

Decision for dispute CAC-UDRP-104586

Case number	CAC-UDRP-104586
Time of filing	2022-05-17 09:27:34
Domain names	GRANTERRE-EXPORT.COM

Case administrator

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

Organization	Caseifici Granterre S.p.A.
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Complainant representative

Organization	Perani Pozzi Associati
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Respondent

Name	Aldo Fabrizi
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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

In these proceedings, the Complainant relies on the following trademarks, among others:

- GRAN TERRE (& device), EU Trademark No. 000500132, registered as of March 25, 1997, in the name of Parmareggio S.p.A. (the previous name of the Complainant), duly renewed; and
- GRAN TERRE (& device), Italian Trademark No. MI2015C001681, registered as of February 24, 2015, in the name of Parmareggio S.p.A. (the previous name of the Complainant), duly renewed.

It is worth noting that, the Complainant (and/or the group of companies it belongs to) owns quite a few similar trademarks especially in Italy (where the Respondent is apparently located), which have not been cited in these proceedings.

FACTUAL BACKGROUND

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

As per the Complainant's allegations, not disputed by the Respondent, as well as on the basis of information appearing on the Complainant's website, the Complainant is an Italian-based company founded in the 1980s, which is well-known primarily for the production and commercialization of the Parmigiano Reggiano cheese around the world. Its consortium is constituted of numerous manufacturers, dairies and farms.

The Complainant owns a fair-sized portfolio of trademarks including mostly the wording "GRAN TERRE", among which an EUTM dating back to 1997. It also owns quite a few related domain names, such as <granterre.eu>, <granterre.org>, <granterre.net>, <granterre.info> and <granterre.biz> since mid-November, 2021, as well as a number of national registrations for the same name "granterre" (.fr, .cn, .uk, .us, .de, .mx, .jp, .es and .hk).

The disputed domain name <granterre-export.com> was registered on December 15, 2021 by the Respondent (i.e. just a month after the above domain name registrations of the Complainant).

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its "GRAN TERRE" trademark, as it wholly incorporates this well-known trademark. This last element is sufficient to support the finding that the disputed domain name is confusingly similar to the Complainant's trademark. Indeed, the mere addition of the descriptive word "export" to the Complainant's trademark does not change the overall impression of a most likely connection with the well-known trademark "GRAN TERRE" of the Complainant. As to the gTLD ".com", the Complainant suggests that it should be disregarded, as per the usual practice.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain name because the Respondent is neither known by the disputed domain name nor has it used in connection with a bona fide offering of goods or services, the Complainant is neither affiliated with nor has it ever authorised the Respondent to register its trademark as a domain name and the Complainant has no business with the Respondent.

According to the Complainant, given the distinctiveness and reputation of the "GRAN TERRE" trademark, the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark in an intentionally designed way with the aim to create a likelihood of confusion with the Complainant's trademarks and domain names for commercial gain, and this is evidence of the fact that the disputed domain name was registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondent has reproduced a quasi-identical layout to its own and uses false/deceptive contacts, a fraudulent behaviour which causes damage to the Complainant, in terms of loss of clientele and reputation, as well as of disruption of its business.

For all these reasons, the Complainant concludes that the Respondent registered and used the disputed domain name in bad faith.

RESPONDENT:

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).

The disputed domain name consists of the Complainant's whole trademark (GRAN TERRE), to which a hyphen and the word "EXPORT" have been added. Such addition is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark of the Complainant.

On another note, the Panel has been convinced – through evidence provided by the Complainant and not disputed by the Respondent – that, a valid change of name has recently taken place from the current registered owner of the trademarks (Parmareggio S.p.A.) to the Complainant.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the GRAN TERRE trademark in a domain name, and that it had never licensed its trademark to the Respondent.

Furthermore, the Respondent has not demonstrated any use of the disputed domain name in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain name.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark (at least in Italy, where the Respondent is apparently located) and the fact that the disputed domain name fully incorporates this trademark (even with the addition of a descriptive word), it is evident that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name resolves to a website that is in essence identical in layout to the official website of the Complainant, in an attempt to attract clients for commercial gain. This fact is to be combined with the full incorporation of the Complainant's reputable trademark in the disputed domain name. For this Panel, same as for many previous panels, such misleading behaviour clearly amounts to use in bad faith. Therefore, it is impossible to conceive any

plausible active use of the disputed domain name that would be legitimate.

The fact that the Respondent uses fake contacts in its dealings with the Complainant's clients, i.e. a criminal/fraudulent behaviour, which the Panel believes that it causes damage to the Complainant, in terms of loss of clientele and reputation, as well as of disruption of its business, cannot but reinforce the above conclusion.

Therefore, the Panel finds it clear that the disputed domain name was used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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 disputed domain name wholly incorporates the Complainant's trademark, with the addition of a descriptive/non-distinctive word. The disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademark in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's reputable trademark. His use of the disputed domain name is in bad faith as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GRANTERRE-EXPORT.COM:** Transferred

PANELLISTS

Name	Sozos-Christos Theodoulou
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DATE OF PANEL DECISION	2022-06-24
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Publish the Decision
