Decision for dispute CAC-UDRP-102472

Case number	CAC-UDRP-102472
Time of filing	2019-05-14 11:48:13
Domain names	nexismartpos.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	NEXI PAYMENTS S.P.A.

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Name	Vildan Erdogan

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks:

(a) EU Trademark NEXI Registration No. 016892151 – Registered 6 October 2017, in classes 9, 16, 35, 36, 38 and 45;

(b) EU Trademark NEXI PAYMENTS Registration No, 016892218 – Registered 6 October 2017, in classes 9, 16, 35, 36, 38 and 45;

(c) EU Trademark NEXI PAY&CASH Registration No. 017221441 – Registered 2 February 2018, in classes 9, 16, 35, 36, 38 and 45;

(d) EU Trademark NEXI SMARTPOS Registration No. 017877182 – Filed 20 March 2018 and registered 22 August 2018, in classes 9, 36 and 38.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The Complainant is a market leader in numerous industrial segments in Italy, including issuing, merchant services, ATM management, interbank corporate banking, and clearing & settlement.

The Nexi Group provides its services to support banks, financial institutions and insurance companies, merchants, businesses and public administration in the field of payment cards, payment acceptance technologies, money transfers between companies and private individuals, and the management of highly complex technical services such as corporate banking.
Nexi is also a major player in the world of investments, providing application and administrative outsourcing services and legal advice. Nexi SpA is also listed on the Italian stock exchange.

The Complainant owns a number of trademarks consisting of, or containing the word NEXI including those listed in the Identification of Rights above. The NEXI trademark enjoys a high degree of reputation in its field. A google search on the word NEXI, discloses only results related to the Complainant. References are also made to the NEXI and NEXISMARTPOS trademarks in Italy.

The Complainant is active on the main social networks including Facebook (https://www.facebook.com), Twitter (https://twitter.com), Linkedin (https://www.linkedin.com) and YouTube (https://www.youtube.com).

The Complainant filed an application to register in the EU the trademark NEXI SMARTPOS on March 20th, 2018.

The disputed domain name was registered on March 20th, 2018.

The Registrant's contact details were originally shielded by a privacy protection service. Following the filing of the UDRP and the Center's request of information, the Registrar disclosed the registrant's identity, i.e. Mr. Vildan Erdogan.

Currently <nexismartpos.com> redirects to an inactive web page.

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

Paragraph 4(a) of the Uniform Domain Name Dispute Resolution Policy (the 'Policy') lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent should be transferred to the Complainant:

(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 right 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 is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

Taking each of these elements in turn:

Paragraph 4(a)(i) - RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

To prove this element, the Complainant must have trademark rights and the disputed domain name must be identical or confusingly similar to the Complainant's trademark.

The Complainant asserts that it has four European trademark registrations all containing or consisting of the word NEXI. The most recent trademark, with priority date of March 20th, 2018 consists of the words NEXI SMARTPOS.

The Complainant asserts it is the sole and exclusive owner of the trademarks NEXI, NEXI PAYMENTS, NEXI PAY&CASH and NEXI SMARTPOS.

The disputed domain name wholly incorporates the Complainant's NEXI and NEXI SMARTPOS registered trademarks.

When a domain name wholly incorporates a complainant's registered trademark, it is sufficient to establish identity or confusing similarity for the purposes of the Policy. See Oki Data Americas, Inc. v. ASD, Inc, WIPO Case No. D2001-0902.

The top-level suffix '.com' is also generally irrelevant when assessing whether a domain name is identical or confusingly similar to a trademark. This is because gTLDs are only required for functionality of a website. See Proactiva Medio Ambiente, S.A. v. Proactiva, WIPO Case No. D 2012-0182.

The Complainant asserts that a google search of the term NEXI discloses only results related to the Complainant and provides evidence of the Group's reputation of its product in Italy.

The disputed domain name here is identical to or similar to the Complainant's trademarks NEXI or NEXI SMARTPOS. Although no evidence of actual confusion has been provided by the Complainant, the Panel, having reviewed the evidence of reputation in support of the Complainant's case, is satisfied that the disputed domain name is likely to cause confusion amongst Internet users given the nature and wide use of the Complainant's trademarks in the classes of goods or services in which they are registered.

Accordingly, the Panel finds that the disputed domain name <nexismartpos.com> is not only identical to but confusingly similar to the Complainant's registered trademarks and that paragraph 4(a)(i) of the Policy is satisfied.

Paragraph 4(a)(ii) - NO RIGHTS OR LEGITIMATE INTERESTS

The burden of proof is on the Complainant to establish that the Respondent lacks rights or legitimate interests in the disputed domain name. Under the UDRP, if a prima facie case is established by the Complainant, then the burden of

production of evidence shifts to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. See Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110; Audi AG v. Dr. Alireza Fahimipour, WIPO Case No. DIR2006-0003.

The Complainant contends that the Respondent has made no use of, or demonstrable preparations to use, the domain name in connection with a bona fide offering of goods or services, is not making a legitimate non-commercial or fair use of the disputed domain names and is not commonly known under the disputed domain names (referring to paragraph 4(c) of the Policy).

The Respondent did not submit a response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, and the Panel draws inferences from this failure to respond, in accordance with paragraph 14(b) of the Rules for Uniform Domain Name Dispute Resolution Policy.

The Complainant's evidence suggests that the disputed domain name has not been used in connection with bona fide offerings of goods or services. The domain name currently redirects to an inactive web page. The Complainant also asserts that the webpage has never been used. These assertions remain unchallenged by the Respondent.

In any event, the Panel considers that it cannot be inferred that the disputed domain name is for use in a fair or legitimate manner, as the disputed domain name pertains to a product created by the Complainant. The Complainant has asserted that the Respondent holds no connection to the Nexi Group, either as a dealer, agent, distributor, wholesaler or retailer of the Complainant. The Panel is satisfied that use of the disputed domain name cannot be connected to the Complainant, the Nexi Group or their products to which the trademarks apply.

In the circumstances, the Panel is satisfied that there is no actual or contemplated active use by the Respondent of the disputed domain name that would be legitimate. On the contrary, given the priority date of the trademark NEXI SMARTPOS any such use by the Respondent, to which no evidence to the contrary has been submitted, of the disputed domain name would likely mislead and direct customers or businesses away from the Complainant's legitimate websites.

By the lack of any response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of <nexismartpos.com> and that paragraph 4(a)(ii) of the policy is satisfied.

Paragaph 4(a)(iii) - BAD FAITH

For the purposes of paragraph 4(a)(iii), paragraph 4(b) of the Policy states that any of the following circumstances shall be considered evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or has 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 to a competitor of that complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the Respondent has 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) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's web site 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 web site or location or of a product or service on the

Respondent's web site or location.

The Complainant has generally dealt with the circumstances set out in paragraph 4(b) of the Policy.

The Complainant asserts that it is significant that the disputed domain name was registered the same day the Complainant filed its EU trademark application for NEXI SMARTPOS. The Complainant provides evidence that it had earlier used the mark NEXI SMARTPOS as to its product offering prior to the filing date.

In these circumstances, the Panel draws the inference that the timing of the registration of the disputed domain name suggests that the Respondent intended to capitalise on the new product released by the Complainant, which would offer commercial value of the disputed domain name.

The Panel is satisfied that the Respondent would have had knowledge of the Complainant's NEXI trademarks given the high degree of the Complainant's reputation in its field at the time of registration of the disputed domain name. An inference can therefore be drawn that the acquisition of the disputed domain name by the Respondent is for commercial reasons as set out in paragraph 4(b)(i) of the Policy.

The Complainant asserts that the use of a privacy protection service when registering the disputed domain name is evidence of the Respondent's bad faith.

The Panel is satisfied that the concealment of the Respondent's identity was intended to 'make it difficult for a brand owner to protect its trademarks against infringement, dilution and cybersquatting'. See Oculus VR, LLC v. PrivacyGuardian.org / Vildan Erdogan, WIPO Case No. D2018-0464) where the Respondent was himself involved as a respondent.

The Complainant asserts that the Respondent has in previous cases been found to be in violation of the UDRP Policy, similar to the present Complaint, in support of their bad faith assertion against the Respondent.

In Oculus VR, LLC v. PrivacyGuardian.org / Vildan Erdogan, WIPO Case No. D2018-0464, the domain name <oculusvenues.com> was registered by the Respondent, Mr Erdogan, on October 11 of 2017, the same day the complainant in that case announced the launch of Oculus Venues and filed a EU trademark application. The Respondent, Mr Erdogan, offered the domain name for sale as stated on the website he registered.

In Intesa Sanpaolo S.p.A. v. Domain Administrator, See PrivacyGuardian.org / Vildan Erdogan, WIPO Case No. D2018-0284, the Respondent, Mr Erdogan, offered the domain name he had registered for sale for USD $950.

In Panchain, Inc. v. Domain Administrator, See Privacy Guardian.org/Vildan Erdogan, WIPO Case No. D2018-2808, the Respondent, Mr Erdogan, registered the domain name the same day that 'Panchain Securities, LLC' was incorporated in the State of Delaware.

In each of the cases referred to above, the Respondent, Mr Erdogan, failed to provide any response to the complaints, and the Panel therein proceeded to determine the complaints on a default basis and decided that the domain names be transferred to the respective owners of the trademarks.

The Panel is satisfied that such cases of similarity are highly persuasive in supporting the Complainant's assertion of bad faith based on a pattern of conduct by the Respondent.

The Panel considers that circumstances of the present case are also sufficiently similar to those present in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 where it was decided that passive holding of the disputed domain name, in certain circumstances, could amount to bad faith.

Accordingly, the Panel concludes that the Complainant has satisfied its burden of showing bad faith registration and use of the disputed domain name 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. **NEXISMARTPOS.COM**: Transferred

PANELLISTS

Name	**Professor William Lye, OAM QC**

DATE OF PANEL DECISION 2019-07-02

Publish the Decision