

Decision for dispute CAC-UDRP-104838

Case number	CAC-UDRP-104838
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Time of filing	2022-09-30 11:40:51
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Domain names	esselungarho.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Esselunga S.p.A.
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Complainant representative

Organization	Mr. Claudio Tamburrino (Barzanò & Zanardo Milano S.p.A.)
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Respondent

Name	Wu Yu
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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 owns several ESSELUNGA trademarks including:

- European Union trademark registration number 13719745 for ESSELUNGA, registered on 8 July 2015 in classes 1, 3, 5, 6, 8, 9, 16, 21, 24, 25, 28, 29, 30, 31, 32, 33 and 35;
- Italian trademark registration number 1002680 for ESSELUNGA, registered on 11 April 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, and 45;
- Italian trademark registration number 1290783 for ESSELUNGA BIO, registered on 24 October 1985; and
- European Union trademark registration number 3370202 for ESSELUNGA BIO, registered on 5 May 2005 in classes 5, 29, 30, 31, 32 and 33.

FACTUAL BACKGROUND

The Complainant is a large Italian retail store chain, which was founded in 1957. The Complainant owns trademark registrations for ESSELUNGA that predate the registration of the disputed domain name. It also owns numerous domain names incorporating the word ESSELUNGA, such as <esselunga.it>, <esselunga.eu> and <esselunga.com>. The Complainant has a substantial on-line presence. Its principal website for the ESSELUNGA brand is www.esselunga.it.

The Respondent is based in China and registered the disputed domain name on 27 June 2022.

PARTIES CONTENTIONS

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 4 (a) of the Policy requires the Complainant to prove each of the following three elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The Complainant contends that the disputed domain name is confusingly similar to its trademark ESSELUNGA.

The disputed domain name incorporates the Complainant's trademark and adds to it the letters "rho". The Complainant asserts that "rho" is a geographic term and has submitted evidence to show that there is an Esselunga mall based in Rho, a municipality in the Milan administrative district.

The dominant feature of the disputed domain name is the Complainant's trademark ESSELUNGA, which is clearly distinguishable in the disputed domain name. In a side-by-side comparison, the only difference between the disputed domain name and the Complainant's trademark is the addition of the term "rho", which could be taken to mean Rho in Italy, where the Complainant has a shopping mall.

The Panel finds that the dispute domain name is confusingly similar to the Complainant's trademark ESSELUNGA and that the requirements of paragraph 4(a)(i) of the Policy have been met.

NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent has no rights or legitimate interest in the disputed domain name. The Complainant states that the Respondent is not an authorised dealer, agent, distributor, wholesaler or retailer of ESSELUNGA, and that it has never

authorised any third party to include its well-known trademarks in the disputed domain name, nor to make any other use of its trademarks. The Complainant also asserts that there is no evidence tending to demonstrate that the Respondent is commonly known by the disputed domain name. It refers to Pharmacia & Upjohn Company v. Moreonline, WIPO Case No. D2000-0134, in which the panel found that “the mere registration, or earlier registration, does not establish rights or legitimate interests in the disputed domain name”.

The Panel finds that the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interest in the disputed domain name. The burden of proof now shifts to the Respondent to show that he has relevant rights or legitimate interest.

The Respondent has not filed a Response and there is no evidence to show that the Respondent has any rights or a legitimate interest in the disputed domain name. The Respondent is not identified in the Whois database as the disputed domain name, and there is nothing to show that he is commonly known by the disputed domain name. The Respondent is not authorised to use the Complainant’s trademark or include it in the disputed domain name. The disputed domain name diverts to a website with sponsored links unconnected with the Complainant. There appears no reason for the Respondent to include such links other than to attempt to attract internet users to its website by creating a likelihood of confusion with the Complainant and its mark.

Having considered the above factors, the Panel concludes that the Respondent has no rights or legitimate interest in the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been met.

REGISTERED AND BEING USED IN BAD FAITH

The Complainant submits that the disputed domain name has been registered and is being used in bad faith and asserts that:

- i. registration of the disputed domain name was not authorised by Complainant and the misappropriation of a well-known trademark as a domain name by itself constitutes bad faith registration for the purposes of the Policy (Volvo Trademark Holding AB v. Unasi, Inc., WIPO Case No. D2005-0556);
- ii. ESSELUNGA is a fanciful word, which strengthens the assumption that the disputed domain name was registered for the sole purpose of misleading potential consumers, to tarnish the Complainant’s trademark and to prevent the Complainant from reflecting its trademark in a corresponding domain name;
- iii. the disputed domain name is currently redirected to different websites, dedicated to third parties services, with pop up advertising prima facie linked to scam attempts; and
- iv. the domain name holder has set up the disputed domain name with active MX records.

The Complainant’s trademark ESSELUNGA pre-dates the registration of the disputed domain name. The Respondent has used a privacy service to register the disputed domain name that is confusingly similar to the Complainant’s trademark ESSELUNGA. It seems implausible that Respondent was not aware of Complainant’s trademark when he registered the disputed domain name. The most likely reason for registering it was to capitalise on the reputation of Complainant’s trademark by diverting Internet users by creating a likelihood of confusion with the Complainant’s mark.

There appears no reason for the Respondent to incorporate the Complainant’s distinctive trademark in the disputed domain name, and combine it with the term “rho”, which could mean Rho in Italy where the Complainant has a retail outlet, other than to create a likelihood of confusion with the Complainant and its mark.

The disputed domain name has been set up with active MX records, which shows that it is, or will be used to send and receive emails. The disputed domain name redirects to a website with links to third parties’ services and possible scam attempts. This points to bad faith use of the disputed domain name by the Respondent.

Considering all these factors, the Panel concludes that the disputed domain name was both registered and is being used in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **esselungarho.com**: Transferred

PANELLISTS

Name	Veronica Bailey
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DATE OF PANEL DECISION	2022-11-08
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