

ADMINISTRATIVE PANEL DECISION

Esselunga S.P.A. v. Giuseppe Volpicelli

Case No. DME2023-0001

1. The Parties

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

The Respondent is Giuseppe Volpicelli, Italy.

2. The Domain Name and Registrar

The disputed domain name <esselunga.me> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 24, 2023. On January 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 25, 2023, 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 (GDPR masked) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 3, 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 3, 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 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 9, 2023.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on March 15, 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, Esselunga S.p.A. is an Italian retail store chain, founded in 1957.

The Complainant is one of the leading Italian supermarket chain, with total revenues amounting to EUR 6.8 billion and more than 150 sales points. Esselunga S.p.A. is also active through its online website (“www.esselunga.it”).

The strength and renown of the Complainant’s ESSELUNGA trademark has already been recognized by previous UDRP panels.

The Complainant has proven to be the owner of the ESSELUNGA trademarks.

The Complainant is, *inter alia*, the owner of:

Italian trademark ESSELUNGA (device) No. 1290783, registered on October 24, 1985;

European Union Trade Mark ESSELUNGA BIO (device) No. 3370202 registered on May 4, 2005.

In addition, the Complainant is also the owner of several generic Top-Level domains (“gTLD”) and country code Top-Level domain names (“ccTLD”), constituted by the verbal element “esselunga”, including <esselunga.it> and <esselunga.eu>.

The Complainant is also active through the main social media networks, including Facebook (“https://www.facebook.com/Esselunga”).

The disputed domain name <esselunga.me> was registered on October 12, 2022.

At the moment of drafting this Decision, the disputed domain name resolves to a webpage, which contains only the following message: “Hello World! Welcome to WordPress. This is your first post. Edit or delete it, then start writing!”

Previously (January 23, 2023), the Complainant submitted evidence that the disputed domain name resolved to a webpage containing the ESSELUNGA trademark and purportedly offering for sale supermarket products and displaying a message in Italian, reading as follows in translation: “Supermarkets Italiani s.p.a. is founded and the first Esselunga supermarket is inaugurated in Viale Regina Giovanna in Milan ... omissis...”

In addition, it appears that the webpage connected to the domain name <esselunga.me> promoting an activity under the name “the organic store”, and that the website <ourstore.com> is active in the fashion field.

5. Parties’ Contentions

A. Complainant

The Complainant claims that the disputed domain name is confusingly similar to the Complainant’s registered trademarks; that the Respondent has no rights or legitimate interests whatsoever with respect to the disputed domain name; and that the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to obtain a transfer of the disputed domain name, paragraphs 4(a)(i) – (iii) of the Policy require that the Complainant must demonstrate to the Panel that:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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 Complainant has established rights in the ESSELUNGA trademark.

The disputed domain name is identical to the Complainant's ESSELUNGA trademark, the only difference being the ccTLD ".me", which is a technical requirement.

Therefore, the Panel finds the disputed domain name to be identical to the ESSELUNGA trademark in which the Complainant has rights.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

This Panel finds that the Complainant has made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent does not appear to be commonly known by the name "Esselunga" or by any similar name. The Respondent has no connection or affiliation with the Complainant, and the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademarks. The Respondent does not appear to make any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods or services. In fact, it appears from the documents available that the disputed domain name currently resolves to a webpage which solely contains the following message: "Hello World! Welcome to WordPress. This is your first post. Edit or delete it, then start writing!" Previously (at least on January 23, 2023) the disputed domain name resolved to a webpage containing the ESSELUNGA trademark, purportedly offering products in the Complainant's sector, and references to the Complainant's business. Finally, the Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name.

UDRP panels have moreover found that domain names identical to a complainant's trademark carry a high risk of implied affiliation – which is the case here.

The Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel, on the basis of the evidence presented, accepts and agrees with the Complainant's contentions that the disputed domain name was registered and has been used in bad faith.

The ESSELUNGA trademark has been registered and used for several decades, in Italy it enjoys a widespread reputation and high degree of recognition as a result of its fame and renown and thus the ESSELUNGA mark is not one that the Respondent would have registered other than for the purpose of creating the impression of an association with the Complainant. This is particularly supported in this case where the Respondent appears to be an Italian residing in Italy where the Complainant's trademark is more

than renowned.

In fact, it is evident from the content previously displayed on the Respondent's website (*i.e.*, displaying the ESSELUNGA trademark and references to the Complainant's business), that the Respondent knew of the Complainant's ESSELUNGA trademark when registering the disputed domain name.

Consequently, the Panel finds that the Respondent knew of the Complainant's marks and intentionally intended to create an association with the Complainant and its business at the time of registration of the disputed domain name.

Further inference of bad faith registration and use of the disputed domain name is given by the fact that the Respondent has not denied the assertions of bad faith made by the Complainant in this proceeding, so it is therefore reasonable to assume that if the Respondent had legitimate purposes for registering and using the disputed domain name, it would have responded to these assertions.

In addition, the Panel finds that the Respondent's use of the Complainant's trademark, in the disputed domain name and on the corresponding website, to attract users to promote "the Organic store" and redirect those users to the website "www.ourstore.com", amounts to bad faith use.

The Panel finds that the Respondent has acted in bad faith by registering and using the disputed domain name, seeking to attract Internet users by creating a likelihood of confusion with the Complainant's ESSELUNGA marks.

Therefore the Panel finds that this use constitutes a disruption of the Complainant's business and qualifies as bad faith registration and use under the Policy.

Accordingly, the Panel finds, on the basis of the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith.

Therefore, the Complainant has satisfied paragraph 4(a)(iii) 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, <esselunga.me> be transferred to the Complainant.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: March 29, 2023