

ADMINISTRATIVE PANEL DECISION

Effe 2005 Gruppo Feltrinelli S.p.A. v. Chiara D'Amato
Case No. D2022-2298

1. The Parties

The Complainant is Effe 2005 Gruppo Feltrinelli S.p.A., Italy, represented by Barzanò & Zanardo Milano SpA, Italy.

The Respondent is Chiara D'Amato, Italy.

2. The Domain Name and Registrar

The disputed domain name <feltrinelli.shop> is registered with eNom, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 24, 2022. On June 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 27, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 28, 2022 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 July 1, 2022.

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 July 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 27, 2022. The Respondent did not submit any response. The Respondent sent an email communication to the Center on July 7, 2022. The Center sent an email to the Parties on July 8, 2022, asking whether they wished to explore settlement discussions. The Complainant requested the suspension of the proceeding in order to explore settlement options with the Respondent. The Center notified to the Parties that the proceeding was suspended as of July 8, 2022. On July 25, 2022, the

Complainant sent an email communication to the Center requesting for reinstatement of the proceeding. The Center notified the Parties that the proceeding was reinstated as of July 29, 2022, and the Response due date was August 17, 2022. The Respondent has not filed a formal Response. Accordingly, the Center notified the commencement of panel appointment process on August 18, 2022.

The Center appointed Andrea Mondini as the sole panelist in this matter on August 23, 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 belongs to a leading Italian publishing and media group founded approximately 70 years ago by Giangiacomo Feltrinelli. With 118 points of sale, the Complainant is today the second largest Italian bookstore chain.

The Complainant owns numerous trademarks for the word mark FELTRINELLI, *inter alia*, the Italian trademark registration no. 362016000017622 filed on January 16, 1986 and registered on July 8, 1986 in classes 16 and 41 and the International Registration no. 505450 registered on September 22, 1986, designating ten European countries.

The Complainant also holds several domain names, including the domain name <feltrinelli.com> and <lafeltrinelli.it>.

The disputed domain name was registered on April 29, 2022.

The disputed domain name originally resolved to a web page reproducing the FELTRINELLI trademark and the web design of <lafeltrinelli.it>. Upon receipt of the Complainant's warning letter, the disputed domain name was redirected to a parking page.

5. Parties' Contentions

A. Complainant

The Complainant contends as follows:

The disputed domain name is identical to the FELTRINELLI trademark in which the Complainant has rights, because it incorporates this trademark in its entirety, and the addition of the generic Top-Level domain ("gTLD") ".shop" is not sufficient to avoid confusing similarity.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The mark FELTRINELLI is associated with the Complainant, since this trademark has been extensively used for decades to identify the Complainant and its publications and bookstores 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 before any notice of this dispute.

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 FELTRINELLI at the time it registered the disputed domain name, since the disputed domain name was initially resolving to a website featuring the FELTRINELLI trademark without any disclaimer of non-affiliation. Moreover, the fact that the Respondent initially posted a website under the disputed domain name reproducing the FELTRINELLI trademark and the web design of <lafeltrinelli.it> constitutes use in bad faith. Also, the fact that the disputed

domain name now resolves to a parking page does not *per se* prevent a finding of bad faith because lack of use of a domain name that coincides with a well-known trademark owned by someone else constitutes use in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions. On July 7, 2022, the Center received the following message: "Sorry but we are not interested in the domain feltrinelly.shop but we would like to keep our anonymity."

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 FELTRINELLI trademark.

The Panel notes that the disputed domain name incorporates the FELTRINELLI trademark in its entirety. The addition of the gTLD ".shop" 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 1.11.

For these reasons, the Panel concludes that the disputed domain name is identical or at least confusingly similar to the Complainant's mark FELTRINELLI.

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 FELTRINELLI 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 "shop", carries a risk of implied affiliation, particularly considering that the trademark FELTRINELLI is well known in Italy for its bookstores. 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 FELTRINELLI trademark is well-known in Italy for books and bookstores.

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, particularly considering that the disputed domain name originally resolved to a web page reproducing the FELTRINELLI trademark and the web design of the Complainant's <lafeltrinelli.it> website. In the circumstances of this case, this is evidence of registration in bad faith.

The disputed domain name has been used in bad faith because it has been resolving to a website featuring the FELTRINELLI trademark without any disclaimer of non-affiliation and copying the web design of the Complainant's <lafeltrinelli.it> website. Moreover, the fact that the disputed domain name now resolves to a parking page does not *per se* prevent a finding of bad faith because lack of use of a domain name that coincides with a well-known trademark owned by someone else constitutes 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, and the Respondent's failure to submit a response or provide any evidence of actual or contemplated good-faith use.

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 <feltrinelli.shop> be transferred to the Complainant.

/Andrea Mondini/

Andrea Mondini

Sole Panelist

Date: August 30, 2022