Decision for dispute CAC-UDRP-106045

Case number	CAC-UDRP-106045
Time of filing	2024-01-17 10:32:20
Domain names	cinecitta.top

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	CINECITTA' SOCIETA' PER AZIONI

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Name	ZHAO PENG

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 demonstrated ownership of registered rights in the trademark CINECITTÀ for the purposes of standing to file a UDRP complaint.

The Complainant is the owner of numerous trademark registrations for CINECITTÀ, including the following, as per trademark registration details submitted as one of the annexes to the Complaint:

- European Union trademark registration No. 001191329 for CINECITTÀ (word mark), filed on May 28, 1999 and registered on October 26, 2000, in classes 3, 9, 14, 16, 18, 25, 40 and 41;

- European Union trademark registration No. 008289431 for CINECITTÀ (word mark), filed on May 8, 2009 and registered on December 1, 2009, in classes 28, 34, 38, 43 and 44;

- International trademark registration No. 721553 for CINECITTÀ (word mark), registered on August 6, 1999, in classes 3, 9, 14, 16, 18, 25, 40 and 41.

FACTUAL BACKGROUND

The Complainant is an Italian public limited company wholly owned by the Ministry of Economy and Finance. The Ministry of Culture in agreement with the Ministry of Economy and Finance exercises shareholder rights.

The Complainant controls Cinecittà Studios, Archivio Luce Istituto Luce-Cinecittà and several editorial activities. For its relevance, history and range of activities, the Complainant is one of the main entities in the cinematographic sector, both in Italy and abroad, with a variety of commitments and activities aimed at supporting Italian cinematography and audiovisual industry worldwide.

The Complainant operates its main website at the domain name <cinecitta.com>, registered on June 3, 2013.

The disputed domain name <cinecitta.top> was registered on May 1, 2023, and resolves to an inactive website.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name <cinecitta.top> is identical to the trademark CINECITTÀ in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the generic Top Level Domain ".top".

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name since: i) the Complainant is in no way related to the Respondent ii) the Respondent has in no way been authorized or allowed by the Complainant to use the CINECITTÀ mark in any way; iii) the Respondent has not acquired trademark rights in a trademark or trade name corresponding to the disputed domain name; iv) the disputed domain name is not pointed to an active website and, therefore, it is not used in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use; and v) the fact that the CINECITTÀ trademark is well-known suggests that the disputed domain name may have been registered for the sole scope of misleading potential consumers, to tarnish the Complainant's trademark and prevent the Complainant from reflecting its trademark in a corresponding domain name.

The Complainant claims that the Respondent registered the disputed domain name in bad faith because, given the distinctiveness and reputation of the CINECITTÀ business and trademarks worldwide, it is inconceivable that the Respondent registered the disputed domain name without having actual knowledge of the Complainant.

The Complainant also submits that the current passive holding of the disputed domain name amounts to bad faith use because i) the Complainant's trademark is highly distinctive, having an excellent reputation and being widely known; ii) CINECITTÀ is a fanciful combination of words, strictly related to the Complainant's business (i.e. its company name) and, therefore, it is hardly conceivable a use of the disputed domain name which would not infringe the Complainant's rights; iii) the disputed domain name is not being used and, to the best knowledge of the Complainant, it never has been; and (iv) the respondent's contact details are redacted.

The Complainant also states that the Respondent's provision of incomplete contact details in the Whois records further demonstrates the Respondent's bad faith.

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

1. The Complainant has provided evidence of ownership of valid trademark registrations for CINECITTÀ.

The Panel notes that the disputed domain name entirely reproduces the trademark CINECITTÀ with the mere omission of the accent in the CINECITTÀ trademark. This difference is immaterial to the purpose of the comparison.

As to the generic Top Level Domain (gTLD) " .top", as established in a number of prior UDRP cases, it is viewed as a standard registration requirement and as such can be disregarded for the purpose of assessing identity or confusing similarity.

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the trademark CINECITTÀ in which the Complainant has established rights for the purpose of paragraph 4(a)(i) of the Policy.

2. With reference to the Respondent's rights or legitimate interests in the disputed domain name, the Panel finds that the Complainant has made a prima facie case and that the Respondent, by not submitting a Response, has failed to provide any element from which a Respondent's right or legitimate interest in the disputed domain name could be inferred.

The Panel notes that, based on the records, the Complainant has not authorized the Respondent to register and use its trademark CINECITTÀ. Moreover, there is no evidence that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name.

Moreover, there is no evidence that the disputed domain name, currently not pointed to an active website, might have been used in connection with a bona fide offering of goods or services or a legitimate non-commercial or fair use without intention to misleadingly divert the consumers or to tarnish the Complainant's trademark.

Furthermore, the disputed domain name, being virtually identical to the Complainant's well-known trademark CINECITTÀ, is inherently misleading, carrying a high risk of implied affiliation with the Complainant.

Therefore, the Panel finds that the Complainant has demonstrated that the Respondent has no rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy.

3. As to bad faith at the time of the registration, the Panel finds that, in light of the Complainant's prior registration and use of the trademark CINECITTÀ, which consists of a fanciful combination of words, and considering the well-known character of the trademark especially in Italy, the Respondent – based in Italy according to the Whois records - clearly had the Complainant's trademark in mind when it registered the disputed domain name in May 2023.

As indicated above, the disputed domain name is currently not pointed to an active website. As established in a number of prior cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding. In the present case, considering i) the well-known character of the Complainant's trademark, ii) the Respondent's failure to file a Response, iii) the implausibility of any good faith use to which the disputed domain name may be put and iv) the Respondent's use of a privacy service and the provision of incomplete contact information in the Whois records, the Panel finds that the current passive holding of the disputed domain name does not prevent a filing of bad faith use.

Therefore, the Panel finds that the Complainant has also demonstrated that Respondent registered and is using the disputed domain name in bad faith according to paragraph 4(a)(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. **cinecitta.top**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2024-02-22