Decision for dispute CAC-UDRP-101608

Case number	CAC-UDRP-101608
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Domain names	EPSILONFUND.NETWORK

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Epsilon SGR S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	Moustache Media

OTHER LEGAL PROCEEDINGS

The Panel is unaware of other legal proceedings, pending or otherwise, which relate to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of various registrations for the trademark “EPSILON”, for example:

- EU trademark registration n. 1642537 “EPSILON”, filed on May 5, 2000, granted on July 3, 2001 and duly renewed, in connection with class 36;
- Benelux trademark registration n. 1237240 “EPSILON”, filed on November 30, 2011 and granted on March 12, 2012, in connection with class 36;
- Italian trademark registration n. 1495669 “EPSILON”, filed on November 30, 2011 and granted on June 6, 2012, in connection with class 36.

Through its business ventures, the Complainant is also the proprietor of the name “EPSILON FUND” in use for a financial product, which the Complainant has shown to be in use by showing references in the trade press and use on the main stock exchanges operating worldwide through Internet printouts attached to the Complaint. In consideration of the above, “EPSILON FUND” is also the trade name of a financial product actively promoted and offered by the Complainant.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is Epsilon SGR S.p.A., an asset manager company owned by the well-known Intesa Sanpaolo Group and specialized in active portfolio management.

Born in 1997 as competence hub in quantitative management, the Complainant has expanded over time its activity perimeter that, since 2008, includes multi-strategy management with “total return” investment objectives. In 2010 Banca IMI became part of the shareholders, joining Eurizon Capital SGR. The joint venture made it possible for Epsilon SGR S.p.A. to extend its activity perimeter to a new family of products that also includes the competences of risk management and the skills of investment protection that are typical of an investment bank.

Epsilon SGR S.p.A. counts on a team of analysts and fund managers that create innovative strategies, making it possible for the typical competences of asset management – stock and market picking, and the other levers typical of a traditional investment process – to blend with those of investment banking, such as financial instruments’ structuring, the development of investment protection methodologies and the sophisticated risk management. The joint venture between the two market leaders allows to efficiently coordinate the different phases of the investment management process.

The Intesa Sanpaolo Group, which owns the Complainant, is the leading Italian banking group and also one of the protagonists in the European financial arena, with a market capitalisation exceeding 46,4 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

Thanks to a network of approximately 3,900 branches capillary and well distributed throughout the Country, with market shares of more than 13% in most Italian regions, the Group offers its services to approximately 11.1 million customers. The Intesa Sanpaolo Group has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,7 million customers. Moreover, the international network specialised in supporting corporate customers is present in 27 countries, in particular in the Mediterranean area and those areas where Italian companies are most active, such as the United States, Russia, China and India.

The Complainant (through one of its parent company) is the owner, among the others, of the domain name <EPSILONSGR.IT>.

In addition, it shall also be considered that “EPSILON FUND” is the name that the Complainant gave to its most famous mutual fund, established in Luxembourg and consisting of seven sub-funds, each with distinctive features and marked by different management styles, ranging from active-style to total-return, as well as to quantitative methodologies.

In consideration of the above, “EPSILON FUND” shall definitely be considered a Complainant’s trade name/business identifier.

On June 7, 2017, the Respondent registered the domain name EPSILONFUND.NETWORK.

The Complainant states the domain name at issue is confusingly similar to the trademark “EPSILON”, with the only addition of the term “fund”, which is merely descriptive of the business field in which the trademark itself is used by the Complainant.

In addition, the Disputed domain name is identical – strange enough – to the mutual fund’s name “EPSILON FUND” run by the Complainant and its Group.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME

The Respondent has no rights on the Disputed domain name, since Moustache Media has nothing to do with Epsilon SGR S.p.A.. In fact, any use of the trademark “EPSILON” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned company – nor by its parent company – to use the domain name at issue.

The domain name at stake does not correspond to the name of the Respondent and, to the best of the Complainant’s knowledge, Moustache Media is not commonly known as “EPSILONFUND”.

Lastly, the Complainant does not find any fair or non-commercial uses of the domain name at stake.

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The domain name <EPSILONFUND.NETWORK> was registered and is used in bad faith.

The Complainant’s trademark “EPSILON” and the trade name/business identifier “EPSILON FUND” are distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is identical/confusingly similar to them indicates that the Respondent had knowledge of the Complainant’s trademarks at the time of registration of the Disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wording “EPSILON” and “EPSILON FUND”, the same would have yielded obvious references to the Complainant. This raises a clear inference of knowledge of the Complainant’s trademark on the part of the Respondent. Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant’s trademark. This is a clear evidence of registration of the domain name in bad faith.

In addition, the contested domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site (par. 4(b)(iv) of the Policy).

First of all, several services can be detected, but not in good faith: in fact, the Disputed domain name is connected to a website sponsoring banking and financial services, for whom the Complainant’s trademarks are registered and used.

Consequently, Internet users, while searching for information on the Complainant’s services, are confusingly led to the websites of the Complainant’s competitors, sponsored on the websites connected to the domain name at issue.

Therefore, the Complainant deems that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant’s web site.

Several WIPO decisions stated that the registration and use of a domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy. See, e.g., Encyclopaedia Britannica Inc. v. Shedon.com, WIPO Case No. D2000-0753 (“Respondent’s Ownership of a site which is a mis-spelling of Complainant’s britannica.com site and which Respondent used to hyperlink to a gambling site demonstrates Respondent’s bad faith registration and use of the britannnica.com domain name”); YAHOO! INC. v. David Murray, Case No. D2000-1013 (finding bad faith where respondent chooses a domain name similar to the complainant’s mark for a site which offers services similar to the complainant); Edmunds.com v. Ultimate Search, Inc., WIPO Case No. D2001-1319 (“Registration and use of a domain name to redirect Internet users to websites of competing organizations constitutes bad faith registration and use under the Policy”); Netwizards, Inc. v. Spectrum Enterprises, WIPO Case No. D2000-1768 (“Registration and continued use of the contested domain name for re-directing Internet users, i.e. particularly customers and potential customers of the Complainant, from the Complainant’s website to the website of…a company which directly competes with the Complainant, constitutes bad faith registration and use”); Oly Holigan, L.P. v. Private, Case No. FA0011000095940 (finding bad faith where respondent used the disputed domain name to “redirect the Complainant’s consumers and potential consumers to commercial websites which are not affiliated with Complainant”); Marriott International, Inc. v. Kyznetsov, Case No. FA0009000095648 (finding bad faith where respondent registered the domain name <marriottrewards.com> and used it to

route internet traffic to another website that “promotes travel and hotel services . . . identical to the services offered by the Complainant”); Zwack Unicom Ltd v. Duna, WIPO Case No. D2000-0037 (respondent’s linking to complainant’s competitor held to constitute bad faith); Schneider Electric SA v. Ningbo Wecans Network Technology Co., Ltd, Ningbo Eurosin International Trade Co., Ltd., Case No. D2004-0554; Microsoft Corporation v. StepWeb, Case No. D2000-1500; Baudville, Inc. v. Henry Chan, Case No. D2004-0059; National City Corporation v. MH Networks LLC, Case No. D2004-0128.

The current use of the Disputed domain name, which allows accessing to the web sites of the Complainant’s competitors, also through the Complainant’s trademarks, causes, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones. So, the Respondent’s conduct is even worse (see WIPO Decisions n. D2000-1500, Microsoft Corporation v. StepWeb, and D2001-1335, The Vanguard Group, Inc v. Venta).

The Complainant claims that the Respondent’s commercial gain is evident, since it is obvious that the Respondent’s sponsoring activity is being remunerated.

On July 10, 2017, the Complainant’s attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the contested domain name to their client. The Respondent never replied to such communication.

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

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According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the Disputed domain name should be transferred or cancelled:

(i) the Disputed 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 Disputed domain name; and

(iii) the Disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Disputed domain name is confusingly similar to the Complainant's trademarks. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of

a) disregarding the top-level suffix in the domain name (i.e. ".network"), and

b) not finding that the addition of a generic word (such as "FUND") would be sufficient to distinguish a domain name from a trademark.
In this case, the Complainant actually uses the registered trademark for a mutual fund and actually uses the term EPSILON FUND as a product name which is in part descriptive for the services being offered. The Respondent makes use of this very term in the Disputed domain name.

Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such a prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the Disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Complainant has put forward that the Respondent is not commonly known by the Disputed domain name. Neither is the Respondent in any way related to the Complainant. Nor has the Respondent been granted an authorization or license to use the Disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the Disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest to the Disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the Disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the Disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the Disputed domain name. The Respondent is also in no way commonly known under the Disputed domain name. This prima facie evidence was not challenged by the Respondent.

Instead the Complainant has shown that the Disputed domain name is in use for a pay-per-click website using the Disputed

domain name to attract traffic to links to third parties' offers which in some cases are in competition with those of the Complainant. It has been shown that by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site. This is clearly a case of use in bad faith.

The failure of the Respondent to reply to this cease and desist letter sent by the Complainant's attorneys on July 10, 2017 may be seen as further evidence of bad faith (see e.g. Coutts & Co. v. Sande Skalnik, Patrick Harding, WIPO Case No. D2015-1590; Citrix Systems, Inc. v. Domains by Proxy, LLC / Sirishareddy Idamakanti - Sirisha Idamaknti, WIPO Case No. D2015-0017; E. & J. Gallo Winery v. Oak Investment Group, WIPO Case No. D2000-1213; Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party, WIPO Case No. D2000-0330).

Therefore, the Panel concludes that the Respondent has registered and is using the Disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **EPSILONFUND.NETWORK**: Transferred

PANELLISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2017-09-06

Publish the Decision