

Decision for dispute CAC-UDRP-105782

Case number	CAC-UDRP-105782
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Time of filing	2023-10-09 10:05:12
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Domain names	esselungalab.com
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Case administrator

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

Organization	Esselunga S.p.A.
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Complainant representative

Organization	Claudio Tamburrino (Barzanò & Zanardo Milano S.p.A.)
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Respondent

Organization	web master (Expired domain caught by auction winner.***Maybe for sale on Dynadot Marketplace***)
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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 has provided evidence of its ownership of European Union Trademark ESSELUNGA, registration number 013719745, registered on July 10, 2015, for goods and services in classes 1, 3, 5, 6, 8, 9, 16, 21, 24, 25, 28, 29, 30, 31, 32, 33 and 35.

FACTUAL BACKGROUND

The Complainant has provided evidence of its ownership of the abovementioned European Union Trade Mark registration of the ESSELUNGA trademark and service mark and has also shown that it uses the mark on its website in its substantial business as the owner of an Italian retail store chain, founded in 1957.

The Complainant's retail business has grown to have 185 points of sale and in 2022 had an operating profit of 133.8 million Euro and a net profit of 63.8 million Euro.

The Complainant has an established Internet presence and is owner of several top-level and country code top-level domain names, constituted by the verbal element <ESSELUNGA>, including <esselunga.it> and <esselunga.eu> and maintains its principal website at <www.esselunga.it> advertising its services. Additionally, the Complainant maintains a social media presence on the Internet with accounts on Facebook and Instagram also used for promotional and advertising purposes.

The Disputed Domain Name <esselungalab.com> was registered on August 8, 2023 and resolves to a parking page on which it is offered for sale.

There is no information available about Respondent except for that provided in the Complaint, the Registrar's Whols and the information provided by the Registrar in response to the request by the Centre for verification of the registration details of the Disputed Domain Name in the course of this proceeding.

PARTIES CONTENTIONS

Parties Contentions

Complainant

The Complainant claims rights in the ESSELUNA mark established by its abovementioned trademark and service mark registrations and extensive use in its retail chain in Italy. The Complainant has also claimed rights in other trademark registrations for the ESSELUNA mark, but unfortunately, notwithstanding that the language of the proceedings is English the documentation submitted in supports of those claims are in the Italian language and of no evidential value.

The Complainant alleges that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, arguing that the Disputed Domain Name contains the Complainant's trade mark in its entirety, differing only by the addition of a generic term "lab", which could be easily be associated with ESSELUNGA services (food lab etc.).

The Complainant submits that as consistently found in decisions of panels established under the Policy, including Telecom Personal, S.A., v. NAMEZERO.COM, Inc, Case No. D2001-0015 and Société Générale and Fimat International Banque v Lebanon Index/La France DN and Elie Khouri Case No. D2002-0760 the generic Top Level Domain "<gTLD>" extension "<.com>" is merely instrumental to the use of the Internet so the Disputed Domain Name remains identical despite the gTLD extension.

Therefore, 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.

The Complainant next alleges that the Respondent has no rights or legitimate interests in the Disputed Domain Name, arguing that it is sufficient for the Complainant to produce prima facie evidence that the Respondent has no rights or legitimate interests in the Disputed Domain name, whereupon the burden of production shifts to the Respondent.

The Complainant asserts that the Respondent is not an authorized dealer, agent, distributor, wholesaler or retailer of the Complainant.

In fact, the Complainant has never authorized any other third party to include its well-known trademarks in the disputed domain name, nor to make any other use of its trademark in any manner whatsoever. 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 an individual, a business, or other organization.

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.

Furthermore, considering that the Disputed Domain Name entirely reproduces the Complainant's ESSELUNGA trademark, it is very difficult to conceive any possible right or legitimate interest, which the Respondent could have in the Disputed Domain Name.

The Complainant next alleges that the Disputed Domain Name was registered and is being used in bad faith, arguing that as far as registration in bad faith is concerned, the Respondent registered the Disputed Domain Name, containing the Complainant's well-known trademark without authorization.

The Complainant adds that the Respondent could not ignore the existence of the ESSELUNGA trademark at the time of the registration of the Disputed Domain Name, because ESSELUNGA is a well-known trademark, and because ESSELUNGA is a fanciful word, therefore it is not conceivable a use of the domain name not related to the Complainant's activities.

The Complainant argues that the misappropriation of a well-known trademark as domain name by itself constitutes bad faith registration for the purposes of the Policy.

In light above, it is inconceivable that Respondent was not well aware of Complainant's trademark rights at the time of the registration of the Disputed Domain Name. Indeed, Respondent's purpose in registering the Disputed Domain Name, incorporating ESSELUNGA, was probably to capitalize on the reputation of Complainant's trademark by diverting Internet users seeking information about this distinctive sign.

Furthermore, the Disputed Domain Name has been registered long after the filing/registration of the Complainant's trademarks.

Moreover, it has frequently been found by panellists appointed pursuant to the Policy, that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. 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.

In the present case the screen capture of the website to which the Disputed Domain Name resolves which has been exhibited in an annex to the Complaint shows that the Disputed Domain Name is offered for sale for a sum well above mere registration costs, a clear proof of the intention to make profit from complainant reputation.

Furthermore the Complainant argues that the Respondent has also failed to provide correct and complete Whois information, as it indicates only as an organization named "Expired domain caught by auction winner."***Maybe for sale on Dynadot Marketplace***".

Respondent

No timely Response has been filed by the Respondent.

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's Rights

The Complainant has provided convincing, uncontested evidence that it has rights in the ESSELUNGA mark, established by the ownership of the portfolio of trademark and service mark registrations described above and the reputation and goodwill that it has established in the mark by extensive use on its human and animal food supplement business.

The Complainant has also claimed rights in other trademark registrations for the ESSELUNA mark and provided a list of same, but unfortunately, notwithstanding that the language of the proceedings is English the documentation submitted as evidence of the Italian registrations which are offered in support of those claims are in the Italian language with no translation into the English language and of no evidential value. Nonetheless there is sufficient convincing and uncontested evidence on the record to prove that the Complainant has rights in the mark and so there is no need for the Panel to request translations which would create unnecessary delay, inconvenience and cost.

Confusing Similarity

The Disputed Domain Name <esselungalab.com> consists of the Complainant's ESSELUNGA mark in its entirety, in combination with the word "labs" and the gTLD extension <.com>.

The Complainant's ESSELUNGA mark is clearly recognizable as being the initial, dominant and only distinctive element in the Disputed Domain Name.

It is well accepted that confusing similarity is typically established once a complainant's trademark is incorporated in its entirety in the domain name at issue.

In the present case, the addition of the descriptive word "labs" to the Complainant's. mark to create the second level of the Disputed

Domain Name does not diminish the confusing similarity of the Disputed Domain Name and the ESSELUNGA mark.

Similarly, the gTLD extension <.com> does not prevent a finding of confusing similarity because in the circumstances of this proceeding, it would be considered to be a necessary technical requirement for a domain name registration,

This Panel finds therefore that the Disputed Domain Name is confusingly similar to the ESSELUNGA mark in which the Complainant has rights, and the Complainant has therefore succeeded in the first element of the test in Policy Paragraph 4(a)(i).

The Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the Disputed Domain Name submitting that:

- the Respondent is not an authorized dealer, agent, distributor, wholesaler or retailer of the Complainant;
- the Complainant has never authorized any other third party to include its well-known trademarks in the Disputed Domain Name, nor to make any other use of its trademark in any manner whatsoever;
- the Complainant 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 an individual, a business, or other organization;
- ESSELUNGA is a fanciful word, which 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;
- considering that the Disputed Domain Name entirely reproduces the Complainant's ESSELUNGA trademark, it is very difficult to conceive any possible right or legitimate interest, which the Respondent could have in the Disputed Domain Name.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondent has failed to discharge that burden and therefore this Panel must find that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

The Complainant has therefore succeeded in the second element of the test in Policy Paragraph 4(a)(ii).

The Complainant has adduced clear and convincing, uncontested evidence that it has registered trademark rights in the ESSELUNGA mark dating back to July 10, 2015Z July 10, 2015, which long predate the registration and first use of the Disputed Domain Name on August 8, 2023.

The Complainant has averred that ESSELUNGA is a coined term and this Panel accepts that ESSLUNGA mark is distinctive. It is therefore most improbable that the Disputed Domain Name was chosen for any reason other than its similarity to the Complainant's mark.

The Disputed Domain Name has no obvious meaning other than as reflecting the Complainant's mark in combination with the gTLD extension <.com>.

This Panel finds therefore that on the balance of probabilities the disputed domain name was registered in bad faith with the Complainant and its mark in mind to take predatory advantage of the Complainant's goodwill and reputation in the ESSELUNGA mark.

In uncontested evidence the Complainant has exhibited a screen capture of the website to which the Disputed Domain Name resolves which is exhibited in an annex to the Complaint. The exhibited screen capture shows that the Disputed Domain Name Is being passively held and is been offered for sale for USD\$ 1,999 or for lease for USD\$ 667 per month.

Given the distinctive character of the Disputed Domain Name, that it is clear that the Respondent has no rights or legitimate interests in the Disputed Domain Name considering that it would contemplate leasing it to a third party for a monthly fee, and that the Respondent has no engaged in this procedure in any way, this Panel has no hesitation in finding that the passive holding of the Disputed Domain Name constitutes use in bad faith for the purposes of the Policy.

As this Panel has found that the Disputed Domain Name Was registered and is being used in bad faith, the Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **esselungalab.com**: Transferred

PANELLISTS

Name	James Bridgeman
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DATE OF PANEL DECISION 2023-11-06

Publish the Decision
