



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Mastellone HNOS. S.A. v. Link Comercial Corp.

Case No. D2005-1047

1. The Parties

Complainant is Mastellone HNOS. S.A., Buenos Aires, Argentina, represented by Mayol & Asociados, Argentina.

Respondent is Link Comercial Corp., Nassau, Bahamas.

2. The Domain Name and Registrar

The disputed domain name <laserenisima.com> is registered with Network Solutions, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 4, 2005. On October 5, 2005, the Center transmitted by email to Network Solutions,

LLC a request for registrar verification in connection with the domain name at issue. On October 6, 2005, Network Solutions, LLC transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. In response to a notification by the Center that the Complaint was administratively deficient, Complainant filed an amendment to the Complaint on October 14, 2005. The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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 October 19, 2005. On November 8, 2005, the Center received an e-mail from counsel for Respondent indicating that the parties were in the process of reaching an agreement on the domain name and that was the reason Respondent had not submitted a formal response to the Amended Complaint. After communication with Complainant, the Center informed the parties by e-mail dated November 9, 2005 that Complainant did not wish to suspend the administrative proceeding pending a potential settlement.

In accordance with the Rules, paragraph 5(a), the due date for the Response was November 8, 2005. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on November 9, 2005. This notification was also e-mailed to counsel for Respondent despite no formal appearance in the proceeding.

The Center appointed R. Eric Gaum as the Sole Panelist in this matter on November 15, 2005. 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

Complainant states that it is the owner of the following rights:

Trademark LA SERENISIMA (design) originally registered in the United States under registration No. 1,305,189 on November 13, 1984 and currently under registration No. 2,183,192 since August 25, 1998, for the following products in relation to which not only is the mark used in the United States but also in its country of origin, Argentina, and in the rest of the countries to which they are exported: Milk, Butter, Yogurt, Cheese and Milk Cream.

The trademark LA SERENISIMA's origin dates back to the year 1929, when its founder, Antonio Mastellone, began making mozzarella cheese and ricotta cheese, which he distributed himself across Buenos Aires City.

Mastellone HNOS. S.A.'s main trademark is LA SERENISIMA, with which it has identified most of its products since 1929 and under which it started exporting its products over 20 years ago to, among others, the following countries: United States, Russia, Mexico, Algeria, Chile, Brazil, Paraguay, Uruguay, Peru, Venezuela, Jamaica, Cuba, Morocco, Ivory Coast, Mauritania, Tunisia, Egypt, Spain, France, Belgium, Austria, Yugoslavia, Korea, Japan, Thailand, Vietnam, Singapore, Indonesia, Philippines, Taiwan, Australia.

5. Parties' Contentions

A. Complainant

Complainant's trademark LA SERENISIMA, due to the quality and use of Complainant's products in the market for approximately 80 years, has become a very well known trademark in Argentina and the rest of the countries where its products are exported to, including the United States, Russia, Mexico, Algeria, Chile, Brazil, Paraguay, Uruguay, Peru, Venezuela, Jamaica, Cuba, Morocco, Ivory Coast, Mauritania, Tunisia, Egypt, Spain, France, Belgium, Austria, Yugoslavia, Korea, Japan, Thailand, Vietnam, Singapore, Indonesia, Philippines, Taiwan, Australia.

When registering the <laserenisima.com> domain name, Respondent cannot deny knowing of Complainant's trademark. The domain name at issue is an identical denomination and the Administrative Contact is an Argentine citizen, domiciled in Buenos Aires, Argentina. Persons accessing the domain name would be bound to think that the domain name has a connection with Complainant. An Internet user may think that the domain name directly refers to the trademark LA SERENISIMA. In conclusion, the domain name <laserenisima.com> generates confusion with Complainant's trademark LA SERENISIMA.

Mastellone HNOS. S.A. also has its trademark LA SERENISIMA registered in Bolivia, Brazil, Chile, Colombia, Spain, Italy, Mexico, Paraguay, Peru, Uruguay, Venezuela, and the Bahamas, among others. Complainant owns the registration of the trademark LA SERENISIMA in the Bahamas, which is where Respondent is allegedly located.

Respondent has no authorization whatsoever from Mastellone HNOS. S.A. to use the LA SERENISIMA mark. This evidences the bad faith of Respondent in registering the domain name as it could not have been unaware of the LA SERENISIMA mark.

Mastellone HNOS. S.A. has also been the owner of the domain name <laserenisima.com.ar> since 1996. This domain name is an important source of marketing of Complainant's products. Complainant's domain name <laserenisima.com.ar> was registered prior to Respondent's domain name <laserenisima.com>.

Respondent's registration prevents Complainant from advertising and commercializing in the American market, which has great commercial importance for Complainant and where Mastellone HNOS. S.A. registered its trademark LA SERENISIMA prior to the registration date of the contested domain name. Respondent has registered the domain name in order to prevent Complainant from reflecting its trademark in a corresponding domain name.

Respondent has no right in respect of this domain name, has no registered trademark whatsoever, and has not developed any activity through the domain name. The contact details provided by Respondent, including its e-mail address and fax and telephone numbers, are false. Respondent does not even appear in the telephone directory in its country of origin.

Respondent's bad faith is also evidenced by the fact that, since this domain name's original registration in 1997, it has not been used and does not link to another Internet site or any other online presence.

There are at least two previous WIPO UDRP decisions that condemn Respondent for illegal appropriation of third parties' trademarks as domain names. These cases are: *Bernardo Neustadt v. Link Commercial Corp.*, [WIPO Case No. D2000-1256](#) and *DCI S.A. v. Link Commercial Corporation*, [WIPO Case No. D2000-1232](#).

B. Respondent

Other than the November 8, 2005 e-mail from counsel for Respondent indicating that the parties were discussing settlement, Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

The Policy, adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999 (with implementing documents approved on October 24, 1999), is addressed to resolving disputes concerning allegations of abusive domain name registration. The Panel will confine itself to making determinations necessary to resolve this administrative proceeding.

It is essential to dispute resolution proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them, and a reasonable opportunity to respond (see, e.g., paragraph 2(a) of the Rules).

The Center forwarded notification of the Complaint to Respondent via post/courier and email in accordance with the contact details found in the appropriate Whois database. The Center also forwarded notification of default to Respondent via email. Further, the Center forwarded notification of default to counsel for Respondent in response to its November 8, 2005, e-mail informing the Center that the parties were discussing settlement.

Based on the methods employed to provide Respondent with notice of the Complaint and default the Panel is satisfied that the Center took all steps reasonably necessary to notify Respondent of the filing of the Complaint and initiation of these proceedings.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration, and to obtain relief. These elements are that:

- (i) the respondent's 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 domain name; and
- (iii) the respondent's domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.

As Respondent has failed to submit a Response to the Complaint, the Panel may accept as true all of the allegations of the Complaint and Amended Complaint (*Talk City, Inc. v. Michael Robertson*, [WIPO Case No. D2000-0009](#)), although Complainant must still establish each of the three elements required by paragraph 4(a) of the Policy.

A. Identical or Confusingly Similar

Based upon the registered trademark for LA SERENISIMA and the continuous use of the mark, Complainant clearly has rights in the mark.

Complainant asserts that the domain name <laserenisima.com> is identical to the trademark LA SERENISIMA.

The Panel agrees with Complainant that the only actual differences between the domain names and the trademark are the addition of "www" and ".com", and the lack of a space, which are trivial.

The Panel finds the <laserenisima.com> domain name is identical to the registered trademark LA SERENISIMA in which Complainant has established it has rights, pursuant to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several circumstances, without limitation, that if found by the Panel shall demonstrate Respondent's rights to or legitimate interests in the domain name for the purposes of paragraph 4(a)(ii). In particular, paragraph 4(c) states:

"(i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

There is no evidence in the record that would indicate that Respondent has any rights or legitimate interests in respect of the domain name <laserenisima.com> and Complainant has established a *prima facie* case that Respondent has no rights to or legitimate interests in the domain name.

The Panel finds that Respondent has no rights or legitimate interests in respect of the domain name <laserenisima.com>, pursuant to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists several factors, without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

"(i) circumstances indicating that you [Respondent] have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

In view of the uncontested facts recited by Complainant and its cited evidence, the Panel follows the rulings set out in *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#) in finding that the passive holding of the domain name by Respondent amounts

to Respondent acting in bad faith. The particular circumstances of this case which lead to this conclusion are:

(a) Complainant has demonstrated that the LA SERENISIMA trademark is used in the United States and throughout much of the world;

(b) Respondent has not provided any evidence of any actual or contemplated good faith use by it of the domain name;

(c) Respondent has apparently actively provided, and failed to correct, false contact details, in breach of its registration agreement; and

(d) Respondent has a pattern of registering domain names to prevent owners of trademark or service marks from reflecting the mark in a corresponding domain name.

The Panel finds Complainant has established that Respondent registered and used the domain name <laserenisima.com> in bad faith, pursuant to paragraph 4(b)(iv) of the Policy.

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 domain name <laserenisima.com> be transferred to Complainant.