Decision for dispute CAC-UDRP-107801

Case number	CAC-UDRP-107801
Time of filing	2025-07-31 13:49:42
Domain names	esselungait.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	Tony Yeap Ka Chun

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 claims to be the owner of numerous trademarks ESSELUNGA in various jurisdictions worldwide, including but not limited to the followings:

- Italian Registration No. 1290783, first filed on March 12, 1980, duly renewed, for classes 3, 6, 8, 9, 16, 21, 28, 29, 30, 31, 32, 33 and 42;
- Italian Registration No. 1002680, first filed on April 09, 2002, duly renewed, 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 and 45;
- European Union Registration No. 013719745, first filed on February 09, 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 by Nelson Rockefeller, Bernardo, Guido and Claudio Caprotti, Marco Brunelli, the Crespi family, and other Italian associates.

The Complainant is a prominent entity in the Italian retail sector, reporting total revenues exceeding €8.3 billion and operating 185 points of sale. In the current fiscal year, the Group's net revenue increased by 1.3%, reaching €9,447.8 million.

The Complainant holds ownership of several top-level and country-code top-level domain names containing the verbal element ESSELUNGA, including <esselunga.it> and <esselunga.eu>.

The primary website associated with the ESSELUNGA brand, through which its services and points of sale are promoted, is <esselunga.it>.

Additionally, the Complainant maintains a presence on major social media platforms, including dedicated channels on Facebook and Instagram, which are utilized for promotional and advertising activities.

Due to its extended use and considerable investment in promotion and advertising, the ESSELUNGA trademark is widely recognized. Previous panels in UDRP proceedings have acknowledged the ESSELUNGA trademark as possessing a notable reputation.

The Respondent appears to be an individual located in Penang, Malaysia.

The disputed domain name was registered on 28 April 2025.

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).

The Complainant claims rights in the ESSELUNGA mark through its trademark registrations. By virtue of its trademark registrations, the Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

The Complainant contends that the disputed domain name wholly incorporates the Complainant's trademark, differing solely by the addition of the letters "it," which may denote either a geographical reference to Italy or the country code ".it." Such addition may constitute a classic instance of typosquatting, particularly considering that esselunga.it constitutes the Complainant's principal website. The generic Top-Level Domain (gTLD) ".com" functions solely as an Internet technicality and does not preclude a finding of confusing similarity. Accordingly, the disputed domain name is confusingly similar to the Complainant's trademark.

Having conducted a side-by-side comparison, the Panel concurs with this assessment, consistent with paragraph 1.7 of the WIPO Jurisprudential Overview 3.0.

For the foregoing reasons, the Panel finds that the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of proof then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

The Complainant asserts that the Respondent is not an authorized dealer, agent, distributor, or retailer of ESSELUNGA, and has never been authorized to use the Complainant's trademarks in any way, including in a domain name. The Complainant is not aware of any evidence indicating that the Respondent is commonly known by the disputed domain name, as an individual, business, or organization. Given that ESSELUNGA is a fanciful term, it is likely that the disputed domain name was registered solely to mislead consumers, tarnish the Complainant's trademark, or block its use in a corresponding domain name. Since the disputed domain name entirely reproduces the Complainant's ESSELUNGA mark, it is difficult to see any legitimate interest the Respondent could claim.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. As a result, the burden of proof shifts to the Respondent to demonstrate such rights or interests.

However, the Respondent has failed to submit any response within the required timeframe to rebut these assertions.

For the foregoing reasons, the Panel finds that the Complainant has satisfied 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).

The Complainant reiterates that ESSELUNGA is a well-known trademark, and as a fanciful term, it is unlikely that the disputed domain name could be used for any purpose unrelated to the Complainant's activities. The misappropriation of a well-known trademark as domain name by itself constitutes bad faith registration for the purposes of the Policy.

The Complainant further claims that it is inconceivable that the Respondent was unaware of the Complainant's trademark rights at the time of registering the disputed domain name. The Respondent likely registered the disputed domain name to capitalize on the reputation of the ESSELUNGA trademark by diverting Internet users seeking information about the Complainant. Moreover, the disputed domain name was registered long after the Complainant's trademarks had been filed and registered. Moreover, previous UDRP panelists have held that the non-use of a domain name does not preclude a finding of bad faith under the doctrine of passive holding.

Having thoroughly considered the overall circumstances and in light of the Respondent's failure to submit an official response, the Panel is of the view that it is improbable that the Respondent's registration of the disputed domain name, which incorporates the Complainant's ESSELUNGA trademark, was coincidental. The Panel further observes that the disputed domain name was registered more than forty years subsequent to the Complainant's registration of the ESSELUNGA trademark in Italy. Additionally, the passive holding of the disputed domain name does not preclude a finding that its registration and use were made in bad faith.

For the foregoing reasons, the Panel finds that the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that the disputed domain name should be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **esselungait.com**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2025-09-03

Publish the Decision