

Decision for dispute CAC-UDRP-104053

Case number	CAC-UDRP-104053
Time of filing	2021-10-04 09:56:32
Domain names	EPSILONCAPTIAL.COM

Case administrator

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

Complainant

Organization	Intesa Sanpaolo S.p.A.
Organization	Epsilon SGR S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.
--------------	-------------------------------

Respondent

Name	seda saygin
------	--------------------

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 First Complainant Intesa Sanpaolo S.p.A. is the owner of:

- UK trademark registration n. 3283159 "EPSILON", filed on January 17, 2018 and granted on June 22, 2018, in connection with class 36.

Second Complainant Epsilon SGR S.p.A. is the owner of the following registrations for the trademark "EPSILON":

- EU trademark registration n. 1642537 "EPSILON", filed on May 5, 2000, granted on July 3, 2001 and duly renewed, in connection with class 36;

- Italian trademark registration n. 1495669 "EPSILON", filed on November 30, 2011 and granted on June 6, 2012, in connection with class 36;

- Benelux trademark registration n. 1237240 "EPSILON", filed on November 30, 2011 and granted on March 12, 2012, in connection with class 36.

First Complainant Intesa Sanpaolo S.p.A. is also the owner of the following domain names including the term "EPSILON": EPSILON-CAPITAL.CO.UK, EPSILONFUND.COM, EPSILONFUND.NETWORK, EPSILONINVESTMENT.COM, EPSILON-INVESTMENTS.COM, EPSILON-INVESTMENTS.FR.

Second Complainant Epsilon SGR is also the owner of the following domain names including the term "EPSILON": EPSILONSGR.IT, and EPSILONSGR.COM.

FACTUAL BACKGROUND

The First Complainant (Intesa Sanpaolo S.p.A.) is the leading Italian banking group resulting from the merger (effective as of January 1, 2007) between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A.

Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 46,6 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,300 branches capillary and well distributed throughout the Country, with market shares of more than 19% in most Italian regions, the Group offers its services to approximately 13,5 million customers.

The Second Complainant (Epsilon SGR S.p.A., established in 1997) is an asset management company of the Intesa Sanpaolo Group, specialized in portfolio management services.

Together the First and Second Complainants own several trademarks and domain names, characterised by the presence of the distinctive term "EPSILON".

On June 17, 2020 the Respondent, Seda Saygin, an individual located in Turkey, registered the disputed domain name <EPSILONCAPTIAL.COM>.

The disputed domain name redirects to a parking page in which the domain is offered for sale for USD \$988.

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

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

1. PRELIMINARY ISSUE – CONSOLIDATION OF COMPLAINANTS

The Panel notes that the present Complaint has been filed by two Complainants. On this subject, paragraph 4.11.1 of the WIPO Overview 3.0 provides inter alia as follows:

"Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes.

...

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation."

The Panel is satisfied that the First Complainant and Second Complainant each have rights in the EPSILON mark as set out in the Identification of Rights section above. The First Complainant and Second Complainant assert that they have been the target of common conduct by Respondent such that there is a common grievance on the part of each of them and a single disputed domain name so it would be procedurally efficient to deal with all matters in the one proceeding. Moreover, First Complainant and Second Complainant are related entities within the Intesa Sanpaolo Group and have the same representative in this Complaint, further factors in support of consolidation. Respondent has not filed a Response and thus remains silent on this issue.

The Panel finds that First and Second Complainants have established that they have a common grievance against Respondent which would affect their individual rights on substantially the same basis. Respondent has not indicated that it would suffer any prejudice from consolidation of the complaints and no potential prejudice is apparent to the Panel. Respondent has not otherwise contested the request for consolidation. Accordingly, the Panel determines that it is procedurally efficient to permit the consolidation and is content that such consolidation is equitable to all Parties. Regarding the remedy sought by Complainants, the Panel notes that, if the Complaint succeeds, First and Second Complainants have specifically requested that the disputed domain name be transferred to the First Complainant.

Hereinafter, the First Complainant and Second Complainant are referred to collectively as "Complainant".

2. THREE ELEMENTS COMPLAINANT MUST ESTABLISH UNDER THE POLICY

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the Disputed domain name should be transferred or cancelled:

- (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 rights 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 has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S RIGHTS

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term EPSILON for insurance, financial affairs, monetary affairs and real estate affairs. Further, the Complainant is the owner of multiple domain names that incorporate its trademark including <EPSILON-CAPITAL.CO.UK> and <EPSILONINVESTMENT.COM>. All of the above were created and registered prior to the June 17, 2020, the creation date of the disputed domain name. As such, the Panel finds that the Complainant possesses rights in its EPSILON trademark.

UDRP panels have held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011) („the mere addition of the words ‚Ninjago‘ and ‚Kai‘ is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant’s trademark.“).

In the present case, the disputed domain name consists of the EPSILON trademark followed by the term “CAPTIAL”, almost certainly a typo-variant of the descriptive term “CAPITAL”. In assessing confusing similarity, the Panel finds the disputed domain name is confusingly similar to the Complainant’s trademark, as it incorporates the entirety of the EPSILON trademark, and differs from such mark merely by adding the generic and descriptive typo-variant term “CAPTIAL”, as previously noted, a variation of “CAPITAL”. In this case, the addition of a term related to the Complainant’s business (which includes monetary, financial and real estate affairs) serves to increase the likelihood of confusion between the Disputed domain name and the Complainant’s trademark. Panel notes that Complainant does not claim trademark usage of the term “CAPITAL” in connection with its mark “EPSILON”, but merely asserts that “CAPITAL” refers to Complainant’s professional area.

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

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain name is confusingly similar to Complainant’s mark.

(B) RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The second element of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests in the disputed domain name. The generally adopted approach by UDRP panels, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

However, the burden of proof still remains with the Complainant to make out its prima facie case on a balance of probabilities; see, for example, CAC Case No. 102263, Intesa Sanpaolo S.p.A. v Ida Ekkert. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name in issue. Simply establishing that the complainant also has rights in the domain name in issue is insufficient.

In the present case, the Complainant asserts that the Respondent is not commonly known by the disputed domain name, is not in any way related to the Complainant, nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent has not responded in any form and thus has failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

Therefore, the Panel concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest to the disputed domain name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The third element requires Complainant to show that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. *Hallmark Licensing, LLC v. EWebMall, Inc.*, Case No. D2015-2202 (WIPO, February 12, 2016) (“The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.”).

For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name. Complainant submits the Respondent is not commonly known under the disputed domain name and that Respondent has never been authorized by Complainant to use the Complainant’s trademark(s) or register the disputed domain name. This prima facie evidence has not been challenged by the Respondent.

Further, the Complainant asserts that its EPSILON trademarks are distinctive and well-known around the world. The Panel considers that it does not have sufficient evidence to support a finding that the Complainant’s EPSILON trademarks are indeed well-known and the Complainant has not pointed the Panel to any other decisions that contained such a finding. However, the name EPSILON, when combined with the generic term “CAPITAL” may be seen as distinctive (see e.g. *ZB, N.A., dba Zions First National Bank and ZB, N.A., dba Amegy Bank v. Cameron David Jackson* WIPO Case No. D2016-1452 which held “the addition of the common and descriptive terms “national”, “association”, “corp”, “bank”, “loanadministration” and “banking” which exacerbate rather than relieve confusion.”).

Additionally, Complainant adduced evidence to show that, if the Respondent had carried out Google search for the term EPSILON CAPITAL, the search results would have yielded immediate and obvious references to the Complainant. It is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical, or confusingly similar to, the Complainant’s trademarks and that they registered the disputed domain name with knowledge of the Complainant’s trademarks.

In the present case, the disputed domain name redirects to a parking page in which the domain is offered for sale for USD \$988. While registering a domain for subsequent resale does not necessarily, without more, support a claim for bad faith, the surrounding circumstances may be factored into the inquiry. Here, the disputed domain name wholly incorporates Complainant’s mark plus the term “CAPTIAL” a typo-variate of “CAPITAL”. “CAPITAL” is a term related to Complainant’s area of commercial activity (which includes monetary, financial and real estate affairs). Due to the use of the typo-variant form of the related term - and in the absence of any explanation from Respondent - the Panel does not see how the Respondent could use the disputed domain name for a good faith purpose. “CAPTIAL” has no meaning in the English language, although it can easily be a mis-typed version of “CAPITAL”. The use of the typo-variant of the related term negates the potential for legitimate use of the disputed domain name, and is one of the surrounding circumstances that weighs in favor of a finding of bad faith. Further, the offer to sell the domain indicates that employment of the Complainant’s trademark serves to trade on that trademark in violation of the Complainant’s rights, as prohibited under paragraph 4(b)(i) and 4(b)(iv) of the Policy.

While Complainant mentions that financial institutions such as Complainant are frequently targeted for improper, diversionary domain name registrations due to the high number of online banking users, Complainant has not asserted that the present case involves or concerns such diversionary tactics.

The failure of the Respondent to reply to the cease and desist letter sent by the Complainant’s attorneys on February 2, 2021

may be seen as further evidence of bad faith (see e.g. Coutts & Co. v. Sande Skalnik, Patrick Harding, WIPO Case No. D2015-1590; Citrix Systems, Inc. v. Domains by Proxy, LLC / Sirishareddy Idamakanti - Sirisha Idamaknti, WIPO Case No. D2015-0017; E. & J. Gallo Winery v. Oak Investment Group, WIPO Case No. D2000-1213; Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party, WIPO Case No. D2000-0330).

Therefore, in light of the above analysis, the Panel concludes that the Complainant made out its case that the disputed domain name was registered and is being used in bad faith, and thus has satisfied the requirement 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. **EPSILONCAPTIAL.COM**: Transferred

PANELLISTS

Name	Claire Kowarsky, LL.M
------	-----------------------

DATE OF PANEL DECISION 2021-10-30

Publish the Decision