

## Riassegnazione rossopomodoro.com: capacità distintiva - ritardata rivendicazione del dominio

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**In:** Diritto civile e commerciale

Si è conclusa con l'accoglimento della domanda di trasferimento la controversia tra Vesevo S.p.A., l'azienda che dal 1997 utilizza il marchio Rossopomodoro, ed una società informatica con sede in Napoli, che aveva registrato il dominio "rossopomodoro.com" nel 2000.

La decisione emanata dal collegio composto da tre saggi nominati dalla WIPO (World Intellectual Property Organization) presenta alcuni punti di particolare interesse. Innanzitutto, il collegio ha dovuto prendere in considerazione una eccezione della Resistente, la quale, nella propria replica, sosteneva che il fatto che la Ricorrente avesse atteso circa sette anni prima di attivare una procedura di riassegnazione, costituisse una implicita rinuncia all'utilizzo del nome a dominio. Il Collegio sul punto, tuttavia, si è espresso in maniera contraria, ritenendo che l'inerzia della ricorrente nel rivendicare il dominio non poteva essere considerata né come una rinuncia ai propri diritti, né come dimostrazione che l'utilizzo del dominio da parte della resistente fosse avvenuto in buona fede, richiamando, tra l'altro, precedenti casi per i quali era stata proposta la medesima eccezione<sup>1</sup>.

In secondo luogo, il Collegio è stato chiamato a valutare la capacità distintiva del marchio Rossopomodoro: la Ricorrente aveva, infatti, messo in discussione la validità di tale marchio in quanto composto da due parole di uso comune. In merito, il Collegio di Saggi chiamato a pronunciarsi sulla vicenda, ha ritenuto sussistente la capacità distintiva del marchio, sottolineando che l'espressione "rosso pomodoro" non può essere considerata di uso comune nella lingua italiana. Inoltre, l'intenso utilizzo del marchio Rossopomodoro da parte della ricorrente - in ambito nazionale ed internazionale - ha consentito comunque l'acquisizione del cd. secondary meaning.

## 1. The Parties

Complainant is Vesevo S.p.A. of Milano, Italy, represented by Studio Legale Ambrosino - Pecora, Italy.

Respondent is Nicolas Bouris of Napoli, Italy, represented by Strasburger & Price, LLP, United States of America.

## 2. The Domain Name and Registrar

The disputed domain name <rossopomodoro.com> is registered with OnlineNic, Inc. d/b/a China-Channel.com.

## 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 8, 2011. On March 8, 2011, the Center transmitted by email to OnlineNic, Inc. d/b/a China-Channel.com a request for registrar verification in connection with the disputed domain name. On March 9, 2011, OnlineNic, Inc. d/b/a China-Channel.com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. In response to a notification by the Center that the Complaint was administratively deficient, Complainant filed an Amended Complaint on March 16, 2011. On March 16, 2011, the Center transmitted an email communication to the parties in both Italian and English regarding the language of the proceeding. On the same day, Complainant requested that Italian be the language of the proceeding. On March 18, 2011,

Respondent objected that the proceeding will be conducted in Italian. 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(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced on March 22, 2011. In accordance with the Rules, paragraph 5(a), the due date for Response was April 11, 2011. The Response was filed with the Center on April 11, 2011.

The Center appointed Nicoletta Colombo, Massimo Introvigne and Jeffrey M. Samuels as panelists in this matter on May 20, 2011. The Panel finds that it was properly constituted. Each member of 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.

### **Language of the proceeding**

The Panel notes that Complainant requested Italian to be the language of the proceeding which has been contested by Respondent.

According to paragraph 11(a) of the Rules, which provides that “unless otherwise agreed by the parties, or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the registration agreement” and taking into consideration that Registrar has confirmed that the language of the registration agreement is English and given the circumstances of this case, the Panel has decided that the language of the proceeding should be English.

Under these circumstances, according to paragraph 11(b) of the Rules, which gives the Panel the power to order documents submitted in languages others than the language of the administrative proceeding to be accompanied by a translation into the language of the administrative proceeding and according to previous UDRP decisions (see Advance Magazine Publishers Inc. v. Cenk Babaeren, WIPO Case No. D2010-2238) the Panel issued on June 8, 2011 an administrative panel order requesting the parties to provide translations into English of their respective documents and briefs including the Complaint.

The Parties have complied with the order.

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

Complainant is the owner of a well-known trademark ROSSOPOMODORO, which is registered around the world for restaurants services in particular for pizza restaurants.

The restaurants chain was launched in Italy in 1997 and the trademark was recently sold for a figure in excess of Euro 50 million.

Respondent has registered the disputed domain name on March 20, 2000.

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

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

Complainant claims that it is the owner of the trademark ROSSOPOMODORO with rights dating back to

the year 1997, and with a particular recognition in Italy in the field of restaurants, pizza restaurants and cafeterias. At the moment the trademark is used in 65 restaurants in Italy and 8 stores abroad (United Kingdom of Great Britain and Northern Ireland, United States of America, Japan, Argentina).

Complainant further contends that Respondent has no rights or legitimate interests in the disputed domain name.

In support of its contention that the disputed domain name was registered and is being used in bad faith, Complainant indicates that:

- when Respondent registered the disputed domain name the trademark had already been registered for years and was largely known;

- Respondent has promised many times to transfer free of charge the disputed domain name to Complainant without doing it.

## **B. Respondent**

Respondent states that the term “rossopomodoro” is an Italian term that, when translated into English, means “red tomato” and therefore is merely descriptive of Complainant’s services. As evidenced by the records of the U.S. Patent and Trademark Office, no one has rights to the term “Pomodoro” for restaurant services and the adding of the term “rosso” (translated into English as Red), does not make the term “Rossopomodoro” distinctive for restaurant services since “red tomatoes” are known types of tomatoes and are used in various restaurants, including Complainant’s restaurants.

Respondent notes that none of Complainant's registrations was for the sole wording "rossopomodoro" or "rosso pomodoro", but it is always included a distinctive design element.

Respondent states that at the time of the registration of the disputed domain name (March 20, 2000) Complainant had not previous right because the only asserted trademark registration No. 00805931 that predated the disputed domain name registration has been cancelled by the Italian Trademark Office. The remaining registrations issued after the year 2000 and are thus irrelevant to this proceeding. Consequently, Complainant has failed to prove it has trademark rights to the term "rossopomodoro."

In support of its contention that the disputed domain name was registered and is being used in good faith, Respondent indicates that:

- in the 1970s Respondent was employed in the food industries, especially the tomato concentrate business and was selling tomato paste under the name "Andrea's";
- Respondent registered the disputed domain name because he liked the red tomato name and thought he would use it for his food business;
- he is the owner of an Italian Company Klik S.p.A. that provides worldwide telecommunications, information technology (IT) and Internet access (ADSL) services in particular telephone and Internet access services;
- it is only in 2007, and therefore after 7 years the registration of the disputed domain name, Complainant tried to register <rossopomodoro.com> and found out that Respondent owned it; the parties exchanged various emails and Respondent allowed Complainant to use the disputed domain name on a trial basis, so long as Complainant would purchase services from Respondent's related company, Klik S.p.A..

## 6. Discussion and Findings

### A. Laches

Respondent points out that he registered the disputed domain name in 2000, i.e. seven (7) years before Complainant first complained of such registration, and that another period of almost four (4) years elapsed before the initiation of the Complaint. In this way Respondent appears to argue that, with such delay, he has not used and registered the disputed domain name in bad faith and to invoke the defense of laches.

UDRP panels have generally declined to apply as such the doctrine of laches (see, e.g., *Mile, Inc. v. Michael Burg*, WIPO Case No. D2010-2011; *Progman Consulting Oy v. Whois Watchdog*, WIPO Case No. D2010-1393). This Panel agrees with these decisions and holds that the defense of laches as such has no application under the Policy.

### B. Identical or Confusingly Similar

Before examining if the disputed domain name is identical or confusingly similar, the Panel finds important to verify if Complainant is the owner of a valid trademark.

First of all it is important to underline that “rosso pomodoro” is not a common and generic expression for “red tomato”. The Panel takes notice that a native Italian speaker would say “È un pomodoro rosso” (“It’s a red tomato”) rather than “È un rosso pomodoro”, just as an English speaker would say “It’s a red tomato” rather than “It’s a tomato red”. Therefore, “rosso pomodoro” is a quite uncommon expression for Italian speakers and it is commonly known as Complainant's service mark in Italy.

Moreover, the Panel takes notice that Complainant has been using the trademark since 1997 for restaurants which are spread out in all the Italian territory and with such extensive use the trademark ROSSOPOMODORO has acquired a very significant secondary meaning.

Complainant has a valid registration since 1997, which has been renewed on 2007 with No. 0001272730, and, therefore, at the time of the registration of the disputed domain name, the latter had a registered trademark. Consequently, the Panel is satisfied that Complainant is the owner of a trademark ROSSOPOMODORO; that Complainant's rights predate Respondent's registration of the disputed domain name; and that the latter is identical to Complainant's trademark.

Accordingly, the Panel finds that the first element under paragraph 4(a)(i) of the Policy is satisfied.

### **C. Rights or Legitimate Interests**

There is no evidence that Respondent has any rights or legitimate interests in the disputed domain name, and no right is granted to Respondent in the Italian, nor in the international, community. There is no evidence that Respondent is commonly known by the name "rossopomodoro" pursuant to Policy, paragraph 4(c)(ii), or that Respondent is making a legitimate noncommercial or fair use of the disputed domain name, or that Complainant authorized Respondent to use Complainant's marks as part of Respondent's domain name.

Accordingly, the Panel finds that the second element under paragraph 4(a)(ii) of the Policy is satisfied.

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

As stated by Complainant and confirmed by Respondent, the latter has absolutely no trademark, service mark or other intellectual property rights in or to the disputed domain name, or any similar marks or names. Therefore, the lack of any intellectual property rights in the disputed domain name supports a finding of bad faith in adopting and using <rossopomodoro.com>.

Moreover, Respondent is a resident of Italy and owns and manages an Italian Company named Klik S.p.A. The Panel is of the opinion that Respondent must have been aware of the existence of ROSSOPOMODORO mark owned and used by Complainant at the time of the registration of the disputed domain name. Respondent, upon information and belief, registered the disputed domain name three (3) years after the registration by Complainant of its ROSSOPOMODORO trademark in 1997, and also well after Complainant's services began to be well-known in Italy.

The circumstance that Respondent, in the 1970s, was employed in the food industries, especially the tomato concentrate business, and registered the disputed domain name because he liked the red tomato name and thought he would use it for his food business are completely groundless and no evidence has been adduced.

On the other hand, the conduct of Respondent demonstrates that the willingness of the latter is purely speculative. In fact, the registration of the disputed domain name was apparently intended to force Complainant into a business relationship with Respondent. As declared by Respondent, the latter allowed Complainant to use the disputed domain name, as long as Complainant would purchase services from Respondent's related company, Klik S.p.A..

Accordingly, the Panel finds that the third element under paragraph 4(a)(iii) of the Policy is satisfied.

## **7. Decision**

For all 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 <rossopomodoro.com> be transferred to Complainant.

Nicoletta Colombo  
Presiding Panelist

Massimo Introvigne  
Panelist

Jeffrey M. Samuels  
Panelist

Dated: July 10, 2011

1Mile, Inc. v. Michael Burg, WIPO Case No. D2010-2011; Progman Consulting Oy v. Whois Watchdog, WIPO Case No. D2010-1393

<https://www.diritto.it/riassegnazione-rossopomodoro-com-capacita-distintiva-ritardata-rivendicazione-del-dominio/>