Decision for dispute CAC-UDRP-106684

Case number	CAC-UDRP-106684
Time of filing	2024-07-11 09:33:02
Domain names	alimonti.com

Case administrator

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

Complainant

Organization	Alimonti S.r.l.

Complainant representative

Organization	Tonucci & Partners

Respondent

Organization	eWeb Development Inc.

Respondent representative

Organization	Muscocvitch Law Professional Corporation

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

Complainant states that it owns two figurative trademark registrations in Italy for marks that include the words ALIMONTI MILANO (Reg. No. 302015000053670; registered June 20, 2017) and ALIMONTI ADVANCE (Reg. No. 302023000147510; registered February 23, 2024). Complainant also states that it has “unregistered trademark rights to the Alimonti sign… [t]hrough more than 100 years or extensive and continuous use of the Alimonti trademark by the Complainant and its family.” These registrations and alleged “unregistered trademark rights” are referred to herein as the “ALIMONTI Trademark.”

FACTUAL BACKGROUND

Complainant states that "[t]he Alimonti family has been active in marble and natural stone business since 1903, operating in Romano di Lombardia, Bergamo, Italy, since its founding"; that "[t]he Alimonti family founded several companies all active in natural stone business and known for their high standard of workmanship: all companies operating in Bergamo area"; and that "[n]owadays Alimonti is an Italian design company recognized worldwide for the quality of workmanship and products."

A registration record from ICANN for the Disputed Domain Name provided by Complainant shows that the Disputed Domain Name was created on March 19, 2009, although Complainant states that the Disputed Domain Name "was [previously] owned by a company belonging to the Alimonti family, as evidenced by the photos downloaded from Web Back [sic] Machine".

Complainant states that the Disputed Domain Name "does not resolve to any web site," although a corresponding annex provided by Complainant shows a web page stating that the Disputed Domain Name is "REGISTERED FOR DEVELOPMENT" and also states: "This domain has been registered. If you're interested in this domain, contact us to check availability for customer use, ownership, or other development opportunities." The web page then offers "Domain Only" services, an "e-Inclusive Package" for "getting your new online business started" and "Other Services."

Respondent states that it is "a corporation located in Richmond, British Columbia, Canada, [that] is in the website development, website hosting, and branding business"; that it "lawfully registers non-infringing domain names and develops websites"; that it "registers domain names that are surnames, descriptive, unique and brand-able, acronyms, or are otherwise non- infringing"; that it "offers a service wherein a customer can either purchase a domain name by itself from Respondent, or the customer can alternatively purchase a website development package along with a domain name."

Respondent further states that it registered the Disputed Domain Name "because it saw the [Disputed] Domain Name as being generally attractive as an Italian-sounding surname that would be potentially attractive to any number of people who shared the Alimonti name and who wished to have a corresponding web presence"; that Respondent has registered other "Italian sounding surnames, such as Binatti.com, Bisanti.com, Lamenti.com, Miniutti.com, Proveti.com, and others"; that "[a]t no time had Respondent been aware of Complainant or its business and certainly did not register the [Disputed] Domain Name because of Complainant or its business," adding that "at the time of the [Disputed] Domain Name registration in 2010, Complainant didn't have any registered trademarks, let alone in Canada where Respondent is located[,] [n]or did Complainant have any significant reputation in Canada such that Respondent would have heard of it."

Respondent further states that "many people and businesses all over the world… share" the Alimonti name as a surname or as a business name. In support thereof, Respondent provides as annexes examples of people with the surname Alimonti on Facebook and LinkedIn; companies that use the Alimonti name in Brazil, Florida (USA) and Germany; "an Alimonti Law Offices and Mediation Services in New York"; as well as individuals who share the surname Alimonti on websites for a wide variety of industries, including writing, accounting, teaching, medicine, sports and more. "Even in Italy where Complainant is located, there are many Alimontis and Alimonti-named businesses that are not associated with Complainant company as shown in the Italian Business Register," Respondent states, adding that "[t]he Italian trademark registry additionally shows many Alimonti-formative trademarks that are unassociated with Complainant marble and stone business, such as Pasta Alimonti and Alimonti Tents" and that the WIPO Global Brand Database shows "many Alimonti formative trademarks belonging to third parties, such as in Brazil (ALIMONTI & Design for construction), PASTIFICO ALIMONTI & Design in Italy for pasta, and DR. ALIMONTI in the United States for wrinkle creams."

Respondent further states that it never "solicit[ed] Complainant" and instead "merely responded to Complainant's request for a quote based upon false pretenses" in which Complainant agreed to Respondent's terms, which include the following: "Neither You nor any Potential Buyer possesses or is claiming any right, title or interest in or to the Domain Name and neither you nor any Potential Buyer have any, or intend to commence any, claim, investigation or proceeding of any nature in law or in equity, by way of arbitration or before any court or other governmental authority that… challenges or contests eWeb's right, title or ownership in and to the Domain Name… [or] alleges bad faith registration or use, or that eWeb has no rights or legitimate interest in the Domain Name."

PARTIES CONTENTIONS

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant argues that it has rights in the ALIMONTI Trademark as a result of the two Italian registrations as well as the alleged "unregistered trademark rights" referred to above. Complainant further states that the Disputed Domain Name "is identical to the trademark 'Alimonti'" and "[t]he addition of .com is also without legal significance in determining identity, as it is a designation that every internet provider must use part of its internet address."

Paragraph 4(a)(ii): Complainant argues that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "it has not licensed or otherwise permitted the Respondent to use any of its unregistered trademark and/or trademark, nor has it licensed or otherwise permitted the Respondent to apply for or use any domain names incorporating any of those marks"; "[t]o the best of the Complainant's knowledge, the Complainant is unable to find any association with the Respondent and Alimonti"; "[w]ith more than 100 years of experience, the Complainant has not heard of any organization, activity, project nor product identified as Alimonti except for the Complainant's own initiative"; "the word 'ALIMONTI' is a family name and not a fancy word or contained in vocabularies [and]… [t]herefore, it is not a word that a trader would rightly choose unless seeking to create an impression to associate with the Complainant."

Paragraph 4(a)(iii): Complainant argues that the Disputed Domain Name was registered and is being used in bad faith because, inter

alia, “Complainant finds it highly unlikely that the Respondent was unaware of the Complainant’s rights by the time it registered the disputed domain name, given the fact Alimonti is not a dictionary word and is an Italian family name”; the Disputed Domain Name “does not resolve to any web site” and “satisfies the concept of ‘passive holding’”; “[i]t is clear that the domain name was registered primarily for the purpose of transferring the domain name registration to the owner of the trademark for valuable consideration in excess of the Respondent’s out-of-pocket costs directly related to the domain name” as “clearly demonstrated by the Respondent's large monetary claim…, taking into account that, starting 2009, the domain name is ‘for sale’,” as shown on a web page stating that the Disputed Domain Name could be purchased for $39,500 USD.

Respondent contends, in relevant part, as follows:

Paragraph 4(a)(i): Respondent argues that, inter alia, “it is arguable whether Complainant’s two respective figurative marks [registered in Italy] each of which contain additional words and images, give Complainant trademark rights in a mark which is identical or confusingly similar to Respondent’s [Disputed] Domain Name,” although “it is respectfully submitted that the case is better decided on the subsequent two parts of the three-part UDRP test.” Respondent further argues that “Complainant’s claim of common law trademark rights has not been adequately supported with evidence.”

Paragraph 4(a)(ii): Respondent states that it has rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, it was “the first person to register the Domain Name at a time when it was not subject to any demonstrated trademark rights held by Complainant”; “Respondent used the Domain Name as understood by the Policy, namely for Respondent’s web development and branding services and also for offering the Domain Name for sale with or without additional services,” which has been upheld in four previous decisions under the Policy, including Kevac S.r.l v. Eweb Development Inc., WIPO Case No. D2019-2991; Sanofi v. Domain Manager, eWeb Development Group, WIPO Case No. D2014-1185; and Ferm-O-Feed B.V. v. Domain Manager, eWeb Development Inc., WIPO Case No. D2018-1112.

Paragraph 4(a)(iii): Respondent states that the Disputed Domain Name was not registered and used in bad faith because, inter alia, “Respondent’s domain name registration precedes any proven trademark rights held by Complainant as aforesaid” and “[i]t is well-established that in general, a finding of bad faith registration cannot be made with respect to a trademark that did not exist at the time of registration of the disputed domain name”; Complainant “provides no evidence whatsoever of any reputation such that Respondent would have heard or even ought to have heard of Complainant”; Respondent “did not target Complainant and was not even aware of it”; “Respondent has provided a credible explanation of why it registered the [Disputed] Domain Name, consistent with its other comparable domain names and has demonstrated that it is in the business of supplying attractive surname, dictionary word, acronym, and made up words to new entrants to the marketplace who are looking for a web presence”; and “it has been established that the name, Alimonti is by no means exclusively or even predominantly associated with Complainant.”

Finally, Respondent asks the Panel to enter a finding that Complainant has engaged in Reverse Domain Name Hijacking because, inter alia, the Complainant lacks “any evidentiary basis for a finding that [Complainant] was targeted by Respondent’s [Disputed] Domain Name registration”; “Complainant failed to address the obvious fact that there were numerous other persons and entities who all share the Alimonti name and that Complainant had no exclusive right to it”; “Complainant made unsubstantiated allegations of ‘worldwide fame’”; “Complainant misrepresented its unregistered trademark rights by conflating third-party entities and prior third-party ownership of the Domain Name”; and “Complainant intentionally omitted the context for its receipt of a quote from [Respondent] and failed to address its breach of its representations and warranties to Respondent.”

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 UDRP).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not shown, to the satisfaction of the Panel, that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name (within the meaning of paragraph 4(a)(ii) of the UDRP).

BAD FAITH

The Complainant has not, to the satisfaction of the Panel, shown that the Disputed Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the UDRP).

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

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the two trademark registrations cited by Complainant for the ALIMONTI Trademark in Italy, it is apparent that Complainant has rights in and to the ALIMONTI Trademark. For purposes of this proceeding, the Panel makes no finding as to whether Complainant has established "unregistered" or common law rights in the ALIMONTI Trademark other than the two registrations.

As to whether the Disputed Domain Name is identical or confusingly similar to either or both of the Italian trademark registrations, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., "alimonti") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.11.1.

With respect to the fact that the two Italian trademark registrations contain design elements in addition to the word ALIMONTI – namely, MILANO and ADVANCE – section 1.10 of WIPO Overview 3.0 states: "Panel assessment of identity or confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. To the extent that design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element."

Notably, the first of the two words in each of the Italian trademark registrations is "ALIMONTI," and in one of the registrations, the word "ALIMONTI" is more dominant than the word "MILANO." As set forth in section 1.7 of WIPO Overview 3.0: "It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name…. While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Here, the Panel finds that the dominant feature of the textual components of the two Italian trademark registrations – namely, ALIMONTI – is clearly recognizable in the Disputed Domain Name. (And notably, Respondent has not made a substantive argument against confusing similarity.)

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

A respondent can demonstrate that it has rights or legitimate interests in a disputed domain name if it can prove that "before any notice to [respondent] of the dispute, [respondent has engaged in] use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services." Policy, paragraph 4(c)(i).

Complainant has not specifically addressed whether Respondent's use of the Disputed Domain Name is bona fide, as Complainant has stated that the Disputed Domain Name "does not resolve to any web site," although – as stated above – a corresponding annex provided by Complainant shows a web page stating that the Disputed Domain Name is "REGISTERED FOR DEVELOPMENT" and offers "Domain Only" services, an "e-Inclusive Package" for "getting your new online business started" and "Other Services." Respondent contends that this active web page demonstrates a bona fide use of the Disputed Domain Name – especially because the name ALIMONTI is widely used by many others worldwide, Respondent's website does not target Complainant, and Complainant has not established that the ALIMONTI Trademark is strong or widely known – just as panels have found in previous cases against Respondent. One of those previous panels, for example, wrote that "the evidence on record suggests that the Respondent's registration and use of the disputed domain name… is consistent with the Respondent's genuine offering of IT-related web development services" and "[t]here is nothing on record to suggest that the Respondent's business is in any way illegitimate." Kevac S.r.l v. Eweb Development Inc., WIPO Case No. D2019-2991 (<kevac.com>). See also WIPO Overview 3.0, section 2.1: "generally speaking, panels have accepted that aggregating and holding domain names (usually for resale) consisting of acronyms, dictionary words, or common phrases can be bona fide and is not per se illegitimate under the UDRP." Although "Alimonti" is not necessarily an acronym, dictionary word or common phrase, its status as a not uncommon surname fits within the same criteria.

Accordingly, the Panel finds that Respondent has established rights or legitimate interests in the Disputed Domain Name, and Complainant therefore has not satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration 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 registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the

registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

Complainant does not specifically cite any of the above paragraphs in its arguments for bad faith, although it appears to refer to paragraph 4(b)(i) given the offer from Respondent to sell the Disputed Domain Name for $39,500 USD. However, Respondent has provided context for this offer, indicating that the communication about a sale was initiated by Complainant. Further, there is no evidence that Respondent registered the Disputed Domain Name for the purpose of selling it "to the complainant." On the contrary, the Response states that "[a]t no time had Respondent been aware of Complainant or its business and certainly did not register the Domain Name because of Complainant or its business." While the Panel would have preferred this statement to be supported by a declaration from Respondent rather than simply as an apparent statement of Respondent's counsel (in a Response, the Panel further notes, that fails to include the certification required by paragraph 5(c)(viii) of the Rules), the statement is not incredible given the full facts of this proceeding.

Complainant further appears to rely on the passive holding doctrine, articulated in one of the earliest decisions under the Policy, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. That policy applies in cases of "non-use of a domain name (including a blank or 'coming soon' page)," WIPO Overview 3.0, section 3.3, which does not appear to be applicable here, given the active web page associated with the Disputed Domain Name advertising Respondent's services.

Therefore, the question is whether registration of a domain name containing what even the Complainant has called "a family name," in connection with services unassociated with and otherwise failing to target the Complainant and its trademark, by a respondent that engages in the practice of registering family names (including other Italian family names) for its domain name and website development business – a practice that has been upheld by multiple previous panels – constitutes bad faith. The Panel answers that question in the negative.

Accordingly, the Panel finds that Complainant has not proven the third element of the Policy.

Reverse Domain Name Hijacking

With respect to Respondent's request that the Panel enter a finding that Complainant has engaged in Reverse Domain Name Hijacking ("RDNH"), the Panel refers to paragraph 15(e) of the Rules, which states, "If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding." The Rules define Reverse Domain Name Hijacking as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name." Further, section 4.16 of WIPO Overview 3.0, states: "Reasons articulated by panels for finding RDNH include… facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the disputed domain name or readily available public sources such as the WhoIs database" and "unreasonably ignoring established Policy precedent notably as captured in this WIPO Overview – except in limited circumstances which prima facie justify advancing an alternative legal argument."

Here, Complainant admits the Alimonti name is "a family name"; a cursory web and/or trademark search would have identified numerous uses of the Alimonti name by those unassociated with Complainant; Complainant's own annex contradicts Complainant's argument that the Disputed Domain Name "does not resolve to any web site"; Complainant has provided no evidence that Respondent has targeted Complainant; Complainant provided incomplete details about Respondent's offer to sell the Disputed Domain Name; and a number of previous decisions under the Policy have denied transfers under similar circumstances. Furthermore, Complainant was represented by counsel, and section 4.16 of WIPO Overview 3.0 states: "Given the undertakings in paragraphs 3(b)(xiii) and (xiv) of the UDRP Rules, some panels have held that a represented complainant should be held to a higher standard." In light of all of these factors, the Panel finds that the Complainant has attempted to engage in RDNH.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **alimonti.com**: Remaining with the Respondent

PANELLISTS

Name	**Alan Limbury**
Name	**Gregor Kleinknecht LLM MCIArb**

Name	**Douglas Isenberg**

DATE OF PANEL DECISION 2024-09-02

Publish the Decision