Decision for dispute CAC-UDRP-103366

Case number	CAC-UDRP-103366
Time of filing	2020-11-02 12:44:16
Domain names	eurizoncapitalspain.com

Case administrator

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

Complainant

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

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Angel Gonzalez

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant, Intesa Sanpaolo S.p.A., owns the following trademarks containing the expressions “EURIZON” and "EURIZON CAPITAL":

- International trademark registration n. 1338441 “EURIZON” registered since December 15, 2016 in class 36;

- EU trademark registration n. 13847587 “EURIZON” applied for on March 18, 2015 and registered since August 31,2015 in classes 9, 16, 35, 36, 41 and 42;

- EU trademark registration n. 5283460 “EURIZON CAPITAL” applied for on August 8, 2006 and registered since June 21, 2007 in class 36.

The Complainants are owners of a wide domain name portfolio containing the expression "EURIZONCAPITAL" registered under numerous TLDs, among which the domain names <eurizoncapital.com> and <eurizoncapital.it>.

The Complainant, Eurizon Capital SGR, has carried on business and provided its services under the company name Eurizon Capital.

The Complainants have proved their rights in the EURIZON and EURIZON CAPITAL trademarks for the purposes of the Policy.

FACTUAL BACKGROUND

The Complainants

Intesa Sanpaolo S.p.A. is a leading Italian banking group and one of the top players of the European financial arena, born from the merger of Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. effective as of January 1, 2007.

Intesa Sanpaolo S.p.A. is among the largest financial institutions in the Euro zone, with a market capitalisation exceeding 31,1 billion Euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,800 branches capillary and well distributed throughout Italy, with market shares of more than 15% in most Italian regions, the Group offers its services to approximately 11,8 million customers. It has also a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,2 million customers. Moreover, the international network specialised 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, specialised in products for retail and institutional customers. Such company manages assets of around 332 billion Euros, and controls a market share of 14,8%, 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 disputed domain name

The disputed domain name was registered on September 4, 2020 by Angel Gonzalez, an individual residing in Spain. At the moment of the filing of the Complaint the disputed domain name resolved to a website in Spanish language related to banking and financial services.

After registration of the disputed domain name the Complainant sent a cease and desist letter to the Respondent without obtaining any response.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

The Parties' Contentions

The Complainants' contentions:

The Complainants contend that the disputed domain name is identical or, at least, confusingly similar to the Complainants' EURIZON trademarks, while it is identical to the EURIZON CAPITAL trademark, since it exactly reproduces such marks, with the mere addition of the geographical term "SPAIN", which is merely descriptive.

The Complainants contend that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainants affirm that neither license nor authorization has been granted to the Respondent to make any use of the Complainants' trademarks, or apply for registration of the disputed domain name. The disputed domain name does not correspond to the name of the Respondent and, to the best of the Complainants' knowledge, the Respondent is not commonly known as "EURIZONCAPITALSPAIN". According to the Complainants, the use of the disputed domain name is not a fair or noncommercial use.

The Complainants finally contend that the registration of the disputed domain name, confusingly similar to the Complainants' well-known trademarks and, thus, the constructive knowledge on behalf of the Respondent of the Complainants' potential rights, as well as the use of the disputed domain name for a website related to banking and financial services, clearly shows the Respondent's bad faith both in the registration and in the use of the disputed domain name.

The Respondent's contentions:

No administratively compliant Response has been filed.

RIGHTS

The Complainants have, 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 Complainants have rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, 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 Complainants have, 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 Complainants to prove each of the following three elements to obtain the transfer or the cancellation of the domain name:

(1) the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and

(2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

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

1. THE COMPLAINANTS' RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANTS' MARK

The Complainants have provided sufficient documentary evidences to demonstrate to be owner of the EURIZON and EURIZON CAPITAL trademarks since 2006.

In assessing identity or confusing similarity the Panel finds that the disputed domain name incorporates the entirety of the Complainants' trademarks and differs from such marks by merely adding the generic and geographic term “SPAIN” and the top-level domain name “.COM". Thus, the disputed domain name is confusingly similar to the Complainants' trademarks.

In UDRP cases where the relevant trademark is recognizable within the disputed domain name, Panels agree that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element (see paragraph 1.7 WIPO Overview 3.0).

UDRP panels also agree that the top-level domain is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant’s trademark as it is a technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the Complainants have proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainants' marks.

2. THE RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP panels that the complainant shall establish a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the respondent (see paragraph 2.1 WIPO Overview 3.0: "where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element").

The Complainants affirm that Respondent has never received any approval of the Complainants, expressed or implied, to use the Complainants' trademarks or to register and use the disputed domain name.

The disputed domain name was registered on September 4, 2020 by Angel Gonzalez, an individual residing in Spain. Therefore, there is no evidence that the Respondent has been commonly known by the disputed domain name or has acquired any trademark or service mark right in the expression "EURIZONCAPITALSPAIN".

The expression "EURIZON" is a fanciful sign and has no dictionary meaning.

UDRP panels have held that where a domain name consists of a trademark plus an additional term (at the second – or top-level), such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. Geographic terms (e.g., name of a country or a city) are seen as tending to suggest sponsorship or endorsement by the trademark owner (see paragraph 2.5.1 WIPO Overview 3.0).

At the moment of the filing of the Complaint the disputed domain name resolved to a website in Spanish language related to banking and financial services, business in which the Complainants are involved. Such use of the disputed domain name is clearly not a legitimate noncommercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainants’ marks (see paragraph 2.5.3 WIPO Overview 3.0: "a respondent’s use of a complainant’s mark to redirect users (e.g., to a competing site) would not support a claim to rights or legitimate interests").

While the Complainants have established their prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainants have met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

3. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Respondent has registered the disputed domain name which is to be considered confusingly similar to Complainants' marks, since it incorporates the EURIZON and EURIZON CAPITAL trademarks in their entirety and differs from those marks merely by adding the generic and geographic term “SPAIN" and the TLD “.COM" (which is disregarded for the purpose of determination of confusing similarity between the disputed domain name and the trademarks of the Complainants as it is a technical requirement of registration).

Given the distinctiveness and reputation of the Complainants and their marks, it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainants' rights in such marks and the intention to exploit such reputation by diverting traffic away from the Complainants’ website(s).

The Complainants have also submitted the results of a Google search on the term “EURIZON”, all of them related to the Complainants, and affirmed that, due to the reputation of the Complainants' marks worldwide, the Respondent had registered the disputed domain name with full knowledge of the Complainants' marks.

At the moment of the filing of the Complaint the disputed domain name resolved to a website in Spanish language related to banking and financial services, thus, competing with the business of the Complainants.

Taken into account the above-mentioned circumstances, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainants and their marks (paragraph 4(b)(iv) of the Policy).

Therefore, the Panel finds that the Complainants have discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (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. **EURIZONCAPITALSPAIN.COM**: Transferred

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2020-12-01

Publish the Decision