Decision for dispute CAC-UDRP-104036

Case number	**CAC-UDRP-104036**
Time of filing	**2022-02-16 09:17:02**
Domain names	**esselunga.life, esselunga.vip**

Case administrator

Name	**Iveta Špiclová (Case admin)**

Complainant

Organization	**Esselunga S.p.A.**

Complainant representative

Organization	**Andrea Mascetti (Barzanò & Zanardo Milano S.p.A.)**

Respondent

Organization	**bei jing ao cha sheng wu ke ji you xian gong si**

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 is an Italian retail store chain founded in 1957 and is the owner of the ESSELUNGA trademark including but not limited to the followings:

-"ESSELUNGA" (device) 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, 42;
-"ESSELUNGA" (device) Italian Registration No. 1480754, first filed on April 9, 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, 45; and
-"ESSELUNGA BIO" European Union Registration No. 3370202, first filed on September 25, 2003, and duly renewed, in classes 5, 29, 30, 31, 32, 33.

Furthermore, the Complainant also owns several top-level and country code top-level domain names, constituted by the verbal element <ESSELUNGA> including <esselunga.it> and <esselunga.eu>.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

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. Currently Esselunga S.p.A. is the Italian leader in the retail field, with total revenues amounting to 7,8 billion and more than 150 point of sales.

Complainant's principal website regarding the ESSELUNGA brand, where its services and points of sales are advertised, is constituted by www.esselunga.it.

The Complainant is also widely promoted on most popular social media with channels and pages specifically dedicated to it, i.e. on Facebook (https://www.facebook.com) and Instagram (https://www.instagram.com) used also for promotional and advertising purposes.

The Registration Date of the both disputed domain names is December 21, 2021.

PARTIES' CONTENTIONS:

COMPLAINANT:

Due to its longstanding use, and the huge promotional and advertising investments, the ESSELUNGA trademark is certainly well-known. Previous Panelists in other UDRP procedures have recognized ESSELUNGA trademark as a trademark enjoying reputation (e.g., Esselunga S.p.A. v. Carla Giorgi, Case n. D2017-2107: "E' indubbio che il marchio della Ricorrente, grazie alla sua capillare presenza sul territorio italiano in particolare del centro nord, è un marchio rinomato", i.e. in English: "It is clear that the Complainant's trademark, through its widespread presence in Italy and, in particular, in the North-Central Italian regions, is a renowned trademark" and Esselunga S.P.A. v. Wang Lian Feng Case No. D2018-0967: "The Complainant's retail store has been in operation since 1957 while its trade mark ESSELUNGA has been registered in Italy since 1980. Being a fanciful term, "esselunga" is indeed distinctive. The Complainant has submitted evidence to show that it enjoys an active online presence. In this day and age of the Internet and advancement in information technology, the reputation of brands and trade marks transcends national borders. As such, a cursory Internet search would have disclosed the ESSELUNGA trade mark and its use by the Complainant. As such, a presumption arises that that the Respondent was aware of the Complainant and its trade marks when it registered the disputed domain name, particularly given that the disputed domain name is identical to the Complainant's mark. Registration of a domain name that incorporates a complainant's well-known trade mark suggests opportunistic bad faith").

RESPONDENT:

1.Esselunga means as for us : "Esse" means "Being/Exist" "Lunga" means "long/continue";
We combine this words and wanna express " keep your life" meaning
It happens to have the same name as the Italian popular supermarket name coincidentally.

2.When we registered the domain name, the website did not remind us of the legal information that would be involved.

3.Of course we respect esselunga's complaint, and we will stop the use and registration of the domain name and delete it as soon as possible.

For the reasons outlined in the Principal Reasons for the Decision below, the Panel does not make a formal finding regarding paragraph 4(a)(ii) of the Policy.

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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.

PRELIMINARY FINDINGS - LANGUAGE OF PROCEEDING:

The Panel notes that the language of the Registration Agreement is Chinese as confirmed by the Registrar, Alibaba Cloud. Both the official Complaint and Response were submitted in English. Pursuant to paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requests to use English as the language of proceeding, with the arguments that the disputed domain names are composed of Latin script and it would be disproportionate to require the Complainant to submit the Complaint in Chinese, as this would result in additional expense and unnecessary delay for the Complainants for translation. The Respondent has not declined to use English as the language of proceeding of the current case.

The Panel is bilingual and is well equipped to deal with the proceeding in both Chinese and English. Having considered the circumstances, Panel believes that it would be fair to both parties to use English as the language of proceeding and it can also uphold the principle of UDRP being a swift dispute resolution process. On this basis, the Panel determines that the language requirement has been satisfied through the English language Complaint and Response, and decides that the language of proceeding to be English.

PRINCIPAL REASONS FOR THE DECISION

The Respondent has confirmed on the Response that it is willing to give up the ownership of the disputed domain names by ceasing to use and deleting both of them. However, the Panel note that the disputed domain names are currently being locked by the registrar due to the current UDRP proceeding so they cannot be deleted by the Respondent.

Considering the principle of UDRP being a swift dispute resolution process, the Panel decides exercise its discretion under paragraph 10 of the Rules to order the transfer of the disputed domain names base on Respondent's unilateral and unambiguous consent and without a detailed review of the 3 elements under paragraph 4(a) of the Policy, see AMUNDI ASSET MANAGEMENT vs. elliott arkin, 103112 (CAC 2020-07-29) and paragraph 4.13 of the WIPO Overview 3.0.

For the foregoing reasons, the disputed domain names shall 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. **ESSELUNGA.LIFE**: Transferred
2. **ESSELUNGA.VIP**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION	2022-03-18

Publish the Decision