Decision for dispute CAC-UDRP-106847

Case number	CAC-UDRP-106847
Time of filing	2024-09-20 12:17:45
Domain names	esselungansw.online, esselungansw.store

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Esselunga S.p.A.

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Name	Ba Long Tan

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 names.

IDENTIFICATION OF RIGHTS

The Complainant has demonstrated ownership of rights in the trademark ESSELUNGA for the purposes of standing to file a UDRP complaint.

The Complainant is the owner of trademark registrations for ESSELUNGA, including the following:

- Italian trademark registration No. 362020000034241 for ESSELUNGA (stylized mark), last renewal of the trademark originally filed on March 12, 1980, and registered on October 24, 1985, in classes 3, 6, 8, 9, 16, 21, 28, 29, 30, 31, 32, 33, 42;

- European Union trademark registration No. 013719745 for ESSELUNGA (word mark), filed on February 9, 2015, and registered 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 in the present dispute is ESSELUNGA S.P.A., 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 and currently leader in the retail field, with over 8,3 billion EUR of total revenues and 185 points of sales.

The Complainant is the owner of several domain names, including <esselunga.it>, registered on December 1, 1997 and used in connection with the Complainant's principal website, and <esselunga.eu>, registered on April 18, 2006.

The disputed domain names <esselungansw.online> and <esselungansw.store> were registered on July 31, 2024 and are not resolving to active websites.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain names <esselungansw.online> and <esselungansw.store> are confusingly similar to the trademark ESSELUNGA in which the Complainant has rights as they both reproduce the trademark in its entirety with the mere addition of the three letters "nsw" and the generic Top-Level Domains ("gTLDs") ".online" and ".store".

The Complainant also asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain names because: i) the Complainant has no relationship with the Respondent; ii) the Respondent has not received any approval from the Complainant to use its trademarks or register any domain names identical or confusingly similar to such marks; iii) there is no evidence that the Respondent acquired any rights in a trademark or trade name corresponding to the disputed domain names; and iv) employing a misspelling like in this case signals an intention on the part of the Respondent to confuse users seeking the Complainant.

The Complainant claims that the Respondent registered the disputed domain names in bad faith because, given the well-known character of the trademark ESSELUNGA and considering ESSELUNGA is a fanciful word, it is inconceivable that the Respondent was not well aware of the Complainant's trademark rights at the time of the registration of the disputed domain names. The Complainant further states that the Respondent's purpose in registering the disputed domain names was probably to capitalize on the reputation of the Complainant's trademark by diverting users seeking information about the Complainant's mark.

The Complainant asserts that the non-use of the disputed domain names does not prevent a finding of bad faith use considering the Complainant's trademark is distinctive and widely known and the Respondent has concealed its contact details in the Whois of the disputed domain names.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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. The Complainant has provided evidence of ownership of valid trademark registrations for ESSELUNGA.

The Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark ESSELUNGA as they both reproduce the trademark in its entirety with the mere addition of the three-letter term "nsw", which could stand for the geographical indicator "New South Wales" and is not sufficient to prevent a finding of confusing similarity.

As to the gTLDs ".online" and ".store", as established in a number of prior UDRP cases, they are viewed as a standard registration requirement and as such can be disregarded for the purpose of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy.

2. With reference to the Respondent's rights or legitimate interests in the disputed domain names, the Panel finds that the Complainant has made a prima facie case and that the Respondent, by not submitting a Response, has failed to provide any element from which a Respondent's right or legitimate interest in the disputed domain names could be inferred.

The Panel notes that, based on the records, the Complainant has not authorized the Respondent to register and use its trademark ESSELUNGA. Moreover, there is no evidence that the Respondent might be commonly known by the disputed domain names or a name corresponding to the disputed domain names.

As highlighted above, the disputed domain names have not been pointed to active websites. Prior Panels have found that the passive holding of a domain name does not constitute a legitimate non-commercial or fair use. Moreover, there is no evidence that the disputed domain names may have been previously used in connection with a bona fide offering of goods or services.

Therefore, the Panel finds that the Complainant has demonstrated that the Respondent has no rights or legitimate interests in respect of the disputed domain names according to paragraph 4(a)(i) of the Policy.

3. As to bad faith at the time of the registration, the Panel finds that, in light of the prior registration and use of the trademark ESSELUNGA in connection with the Complainant's products and services, including online via the website at "www.esselunga.it", and considering the distinctiveness of the Complainant's trademark ESSELUNGA, with which the disputed domain names are confusingly similar, the Respondent was likely aware of the Complainant's trademark when it registered the disputed domain names on July 31, 2024.

The disputed domain names have not been pointed to active websites. As established in a number of prior UDRP cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding. In the present case, considering i) the distinctiveness and well-known character of the Complainant's trademark ESSELUNGA, ii) the confusing similarity of the disputed domain names with the Complainant's mark; iii) the Respondent's failure to reply to the Complaint; and iv) the Respondent's concealing its identity in the Whois of the disputed domain name, the Panel finds that the passive holding of the disputed domain names does not prevent a filing of bad faith use.

Therefore, the Panel finds that the Complainant has also demonstrated that Respondent registered and is using the disputed domain names in bad faith according to paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **esselungansw.online**: Transferred
2. **esselungansw.store**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2024-11-04

Publish the Decision