Decision for dispute CAC-UDRP-102538

Case number	CAC-UDRP-102538
Time of filing	2019-06-24 15:38:08
Domain names	unicredt-mobile.com, unicredit-mobile.net, unicredit-bacheca.net, fineco-sicurezza.net

Case administrator

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

Complainant

Organization	UNICREDIT S.p.A.

Complainant representative

Organization	Convey srl

Respondent

Name	Ida Ekkert

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings relating to the disputed domain names.

IDENTIFICATION OF RIGHTS

Complainant owns several trademarks consisting of or containing the “UNICREDIT” and “FINECO” sign, including the European Union Trademark Registration UNICREDIT No. 002911105, registered on July 14, 2009 in classes 9, 16, 35, 36, 38, 39, 41, 42, duly renewed and the Italian Trademark Registration FINECO No. 0001312043, registered on July 1, 2010 in classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

The Complainant is UniCredit S.p.A., an Italian global banking and financial services company and is the third largest banking group in Europe, its network spans 50 markets in 18 countries. Fineco is an Italian financial service company that specializes in online brokerage and a subsidiary of Complainant. In 2016 UniCredit sold 20 % shares to public market and it became a listed company since 2014 in the Italian stock market. In 2017 FinecoBank listed on the Stoxx Europe 600, the index of large cap European companies.

Respondent is Idda Ekkert.

Respondent registered the disputed domain names <unicredt-mobile.com>, <unicredit-mobile.net>, <unicredit-bacheca.net>

and <fineco-sicurezza.net> on December 2018 and January 2019.

The disputed domain name <unicredt-mobile.com> apparently was not redirected to an active web site but to a Google page warning the users of the misleading web site, should the users attempt to see the contents, the web site appeared to be inactive. The disputed domain name <unicredit-bacheca.net> was not redirected to an active website. The disputed domain name <unicredit-mobile.net> was redirected to a web site dedicated to Sky, the Europe's largest media company and pay-TV Broadcaster. The disputed domain name <fineco-sicurezza.net> was redirected to a web site dedicated to providing a video-on-demand service.

A cease and desist letter was sent on April 4, 2019, by e-mail to the domain name registrant's known e-mail address indicated in the WhoIs records.

The Respondent did not provide a reply but the websites corresponding to the disputed domain names <unicredit-mobile.net> and <fineco-sicurezza.net> have been deactivated following the cease and desist letter. The disputed domain name <unicredit-bacheca.net> has been redirected to the same web page where the disputed domain name <unicredt-mobile.com> points.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT:

Complainant argues that the disputed domain names are confusingly similar to its UNICREDIT trademark. Indeed, Complainant states the addition of the generic words "mobile", "sicurezza" (translation of security in Italian) and "bacheca" (translation of noticeboard in Italian) are not sufficient to avoid similarity between the trademark and the domain name.

Complainant contends that Respondent has no rights or legitimate interests in respect of the disputed domain names. Complainant further asserts that Complainant has granted no license or authorization to Respondent to use or register its UNICREDIT trademark in the disputed domain names. The uses of the disputed domain names show that Respondent intended to trade upon the Complainant's trademarks by intentionally attempting to mislead Complainant's users.

Complainant argues that the disputed domain names were registered in bad faith. Complainant further argues that Complainant's UNICREDIT trademark is well-known and it is difficult to imagine that Respondent could have ignored the trademark at the time it applied for the disputed domain names. Respondent registered and used the disputed domain names to intentionally attempt to attract Internet users to its website by creating a risk of confusion.

RESPONDENT

Respondent did not file a response.

RIGHTS

The Panel concludes that Respondent did not file its Response to the Complaint. The Respondent is completely passive and does not respond to notifications of the CAC ADR Center made via the CAC's online platform. Therefore, pursuant to Paragraph B (10) of the ADR Rules the Panel shall proceed to issue a Decision based upon the facts and evidence provided by the Complainant.

Under Article 21 (1) pf the Regulation (EC) No. 874/2004 in order to succeed under the dispute resolution procedure the Complainant must show that the disputed domain name:

(i) is identical or confusingly similar to a name in respect of which a right is recognised or established by national of a

Member State and/or Community law and; either

(ii) has been registered by its holder without rights or legitimate interest in the name; or

(iii) has been registered or is being used in bad faith.

Complainant has duly shown rights over the FINECO and UNICREDIT trademarks, including the European Union Trademark Registration UNICREDIT No. 002911105, registered on July 14, 2009 in classes 9, 16, 35, 36, 38, 39, 41, 42, duly renewed and the Italian Trademark Registration FINECO No. 0001312043, registered on July 1, 2010 in classes 9, 16, 35, 36, 38, 41 and 42.

First, the Respondent has taken the Complainant's trademarks in its entirety, and merely added the generic terms "mobile", "sicurezza" (translation of security in Italian) and "bacheca" (translation of noticeboard in Italian), which is not sufficient to avoid similarity between the trademark and the disputed domain names. Previous panels have found similarity where a domain name included the trademark in its entirety (See Britannia Building Society v. Britannia Fraud Prevention, WIPO Case No. D2001-0505, "the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark". See also Red Bull GmbH v. PREGIO Co., Ltd., WIPO Case No. D2006-0909 "the trademark RED BULL is clearly the most prominent element in this combination, and that may cause the public to think that the domain name <redbull-jp.net> is somehow connected with the owner of RED BULL trademark").

Moreover, the addition of the generic terms as "mobile", which could refer to the sector of mobile banking in which Complainant operates, to the UNICREDIT trademark in the domain name creates a risk of confusion as to the sources of the domain names. A risk of confusion is also created by the combination among the Complainant's trademark and the Italian words "sicurezza" and "bacheca".

Previous panels have found that the mere addition of descriptive words does not provide sufficient distinction from Complainant (See, e.g., Dansko, LLC v. Wenhong Chen Case No. D2012-0583, (concerning <danskooutletonline.com>), in which the Panel found that "the addition of the descriptive words "outlet" and "online" does not provide sufficient distinction from the Complainant.

The Panel therefore finds that there is a likelihood of confusion created as consumers may be led to believe that there is a connection between the disputed domain names and the Complainant's trademarks.

Second, the generic Top-Level Domain ("gTLD") is generally disregarded under the identity or confusing similarity test, as it is a functional element. Thus, the Panel notes that <.com> and <.net> should not be taken into account when comparing the disputed domain names with the claimed trademarks as they are only a technical and necessary part of the domain name with no distinguishing feature nor legal significance (See WIPO Case No. D2016-2234 Figaro Classifieds v. Bernard Elkeslassy).

Therefore, the Panel finds that the disputed domain names are similar to Complainant's trademarks.

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant must show a a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain names, which the Respondent may rebut (see Paragraph I. Procedural questions, section 17 of CAC Panel Views on Selected Questions of the Alternative Dispute Resolution for .EU Domain Name Disputes, 2nd Edition ("CAC .EU Overview 2.0")).

Complainant claims that it has granted no license or authorization to the Respondent to make any use, or register the disputed domain names.

The Panel finds that Complainant has made a prima facie showing of Respondent's lack of rights to or legitimate interest in the disputed domain name.

Moreover, the Panel finds that Respondent's lack of rights or legitimate interests in the disputed domain name can be inferred in the circumstances of this case from Respondent's failure to respond to Complainant's contentions (See Pomellato S.p.A v. Richard Tonetti, WIPO Case No. D2000-0493 : "non-response is indicative of a lack of interests inconsistent with an attitude of ownership and a belief in the lawfulness of one's own rights").

The disputed domain names <unicredit-mobile.net> and <fineco-sicurezza.net> are inactive. The disputed domain name <unicredit-bacheca.net> has been redirected to the same web page where the disputed domain name <unicredt-mobile.com> points.

The uses of the disputed domain names show that there is no bona fide offering of goods or services nor legitimate non-commercial or fair use of the disputed domain names (See Deutsche Kreditbank AG v. DKB Data Services (USA), Inc. WIPO Case No. D2009-1084: "there is no evidence provided which would satisfy paragraph 4 (c) (i) or (ii) of the Policy in the Respondent's favour. That is, there is no functioning website available from the disputed domain name (and there is no legitimate non-commercial or fair use), and there is no evidence that there ever was a functioning website prior to the Complaint being filed").

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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

First, Previous panels have found that Complainant's UNICREDIT trademark is well-known in several countries in the sector of banking and financial services (See UniCredit S.p.A. v. Registration Private / Guido Eugenio Ramella WIPO Case No. D2014-1933 and UniCredit S.p.A. v. Highview Ventures LLC CAC Case No. 102085: "the Complainant's UNICREDIT trademark is well-known for financial services, well before the registration of the disputed domain name. The Respondent's registration, of the disputed domain name wholly incorporating a well-known third party mark is, in the Panel's view, indicative of bad faith since the Respondent's website is offering financial services. Therefore, the Complainant's trade mark and company name are unfairly exploited for the Respondent's commercial interest".)

The Panel therefore finds that Respondent could not have ignored the UNICREDIT trademark at the time it registered the disputed domain names (December 2018 and January 2019).

Second, the UNICREDIT trademark being an invented word, is highly distinctive. This distinctiveness, and the adjunction of the generic terms 'sicurezza", "mobile" and "bacheca" creates confusion as to the sources of the domain names. The Panel therefore finds that Respondent intentionally attempted to mislead Complainant's users in order to trade upon the Complainant's trademarks.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are 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

The Panel finds that Complainant has duly shown over the FINECO and UNICREDIT trademarks, including the European Union Trademark Registration UNICREDIT No. 002911105, registered on July 14, 2009 in classes 9, 16, 35, 36, 38, 39, 41, 42, duly renewed and the Italian Trademark Registration FINECO No. 0001312043, registered on July 1, 2010 in classes 9, 16, 35, 36, 38, 41 and 42.

The Panel finds that the disputed domain names are identical or confusingly similar to Complainant's trademarks, have been

registered by its holder without rights or legitimate interest in the name and have been registered or are being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UNICREDT-MOBILE.COM**: Transferred
2. **UNICREDIT-MOBILE.NET**: Transferred
3. **UNICREDIT-BACHECA.NET**: Transferred
4. **FINECO-SICUREZZA.NET**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2019-07-31

Publish the Decision