Panel Decision for dispute CAC-ADREU-004229

Case number	CAC-ADREU-004229
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Domain names	ornellaia.eu

Case administrator

Name	Tomáš Paulík

Complainant

Organization / Name	Ornellaia Società Agricola S.r.l., Leonardo Raspini

Respondent

Organization / Name	Zheng Qingying

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is Ornellaia Società Agricola S.r.l., one of the leading Tuscany producers of wine and olive oil, registered and based in Italy. The Complainant pertains to the Marchesi de' Frescobaldi S.p.A. group, and is the owner of several registered trademarks for the word "Ornellaia". The business of the company is presented by the website at www.ornellaia.it and at www.ornellaia.com.

The complainant applied for the registration of the domain name <ornellaia.eu> during the sunrise period, but was unsuccessful. During the Land Rush period the complainant tried again to register the domain name, but the registration failed because the Respondent had already applied for the disputed domain name.

The Complainant requested the transfer of the domain name <ornellaia.eu>.

A. COMPLAINANT

The Complainant contends as follows:

A. ornellaia.eu is identical and confusingly similar to ORNELLAIA company name, trademarks and domain names in respect of which the Complainant owns the relevant rights - ADR Rules B1(b)(10)(i)(A).

Save for the additional element of the ".eu" top level-domain (which is not a factor for the purposes of determining identity), the disputed domain name <ornellaia.eu> is (i) confusingly similar to the company name "Ornellaia Società Agricola S.r.l." and (ii) identical to the "ORNELLAIA" trademarks and to the domain names <ornellaia.it> and <ornellaia.com>, in respect of which the Complainant and the holding company (with regards only to the domain name <ornellaia.com>) are recognized, by Member States law and/or Community law, as the relevant owners.

(a) ORNELLAIA Company Name
The Complainant is one of the leading Tuscany producers of wine and olive oil based in Maremma countryside (closed to the Bolgheri town) and it produces several varieties of wines (among which "Ornellaia"), the "Ornellaia" olive oil and the "Ornellaia" spirit (grappa).
As certified in the produced certificates of the Italian Chamber of Commerce – Company Register Office, the Complainant began trading in 1981 as "Ornellaia S.r.l." and adopted the name "Tenuta dell'Ornellaia S.p.A." in 1988. Then it changed the company name in "Ornellaia Società Agricola S.p.A." in 2000. In 2006, the Complainant was incorporated as a limited liability company and adopted the name "Ornellaia Società Agricola S.r.l.". At present, the company is still operating under the name Ornellaia Società Agricola S.r.l.

Although changes in the company name have been made from time to time, as explained above, the heart of the company name is “ORNELLAIA” and therefore, the domain name in dispute is confusingly similar to the company name of the Complainant.

(b) ORNELLAIA Trademarks and use
The Complainant relies on its ownership of the following “ORNELLAIA” trademark registrations and applications:

- IT - N. 0000459029 - 15 December 1986 - Application N. FI1986C010349 - Application Date: 11 June 1986 – Class 33;
- IT – N. 0000769069 - 14 January 1999 - Application N. FI1996C000527 - Application Date: 29 April 1996 – Class 33 (wines);
- IT – N. 0000797727 - 20 December 1999 - Application N. FI1997C000416 - Application Date: 22 April 1997 – Class 33 (wines);
- IT Application N. FI2006C000539 - 28 April 2006 – Class 33 (wines);
- I.R. (AT, BX, CH, DE, FR) - N. 508469 - 15 December 1986 – Application N. 508469 - Application Date: 15 December 1986 – Class 33 (wines);
- JP - N. 2091688 - 30 November 1988 – Application N. S61063935 - Application Date: 8 September 1998 – Class 28 (wines);
- UK – N. 1269534 - Application Date: 19 June 1986; Class 33 (wines);
- US – N. 1512013 - 8 November 1988 – Application N. 717311 - Application Date: 16 March 1988 – Class 33 (wines);
- CA – N. TMA398121 - 15 May 1992 – Application N. 0565113 - Application Date: 25 June 1986 – Class 33 (wines).

The Complainant has registered its “ORNELLAIA” trademarks continuously since 1986 and used them since 1984.

The Complainant also relies on the historical and present use of the “ORNELLAIA” trademarks in its business and has produced examples of commercial and promotional uses of “ORNELLAIA” trademarks in connection with the advertising, promotion and sale of Ornellaia products (wines, olive oils and spirits), in Italy and abroad (mainly in Europe, North America, South America, Asia, Australia and New Zeland).

The principal name, used by the group of companies of which the Complainant is part, is “ORNELLAIA”, although other trademarks and names for wines are used (such as “Masseto”, “Le Serre Nuove”, “Le Volte”). Details on products and products names are advertised on the website of the Complainant at www.ornellaia.it (which is identical to the web site www.ornellaia.com).

(c) Domain name registrations
The Complainant, also through the holding company Marchesi de’ Frescobaldi S.p.A., has registered the domain name <ornellaia.it> and <ornellaia.com> and it has activated the web sites corresponding to those domain names at www.ornellaia.it and www.ornellaia.com. The domain names have been registered since 1997.

(d) Notoriety of “ORNELLAIA” and goodwill achieved
The principal activity of the Complainant under the name “ORNELLAIA” is the production and distribution of wines, olive oil and spirit (grappa) in Italy and in many countries of the world.

The Complainant distributes its products through Italy, Austria, Belgium, Bulgaria, Cyprus, Croatia, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Holland, Hungary, Ireland, Latvia, Lithuania, Luxemburg, Malta, Poland, Portugal, Romania, Russia, Serbia-Montenegro, Spain, Sweden, Switzerland, United Kingdom, Bermuda, Canada, United States of America, Hong Kong, India, Israel, Japan, P. Republic of China, Singapore, South Korea, Taiwan R.O.C., Australia, New Zealand, Brazil, Colombia, Costa Rica, El Salvador, Guatemala, Puerto Rico, Dominican Republic, Venezuela having appointed a number of distributors details of which are listed on the web sites www.ornellaia.it and www.ornellaia.com.

In addition, since 1985, Ornellaia wines have been presented and sold at auctions of Sotheby’s, Christie's, Pandolfini, Wine Gallery, Finarte, in London, New York, Chicago, Los Angeles, Hong Kong, Geneva, Amsterdam, Milan, Rome, details of which are available on the web sites www.ornellaia.it and www.ornellaia.com.

Ornellaia wine has achieved and won a number of awards, rating and accolades, since 1986, around the world such as rating from Italian wine guides “Gambero Rosso” and “I vini di Veronelli”, Top Score by Italian Sommellier’s Association, Cellar Selection of Wine Spectator’s publication (USA), details of which are published on the web sites www.ornellaia.it and www.ornellaia.com.

In addition to the Complainant’s registered rights, the Complainant has a very substantial goodwill in the trademark “ORNELLAIA”. Further evidence of such substantial goodwill is seen by the Complainant’s presence on the Internet through third parties’ web sites, examples of which are downloaded on 12 December 2006 through the search engines: Google (www.google.co.uk and www.google.it), Froogle and Baidu (www.baidu.com) details of which are produced by the complainant.

Therefore, the Complainant has established rights to the name “ORNELLAIA” in respect of which a right is recognized or established by the national law and/or Community law based on:

(a) the registered trademark rights to the “ORNELLAIA” trademarks;

(b) the registered rights to the domain names <ornellaia.com> and <ornellaia.it>;

(c) the registrered rights to “ORNELLAIA” name as company name of the Complainant;

(d) a long established goodwill in the use of the “ORNELLAIA” trademarks, the “ORNELLAIA” company name and of the domain names <ornellaia.com> and <ornellaia.it> through several countries of the world and through the web sites www.ornellaia.com and www.ornellaia.it.

B. The domain name has been registered by its holder without rights or legitimate interests in respect of the domain name that is the subject of the Complaint - ADR Rules B1(b)(10)(i)(B)

It is submitted that the Respondent should be considered as having no rights or legitimate interests in respect of the domain name that is subject to the Complainant for the following reasons:

(a) the Respondent is not associated, connected with or authorized by the Complainant or any of the company of its Group to use the “ORNELLAIA” trademarks;

(b) the Respondent is not the owner or beneficiary of any trademark, trade name or other trade sign that is identical to the disputed domain name;

(c) the Respondent is not commonly known by the name “ORNELLAIA”;

(d) the Complainant is not aware of any demonstrable preparations by the Respondent to use the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services. In this regard, the Complainant notes that the disputed domain name is not presently resolving to any web site.

C. The domain name should be considered as having been registered or being used in bad faith - ADR Rules B1(b)(10)(i)(C)

The Complainant submits that the disputed domain name has been registered in bad faith in the meaning of Article 21 (1) (b) and (3) of the EU Regulation No 874/2004 for the following reasons:

(a) the Respondent, Mr. Zheng Qingying, must have been aware of the Complainant’s rights and goodwill in the name ORNELLAIA at the time of its application to register the domain name in dispute because of the international renown of the Complainant. Further or in the alternative, he will have aware of the use of the name “ORNELLAIA” on the Internet and specifically both in United Kingdom and in P. Republic of China, in connection with the advertising, promotion and sale of Ornellaia products;

(b) the disputed domain name has been registered without any intention of using it and only in order to prevent the Complainant in respect of which rights have recognised and established by national and/or Community law from reflecting this name in a corresponding domain name provided however that:

i. the Respondent is a well-known cyber-squatter of .eu domain names (see, Panel Decision of ADR Center for .eu attached to the Arbitration Court of the Economic Chamber of Czech and Agricultural Chamber of the Czech Republic – Czech Arbitration Court, held on 2 November 2006, Case no. 02325 filed on 19 July 2006 “Glen Dimplex UK Limited v. Zheng Qingying”; Panel Decision of the ADR Center for .eu attached to the Arbitration Court of the Economic Chamber of Czech and Agricultural Chamber of the Czech Republic – Czech Arbitration Court, held on 30 October 2006, Case no. 02429 filed on 26 July 2006 “Ericpol Telecom sp.z.o.o. v. Zheng Qingying”);

ii. the Respondent filed the registration of the domain name <ornellaia.eu> claiming to be domiciled in the United Kingdom although it used a registrar, Buycool Limited based in Shenzhen (China). The Respondent has given Chinese telephone and fax numbers in the contact details as displayed on the EURid database and the Complainant has provided evidence of the notoriety of its trademarks and its trading reputation also in each of these countries (United Kingdom and China). According to “Glen Dimplex UK Limited v. Zheng Qingying” case, the Court has ruled that these circumstances together with the passive holding of the disputed domain name would infer registration or use in bad faith;

iii. the Respondent has chosen Lithuanian as the language of the domain name registration agreement as evidenced by the details contained in the EURid database downloaded on 1 September 2006 and afterwards he changed the language into English as proved by the produced details contained in the EURid database downloaded on 16 October 2006 and 28 November 2006.
Consequently, the language initially chosen by the Respondent (in which the Complainant should have been initially required to present its Complaint) was Lithuanian, which is the oldest and most difficult language from the group of Indo-European languages. The selection of this language was made by the Respondent with the clear intention (as done in a past ADR proceeding before the Court) to cause the maximum possible translation expenses for the Complainant (see, the case "Ericpol Telecom sp.z.o.o. v. Zheng Qingying"). This reflects an abuse of the ADR proceeding and it clearly reflects the bad faith of the Respondent in the registration of the disputed domain name;

iv. the Respondent has showed his bad faith conducting another cyber-squatting practice according to which he changed, in the EURid database, his e-mail address only after the decision of the Court in the case "Ericpol Telecom sp.z.o.o. v. Zheng Qingying", as proved by the produced details downloaded by the EURid WHOIS database on 1 September 2006, 16 October 2006, 28 November 2006 and 26 January 2007. Although the simply use by the Respondent of his access to the EURid Registry database to change the e-mail is not the evidence of a cyber-squatting practice, in the particular case of <ornellaia.eu>, it is clear that the Respondent has changed an identification element of his data (e-mail address) immediately after the Court decision of "Ericpol Telecom sp.z.o.o. v. Zheng Qingying" case in order to occult his identity: in the "Ericpol Telecom sp.z.o.o. v. Zheng Qingying" case, this Court ruled that the searches on Google has revealed that the holder of the e-mail address domain.com@gmail.com has cyber-squatted several more domain names.

v. On 15 November 2006, the Complainant has filed before EURid the request of the disclosure of personal data of the Respondent. On 28 November 2006, EURid has rejected the request of disclosure of the Registrant's personal data due to the fact that the e-mail provided in the request of disclosure form was different from the one later appearing in the EURid Registry database causing delay in defending its rights and interests in domain name ornellaia.eu by filing the Complaint and additional expenses for filing a new request to EURid Registry for the disclosure of personal data. Practices of this kind are undoubtedly acknowledged as cyber-squatting and therefore prove the bad faith in the registration of the disputed domain name.

B. RESPONDENT

The Respondent did not submit a Response.

DISCUSSION AND FINDINGS

According to Article 21 (1) of the Commission Regulation (EC) No 874/2004 of 28 April 2004, a registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, where that name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it:
(a) has been registered by its holder without rights or legitimate interest in the name; or
(b) has been registered or is being used in bad faith

The Complainant's company name is "Ornellaia Società Agricola S.r.l.". The acronym "S.r.l." is the Italian company type indicator for Limited Liability Company, regulated by the Italian Civil Code and it is not a relevant part of the name. The part "Società Agricola" is an indicator requested by Article 2 of the Italian Legislative Decree No 99/2004 to all the companies operating exclusively in the agricultural field (as defined by article 2135 of the Civil Code).

The Complainant is the owner (and legal successor of the owner) of numerous trademark registrations for the word "ORNELLAIA", used in Italy and abroad, accordingly with the submitted documents.

Furthermore, the Complainant uses two company domain names and has activated a website, presenting its products, at www.ornellaia.it and www.ornellaia.com, as proved by the documents attached to the complaint.

It is well established that the top level domain, in determining identity or confusing similarity of domain names to other rights, is excluded from consideration, therefore the contested domain name is identical to the word mark registrations "ORNELLAIA" and the company domain names "ornellaia.it" and "ornellaia.com", and is confusingly similar to the Complainant's company name "Ornellaia Società Agricola S.r.l."

All the cited rights are recognised by the Italian Law (Civil Code, Art. 2563-2574, 2598-2600; Industrial Property Code, Art. 7-30).

The Complainant has, therefore, satisfied the requirements of the first paragraph of Article 21(1).

The Complainant has argued that the Respondent has no rights or legitimate interests in the contested domain name. The Complainant states that:

(a) the Respondent is not associated, connected with or authorized by the Complainant or any of the company of its Group to use the "ORNELLAIA" trademarks;
(b) the Respondent is not the owner or beneficiary of any trademark, trade name or other trade sign that is identical to the disputed domain name;
(c) the Respondent is not commonly known by the name "ORNELLAIA";
(d) the Complainant is not aware of any demonstrable preparations by the Respondent to use the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.

No response or other communication was received from the Respondent in respect of the complaint.

The Panel accepts the arguments of the Complainant with respect of missing rights and legitimate interests of the respondent in the domain name "ornellaia.eu" and, according to article 22 (10) of the Commission Regulation No 874/2004 and paragraph B 10 of ADR Rules, bases its decision on this presentation.

For reasons of procedural economy, as the Complaint is already well-founded according to Article 21 (1) of the Commission Regulation No 874/2004, the Panel does not need to assess a possible bad faith of the Respondent in the registration of the contested domain name.

The Complainant requested the transfer of the domain name "ornellaia.eu". As the Complainant, an Italian based company (as well as its attorney Mr. Leonardo Raspini, as certified by the Chamber of Commerce – Company Register Office), satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002, the disputed domain name is transferred to the Complainant.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name ORNELLAIA be transferred to the Complainant

PANELISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2007-04-11

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is the Italian company "Ornellaia Società Agricola S.r.l.", one of the leading Tuscany producers of wine and olive oil.
The Complainant uses a company name, numerous registered trademarks and two domain names based on the word Ornellaia, with a long established goodwill.
The Complainant, according to Article 21 (1) of the Commission Regulation No 874/2004 of 28 April 2004, contended that:
A) the domain name registered by the Respondent (ornellaia.eu) is identical and confusingly similar to Ornellaia company name, trademarks and domain names in respect of which the Complainant owns the relevant rights;
B) the contested domain name has been registered by its holder without rights or legitimate interests in the sign Ornellaia;
C) the contested domain name has been registered in bad faith.
The Complainant requested the transfer of the domain name "ornellaia.eu".
The Responded did not submit a response.
The Panel held that the requirements of Article 21 (1) of the Commission Regulation No 874/2004 were satisfied.
It was not necessary to examine the allegation of bad faith, as the Complainant proved its rights and – prima facie – the Respondent lack of rights or legitimate interest in the name.
The Complainant, being an Italian registered and based company, also satisfied the criteria for eligibility set out in Article 4 (2) (b) of Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002, therefore the Panel ordered the requested transfer of the disputed domain name.