Decision for dispute CAC-UDRP-106432

Case number	CAC-UDRP-106432
Time of filing	2024-04-29 09:50:50
Domain names	MONDOCONVENIENZA.WEBSITE

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

Name	Dario Lepore

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 of several « MONDO CONVENIENZA » trademarks, including the following:

Italian trademark MONDO CONVENIENZA (device) No. 0000689185, registered on October 14, 1996;

Italian trademark MONDO CONVENIENZA (device) No. 0001609623, registered on October 8, 2014;

European trademark MONDO CONVENIENZA (device) No. 002635704, registered on June 17, 2003.

The Complainant is also the owner of inter alia the domain name <mondoconvenienza.com>.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The Complainant, founded in 1985, is an Italian company specializing in large-scale organized distribution of furniture and furnishing accessories at competitive costs accessible to all.

The Complainant is one of the main distributors of home furnishings in Italy. The Complainant has more than 40 sales points in Italy and 3 in Spain, more than 4,000 employees, 6,500 daily customers and sales of EUR 1.3 bn.

The disputed domain name <mondoconvenienza.website> was registered on November 17, 2023.

The disputed domain name is currently inactive. From the submissions provided by the Complainant it appears that previously (i.e. at the time the complaint was filed) the disputed domain name redirected to an ICANN page announcing that the domain name was pending ICANN verification. However, in the WHOIS data the domain status was not indicated as suspended.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that:

1. The disputed domain name is identical to the Complainant's trademark.

The Complainant contends that the disputed domain name is identical to its trademark, as it is solely composed of the words MONDO and CONVENIENZA.

2. The Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant contends that the Respondent is not commonly known by the disputed domain name and that the Respondent is not affiliated with or authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and is not related to the Complainant’s business in any way. The Complainant does not carry out any activity for, nor has any business dealings with, the Respondent.

3. The disputed domain name has been registered and is being used in bad faith

The Complainant contends that owing to the distinctiveness of the Complainant’s trademark and reputation, it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of the Complainant's rights in the MONDO CONVENIENZA trademark.

As concerns bad faith use, the Complainant notes that the Respondent is passively holding the disputed domain name. The Complainant, quoting Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, claims that the passive holding of a domain name can, in certain circumstances, constitute bad faith use. The Complainant lists the circumstances of the present case as follows:

(i) the Complainant’s trademark is highly distinctive and widely known;

(ii) MONDO CONVENIENZA is a fanciful combination of words, strictly related to the Complainant's business (it is the company name). As a consequence, it is hardly conceivable that use of the disputed domain name would not infringe the Complainant's rights;

(iii) the disputed domain name is not being used and, to the best of the Complainant’s knowledge, it never has been used;

(iv) the Respondent's contact details are redacted. Previous panels have considered such circumstance as an indication of bad faith in combination with other elements;

The Complainant thus states that the above circumstances show that the Respondent's passive holding amounts to acting in 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. A) Confusing similarity

The disputed domain name is identical to the textual part of the Complainant's trademark, save for the addition of the ".webstore" Top-Level Domain ("TLD").

Owing to the fact that the design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for the purposes of assessing identity or confusing similarity under the first element; see section 1.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"). Considering that gTLDs are also generally disregarded under the test for confusing similarity for the purposes of the Policy, the disputed domain name can be considered identical to the Complainants' trademark.

1. B) Lack of legitimate rights or interests

The disputed domain name is a distinctive, non-descriptive name, and the MONDO CONVENIENZA trademark is renowned in Italy, the country where the Respondent apparently resides. It is therefore at the least very unlikely that the Respondent registered the disputed domain name without having the Complainant firmly in mind. The Complainant's assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorized by the Complainant are sufficient to constitute a prima facie demonstration of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent. The burden of evidence therefore shifts to the Respondent to show, using tangible evidence, that it does have rights or legitimate interests in the disputed domain name. The Respondent has made no attempt to do so.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

1. C) Registered and Used in Bad Faith

The Complainant gives sound bases for its contention that the disputed domain name was registered and has been used in bad faith.

Firstly, owing to the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademarks, and so the Panel finds on the balance of probabilities that the Respondent was aware of the Complainant's trademarks when registering the disputed domain name.

Secondly, the Panel accepts the Complainant's unchallenged assertion that the Respondent registered the disputed domain name with the aim of creating a likelihood of confusion with the Complainant's trademark.

Thirdly, the disputed domain name appears to be passively held, and it is hardly conceivable that use of the disputed domain name would not infringe the Complainant's rights.

Finally, the Respondent has not responded to nor denied any of the assertions made by the Complainant in this proceeding.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MONDOCONVENIENZA.WEBSITE**: Transferred

PANELLISTS

Name	**Fabrizio Bedarida**

DATE OF PANEL DECISION 2024-06-03

Publish the Decision