Decision for dispute CAC-UDRP-102899

Case number	CAC-UDRP-102899
Time of filing	2020-02-17 09:23:38
Domain names	esselungaitalia.com

Case administrator

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

Complainant

Organization	ESSELUNGA S.P.A.

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Name	Navrup Bhinder

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings.

IDENTIFICATION OF RIGHTS

The Complainant has a portfolio of national and regional marks and these include the following marks.

The Italian national mark, registration number 1290783, filed on 12 March 1980, duly renewed, for classes 3, 6, 8, 9, 16, 21, 28, 29, 30, 31, 32, 33, 42 and the sister mark, the Italian national mark number 1480754, filed on 9 April 2002, and duly renewed, in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45. It also relies on its EUTM, European Union Trade Mark, Registration number 3370202, filed on 25 September 2003, and duly renewed, in classes 5, 29, 30, 31, 32, 33. That is a composite mark but the word element, ESSELUNGA, is the distinctive and dominant part.

The Complainant is also the owner of several top-level and country code top-level domain names, consisting of the word element including <esselunga.it> and <esselunga.eu>. The Complainant's principal website is at www.esselunga.it. In addition, the Complainant is also widely promoted on the most popular social media with channels and pages specifically dedicated to it, on Facebook and Instagram.

Due to its longstanding use, and the promotional and advertising investments, the mark is a well-known mark.

FACTUAL BACKGROUND

FACTUAL BACKGROUND

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

Esselunga S.p.A. is an Italian retail store chain, founded in 1957 by Nelson Rockefeller, Bernardo, Guido and Claudio Caprotti, Marco Brunelli, the Crespi family and other Italian associates. Wikipedia says it is now owned by the Caprotti family through Supermarkets Italiani S.p.A. Currently Esselunga S.p.A. is a domestic leader in the retail field in Italy, with total revenues amounting to EUR 7.8 billion and more than 150 outlets. It has over 20, 000 employees.

The name means in Italian literally “long S”.

The disputed domain name is registered in the name of a private person, Navrup Bhinder, apparently based in Canada and was registered on 29 September 2019. It is not currently directed to an active website or webpage.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant says that due to its longstanding use, and extensive promotional and advertising investment, the ESSELUNGA trade mark is well-known. Previous panelists in other UDRP procedures have recognized ESSELUNGA trademark as a trademark enjoying reputation (e.g., Esselunga S.p.A. v. Carla Giorgi, Case n. D2017-2107: “E’ indubbio che il marchio della Ricorrente, grazie alla sua capillare presenza sul territorio italiano in particolare del centro nord, è un marchio rinomato”, i.e.in English: “It is clear that the Complainant’s trademark, through its widespread presence in Italy and, in particular, in the North-Central Italian regions, is a renowned trademark” and Esselunga S.P.A. v. Wang Lian Feng Case No. D2018-0967: “The Complainant's retail store has been in operation since 1957 while its trade mark ESSELUNGA has been registered in Italy since 1980).

"Esselunga" is idistinctive and the brand enjoys an active online presence. In this day and age of the Internet and advancement in information technology, the reputation of brands and trade marks transcend national borders. As such, a cursory Internet search would have disclosed the ESSELUNGA mark and its use by the Complainant. As such, a presumption arises that that the Respondent was aware of the Complainant and its trade marks when it registered the disputed domain name, particularly given that the disputed domain name is identical to the Complainant's mark.

Registration of a domain name that incorporates a complainant's well-known trade mark suggests opportunistic bad faith”).

The disputed domain name is confusingly similar to the Complainant’s trademarks, as it entirely incorporates ESSELUNGA trade marks. It is a well-established principle that domain names that wholly incorporate a trademark are found to be confusingly similar for purposes of the Policy, despite the fact that they may also contain misspelling, descriptive or generic terms. As to the decisions addressing situations where generic terms are used in combination with trademarks, see, among others, Fry’s Electronics, Inc. v. Whois ID Theft Protection, WIPO Case No. D2006-1435; Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation v. Marko Tusla d/b/a/ Toshiba-Club.com WIPO Case No. D2004-1066.

Furthermore, in the present case, the terms selected by Respondent for his domain name registrations are particularly apt to increase the likelihood of confusion and to induce Internet users to believe that there is an association between the Domain Names and Complainant. In fact, “Italia” is the country where ESSELUNGA was founded and where its physical stores are located, therefore the use of the trade mark ESSELUNGA in addition to “Italia” in the domain name clearly recall Complainant’s online sales and official website, as found, inter alia, in Guccio Gucci S.p.A. v. Huangwensheng, Shirley, wangliang, xiaomeng xiexun, jiangxiuchun, WIPO Case No. D2012-0342.

Finally, as consistently found in several decisions, including Telecom Personal, S.A., v. NAMEZERO.COM, Inc, WIPO Case No. D2001-0015 and Société Générale and Fimat International Banque v. Lebanon Index/La France DN and Elie Khouri, WIPO Case No.D2002-0760, the top level ".com" is merely instrumental to the use of the Internet so the Disputed Domain Names remain confusingly similar despite their inclusion.

Therefore, the disputed domain name is confusingly similar to the earlier ESSELUNGA trademarks, and the first requirement under para. 4 (a)(i) of the Policy and of para. 3(b), (viii), (b)(ix)(1) of the Rules is satisfied.

According to paragraph 4(a) of the Policy, the burden of proving the absence of the Respondent's rights or legitimate interests in respect of the disputed domain name lies with Complainant. It is nevertheless a well-settled principle that satisfying this burden is unduly onerous, since proving a negative fact is logically less feasible than establishing a positive. Accordingly, it is sufficient for Complainant to produce prima facie evidence in order to shift the evidential burden to the Respondent. See paragraph 2.1 of WIPO Overview 3.0 and, e.g., Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110.

In the present case, the Complainant denies that the Respondent is an authorized dealer, agent, distributor, wholesaler or retailer of ESSELUNGA. In fact, the Complainant has never authorized Mr. Navrup Bhinder or any other third party to include its well-known marks in the disputed domain name, nor to make any other use of its trade mark in any manner whatsoever.

The Complainant also confirms that it is not in possession of, nor aware of the existence of, any evidence tending to demonstrate that the Respondent is commonly known by the disputed domain name, as individual, business, or other organization. As stated i.a. in WIPO Case No. D2000-0134 Pharmacia & Upjohn Company v. Moreonline, "the mere registration, or earlier registration, does not establish rights or legitimate interests in the disputed domain name".

In light of these considerations, the Complainant excludes that the Respondent is commonly known by the disputed domain name under Art. 4(c)(ii) of the Policy.

The fact that ESSELUNGA is a fanciful word, strengthens the assumption that the disputed domain name was registered for the sole scope of misleading potential consumers, to tarnish the Complainant's trademark and to prevent the Complainant from reflecting its trademark in a corresponding domain name. This is even truer considering that the disputed domain name differs from trademark ESSELUNGA only for the world ITALIA that could easily be linked to it business reality.

Lastly, considering that the disputed domain name entirely reproduces the Complainant's marks, it is very difficult to conceive any possible right or legitimate interest which the Respondent could have in the disputed domain name (see also DHL International GmbH v. Diversified Home Loans, WIPO Case D2010-0097).

For all reasons mentioned above the Complainant says it has discharged its burden and proved that the Respondent lacks rights and legitimate interests in respect of the disputed domain name.

The disputed domain name is currently not redirected to an active website but for use in bad faith, since the inception of the UDRP, many panelists have found that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. It is a fact sensitive question.

In this regard, different factors have been considered relevant in applying the passive holding doctrine including the degree of distinctiveness or reputation of the complainant's mark and the implausibility of any good faith use to which the domain name may be put, and both factors are indeed relevant in the present case. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, Jupiter Limited v. Aaron Hall, WIPO Case No. D2000-0574; Virgin Enterprises Limited v. Ceasr Alvarez, WIPO Case No. D2016-2140.

In light of the above, Complainant respectfully submits that the disputed domain name was registered and is being used in bad faith in full satisfaction of paragraph 4(a)(iii) of the Policy.

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

The Complainant has rights in the name and mark similar to the disputed domain name due to its national marks and its EUTM. It is clear that the mark is a famous or well-known mark. The addition of the word Italia is generic and adds nothing.

There is no fair or legitimate use here. Passive holding may not be bad faith when there is a descriptive mark or a primary meaning. This is not applicable here. Nor is there fair or indeed other use of any kind.

The Complainant’s mark is a made up or fanciful mark so that it is otherwise meaningless.

It can only have been selected to reference the Complainant.

The Respondent has not come forward with any other explanation.

It is therefore clear that the disputed domain name was registered with knowledge of the Complainant and to free-ride on the reputation of the Complainant. This is paradigm bad faith.

The Complainant has made out its case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ESSELUNGAITALIA.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2020-03-24

Publish the Decision