

ADMINISTRATIVE PANEL DECISION

Sammontana S.p.A v. Domain Sales - (Expired domain caught by auction winner) c/o Dynadot
Case No. D2023-0502

1. The Parties

The Complainant is Sammontana S.p.A, Italy, represented by Porta & Consulenti Associati S.p.A., Italy.

The Respondent is Domain Sales - (Expired domain caught by auction winner) c/o Dynadot, United States of America.

2. The Domain Name and Registrar

The disputed domain name <tremarieanticamarca.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 2, 2023. On February 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 10, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 13, 2023.

The Center verified that the Complaint together with the amended 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 February 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 10, 2023.

The Center appointed John Swinson as the sole panelist in this matter on March 21, 2023. 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 an Italian company. The Complaint did not provide much information about its business. The Complainant sells pastries and sweet foods.

According to the Complainant's website, in 1896 the "Tre Marie" pastry shop opened in Milan.

The Complainant owns a registered trademark for TRE MARIE being European Trademark No. 007056765 that was filed on July 10, 2008 and registered on January 18, 2011. The Complainant owns other trademark registrations, including for a device mark that has three women (who are dressed in traditional or religious cloths) looking at or holding a cake and that includes the words TRE MARIE.

On September 19, 2022, the Complainant filed a European trademark application for a logo that includes three women and a cake and the words TRE MARIE ANTICA MARCA. This application registered as Registration No. 018763293. The words "Antica Marca" translate into English as "ancient mark" or "ancient brand".

The disputed domain name was also registered on September 19, 2022.

The disputed domain name redirects to the Dan.com domain name resale website that lists the disputed domain name for sale for USD 4,995.

The Respondent did not file a Response.

5. Parties' Contentions

A. Complainant

In summary, the Complainant made the following submissions:

The disputed domain name is confusingly similar to the Complainant's TRE MARIE trademark. TRE MARIE is famous in Italy for sweets and ice creams.

The disputed domain name was registered on the same day that the Complainant filed for a trademark registration for TRE MARIE ANTICA MARCA. This is an original and historic trademark of the Complainant.

No other person can have a legitimate interest in the combination TRE MARIE ANTICA MARCA, because only the Complainant can describe TRE MARIE as an "old brand".

The Respondent does not have legitimate prior use of TRE MARIE ANTICA MARCA, does not use it for pastry and sweet food, or for any other product or service.

The disputed domain name is listed for sale for USD 4,995, which means that it is not being used by the Respondent. This also demonstrates bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (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 respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The *onus* of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

Identity of Respondent

The Panel cites with agreement the discussion in: *Akiem Holding v. Domain Sales - (Expired domain caught by auction winner) c/o Dynadot*, WIPO Case No. [D2023-0188](#):

"In this case the Respondent, whose details have been verified by the Registrar, appears to be some form of a privacy or proxy service that may be operated by the Registrar. Typically, when a registrar timely discloses the identity of the underlying registrant or "beneficial holder" of a disputed domain name, the panel may find that only that underlying registrant, and not the registrar, should properly be regarded as the respondent in the proceeding (see e.g. section 4.4.5. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

In this regard, as the panel in *NETANY S.A. v. Domain Sales - (Expired domain caught by auction winner) c/o Dynadot*, WIPO Case No. [D2022-5029](#) stated "It is not clear who exactly is the registrant of the Domain Name, but the Respondent name suggests that at some point it was acquired via an auction conducted by the Registrar following the Domain Name's expiry. However, to what extent this statement is consistent with a creation date of May 6, 2022 is also unclear." Similarly, the Panel notes in this proceeding that the creation date as per the Registrar's public Whois is August 5, 2022, which casts some doubt on the possibility of the disputed domain name having been registered further to an auction after expiration, as the provided registrant's name appears to suggest.

In this case also, the Registrar has not disclosed any underlying or beneficial registrant of the disputed domain name and "Domain Sales - (Expired domain caught by auction winner) c/o Dynadot" therefore remains the Respondent in the proceeding. In the view of the Panel, this approach on the part of the Registrar would fall (similarly) under the scenario of not disclosing an underlying registrant behind a privacy or proxy service. If so, such conduct has potential consequences, particularly in circumstances where, as further discussed below, adverse findings have previously been made against the Respondent and other privacy or proxy services apparently operated by the Registrar. However, the Panel cannot dismiss the possibility of the actual registrant providing the name "Domain Sales - (Expired domain caught by auction winner) c/o Dynadot" at the time of the registration of the disputed domain name."

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

As set out in Section 4 above, the Complainant has a registered trademarks for TRE MARIE (word mark) and TRE MARIE ANTICA MARCA (device mark).

Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation, disregarding the Top-Level Domain part of the domain name (e.g., disregarding the “.com” part of the domain name.)

Here, the disputed domain name includes the TRE MARIE registered trademark in its entirety.

Additionally, the disputed domain name is identical to the words in the TRE MARIE ANTICA MARCA device trademark registration.

The Complainant succeeds on the first element of the Policy.

B. Rights or Legitimate Interests

As stated in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), “while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production of evidence on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element”.

The Complainant’s allegations to support the Respondent’s lack of rights to or legitimate interests in the disputed domain name are set out in Section 5A above.

There is no evidence that the Respondent is commonly known by the disputed domain name. The disputed domain name was registered well after the Complainant established its trademark rights in TRE MARIE.

Offering a domain name for sale – while certainly not prohibited – does not, of itself, constitute a legitimate interest under the second element of the Policy. *Khadi & Village Industries Commission v. Michael F Mann, Domain Asset Holdings, LLC*, WIPO Case No. [D2021-3242](#); *So Bold Limited v. TechOps, VirtualPoint Inc.*, WIPO Case No. [D2022-1100](#).

Having regard to all these matters, the Panel finds that the *prima facie* case established by the Complainant has not been rebutted by the Respondent and the Complainant succeeds on the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith.

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed

domain name to take advantage of its significance as a trademark owned by the complainant. *Fifth Street Capital LLC v. Fluder (aka Pierre Olivier Fluder)*, WIPO Case No. [D2014-1747](#).

The Complainant asserts that the TRE MARIE trademark is famous. The Complainant's website discusses the history of this trademark, going back hundreds of years. The Complainant's trademark describes itself as an "ancient mark".

The disputed domain name includes the Complainant's TRE MARIE ANTICA MARCA trademark in its entirety. This is a unique expression, and it would be highly unlikely for a person to register a domain name with this term unless that person had knowledge of the Complainant. The fact that the disputed domain name was registered on the same day that the Complainant filed its TRE MARIE ANTICA MARCA trademark application also raises suspicion.

The TRE MARIE ANTICA MARCA trademark is sufficiently distinctive and well-known such that, noting that the disputed domain name is identical to the TRE MARIE ANTICA MARCA trademark apart from generic Top-Level Domain, without further information from the Respondent it is difficult to conceive of any use that the Respondent might make of the disputed domain name without the Complainant's consent that would not involve bad faith. This is particularly the case because any new use of TRE MARIE ANTICA MARCA would be inherently misleading, as the domain name itself states that TRE MARIE is an ancient mark, thus referencing the Complainant's well-known TRE MARIE trademark, and the new use would not be "antica". Compare *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#). See also *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#) ("[The disputed domain name] is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith.")

The disputed domain name is listed for sale. In the present case, the obvious buyer is the Complainant or a person wishing to trade off the Complainant's reputation. This is also suggestive of bad faith.

The Panel finds that the Respondent registered and used the disputed domain name in bad faith.

The Complainant succeeds on the third element of the Policy.

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 <tremarieanticamarca.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: April 4, 2023