

Decision for dispute CAC-UDRP-105597

Case number	CAC-UDRP-105597
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Time of filing	2023-07-13 12:04:17
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Domain names	esselunga.top
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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

Organization	In ger
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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

The Complainant is owner of numerous registered trademarks for the term "ESSELUNGA" (hereinafter the "ESSELUNGA Trademark"), among which:

- Italian trademark No. 1290783, filed on 12 March 1980, registered since 24 October 1985 in Nice classes 3, 6, 8, 9, 16, 21, 28, 29, 30, 31, 32, 33, 42;
- Italian trademark No. 1002680, filed on 9 April 2002, registered since 11 April 2006 in all Nice classes;
- European Union trademark No. 013719745, filed on 9 February 2015, registered since 8 July 2015 in Nice classes 1, 3, 5, 6, 8, 9, 16, 21, 24, 25, 28, 29, 30, 31, 32, 33 and 35.

FACTUAL BACKGROUND

The Complainant is an Italian retail store chain, founded in 1957.

With over 8,3 billion EUR of total revenues and 185 points of sales, the Complainant is leader in the Italian retail field.

The Complainant promotes its products and services through its main website associated to the domain name <esselunga.it> and social media accounts (e.g., Facebook and Instagram).

The disputed domain name was registered with privacy or proxy service on 10 June 2023 by In ger, residing in France.

The disputed domain name does not resolve to any active website.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is identical to its ESSELUNGA Trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not known by the disputed domain name. The Complainant does not have any relationship with the Respondent. The Respondent is not affiliated with nor authorized by the Complainant in any way to make any use of the Complainant's mark or to register the disputed domain name.

Besides, the Complainant contends that the Respondent did not use the disputed domain name, and it confirms that the Respondent has no demonstrable plan to use the disputed domain name.

Finally, the Complainant contends that given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark. More of the passive holding of the domain name by the Respondent constitutes bad faith use.

The Complainant requests the transfer of the disputed domain name.

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).

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

Under paragraph 4(a) of the Policy, the complainant is required to prove each of the following three elements to succeed in the administrative proceeding:

- i. the disputed domain name is identical or confusingly similar to a trade mark 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 by the Respondent in bad faith.

If all three elements are met, the domain name registration is ordered to be cancelled or transferred to the complainant. If one or more elements are not met, the complaint is denied, and the domain name registration remains intact.

I. THE COMPLAINANT'S RIGHTS AND IDENTITY OR CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has established that it has rights in the ESSELUNGA Trademark since 1980.

The test for identity or confusing similarity involves comparing the alpha-numeric domain name and the textual components of the relevant mark to assess whether the mark is recognizable within the domain name. When a domain name wholly incorporates the complainant's trademark, the domain name is considered confusingly similar (see 1.7 WIPO Overview 3.0).

In assessing identity or confusing similarity, the Panel finds that the disputed domain name is identical to the ESSELUNGA Trademark, because it incorporates the entirety of such mark with the addition of the TLD <.top>.

According to the established case law, the TLD is usually disregarded for the purpose of determination of identity or confusing similarity between the disputed domain name and the complainant's trademark, as it is a technical requirement of the registration. The practice of ignoring the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD, including with regard to new gTLDs; the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment of the first element. The meaning of such TLD may however be relevant to panel assessment of the second and third elements (see 1.11 WIPO Overview 3.0).

Hence, the Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is identical to the Complainant's mark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

Under paragraph 4(a)(ii) of the Policy, the complainant has the burden of establishing that the respondent has no rights or legitimate interests in respect of the disputed domain name. If the complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (see paragraph 2.1 of WIPO Overview 3.0).

But, by virtue of paragraph 4(c) of the Policy, any of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate the respondent's rights or legitimate interests to the domain name:

- i. before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- ii. the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- iii. the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In this case, the Panel considers that the Complainant has made out a sufficient prima facie case.

The disputed domain name was registered on 10 June 2023 by In ger, residing in France. Therefore, no evidence is available to show that the Respondent has been commonly known by the disputed domain name or acquired any trademark or service mark rights in a name corresponding to the disputed domain name.

The Complainant has no relationship with the Respondent whatsoever and has never authorised the Respondent to use the ESSELUNGA Trademark or to register the disputed domain name.

The Respondent registered the disputed domain name, incorporating the entirety of the Complainant's trademark, and, thus identical to the ESSELUNGA Trademark.

UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation (see paragraph 2.5.1 of WIPO Overview 3.0).

Moreover, the disputed domain name is inactive.

Therefore, the Panel is unconvinced that, before any notice of the dispute, the Respondent used or prepared to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services or is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the ESSELUNGA Trademark.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests to the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

III. REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel finds that disputed domain name has been registered and is being used in bad faith for the following reasons.

The Respondent concealed its identity by using privacy or proxy service. Upon CAC's request for verification, the Registrar disclosed the underlying registration data, which is apparently false.

UDRP panels agree that, although the use of privacy or proxy service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used may however impact a panel's assessment of bad faith (see paragraph 3.6 of WIPO Overview 3.0).

The Respondent registered the disputed domain name, incorporating in its entirety the dominant and distinctive element of the Complainant's prior mark (namely the term ESSELUNGA). The addition of the TLD <.top> (a technical requirement of the registration) is insufficient to escape the finding of identity between the disputed domain name and the Complainant's mark. To the contrary, the Panel finds that the TLD <.top> is a laudatory term that even enhances and reinforces the confusion among Internet users, who might falsely believe that the future website associated to the disputed domain name is operated by the Complainant for its new offer of special products or services.

Given the distinctiveness of the Complainant's mark, confirmed by prior UDRP decisions (e.g., WIPO Case No. D2017-2107; WIPO Case No. 2018-0967), the Respondent's choice to register the disputed domain name could not have been for a mere chance without actual knowledge of the Complainant's rights in such mark and the intention to exploit its reputation by diverting traffic away from the Complainant's website.

The disputed domain name does not resolve to any active website.

UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see 3.3 WIPO Overview 3.0 and, in particular, Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003).

The following factors were considered by this Panel when applying the passive holding doctrine in the present case:

- i. the degree of distinctiveness and/or reputation of the Complainant's trademark;
- ii. the failure of the Respondent(s) to submit a response or to provide any evidence of actual or contemplated good faith use;
- iii. the Respondent's concealing its identity (privacy or proxy service) or use of false contact details;
- iv. the implausibility of any good faith use to which the disputed domain name may be put.

Taken into account all circumstances of this case, the Panel finds that it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as by being an infringement of the Complainant's ESSELUNGA Trademark under trademark law, an act of unfair competition, or an infringement of consumer protection legislation.

Therefore, the Panel finds that the Respondent, by registering and using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the ESSELUNGA Trademark as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location (paragraph 4(b)(iv) of the Policy).

The Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

The disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **esselunga.top**: Transferred

PANELLISTS

Name	Ivett Paulovics
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DATE OF PANEL DECISION	2023-08-04
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Publish the Decision	
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