

Decision for dispute CAC-UDRP-105417

Case number	CAC-UDRP-105417
Time of filing	2023-05-19 09:35:34
Domain names	esselungacasa.net, esselungaacasa.net

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Esselunga S.p.A.
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Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.
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Respondent

Name	Alfredo Mascheroni
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of, inter alia, the European Union Trademark registration 13719745 ESSELUNGA in classes 1,3,5,6,8,9,16, 21, 24, 25,28,29,30,31,32,33 and 35, filed on February 9, 2015 and registered on July 8, 2015 and being in effect.

FACTUAL BACKGROUND

The Complainant is the Italian leader in the retail field and has around 185 points of sales and had a net revenue of over 8 billion EUR in 2022.

The disputed domain names <esselungacasa.net> and <esselungaacasa.net> were both registered on February 28, 2023 and resolve to a parking page with commercial links to third parties, inter alia in the field of food.

The Respondent's residence is in Parma, Italy, and several Esselunga Stores are close to the mentioned address.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant contends that the disputed domain names are confusingly similar to the trademark ESSELUNGA since the domain names wholly incorporate Complainant's mark. The Complainant denies that the Respondent is an authorized dealer, agent, distributor, wholesaler or retailer of ESSELUNGA and contends that he never authorized any other third party to include its well-known trademarks in the disputed domain names, nor to make any other use of its trademark in any manner whatsoever. Given Complainant's trademark being well known, Complainant finally contends that the Respondent has registered and used the domain names with full knowledge of the Complainant's trademark.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

In order to succeed in its claim, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

- (i) The disputed domain names are 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 with respect to the disputed domain names; and
- (iii) The disputed domain name have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established the fact that it has valid trademark rights for "ESSELUNGA". The disputed domain names are confusingly similar to the Complainant's mark since the addition of the non distinctive and descriptive words „Casa“ (in English: "home") and „a Casa“ (in English: "at home") cannot be considered as relevant to influence the overall impression of the domain names respectively avoid a highly confusing similarity.

The Panel therefore considers the disputed domain names to be confusingly similar to the trademark „ESSELUNGA“ in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Respondent has no rights or legitimate interests in the disputed domain names, since the Respondent is not a licensee of the Complainant nor has the Complainant granted any permission or consent to the Respondent to use its trademarks or designations confusingly similar to its trademarks. Furthermore, the Respondent has no rights or legitimate interests in the disputed domain names, since there is no indication that the Respondent is commonly known by the names „Esselunga“ or <esselungacasa> or <esselungaacasa> or that the Respondent is using the disputed domain names in connection with a bona fide offering of goods or

services.

The Panel therefore finds that the Respondent does not have rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

The Panel does not believe that the application of two domain names being highly similar to a distinctive trademark as the one from Complainant is accidental.

The Panel assumes that Complainant's mark is at least in Italy, widely known, accordingly also to the Italian registrant with residence in the city of Parma where Esselunga Stores are close to his mentioned address.

This Panel does not see any conceivable legitimate use that could be made by the Respondent of these particular domain names without the Complainant's authorization.

The circumstances of this case, in particular the commercial advertising links to third parties furthermore indicate that the Respondent registered and uses the disputed domain names primarily with the intention of attempting to attract, for commercial gain, Internet users to its potential website or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such website or location, or of a product or service on such website or location. The Panel therefore considers the disputed domain names to have been registered and used in bad faith in accordance with paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **esselungacasa.net**: Transferred
2. **esselungaacasa.net**: Transferred

PANELLISTS

Name	Dietrich Beier
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DATE OF PANEL DECISION **2023-06-27**

Publish the Decision
