Decision for dispute CAC-UDRP-106680

Case number	CAC-UDRP-106680
Time of filing	2024-07-15 10:08:54
Domain names	esselunga.one

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Esselunga S.p.A.

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Organization	esselunga

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 « ESSELUNGA » trademarks, including the following:

Italian trademark ESSELUNGA (device) registration No.1290783, registered on May 27, 2010;

Italian trademark ESSELUNGA (device) registration No.1002680, registered on April 11, 2006;

European trademark ESSELUNGA (word) registration No. 013719745, registered on July 8, 2015.

The Complainant is also the owner of numerous domain names comprising the ESSELUNGA trademark, such as the domain name <esselunga.it> which is used for its official website.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:
The Complainant is an Italian retail store chain, founded in 1957 by Nelson Rockefeller, Bernardo, Guido and Claudio Caprotti, Marco Brunelli, the Crespi family and other Italian associates.
Currently Esselunga S.p.A. is the leading Italian company in the retail field, with over 8,3 billion EUR of total revenues and 185 sales

points.
Previous Panelists in other UDRP procedures have recognized the ESSELUNGA trademark as a trademark enjoying a reputation, i.e. a renowned trademark.
The disputed domain name <esselunga.one > was registered on April 23, 2024.
The disputed domain name is not currently redirected to an active page. However, it is configured with active MX records.

PARTIES CONTENTIONS

COMPLAINANT:
The Complainant contends that:
1. The disputed domain name is confusingly similar to the Complainant's trademark.
The Complainant contends that the disputed domain name is identical to its trademark "ESSELUNGA".
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 Complainant's rights in the ESSELUNGA trademark.
The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and that it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate. In this sense the Complainant quotes previous UDRP decisions affirming that the incorporation of a famous trademark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

The Complainant further contends that the disputed domain name, which is not currently redirected to an active page, is however set up with active MX records, indicating that it is used to send and receive e-mails and therefore indicating a high risk that it is registered for use in phishing activities.

Finally, the Complainant contends that the fact that the only visible element in the WhoIs entry for the disputed domain name is the name ESSELUNGA as the registrant organization, which is clearly false, is further evidence of bad faith registration.

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

A) Confusing similarity
The disputed domain name is identical to the Complainant's trademark, save for the ".one" Top-Level Domain ("TLD").
B) Lack of legitimate rights or interests
The disputed domain name is a distinctive, non-descriptive name. It is 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.

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, it appears that the Respondent, when registering the disputed domain name, provided false contact details, namely the name Esselunga as the registrant organisation.
Fourthly, the disputed domain name is not currently redirected to an active page. Nevertheless, MX records have been set up for the disputed domain name.

As stated in CKM Holdings Inc. v. Grant Chonko, Genesis Biosciences, WIPO Case No. D2022-0479: "A MX record is a resource record in the domain name system specifying which email server is responsible for accepting email on behalf of a domain name. It is not necessary to assign MX records to a domain name if the registrant does not intend to use the domain name to send and receive email. Activating the MX records to designate an email server and enable email is an action beyond mere registration of the Disputed Domain Name and may constitute bad faith use." It is not clear if the Respondent took this action, or it may be a Registrar default, but without the benefit of a Response, the Panel has no information from the Respondent to the contrary.

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. **esselunga.one**: Transferred

PANELLISTS

Name	**Fabrizio Bedarida**

DATE OF PANEL DECISION 2024-08-09

Publish the Decision