

## **ADMINISTRATIVE PANEL DECISION**

Esselunga S.P.A. v. Liliana Beretta

Case No. D2022-2744

### **1. The Parties**

The Complainant is Esselunga S.P.A., Italy, represented by Barzanò & Zanardo Milano SpA, Italy.

The Respondent is Liliana Beretta, Italy.

### **2. The Domain Name and Registrar**

The disputed domain name <metaversoesselunga.com> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 26, 2022. On July 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 27, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center received an informal communication from the Respondent from a third party email on August 8, 2022. The Center sent a communication to the third-party email on August 11, 2022, asking to confirm whether this third-party email address was owned by the Respondent. The Respondent did not respond to the Center’s communication.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 25, 2022. The Respondent did not submit a formal response. However, the Center received an informal communication, apparently from the Respondent, on August 8, 2022. Accordingly, the Center notified the Respondent’s default on September 9, 2022.

The Center appointed Andrea Mondini as the sole panelist in this matter on September 29, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is a major Italian retail store founded in 1957 with over EUR 8.3 billion of total revenues and more than 150 points of sale throughout Italy.

The Complainant owns several trademarks with the element ESSELUNGA, *inter alia*, the Italian trademark registration No. 1290783 first registered on October 24, 1985 and duly renewed on May 5, 2020, and the European Union Trade Mark registration ESSELUNGA No. 013719745 registered on July 8, 2015. Both trademarks are registered in numerous Classes.

The Complainant also holds several domain names, including the domain names <esselunga.it> and <esselunga.eu>.

The disputed domain name was registered on December 8, 2021.

The disputed domain name resolves to an inactive site.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends as follows:

Due to its longstanding use, its significant advertising and its widespread network of stores, the trademark ESSELUNGA is well known in Italy.

The disputed domain name is confusingly similar to the ESSELUNGA trademark in which the Complainant has rights, because it incorporates this trademark in its entirety, and the addition of the term "metaverso" does not prevent a finding of confusing similarity.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The mark ESSELUNGA is associated with the Complainant, since the trademark ESSELUNGA has been extensively used to identify the Complainant and its services in Italy. The Respondent has not been authorized by the Complainant to use this trademark and there is no evidence of the Respondent's use, or demonstrable preparation to use, the disputed domain name in connection with a *bona fide* offering of goods and services.

The disputed domain name was registered and is being used in bad faith because it is obvious that the Respondent had knowledge of both the Complainant and its well-known trademark ESSELUNGA at the time it registered the disputed domain name, and because the lack of use of a domain name that coincides with a well-known trademark owned by someone else constitutes use in bad faith. Moreover, the Respondent failed to respond to a cease and desist letter sent by the Complainant.

##### **B. Respondent**

The Respondent did not formally reply to the Complainant's contentions. However, on August 8, 2022, the Center received an informal communication, apparently from the Respondent, stating in essence "I am happy to inform you that the website metaversoesselunga.com is no longer mine. I filed for cancellation on July 11 2022".

#### **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

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

#### **A. Identical or Confusingly Similar**

The Panel is satisfied that the Complainant owns trademark registrations for its ESSELUNGA trademark.

The Panel notes that the disputed domain name incorporates the ESSELUNGA trademark in its entirety. The addition of the term “metaverso” does not prevent a finding of confusing similarity under Policy, paragraph 4(a)(i). See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant’s mark ESSELUNGA.

The first element of paragraph 4(a) of the Policy has been met.

#### **B. Rights or Legitimate Interests**

The Complainant states it has not authorized the Respondent to use the trademark ESSELUNGA and that before notice of the dispute, there is no evidence of the Respondent’s use, or demonstrable preparation to use, the disputed domain name. The Panel does not see any contrary evidence from the record.

In the view of the Panel, the Complainant has succeeded in raising a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. For its part, the Respondent failed to provide any explanations as to any rights or legitimate interests. Therefore, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name.

Furthermore, the nature of the disputed domain name, comprising the Complainant’s trademark and the term “metaverso” (which means “metaverse” in Italian), carries a risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.1.

The second element of paragraph 4(a) of the Policy has been met.

#### **C. Registered and Used in Bad Faith**

The Complainant has shown to the satisfaction of the Panel that its ESSELUNGA trademark is well-known in Italy.

In the view of the Panel, it is inconceivable that the Respondent could have registered the disputed domain name without knowledge of the Complainant’s well-known trademark. In the circumstances of this case, this is evidence of registration in bad faith.

The disputed domain name resolves to an inactive site. However, the Respondent’s passive holding of the disputed domain name qualifies as use in bad faith in this case (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)). In this regard, the Panel notes the reputation of the Complainant’s trademark, the Respondent’s failure to respond to the Complainant’s cease and desist letter and the Respondent’s failure to submit a response or provide any evidence of actual or contemplated good-faith use. Furthermore, it is inconceivable that the Respondent could make any good faith use of the disputed domain name.

The Panel thus finds that the disputed domain name was registered and is being used in bad faith.

The third element of paragraph 4(a) of the Policy has been met.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <metaversoesselunga.com> be transferred to the Complainant.

*/Andrea Mondini/*

**Andrea Mondini**

Sole Panelist

Date: October 11, 2022