

Decision for dispute CAC-UDRP-106380

Case number	CAC-UDRP-106380
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Time of filing	2024-04-02 09:22:44
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Domain names	mutti.com
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Case administrator

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

Organization	Mutti s.p.a.
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Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.
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Respondent

Organization	Web Media Group LLC
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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 is the owner, amongst others, of the following trademark registrations:

- 1) MUTTI PARMA (device) International reg. no. 827135 registered on April 30, 2004 in classes 29, 30 and 32 and duly renewed;
- 2) MUTTI EUTM no. 3492402, filed on October 31, 2003, registered on June 6, 2005 in classes 29, 30 and 32 and duly renewed;
- 3) MUTTI PARMA (device) EUTM no. 3502391, filed on October 31, 2003, registered on April 14, 2005, in class 29, 30 and 32 and duly renewed.

FACTUAL BACKGROUND

The Complainant (MUTTI s.p.a.) is an Italian company specialised in preserved food and, particularly, in the tomato field. MUTTI s.p.a. was founded in 1899 in Piazza di Basilicanova, a district in Montechiarugolo, in the province of Parma by Callisto and Marcellino Mutti.

The Complainant informs that the “two lions” trademark (MUTTI PARMA device) was registered in 1911 and that the company obtained its first award with the First-Class Gold Medal certificate at the International Industry and Agriculture Exhibition in Rome. In 1914, Mutti obtained the Grand Cross certificate and was enrolled in the Gran Libro d'Oro dei Benemeriti del lavoro.

The Complainant is the owner of several trademarks consisting of or including MUTTI and it is also the owner of the domain name <mutti-parma.com> registered since January 27, 1999 and used in connection with the official website of Mutti s.p.a.

The disputed domain name was registered on December 13, 2003 and, according to the Complainant's view, it is not actively used.

The Complainant conducted a historic Whois search on <mutti.com>, according to which the first available registrant of the domain name (after its registration on December 2003) is a British company, Loyal Internet Group Ltd that owned <mutti.com> until at least May 14, 2007. Subsequently (February 28, 2008) the disputed domain name was transferred to the Hong Kong company W.D. Group LTD which is the last known owner of the domain name before it was owned by Wed Media Group LLC. On the basis of these information the Complainant assumes that Web Media Group LLC acquired the disputed domain name for sure after February 28, 2008

The Complainant also notes that the disputed domain name was never used but on 2014 and 2016 it contained links related to the Complainant's trademark and business.

The Complainant states that the disputed domain name <mutti.com> is identical to the Complainant trademarks. In particular, in the Complainant's view, the mere fact that a domain name wholly incorporates a Complainant's registered mark is sufficient to establish confusing similarity for purposes of the Policy.

The Complainant states that the Respondent is not affiliated with him nor authorized by him in any way. The Complainant states that the Respondent has no right nor legitimate interest in the disputed domain name and it is not related in any way to its business. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Respondent, according to the Whois database, is not commonly known by <mutti.com> or by other names similar to the disputed domain name.

According to the Complainant, given the distinctiveness and reputation of MUTTI's business and trademarks worldwide, it is inconceivable that the Respondent could have acquired the disputed domain name without actual knowledge of MUTTI and its rights in such marks.

Finally, it is the Complainant's view that <mutti.com> was acquired for the purpose of selling it to the trademark owner. This is confirmed by the fact that currently the disputed domain name is offered for sale for a very high amount of money.

PARTIES CONTENTIONS

Complainant's contentions are summarized above.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

- (i) the disputed domain name is 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 respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

1) Having duly analysed the Complainant trademarks, the Panel's view is that the only element to be considered in the present comparison is MUTTI since PARMA (depicted in very small characters) is a mere geographical indication without distinctive character (see *The Ritz (London) Limited v. Keith Raybon*, CAC Case No. 105811 related to the trademark RITZ LONDON). Therefore, the Panel finds that the disputed domain name <mutti.com> is confusingly similar to the Complainant's trademark MUTTI. Many panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see, among others, *Chubb Security Australia PTY Limited v. Mr. Shahim Tahmasebi*, WIPO Case No. D2007-0769; *Société Air France v. Virtual Dates, Inc.*, WIPO Case No. D2005-0168 and *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662). This is the case in the present situation where the Complainant's registered trademark MUTTI is fully included in the disputed domain name. The additional element, namely the gTLD ".com", is a mere technical requirement, which does not affect the identity between the signs and should be disregarded. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant demonstrated that the disputed domain name is offered for sale for a very high amount of money. The Panel finds that said activity, per se, does not provide a legitimate interest in the disputed domain name under the Policy. Furthermore, the Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use the MUTTI trademark by the Complainant. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds on the second element of the Policy.

3) The Panel has duly considered that, according to the current Whois records and to the report made available by Complainant, the disputed domain name was registered in 2003, but the ownership of the disputed domain name has changed in favour of the current owner only after February 28, 2008. The Panel wishes to consider the Respondent best scenario (domain name acquisition on March 2008) in assessing bad faith according to section 3.9 of the WIPO Overview 3.0 (the transfer of a domain name registration from a third party to the respondent is not a renewal and the date on which the current registrant acquired the domain name is the date a panel will consider in assessing bad faith). According to the above it is clear to the Panel that the Respondent has acquired the disputed domain name years after the registration of the MUTTI mark. In any case, given the use of the mark MUTTI since the beginning of 90s, it is highly possible that even the original registrant of the disputed domain name was aware of the MUTTI trademark when it registered <mutti.com> on December 13, 2003. Accordingly, the Panel finds that it was more likely than not that the current Respondent was well aware of the Complainant, its business and of the MUTTI mark when it registered the disputed domain name and that he did so opportunistically. The disputed domain name has not been used by the Respondent but rather resolves to a parking page on which it is simply advertised as being for sale for USD 250.000. The advertised price is exorbitant especially if compared with the administrative costs involved in applying for and maintaining the disputed domain name. Therefore, it is apparent that the Respondent acquired the disputed domain name in order to make a profit from its re-sale. These facts, including the well-reputed nature of the MUTTI mark, the parking of the disputed domain name on a parking page with an advertisement for sale of the same disputed domain name <mutti.com> at an exorbitant price and the fact that the disputed domain name has been used in the past in connection with a webpage including links related to the Complainant's trademark and business, are circumstances together highly supportive of an inference of the Respondent's use of disputed domain name in bad faith. Under paragraph 4(b)(i) of the Policy, circumstances indicating that a respondent has registered a domain name primarily for the purpose of selling, renting, or otherwise transferring it to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name are evidence of registration and use of a domain name in bad faith (see between many others *Frankie Shop LLC v. Domain Sales - (Expired domain caught by auction winner) c/o Dynadot*, WIPO Case No. D2023-2529). Accordingly, the Panel finds that the disputed domain name was both registered and used in bad faith and the Complainant also succeeds on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **mutti.com**: Transferred

PANELLISTS

Name **Guido Maffei**

DATE OF PANEL DECISION 2024-04-30

Publish the Decision