Decision for dispute CAC-UDRP-102234

Case number	CAC-UDRP-102234
Time of filing	2018-11-29 10:24:12
Domain names	unicreditservice.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	UNICREDIT S.p.A.

Complainant representative

Organization	Convey srl

Respondent

Organization	Claudio Sallah

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns the following trade mark registrations:

• EU trade mark no. 002911105 for UNICREDIT (figurative mark) in classes 9, 16, 35, 36, 38, 39, 41 and 42, registered 14 July 2009.

• International trade mark no. 799384 for UNICREDIT BANCA (figurative mark) in classes 09,16,35,36,38,39, 41 and 42, registered 10 December 2002.

• International trade mark no. 1046723 for UNICREDIT CORPORATE AND INVESTMENT BANKING (figurative mark) in classes 35, 36 and 41, registered 1 April 2010.

• Italian trade mark no. 0001138942 for UNICREDIT PASS in classes 9 and 36, registered 10 September 2008.

• Italian trade mark no. 0001011970 for UNICREDIT in class 36, registered 13 June 2006.

• Canadian trade mark no. TMA920264 for UNICREDIT in classes 9, 35, 36, 39, 41 and 42, registered 16 November 2015.

• Canadian trade mark no. TMA920248 for UNICREDIT (figurative mark) in classes 9, 35, 36, 39, 41 and 42, registered 16 November 2015.

FACTUAL BACKGROUND

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

The Complainant, UNICREDIT S.p.A., is a well-known Italian global banking and financial services company. Complainant is the main sponsor of major sporting and musical events.

The Complainant is the owner of the trade mark UNICREDIT, with several international and national trade mark registrations worldwide.

The disputed domain name was registered on 28 June 2018.

On 6 November 2018, a cease and desist letter was sent by email to the disputed domain name registrant’s known email addresses indicated at that time in the WhoIs record. The automated reply from Contact Privacy indicated that a message could be sent to the contacts listed in the WHOIS record for the domain, including the administrative contact, the billing contact, the registrant, and the technical contact, by completing the online form. The Complainant's legal representative filled in the form online but did not receive a reply.

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 trade mark 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

Paragraph 4 (a) of the Policy requires the Complainant to prove each of the following three elements:

(i) The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

(ii) The Respondent has no rights or legitimate interests in the disputed domain name.

(iii) The disputed domain name has been registered and used in bad faith.

A. The disputed domain name is confusingly similar to the protected mark.

The Complainant asserts that the disputed domain name, <unicreditservice.com>, is confusingly similar to its trade mark UNICREDIT.

The Panel is satisfied that the Complainant is the owner of trade mark registrations for UNICREDIT that predate the registration of the disputed domain name.

It is well established that the top-level domain suffix ".com" can be ignored when assessing confusing similarity under paragraph 4(a)(i) of the Policy (e.g. Magnum Piercing, Inc. v D. Mudjackers and Garwood S. Wilson, Sr. WIPO Case No. D-2000-1525; Hugo Boss A.G. v. Abilio Castro, WIPO case No. DTV2000-0001; Radale Inc. v. Cass Foster, WIPO case No. DBIZ2002-00148. Carlsberg A/S v. Brand Live television, WIPO case NO. DTV-2008-0003).

The disputed domain name incorporates entirely the Complainant's the well-known trade mark UNICREDIT plus the word "service". Complainant submits that adding the term "service" to its trade mark UNICREDIT is particularly problematic as it could refer to the online banking services it provides to clients. The Panel agrees that adding the word "service" to the trade mark UNICREDIT does not prevent the disputed domain name being confusingly similar to the Complainant's trade mark.

The Panel finds that the disputed domain name is confusingly similar the Complainant's registered trade mark and that the requirements of paragraph 4(a)(i) of the Policy have been met.

B. The Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name and says:

(i) The mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name.

(ii) The Respondent is not a licensee or an authorised dealer of the Complainant, nor has been authorised by the Complainant to use the trade mark UNICREDIT in the disputed domain name.

(iii) There is nothing to indicated that the Respondent is commonly known by the disputed domain name or a name corresponding to the disputed domain name as an individual, business, or other organisation.

(iv) The Respondent has not provided the Complainant with any evidence of its use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before any notice of the dispute.

(v) The above-described use of the disputed domain name suggests that the Respondent intended to trade upon the Complainant's trade marks by intentionally attempting to attract to its website users looking for the Complainant, its products and services, by misleading them as to the source or affiliation of its web site.

(vi) The disputed domain name is not redirected to an active website and does not appear to be in use for any bona fide offering of goods or services. The Respondent has simply passively held the disputed domain name since registering it. Such unauthorised use of the cannot be qualified as a bona fide offering of goods or services nor as a legitimate non-commercial or fair use. Furthermore, the apparently misleading activity carries out on the web site where the disputed domain name is redirected cannot be qualified as a bona fide offering of goods or services nor as a legitimate non-commercial or fair use.

(vii) According to the Facebook account related to the web site corresponding to the disputed domain name, the Respondent

is active in the sector of finance, as indicated in a post: “Unicredit: service that accompanies you in all your financing projects. Contact us today: Email: info@unicreditservice.com Web site: www.unicreditservice.com”. Therefore, this Facebook account confirms the misleading activity put in place on the web site where the disputed domain name is redirected. Currently, following the cease and desist letter sent to the Respondent, the account is inactive.

The Respondent has not filed a Response, nor contested any of the Complainant’s submissions, nor provided any evidence of any rights or legitimate interests in the disputed domain name. The Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or a legitimate interest in the disputed domain name. There is nothing to indicate that the Respondent has any relevant rights itself. The Respondent is not commonly known by the disputed domain name and has not been authorised by the Complainant to use the name UNICREDIT.

Panel finds that the Respondent does not have any rights or legitimate interest in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

C. The disputed domain name has been registered and is being used in bad faith

The Complainant’s well-known trade mark UNICREDIT predates the Respondent's registration of the disputed domain name. The Panel finds that it is highly unlikely that the Respondent was unaware of the Complainant's rights when it the registered the disputed domain name. There appears no reason why the Respondent would incorporate the Complainant's well-known mark in the disputed domain name, other than to create the impression that it is connected to the Complainant.

There is no evidence of actual or intended use in good faith of the disputed domain name by the Respondent, and in not filing a Response the Respondent has not asserted any good faith use. The Respondent has concealed its identity with a privacy shield and has not answered the Complainant's cease and desist letter.

It appears from evidence submitted with the Complaint that the disputed domain name was used to create the e-mail address <info@unicreditservice.com>, where internet users could obtain information on Respondent’s financial services, as indicated in a post of the Facebook account related to the Respondent.

The Panel agrees with the Complainant that where a domain name is identical or similar to a registered trade mark for the name of a bank or financial institution, there is the risk of the domain name being used for phishing or scams. The registration of the e-mail address <info@unicreditservice.com> and the redirection of the disputed domain name to a deceptive website indicates that the disputed domain name was being used in bad faith by the Respondent.

Taking all these factors into account, the Panel finds that the disputed domain name was registered and is being used in bad faith and that the requirements of paragraphs 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UNICREDITSERVICE.COM**: Transferred

PANELLISTS

Name	**Mrs Veronica Bailey**

DATE OF PANEL DECISION 2019-01-10

Publish the Decision