered the disputed domain name by incorporating in whole the Complainant's GAMBERO ROSSO trademarks;

(iv) the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name similar to the Complainant's trademarks;

(v) the disputed domain name points to an inactive/parking webpage;

(vi) the Respondent is at times trying to sell the domain name by considering "reasonable offers".

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GAMBEROROSSO.COM**: Transferred

PANELLISTS

Name	Delia-Mihaela Belciu
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DATE OF PANEL DECISION	2021-07-21
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Publish the Decision