

Alternative Dispute Resolution (ADR)

DECISION

2013-08-16

TICKETNUMBER

682

APPLICANT

Alessi S.P.A. (IT00465840031)

Via Privata Alessi 6

28887 Crusinallo (VB)

Italy

DOMAIN HOLDER

ITALIAN DESIGN AB (556301-8216)

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42677 Västra Frölunda

MATTER

Alternative dispute resolution regarding the domain name < **alessi.se.se**>.

DECISION

The domain name <alessi.se> shall be transferred to the Applicant.

BACKGROUND TO THE DISPUTE

The disputed domain name was registered on May 12, 2003.

In the application dated June 25, 2013, the Applicant has applied for alternative dispute resolution and requested that the dispute should be decided by a sole Adjudicator.

The Opponent has replied to the Applicant's contentions.

CLAIMS

The Applicant has claimed that the domain name <alessi.se> shall be transferred to the Applicant.

The Opponent disputes the Applicant's claims.

PARTIES' CONTENTIONS

The Applicant

The Applicant is an enterprise specialized in high-end table design tableware and gift items. The company is based in Italy, and have obtained acknowledgement all over the world. It is the holder of the trademark ALESSI which is registered in most countries, even in Sweden since 1997. Furthermore, the Applicant is the holder of the domain name *alessi.com* by means of which it sells its products in different countries, inter alia in Sweden.

The Opponent, based in Sweden and managed by Mr John B, has been an Alessi agent for Sweden from 1996 to 2008. The Opponent was also managing an Alessi flagship store in Stockholm from 1998 to 2012. Subsequently, the Applicant and the Opponent terminated their business relationship.

In 2007, the Opponent registered <alessi.se>. The Applicant has persistently asked Mr John B to redirect the domain to *alessi.com* or transfer it to the Applicant, but Mr John B has always refused.

After the termination of the agency agreement in 2008, the Opponent lost its title of Alessi agent, and in 2012 it even lost the right to use the ALESSI trademark for its store. Consequently, the Opponent has now no legitimate interest in respect of the domain name <alessi.se>. Notwithstanding, Mr John B insisted in keeping <alessi.se> and using it in bad faith as it resolved to an "under construction page", with the only purpose of preventing the Applicant to use it, and disrupting the business of the Applicant in Sweden.

The Opponent

The domain name <alessi.se> was registered on May 12, 2003. At the time of registration, there were no restrictions regarding who could file the application for registration, or which kind of business that would be operated etc. At the time, John B was an Alessi agent in Sweden. Since 1996, the Opponent runs the store *Alessi Flagship* in Stockholm. Since 2008, John B is no longer an Alessi agent, but is still running the Flagship store.

The Opponent's web shop <alessi.se> is in Swedish, managed in accordance with Swedish law. The Opponent's customers feel at home as to complaints, warranties, and the communication through the store in Stockholm. This has contributed to a successful sale, it is a complement to the store in Stockholm, and it has also been necessary for the survival of the Opponent. The Applicant saw the potential in <alessi.se>, and in 2011 it claimed that the Opponent should immediately transfer <alessi.se> to the Applicant. The Applicant planned to use it as a webshop for the Swedish market, to gain even more market shares.

The Opponent refused to hand over the disputed domain name. Consequently, the Applicant terminated the flagship status of the store in Stockholm after 16 years. This meant that the

Opponent could no longer use the Applicant's logo on the website. The logo on the Opponent's website was therefore changed to *alessi.se* in lower case, which was not in conflict with the Applicant's official logo.

The Opponent has made investments in the domain. It generates sales, and has nothing to do with the Applicant's registered trademark in Sweden. <alessi.se> was registered as early as in 2003, and has been used ever since. If the Applicant wants to purchase the disputed domain name, it has to give the Opponent economic compensation.

FINDINGS OF THE ARBITRATOR

A domain name may, according to the General Conditions, paragraph 7.2, in connection to an ADR proceeding be cancelled or transferred to the Applicant if

- the domain name is identical or confusingly similar to e.g. a trademark that enjoys legal protection in Sweden and in which the Applicant can show a right,
- the domain name is registered or used in bad faith; and
- the holder has no right or legitimate interest in the domain name.

The Adjudicator makes the following assessment.

Identical or confusingly similar

The Applicant is the holder of the Swedish trademark registration for ALESSI. The disputed domain name consists of the ALESSI trademark and the generic top-level domain (gTLD) ".se". According to well established consensus among ADR Adjudicators, the gTLD is not distinguishing.

The Adjudicator therefore finds the domain name to be identical to the registered trademark in which the Applicant has rights. The first criterion is thus fulfilled.

Registered or used in bad faith

The Applicant and the Opponent have presented different information about the time of registration of the domain name <alessi.se>. The Applicant has alleged that the domain name was registered in 2007, while the Opponent has referred to a registration date in 2003. The Opponent was an Alessi agent in 2003 as well as in 2007, and also managed an Alessi flagship store in Stockholm since 1998. There are no indications that the disputed domain name was registered in bad faith.

However, the agency agreement was terminated in 2008. In 2012, the Applicant terminated the Opponent's right to manage the store in Stockholm as a flagship store. In connection with this termination, the Opponent also lost its license to use the ALESSI trademark for its store. Furthermore, a domain name is considered to be used in bad faith when the registration prevents or aggravates the Applicant from reflecting its own trademark in a corresponding domain name. In this case, the Opponent is well aware of the Applicant's Swedish trademark registration for ALESSI. It is also clear that the Opponent's registration of <alessi.se> prevents the Applicant from registering the trademark as a domain name. According to information given from the Applicant as well as the Opponent, the Applicant has requested the Opponent to transfer the domain name

to the Applicant. If there ever was an approval from the Applicant regarding the Opponent's registration of the disputed domain name, the approval must now be considered as terminated. This is further evidence of bad faith.

Furthermore, the use of a trademark by an agent or licensee is considered to me made on behalf of the Principal and all rights therefrom shall inure to the benefit of the Principal. Consequently all use prior to the Applicant's termination is to be considered as made by Applicant and all use thereafter is made in bad faith.

All in all, the Adjudicator finds that the disputed domain name is being used in bad faith. The second criterion is thus fulfilled.

Rights or legitimate interests

The Opponent has been selling Alessi products for many years. As stated in several ADR-rulings, the position as a distributor does not in general grant the right to register a domain name which is identical to or similar with the trademark of the distributed products, if the trademark belongs to someone else, see inter alia ADR nr 9 <peugeot.se>, nr 37 <funai.se>, nr 39 <plantronics.se> and 527 <redkap.se>). In some cases, the judgment has been different due to the fact that the trademark holder has approved the Opponent's registration or use. In this case, the Opponent has alleged that there were no restrictions from the Applicant at the time of registration of the disputed domain name. As stated above, however, the Opponent is no longer an Alessi agent, its store lost its status as a flagship store in 2012, and it has no longer a license to use the ALESSI trademark for its store. Furthermore, the Swedish trademark ALESSI was registered several years before the registration of the disputed domain name.

In the light of what is stated above, the Adjudicator finds that the Opponent is not connected with the Applicant or authorized to use the ALESSI trademarks in the disputed domain name. Neither does the Adjudicator find any other indications that the Opponent has rights or legitimate interests in the disputed domain name. Therefore, the Adjudicator finds that the second criterion fulfilled.

As all the criteria are fulfilled, the requested relief of the Applicant shall be granted and the domain name <alessi.se> shall be transferred to the Applicant.

On behalf of .SE

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Jonas Gulliksson