Decision for dispute CAC-UDRP-103029

Case number	CAC-UDRP-103029
Time of filing	2021-07-20 09:58:51
Domain names	AMEDEITOSCANA.COM

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Amedei S.r.l.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	DOMAIN IS FOR SALE AT WWW.DAN.COM ---- c/o Dynadot

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following registrations for the trademarks “AMEDEI” protected in numerous countries.

- International trademark registration no. 879334 “AMEDEI”, dated January 30, 2006, and duly renewed, in classes 29, 30, 33, and 43;
- EU word trademark registration no. 4796281 “AMEDEI”, dated November 29, 2006, duly renewed in classes 29, 30, 33, and 43; and
- EU figurative trademark registration no. 11101367 “AMEDEI TUSCANY”, dated April 30, 2013, in classes 29, 30, and 43.

Additionally, the Complainant has the pending application as described below.
- EU figurative trademark application n. 18485267 “AMEDEI TOSCANA”, applied on June 4, 2021, in class 30.

FACTUAL BACKGROUND

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

The Complainant is one of the most appreciated Italian producers and distributors of chocolate. The Complainant was founded in 1990 by Mrs. Cecilia Tessieri, the first female maître chocolatier when Mrs. Tessieri decided to dedicate herself to an extraordinary adventure that led her to discover all the precious secrets of chocolate. She had the whole family's support, including her maternal grandmother, a delightful lady whose surname, Amedei, has been used as the company name. This dedication would give life to a successful and innovative venture, a unique situation - an Italian boutique workshop maintaining control of the whole production line, from cocoa bean to the finished product.

Amedei's main export markets are Europe, United States, Australia, Hong Kong, Singapore, and Japan. The plant is an old establishment located in the countryside near Pontedera in Tuscany, converted from a cast-iron factory, 2500 square meters with the charm of an old-world workshop. The preparation of the chocolate, consisting of 120 varieties, follows a process and diverse phases, all overseen by Mrs. Tessieri personally. The resulting product is a unique creation, handmade with great care and passion. The American moviemakers also appreciated the luxury appeal and the incredible qualities of the Complainant products. In Alec Baldwin's best moment cited by <filmdaily.co>, it is mentioned an episode of 30 Rock where the actor, in an attempt to seduce Salma Hayek, tells her "Imagine a dessert for two, Tahitian vanilla bean ice cream in a pool of cognac, drizzled in the world's more expensive chocolate, Amedei Porcelana, covered with shaved white, black and clear truffles, topped with edible 25-carat gold leaf".

Moreover, the Complainant is the owner, among the others, of several domain names bearing the sign "AMEDEI", such as <amadei.com>.

All of them are connected to the official website "www.amedei.it".

On June 7, 2021, the Respondent registered the disputed domain name <amedeitoscana.com>.

PARTIES CONTENTIONS

COMPLAINANT

A. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name is identical or confusingly similar to the Complainant's trademark "AMEDEI". As a matter of fact, <amedeitoscana.com> fully includes the "AMEDEI" trademark with the addition of the word "TOSCANA" which is a generic word since it merely indicates an Italian region. It appears to be strictly connected with the Complainant since TOSCANA (or Tuscany in English) is the Italian region where the Complainant has its legal seat and laboratories. In this respect, it must also be noted that the domain name here contested is almost identical to the EU trademark "AMEDEI TUSCANY" no. 11101367 and entirely identical to the very recent EU trademark application "AMEDEI TOSCANA" no. 18485267, both owned by the Complainant. According to the pertinent case law, as far as the gTLD suffix ".com" is concerned, said suffix must be disregarded in the comparison.

The Complainant, therefore, considers that the first element of the Policy is fully satisfied.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME

The Respondent has no rights on the disputed domain name since the Respondent has nothing to do with the Complainant. Any use of the trademark "AMEDEI" has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned Italian chocolate producer to use the disputed domain name.

The disputed domain name does not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as "AMEDEI".

Lastly, the Complainant did not find any use of the disputed domain name since it has never been linked to an active website presenting a genuine offer of goods or services.

The Complainant, therefore, considers that also the second element of the Policy is fully satisfied.

C. THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

The disputed domain name was registered and is used in bad faith.

The Complainant's trademark "AMEDEI" is distinctive and well-known in most countries. The fact that the Respondent has registered a domain name that is almost identical and at least confusingly similar indicates that the Respondent knew of the Complainant's trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search regarding the word "AMEDEI", the same would have yielded apparent references to the Complainant. This raises a clear inference of knowledge of the Complainant's trademark on the part of the Respondent. Therefore, it is likely that the disputed domain name would not have been registered if not for Complainant's trademark. This is clear evidence of registration of the disputed domain name in bad faith.

In addition, the disputed domain name is not used for any bona fide offerings. More particularly, present circumstances are indicating that the Respondent has registered or acquired the disputed 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 Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy).

The disputed domain name redirects to a parking page in which it is announced that the disputed domain name <amedeitoscana.com> is for sale.

First of all, it must be underlined that several WIPO decisions ascertained how "Although Respondent's offer of the Disputed Domain Name for sale was not made specifically to Complainant or its competitor, offers for sale to the public may nevertheless constitute evidence of bad faith under the Policy".

In this regard, it shall also be taken into account that "Offers to sell to the public at large domain names that are identical or confusingly similar to marks of others may constitute bad faith […] This is based on the non-exhaustive character of the express list of bad faith factors in paragraph 4(b) of the Policy and the lack of a justification for awarding financial gain to persons for the mere act of registration of the marks of others".

Paragraph 4(b) of the Policy also provides a non-exhaustive list of circumstances that can constitute evidence of a Respondent’s bad faith in registering and using a Domain Name. In particular, the consensus view of WIPO UDRP panelists is that bad faith may in, some cases, be found in other conducts carried out by a domain name holder. Panels have tended to make such findings in the circumstances in which, for example, a complainant's mark is well-known. There is no conceivable use that could be made of the domain name that would not amount to an infringement of the Complainant's trademark rights.

As regards the first aspect, the Complainant believes it has already extensively proved renowned for its trademarks. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does precisely correspond to the Complainant's trademarks and that result so similar to the Complainant's domain names currently used by the latter to provide an online offer for sale of its chocolate products.

The last aspect shall be considered: it should be noted that the disputed domain name has been registered only three days after the filing of the EU trademark application no. 18485267 "AMEDEI TOSCANA". This is not a coincidence in the Complainant's view, as it is highly probable the Respondent received (or was aware of) our insider information concerning the Complainant's trademark filing. This suggests opportunistic bad faith according to WIPO Overview 3.0 "3.8.2 Domain names registered in anticipation of trademark rights - As an exception to the general proposition described above in 3.8.1, in certain limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, panels have

been prepared to find that the respondent has acted in bad faith. Such scenarios include registration of a domain name: (i) shortly before or after the announcement of a corporate merger, (ii) further to the respondent's insider knowledge (e.g., a former employee), (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant's filing of a trademark application".

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established according to the Complainant.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

To the satisfaction of the Panel, the Complainant has shown that the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

To the satisfaction of the Panel, the Complainant has 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

To the satisfaction of the Panel, the Complainant has 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 the Policy were met, and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

As per paragraph 4(a) of the Policy, for this Complaint to succeed concerning the disputed domain name, the Complainant must prove the following:

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
(ii) The Respondent has no rights or legitimate interests in respect of 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

The Panel is satisfied that the Complainant has shown it owns rights in the "AMEDEI" trademark, with the earliest registration dating back to 2006.

The Panel must now analyze if there is a confusing similarity between the disputed domain name and the trademark. As contained in the record and evidence at hand, the disputed domain name reproduces the trademark in its totality, namely, "AMEDEI" with the addition of the word "TOSCANA". The term "TOSCANA", in its English translation, is contained in figurative trademark registrations by the Complainant, namely EU trademark registration no. 11101367, for “AMEDEI TUSCANY”. Additionally, the Complainant submitted the EU figurative trademark application no. 18485267 for "AMEDEI TOSCANA" three days before the disputed domain name registration. It is worth noting that Toscana is also the region in Italy where the Complainant has its Headquarters. This additional information is merely provided for context since the analysis under the

first element is “typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name” (para. 1.7 WIPO 3.0 Overview). In this case, the disputed domain name does include the entirety of the trademark, namely "AMEDEI". At the same time, the addition of the geographical term "TOSCANA" is not substantive enough to dispel the confusing similarity between the disputed domain name and the Complainant's trademarks since the trademark is recognizable within the disputed domain name (para. 1.8 WIPO 3.0 Overview).

The other aspects alluded to in the preceding paragraph will be analyzed further in the subsequent sections. Still, for what it concerns to the first element, the Panel determines that the Complainant has satisfied the first element set under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the record, the uncontested facts indicate that a) the Respondent is not commonly known as the disputed domain name; b) the Respondent is not authorized to carry out any activity for the Complainant; b) the Respondent has no license or authorization to use the trademark and c) the Respondent is not affiliated with the Complainant.

In addition to this, the Respondent's use of the trademark plus the geographic term "TOSCANA", seems to indicate that the Respondent not only was aware of the Complainant but deliberately targeted the Complainant. This is evidenced by the disputed domain name registration just a few days after the Complainant's trademark application for “AMEDEI TOSCANA”, on June 4, 2021.

With this evidence at hand, and without a Response, it seems unlikely the Respondent is making a legitimate non-commercial or fair use of the disputed domain name without intent for commercial gain to divert consumers misleadingly or to tarnish the trademark or service mark at issue, as contained under para. 2.1 of WIPO 3.0 Overview. This conclusion is reinforced by the fact that the Respondent appears to trade in domain names and has, in fact, appeared as Respondent in other proceedings, which would indicate that the Respondent is familiar with the UDRP. Should the Respondent have a defense under UDRP paragraph 4(c), the Respondent would likely have provided one.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name based on the above. Therefore, the Complainant has fulfilled the second requirement set under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

As per the record and evidence at hand, the Panel finds that the Respondent was likely aware of the Complainant and targeted the Complainant's trademark when registering the disputed domain name. This conclusion is reinforced because the disputed domain name was registered a couple of days after the Complainant’s trademark application for “AMEDEI TOSCANA”.

Additionally, the evidence on record and the balance of probability, the circumstances indicate that the Respondent registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name, either to Complainant 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 disputed domain name. This conclusion seems in line with para. 3.1 of WIPO 3.0 Overview.

Without having any other explanation from the Respondent, in conjunction with the other facts and evidence, in this case, it strengthens the allegations and the points raised by the Complainant on the bad faith registration and use of the disputed domain name. It is of added importance that the Respondent trades in domain names and should be familiar with the registration of domain names and the potential consequences of not responding, especially if the Respondent considers it has a good defense. This is not enough to be considered a pattern in the Respondent's conduct; nevertheless, this

circumstance complements the evidence at hand on the balance of probability with a finding of bad faith.

In light of the case's circumstances, based on the available records, the Panel finds that the Complainant has proven that the disputed domain name was registered and is used in bad faith according to paragraph 4(a)(iii) of the Policy.

D. Decision

For the preceding reasons and concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed domain name to the Complainant

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AMEDEITOSCANA.COM**: Transferred

PANELLISTS

Name	**Rodolfo Carlos Rivas Rea**

DATE OF PANEL DECISION 2021-08-16

Publish the Decision