Decision for dispute CAC-UDRP-102722

Case number	CAC-UDRP-102722
Time of filing	2019-10-16 11:56:13
Domain names	EURIZONREALASSET.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.
Organization	Eurizon Capital SGR S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	Super Privacy Service LTD c/o Dynadot

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following registrations for the trademarks “EURIZON REAL ASSET”, “EURIZON”, “EURIZON ASSET MANAGEMENT” and “INTESA EURIZON ASSET MANAGEMENT BELGRADE”:

-EU trademark registration n. 18107327 “EURIZON REAL ASSET”, filed on August 12, 2019 in classes 9, 16, 35, 36, 41 and 42;
-International trademark registration n. 1338441 “EURIZON”, granted on December 15, 2016, in class 36;
-International trademark registration n. 1015255 “INTESA EURIZON ASSET MANAGEMENT BELGRADE”, granted on August 6, 2009, and duly renewed, in classes 9, 16, 35, 36, 41 and 42;
-EU trademark registration n. 8447815 “INTESA EURIZON ASSET MANAGEMENT BELGRADE”, applied on July 24, 2009 and granted on January 12, 2010, in classes 9, 16, 35, 36, 41 and 42.
-EU trademark registration n. 16476418 “EURIZON ASSET MANAGEMENT & device”, applied on March 16, 2017 and granted on August 7, 2017, in classes 9, 16, 35, 36, 41 and 42.

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 the leading Italian banking group and also one of the protagonists in the European financial arena. Intesa Sanpaolo is the company resulting from the merger (effective as of January 1, 2007) between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups.

Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalization exceeding 38.1 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 16% in most Italian regions, the Group offers its services to approximately 11.8 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1,100 branches and over 7.2 million customers. Moreover, the international network specialized in supporting corporate customers is present in 25 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.

Eurizon Capital SGR is the asset management company of the Intesa Sanpaolo Group, specialized in products for retail and institutional customers. Such company manages assets of around 255.4 billion Euros, and controls a market share of 15,3%, making it one of the largest Italian asset managers. On the other side, Eurizon Capital SA is an asset management company established in 1988 in the Grand Duchy of Luxembourg and fully owned by Eurizon Capital SGR, which manages and distributes Luxembourg based collective investment funds for retail and institutional clients. In Luxembourg, the company offers a broad range of services dedicated to institutional investors, including the possibility of setting up customized collective investment funds.

The Complainant is the owner, among others, of the following registrations for the trademarks “EURIZON REAL ASSET”, “EURIZON”, “EURIZON ASSET MANAGEMENT” and “INTESA EURIZON ASSET MANAGEMENT BELGRADE”:

-EU trademark registration n. 18107327 “EURIZON REAL ASSET”, filed on August 12, 2019 in classes 9, 16, 35, 36, 41 and 42;
-International trademark registration n. 1338441 “EURIZON”, granted on December 15, 2016, in class 36;
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-EU trademark registration n. 8447815 “INTESA EURIZON ASSET MANAGEMENT BELGRADE”, applied on July 24, 2009 and granted on January 12, 2010, in classes 9, 16, 35, 36, 41 and 42.
-EU trademark registration n. 16476418 “EURIZON ASSET MANAGEMENT & device”, applied on March 16, 2017 and granted on August 7, 2017, in classes 9, 16, 35, 36, 41 and 42.

The disputed domain name was registered on August 12, 2019.

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 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
(2) Respondent has no rights or legitimate interests in respect of the domain name; and
(3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (FORUM July 31, 2000) (holding that the respondent’s failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Rights

The Panel observes that the Complainant is the owner, among others, of the following registrations for the trademarks:

-International trademark registration n. 1338441 “EURIZON”, granted on December 15, 2016, in class 36; and

-EU trademark registration n. 16476418 “EURIZON ASSET MANAGEMENT & device”, granted on August 7, 2017, in classes 9, 16, 35, 36, 41 and 42.

The Panel notes that trademark registrations with the EUIPO and the WIPO are sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the marks “EURIZON” and “EURIZON ASSET MANAGEMENT & device”.

The Complainant further contends that the disputed domain name is confusingly similar to its marks “EURIZON” and “EURIZON ASSET MANAGEMENT”. In particular, the disputed domain name reproduces the trademarks “EURIZON ASSET MANAGEMENT”, with the mere omission of the verbal portion “management”, and the addition of the English word “real” between the terms “EURIZON” and “ASSET”.

The Panel notes that the disputed domain name incorporates the Complainant’s mark “EURIZON” and the portion “EURIZON ASSET” of the mark “EURIZON ASSET MANAGEMENT & device” with the mere omission of the non-distinctive portion “management”, and the addition of the descriptive English word “real” between the terms “EURIZON” and “ASSET”. Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's marks “EURIZON” and

“EURIZON ASSET MANAGEMENT”.

No rights or legitimate interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy). See also Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that the Respondent has no rights on the disputed domain name: it has never granted the Respondent any right to use the Complainant's trademarks within the disputed domain name; the disputed domain name does not correspond to the name of the Respondent; the Respondent is not commonly known by the disputed domain name; and there are no fair or non-commercial uses of the disputed domain name. The Complainant submitted a screenshot of the disputed domain name's resolved website.

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

The Complainant contends that the disputed domain name was registered and is used in bad faith. The Complainant’s trademarks “EURIZON” and “EURIZON ASSET MANAGEMENT” are distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent must have had actual knowledge of the Complainant’s trademark at the time of registration of the disputed domain name.

The Panel infers, due to the notoriety of the Complainant's marks that the Respondent had actual knowledge of the Complainant’s rights in the Complainant’s trademarks “EURIZON” and “EURIZON ASSET MANAGEMENT” prior to its registration of the disputed domain name, and thus the Respondent's registration of the disputed domain name constitutes bad faith per paragraph 4(a)(iii) of the Policy.

Next, the Complainant contends that the disputed domain name is not used for any bone fide offerings. More particularly, there are circumstances indicating that the Respondent has registered or acquired the disputed 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 or to a competitor of Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy). It has been noted that the disputed domain name redirects to a parking page in which the same is offered for sale for the amount of USD 990.00. The Complainant has underlined several WIPO decisions stating: “Although Respondent’s offer of the disputed Domain Name for sale was not made specifically to Complainant or its competitor, offers for sale to the public may nevertheless constitute evidence of bad faith under the Policy” (United Artists Theatre Circuit Inc. v. Domains for Sale Inc., WIPO Case No. D2002-0005, March 27, 2002).

The Panel agrees with the Complainant and finds that the Respondent’s offer of the disputed domain name for sale to the public for the amount of USD 990.00 constitutes bad faith registration and use of the disputed domain name per paragraph 4(b)(i) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **EURIZONREALASSET.COM**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2019-11-28

Publish the Decision