Decision for dispute CAC-UDRP-106101

Case number	CAC-UDRP-106101
Time of filing	2024-01-16 10:06:04
Domain names	esselunga.business, esselunga.email

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Esselunga S.p.A.

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Name	Fatima Azucena Chang Chiquito

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 owns numerous ESSELUNGA trademarks including:

- Italian trademark registration number 1480754 for ESSELUNGA registered on 5 March 2005;
- European Union trademark registration number 013719745 for ESSELUNGA, registered on 8 July 2015; and
- European Union trademark registration number 3370202 for ESSELUNGA BIO, registered on 4 May 2005.

FACTUAL BACKGROUND

The Complainant is a large Italian retail store chain, founded in 1957. The Complainant owns several trademark registrations for ESSELUNGA that predate the registration of the disputed domain names. It also owns several domain names that include ESSELUNGA, such as <esselunga.it>, <esselunga.eu> and <esselunga.com>. The Complainant's principal website where its services and point of sales are advertised, uses the domain name <esselunga.it>. The Complainant is active on social media, including Facebook and Instagram.

The Respondent registered the disputed domain names on 11 January 2023 using a privacy service. The disputed domain names redirect to parking pages with sponsored links.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant asserts that the disputed domain names are confusingly similar to its trademark, ESSELUNGA.

The Respondent has no rights or legitimate interests in respect of the domain names and asserts that:

i. the Respondent is not an authorised dealer, agent, distributor, wholesaler or retailer of ESSELUNGA and is not authorised to use Complainant's well-known trademark in the disputed domain names;
ii. the Respondent is not commonly known by the disputed domain names; and
iii. the disputed domain names are not used in connection with a bona fide offering of goods and services and they currently redirect to a parking page with sponsored links.

The Complainant asserts that the disputed domain names were registered and are being used in bad faith and states:

i. the Respondent registered the disputed domain names containing its well-known trademark without authorisation and using a privacy service;
ii. the disputed domain names were registered long after registration of the Complainant's trademarks;
iii. the disputed domain names redirected to webpages displaying sponsored links to various third-party commercial websites, mainly related to Complainant and competitors' services, which indicates bad faith (see Autodesk, Inc. v. PrivacyProtect.org / Tech Domain Services Private Limited, WIPO Case No. D2011-1958; DeutscheTelekom AG v. Gary Seto, WIPO Case No. D2006-0690; Claire's Stores, Inc., Claire's Boutiques, Inc., CBI Distributing Corp. v. La Porte Holdings, WIPO Case No.D2005-0589; Volvo Trademark Holding AB v. Michele Dinoia, WIPO Case No. D2004-0911); and
iv. the disputed domain names are set up with MX Records and could be used to send and receive emails with a high risk that they could be involved in phishing or fraud activities as there will be emails sent by an email address "@esselunga.business" or "@esselunga.email", clearly impersonating Complainant.

RESPONDENT:

No administratively compliant Response has been filed.

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 Complainant requests that the language of proceedings be in English and states that:

i. the Complainant does not understand Spanish and to translate the Complaint and its annexes would be burdensome and expensive for the Complainant and cause unnecessary delay;

ii. the parking page to which the disputed domain names redirects is partially in English and partially in Italian; and
iii. the disputed domain names include the English words "business" and "email".

Under paragraph 11 of the Rules, the language of the administrative proceedings is the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise. The Respondent has not challenged the Complainant's request that the language of the proceedings be English. The Respondent has used the English words "business" and "email" in the disputed domain names. The "Cookie Settings" notice on the webpages linked to the disputed domain names is in English. Considering these factors, the Panel finds that the Respondent has sufficient knowledge of English for the language of the proceeding English.

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

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements:

(i) that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in the disputed domain names; and

(iii) the disputed domain names have been registered and used in bad faith.

A. Identical or confusingly similar

The dominant feature of the disputed domain names is the Complainant's ESSELUNGA trademark, which is clearly distinguishable in the disputed domain names. The disputed domain names consist of the Complainant's mark, plus the top level domain ".business" and the Complainant's mark plus the top-level domain ".email". This does not avoid a finding of confusing similarity.

The Panel finds that the dispute domain names are confusingly similar to the Complainant's trademark ESSELUNGA and that the requirements of paragraph 4(a)(i) of the Policy have been met.

B. No rights or legitimate interests

The Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interest in the disputed domain names. The burden of proof now shifts to the Respondent to show relevant rights or legitimate interest in the disputed domain names.

The Respondent has not filed a Response nor submitted any evidence to show that the Respondent has any rights or legitimate interests in the disputed domain names. There is nothing to show that the Respondent is commonly known by the disputed domain names. The Respondent is not an authorised dealer, agent, distributor, wholesaler or retailer of the Complainant, nor authorised to use the Complainant's ESSELUNGA trademark. Using the disputed domain names in connection with webpages with sponsored links, appears to be an attempt to attract internet users by creating a likelihood of confusion with the Complainant and its mark, rather than a genuine offering of goods and services.

The Panel concludes that the Respondent has no rights or legitimate interest in the disputed domain names and that the requirements of paragraph 4(a)(ii) of the Policy have been met.

C. Registered and used in bad faith

The Complainant's trademarks predate the registration of the disputed domain names by many years. The Respondent used a privacy service to register the disputed domain names, which are confusingly similar to the Complainant's trademark. The disputed domain names redirected to webpages displaying sponsored links for commercial gain, and are set up with MX Records that could be used to send and receive emails to impersonate the Complainant.

Considering the above factors the Panel concludes that the disputed domain names were both registered and used in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **esselunga.business**: Transferred

2. **esselunga.email**: Transferred

PANELLISTS

Name	**Veronica Bailey**

DATE OF PANEL DECISION 2024-02-20

Publish the Decision