

Decision for dispute CAC-UDRP-104426

Case number CAC-UDRP-104426

Time of filing 2022-04-04 09:12:45

Domain names chianticlassico.website

Case administrator

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

Complainant

Organization Consorzio Vino Chianti Classico

Complainant representative

Organization Convey srl

Respondent

Name Fabio Baccilli

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 proved to own the following trademarks:

- Italian Trademark no. 302013902136159 – “CHIANTI” – Nice Classification: 3, 8, 9, 14, 18, 20, 21, 24, 25, 28, 30, 32, 41, 43;
- Italian Trademark no. 0001614370 – “CHIANTI CLASSICO” – Nice Classification: 3, 8, 9, 14, 18, 20, 21, 24, 25, 28, 30, 32, 41, 43;
- International Trademark no. 877636 – “CHIANTI CLASSICO” – Nice Classification: 33;
- International Trademark no. 1183136 – “CHIANTI CLASSICO DAL 1716” – Nice Classification: 33;
- European Union Trademark no. 0902976 – “CHIANTI CLASSICO DAL 1716” – Nice Classification: 33;
- European Union Trademark no. 002258903 – “CONSORZIO DEL MARCHIO STORICO CHIANTI CLASSICO” – Nice Classification: 3, 8, 14, 16, 18, 20, 21, 24, 25, 28.

According to the information provided, the Complainant's trademarks are all "collective trademarks".

FACTUAL BACKGROUND

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

I. The Complainant

The Complainant is an Italian association established in 1987 which regulates and protects the wine produced in the Chianti Classico region.

The Complainant uses the "CHIANTI CLASSICO" denomination on internet including and not limited to the association's official website <https://www.chianticlassico.com> and to the official accounts on the major social networks such as Facebook, Instagram, YouTube and Twitter.

II. The disputed domain name and the Respondent

According to the Whois, <chianticlassico.website> was registered on April 10, 2021 and is not used in connection with an active website.

The owner of the disputed domain name is Mr. Fabio Baccilli, based in province of Lucca in the Tuscany region.

On February 15, 2022, the Complainant sent a cease and desist letter to the Respondent notifying the potential infringement of its trademarks. The Respondent did not reply to the letter.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

As regards the First element of the Policy, the Complainant contends that the disputed domain name is confusingly similar to the Trademark. The Complainant supports that the addition of the "gTLD" has no impact in the confusing similarity assessment.

As regards the Second element of the Policy, the Complainant contends that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks. According to the Complainant's information, the Respondent is not commonly known by the disputed domain name as individual, business or other organization and its family name does not correspond to CHIANTI CLASSICO or to the disputed domain name.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. It contends that the Respondent must have been aware of the Complainant and its well-known Trademark at the time of registration of the disputed domain name and that the Respondent's passive holding of the disputed domain name is evidence of bad faith.

RESPONDENT:

The Respondent did not reply to the Complaint.

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

1. The disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant has successfully proved to be the owner of the trademarks composed by the element "CHIANTI", alone or combined with other terms, such as "classico". The disputed domain name is identical to the Complainant's trademark "CHIANTI CLASSICO". The Panel agrees that the ".website" extension has no impact in the confusing similarity assessment due to its technical function. As a consequence, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, for the purposes of the First Element of the Policy.

2. The Respondent lacks rights or legitimate interests in the disputed domain name. Pursuant to paragraph 4(a)(ii) of the Policy, a complainant is required to make out a prima facie case that a respondent lacks rights or legitimate interests in a domain name. Once such a prima facie case is made, the respondent carries the burden of demonstrating its rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. In this case, the Panel finds that the Complainant's submitted evidence and allegations are sufficient to establish a prima facie case of Respondent's lack of rights and legitimate interests in the disputed domain name also considering that the Respondent did not file a Response or attempted by any other means to rebut the prima facie case against it. According to the information provided by the Complainant and not contested, the Respondent is not commonly known by the disputed domain name nor he is authorized to use the Complainant's trademarks "CHIANTI" and "CHIANTI CLASSICO". Moreover, the Panel argues that the actual use of the disputed domain name does not amount to a bona fide offering of good and services and to a legitimate non-commercial use as defined by the Policy and by the relevant case law. As a matter of fact, <chianticlassico.website> does not resolve to an active website. The Respondent did not submit any concrete evidence that could suggest an intention to use the disputed domain name. The Panel is aware that the disputed domain name is composed by the name of an Italian region and that the Complainant's trademarks are collective trademarks composed by geographical terms. According to the laws of the main EU countries, collective trademarks composed by geographical indications enjoy a limited scope of protection and they cannot be used to contest third parties that are willing to use the geographical indication provided such use complies with honest practices in industrial or commercial matters. However, in this particular case the Respondent did not file any evidence that could support an effective intention to use the "chianticlassico" indication in a way that does not infringe the collective trademark scope of protection.

3. The disputed domain name was registered and is used in bad faith. The Panel finds the following circumstances as material in order to establish the Respondent's bad faith in the registration of the disputed domain name:

- (i) the disputed domain name was registered well after the Complainant acquired rights on the trademarks CHIANTI and CHIANTI CLASSICO;
- (ii) the Complainant's trademark enjoys a high degree of reputation in the World and particularly in Italy. The Respondent is based near Lucca, a town in the Toscana region, which is the same region where the Chianti is produced. The Panel has no doubts that the Respondent was aware of the existence of the CHIANTI and CHIANTI CLASSICO trademarks at the time of the registration of the disputed domain name.

As regards use in bad faith, the Panel notes that the disputed domain name is not used in connection with an active website. According to paragraph 3.3 of the WIPO Overview 3.0., previous panels "have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding." The Panel agrees that the passive holding of <chianticlassico.website> without any reasonable explication by the Respondent constitutes a use in bad faith of the domain name for the purposes of the Policy. The Panel reiterates that the Respondent had the chance, before and within this proceeding, to explain why he registered the domain name and how he intended to use the geographical indication CHIANTI CLASSICO but failed to do so. The Panel concludes that, on the basis of the information of the case, the disputed domain name is registered and used in bad faith.

Accepted

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

1. CHIANTICLASSICO.WEBSITE: Transferred
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PANELLISTS

Name	Andrea Mascetti
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DATE OF PANEL DECISION 2022-05-04

Publish the Decision
