Decision for dispute CAC-UDRP-106679

Case number	CAC-UDRP-106679
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Domain names	esselungashop.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Esselunga S.p.A.

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Name	Abe Abe

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 holder of several trademarks including:

- Italian figurative mark “ESSELUNGA” registered under No. 1002680 registered on April 11, 2006, in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45;
- European Union word mark “ESSELUNGA” registered under No. 013719745 on July 8, 2015, in classes 1, 3, 5, 6, 8, 9, 16, 21, 24, 25, 28, 29, 30, 31, 32, 33 and 35.

FACTUAL BACKGROUND

The Complainant, Esselunga S.p.A., is an Italian retail store chain, founded in 1957.

The Complainant is the owner of several ESSELUNGA trademarks, including the European Union word mark “ESSELUNGA” registered under No. 013719745, on July 8, 2015, covering goods and services in classes 1, 3, 5, 6, 8, 9, 16, 21, 24, 25, 28, 29, 30, 31, 32, 33 and 35.

The Complainant also owns the domain name <esselunga.it>.

The disputed domain name has been registered on May 14, 2024. The disputed domain name currently resolves to an inaccessible website.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.
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 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. The Respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

1. Identity of confusing similarity

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant shows to be the holder of several registered ESSELUNGA trademarks, it is established that there is a trademark in which the Complainant has rights.

The disputed domain name incorporates the Complainant's ESSELUNGA trademark in its entirety, merely adding the term "shop". In the Panel's view, this addition does not prevent the Complainant's trademark from being recognizable within the disputed domain name (see section 1.8 WIPO Overview 3.0; IM PRODUCTION v. Xue Han, CAC Case No. 104877 <isabel-marantus.com>).

Additionally, it is well established that the Top-Level Domains ("TLDs") such as ".com" may be disregarded when considering whether the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (see section 1.11 WIPO Overview 3.0).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No rights or legitimate interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of production to the Respondent (although the burden of proof always remains on the Complainant) (see section 2.1 WIPO Overview 3.0 and Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455; Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is known as "Abe". The Respondent's use and registration of the disputed domain name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Fundamentally, a respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner. The correlation between a domain name and the complainant's mark is often central to this inquiry. Generally speaking, UDRP panels have found that where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 WIPO Overview 3.0). The disputed domain name incorporates the Complainant's ESSELUNGA trademark in its entirety, merely adding the term "shop". In the Panel's view, this combination may even increase the risk of confusion with the Complainant as "shop" will likely be linked with the Complainant's retail store business. Therefore, the Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant and cannot constitute fair use.

Beyond looking at the domain name and the nature of any additional terms appended to it, panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the WIPO Overview 3.0).

The Panel observes that the disputed domain name appears to be inactive, and neither the Respondent nor the facts of the case indicate any demonstrable preparations to a good faith use of the disputed domain name. The passive holding or non-use of domain names is, in appropriate circumstances, evidence of a lack of rights or legitimate interests in the domain names (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Facebook, Inc. v. Mirza Azim, WIPO Case No. D2016-0950; American Home Products Corporation v. Ben Malgioglio, WIPOCase No. D2000-1602; and Vestel Elektronik Sanayi ve Ticaret AS v. Mehmet Kahveci, WIPO Case No.D2000-1244).

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name. In light of the above, the Complainant succeeds on the second element of the Policy.

3. Bad faith

The Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (see section 4.2 WIPO Overview 3.0 and e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

According to the Panel, a respondent's awareness of a complainant and/or a complainant's trademark rights at the time of registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070).

In the instant case, the Panel finds that the Respondent must have had knowledge of the Complainant's rights in the ESSELUNGA trademark when it registered the disputed domain name, since the disputed domain name incorporates the Complainant's distinctive ESSELUNGA trademark in its entirety and only adds a term descriptive of the Complainant's business. Moreover, some of

the Complainant's ESSELUNGA marks have been registered more than 10 years before the disputed domain name.

The Panel observes that the Respondent is not presently using the disputed domain name. While panelists will look at the totality of the circumstances in each case, factors that have been considered

relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain names may be put (see section 3.3 WIPO Overview 3.0).

In the present case, the Panel is of the opinion that several of the above factors apply:

- the Panel finds that the Complainant's ESSELUNGA trademark is distinctive;

- the Respondent did not submit any response or provided any evidence of actual or contemplated good-faith use;

- given the confusing similarity with the Complainant's mark and the combination with the descriptive term "shop", the Panel finds it difficult to conceive any plausible legitimate future use of the disputed domain name by the Respondent.

The fact that the Respondent did not formally take part in the administrative proceedings serves as yet another indication of the Respondent's bad faith.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **esselungashop.com**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2024-08-16

Publish the Decision