Decision for dispute CAC-UDRP-106046

Case number	CAC-UDRP-106046
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Domain names	mondoeconvenienza.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Mondo Convenienza Holding S.p.A.

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Organization	Multex.PK

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 adduced evidence showing that it is the owner of the following trademarks:

1. MONDO CONVENIENZA, Italian trademark No. 0000689185 registered on 14 October 1996 in Nice Classification classes 9, 11, 20 and 21, for a figurative mark in respect of which the record shows an original filing was made on 3 October 1984.

2. MONDO CONVENIENZA, Italian trademark No. 0001609623 registered on 8 October 2014 for a figurative mark in the same Nice classes.

3. MONDO CONVENIENZA, EU trademark No. 002635704, again for a figurative mark, registered on 17 June 2023 in Nice classes 11, 20, 21, 35 and 39.

The Complainant further produced its own history of the Complainant's trademark filings, which includes cropped screenshot images of variations on the name logo that constitutes the MONDO CONVENIENZA figurative mark. In each case, emphasis is lent to the word "MONDO" ("world" in English) by representing the globe graphically within its first "O". This history in a similar manner includes an image of a different name in figurative form, DOLCE CASA, for which no official registration record was submitted to the Panel.

The Panel does not accept the history of trademark filings as proof of rights as such but does accept that it indicates the Complainant's intention to protect its distinctive mark MONDO CONVENIENZA in figurative form over a considerable period of time.

Supporting evidence is also adduced that shows current actual use of this figurative mark in promotional brochures, on the Complainant's website and in social media. Brand recognition is furthermore shown in the Complainant's mark being included alongside other well-known logos for firms active in the Complainant's business area in a 2018 report on the Complainant in the Italian financial newspaper, 24 Ore.

The Complainant does not supply direct evidence of its registration of its domain name -- only screenshots of website content without inclusion of the URL. It states that its domain name is a shortened version of MONDO CONVENIENZA under the <.it> country code TLD for Italy.

The Registrar Verification performed by the CAC Case Administrator shows that the Respondent became the registrant of the disputed domain name <mondoeconvenienza.com> on 10 September 2023.

FACTUAL BACKGROUND

The Complainant, Mondo Convenienza Holding S.p.A., is an Italian company specialized in large-scale organized distribution of furniture and furnishing accessories at competitive prices intended to make its products widely accessible. It was founded in 1985 and has established itself among the main home furnishings distributors in Italy; the Company has recently extended its business to Spain. The Complainant has over 4,000 employers and claims to have a turnover of over €1 billion (the Panel was not in a position to access the reference provided by the Complainant in this regard).

The Case File, despite statements in the Complainant's contentions in its Amended Complaint, contains both the name of the Respondent, Multex.PK, and accurate postal address details. There is no resemblance between the Respondent's name and the disputed domain name. In exercise of the Panel's general powers under the Rules, a routine online check of the details provided indicates that the Respondent is engaged in the provision of web-related services including website construction.

The Complainant provided a screenshot of the webpage associated with the disputed domain name. In the Complainant's contentions, below, it is contended that the domain name is passive, whereas the screenshot shows a <cgi-sys/suspendedpage.cgi> error message. This indicates some form of preparation for use of the disputed domain name, albeit obviously deficient, at the point when the screenshot was taken (23 December 2023). A <cgi-sys/suspendedpage.cgi> issue can arise for various reasons, from intervention by the hosting internet service provider to inadvertant technical error.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant first contends that the domain name is identical or confusingly similar to trademarks in which the Complainant has rights, as shown in its submissions (see Identification of Rights). The disputed domain name is very close to the Complainant’s trademarks, being composed by the words MONDO and CONVENIENZA with the sole addition of the letter “e” between the two words. This makes this a clear case of typosquatting.

The Complainant next contends that the Respondent’s contact details are not available and then proceeds to advance "assumptions" to deny that the Respondent could have any right or legitimate interest in registering the disputed domain name. The Complainant asserts that its internal policies preclude even any commercial partner being authorized to register and use MONDO CONVENIENZA as a domain name, thereby excluding any possibility of such authorization in the Respondent's case. It is very improbable that the Respondent could be commonly known as “MONDO CONVENIENZA", considering that MONDO CONVENIENZA is the Complainant's protected brand and company name and corresponds to a fanciful combination of words. The disputed domain name is currently inactive and thus not used in connection with a bona fide offering of goods and services. Nor is the Respondent using it in a legitimate noncommercial or fair manner. As to discharge of its burden of proof under this second limb of the UDRP three-part test, the Complainant claims that prima facie evidence is required in order to shift the burden to the Respondent, giving as reason that proving a negative fact is logically less feasible than establishing a positive, as previous Panels have recognized.

Third, in regard to the final limb of the UDRP three-part test, the Complainant contends that the domain name was registered and is being used in bad faith because the disputed domain name contains a well-known third party’s trademark without authorization whose existence could not have been overlooked at the time of the disputed domain name's registration. A use of the domain name unrelated to the Complainant’s activities is inconceivable, particularly since the only difference between disputed domain name and the Complainant's trademark MONDO CONVENIENZA is the letter “e” that the Respondent inserted between the brand's words. Also, the Complainant claims that the Respondent passively holds the disputed domain name and that the Respondent's contact details were redacted, a circumstance previous Panels have found to indicate bad faith in combination with other elements.

In view of these contentions, the Complainant claims that it has satisfied all elements of the UDRP cumulative three-part test.

RESPONDENT: NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to trademarks 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 that 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 the UDRP were met and that there is no other reason why it would be inappropriate to provide a decision.

The Panel notes that its résumé of the Parties' contentions includes for the Complainant only its arguments pertinent to reaching a decision in this proceeding. The Panel notes in this regard the Complainant's contentions as to:

- prima facie proof indicating an absence of legitimate rights or interests on the Respondent's behalf; and

- passive use of the disputed domain name for the purpose of showing bad faith use in particular.

The Panel observes here that:

- as concerns prima facie proof, the Amended Complaint does not take account of the Respondent's actual details as revealed by the CAC's Registrar Verification. These details remove the need solely to rely on making assumptions, as the Complainant sought to do;

- it is not in any way less feasible, with the information now available about the Respondent in conjunction with the other circumstances of the case, to arrive at a negative determination as to the Respondent's lack of rights or legitimate interests. The Panel thus rejects this procedural argument of the Complainant as unfounded;

- the evidence put forward in this case includes a <cgi-sys/suspendedpage.cgi> error message, which raises, as explained under Factual Background, at least the possibility of preparations by the Respondent for use of the disputed domain name, so rendering it necessary for the Panel to make an assessment of the specific circumstances of this case.

PRINCIPAL REASONS FOR THE DECISION

The Complainant in this uncontested case has established its own rights based on trademarks in figurative form in Italy and the EU that correspond to a well-known brand, MONDO CONVENIENZA. The mark is also the Complainant's company name.

The two words incorporated in the brand are on their own not distinctive; it is their combination that makes them so, particularly in relation to the market for home furnishings, in which the Complainant has built up its retail business and achieved prominence.

The disputed domain name was composed by a Respondent in Pakistan to incorporate both of MONDO CONVENIENZA's parts without alteration exception for interposition of the Italian word "e", meaning "and" in English. This produced a 16-letter disputed domain name stem compared to the 9-letter shortened stem that the Complainant chooses to employ with <.it> or <.es> country code TLD suffixes. Adding the gTLD suffix <.com> to the disputed domain name stem produces a total of 19 characters for the internet user to process optically, which is relatively long and can make spotting the variation from the correct brand name difficult.

The Panel thus finds the disputed domain name to be confusingly similar to the Complainant's trademark, so satisfying the first part of the UDRP three-part cumulative test.

There is no hint from the Case File, nor from the Panel's routine scrutiny online of the Respondent's details as revealed by the Registrar Verification, that the Respondent has any connection to the Complainant, to Italy or the Italian language, or to some other interest in employing the string of characters resembling the protected brand MONDO CONVENIENZA. To the contrary, all the circumstances appear to bear out the Complainant's contention of typosquatting, i.e. illegitimate use of this brand name (and this is despite the Complainant making this contention without taking pertinent circumstances evident from the Registrar Verification into

account).

The Panel accordingly finds a lack of right or legitimate interest on the part of the Respondent, so satisfying the second part of the UDRP three-part cumulative test.

As to the third part of the test -- presence of bad faith registration and use -- the Panel notes the finding of typosquatting just made and the fact of the peculiar interposition of the Italian short word "e" between the two parts of the Complainant's protected brand in the disputed domain name's stem. This act can safely be presumed to be intentional and there is no apparent alternative explanation of its purpose other than to impersonate the Complainant. What the precise ulterior motive was for doing so was and is obscure in this uncontested case. There may be an indication yielded by the evidence in this proceeding of the <cgi-sys/suspendedpage.cgi> error message. One cannot read too much into this message; certainly not all such messages are generated because of conduct that might qualify as bad faith use. But its combination with the finding of typosquatting is noteworthy. Be this as it may, it is not necessary to reach a distinct finding on this aspect: the very preparations that led to that error message are suggestive of deployment of the disputed domain name in some manner (including perhaps e-mail). And the likelihood in the context of a clear instance of typosquatting is strongly that such use will be to the detriment of the Complainant as right holder and of internet users alike.

The Panel hence finds both bad faith registration and use, meaning that the Complainant has also satisfied the last part of the UDRP test.

It accordingly ORDERS transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **mondoeconvenienza.com**: Transferred

PANELLISTS

Name	**Kevin Madders**

DATE OF PANEL DECISION 2024-02-20

Publish the Decision