

Decision for dispute CAC-UDRP-105785

Case number	CAC-UDRP-105785
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Time of filing	2023-10-09 10:42:04
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Domain names	esselunga-shop.com
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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	xuxu
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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 (the "Domain Name").

IDENTIFICATION OF RIGHTS

The Complainant is the owner of a number of registered trade marks around the world that comprise or incorporate the term "ESSELUNGA" including- European Union Registration n° 013719745, for ESSELUNGA as a word mark first filed on 9 February 2015, in classes 1, 3, 5, 6, 8, 9, 16, 21, 24, 25, 28, 29, 30, 31, 32, 33 and 35.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The Complainant is an Italian retail store chain, founded in 1957 by Nelson Rockefeller and others.

In the year ended 31 December 2022 the Complainant had 8.3 billion EUR of total revenues and 185 points of sale, with gross profits of 133.8 million Euro and net profits of 63.8 million Euro.

"Esselunga" is a fanciful word. As well as numerous trade marks, the Complainant is owner of several top-level and county top-level domain names, that incorporate that term, including <esselunga.it> and <esselunga.eu>. The Complainant has also been successful in a number of cases under the UDRP including *Esselunga S.p.A. v. Carla Giorgi*, WIPO Case no. D2017-2107 and *Esselunga S.P.A. v*

Wang Lian Feng WIPO Case no. D2018-0967.

The Domain Name was registered on 4 August 2023. It has not been used for an active website since registration.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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 demonstrated trade mark rights for ESSULUNGA and the Domain Name can only be sensibly read at the term “Esselunga”, combined with the ordinary English word “shop” and the “.com” gTLD. Accordingly, the trade mark is clearly recognisable in the Domain Name. This is sufficient for a finding of confusing similarity under the Policy (see sections 1.7 of the WIPO Overview 3.0). The Complainant has, therefore, satisfied the requirements of paragraph 4(a)(i) of the Policy.

Why the Respondent has registered the Domain Name is not exactly clear. Nevertheless, the Panel is persuaded that the Domain Name comprising the Complainant’s fanciful trade mark and the ordinary word “shop”, inherently impersonates the Complainant. By reason of the nature of the Domain Name and the size and reputation of the Complainant’s business under the ESSULUNGA mark the Panel is also persuaded that this impersonation is deliberate on the part of the Respondent.

There is no right or legitimate interest in holding a domain name for the purpose of impersonation and the registration and use of a domain name for such a purpose is registration and use of a domain name in bad faith (as to which see section 2.5.1 of the WIPO Overview 3.0 and also the reasoning in Johnson & Johnson v. Ebubekir Ozdogan WIPO Case No. D2015-1031, where the domain name in issue, apart from the top level domain, comprised the Complainant’s mark and a geographical term). It follows that the Complainant has also satisfied the requirements of paragraph 4(a)(ii) and (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. **esselunga-shop.com**: Transferred

PANELLISTS

Name	Matthew Harris
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DATE OF PANEL DECISION	2023-11-13
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Publish the Decision