

Decision for dispute CAC-UDRP-104682

Case number	CAC-UDRP-104682
Time of filing	2022-06-29 16:00:12
Domain names	ASSICURAZIONISISALMOONEY.COM

Case administrator

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

Organization	Mooney S.p.A.
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Complainant representative

Organization	Perani Pozzi Associati
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Respondent

Name	Eleonora Beato
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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 Complainant is the owner, among others, of the following registrations for the trademarks "Sisalpay" and "Mooney":

- International trademark registration n. 1547324 "Mooney", granted on June 18, 2020, in connection with classes 9, 36, 37, 38 and 42; and
- EU trademark registration n. 018248141 "Mooney", granted on September 16, 2020, in connection with classes 9, 36, 37 and 38; and
- Italian trademark registration n. 302020000038617 "MOONEY", filed on May 20, 2020, granted on October 7, 2020, in connection with classes 9, 36, 37, 38 and 42; and
- Italian trademark registration n. 3020190000034785 "SISALPAY & device", filed on May 31, 2019, granted on March 16, 2020, in connection with classes 9, 16, 36 and 38.

Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the sign “Mooney”: MOONEY.JP, MOONEY.AR, MOONEY.LU, MOONEY.CO.TH, MOONEYGO.NL, MOONEYGO.DE, MOONEYGO.FI, MOONEYGO.PL. All of them are now connected to the official website <https://www.mooney.it/> home page.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is Mooney S.p.A. is a company born in December 2019, thanks to the agreement between SisalPay and Banca 5 (Intesa Sanpaolo Group), that offers excellence and security in payments. In particular, Mooney S.p.A. makes payment services and all transactional operations always available thanks to a network of over 45,000 points of sale - tabacconists, bars and newsstands - and the most modern digital platforms. The union of SisalPay and Banca 5 has made it possible to make people's relationship with banking and payments more accessible and familiar, promoting, throughout the country, a new simple and fast lifestyle. In this way Mooney S.p.A. has become the first Proximity Banking & Payments company in Italy.

On March 30, 2022 the Respondent registered the domain name <SSICURAZIONISISALMOONEY.COM>.

The Complainant contested that it is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant's trademarks “MOONEY” and “SISALPAY”. As a matter of fact, the disputed domain name is almost identical to Complainant's trademarks, with the mere addition of the generic term “ASSICURAZIONI” at the beginning does not change the impression. ASSICURAZIONI is the Italian word for assurance or insurance and close to the financial business in costumers' view.

The Respondent has no rights on the disputed domain name, and any use of the trademarks “Sisal” and “Mooney” has to be authorized by the Complainant. Nobody has been authorized or licensed by the company group of the complainant to use the domain name at issue.

The disputed domain name at stake does not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as “ASSICURAZIONISISALMOONEY”.

Lastly, there is no fair or non-commercial uses of the domain name at stake.

The disputed domain name was registered and is used in bad faith.

The Complainant's trademarks “SISAL” and “MOONEY” are distinctive and well known in the country where the Respondent lives. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wording “Sisal” or “Mooney”, the same would have yielded obvious references to the Complainant. Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant's trademark. This is clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bona fide offerings. More particularly, there are present circumstances indicating that, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site (paragraph 4(b)(iv) of the Policy).

First of all, several services can be detected, but not in good faith: in fact, the domain name is connected to a website that resembles one of the Complainant's official websites with financial services, for whom the Complainant's trademarks are registered and used.

Consequently, Internet users, while searching for information on the Complainant's services, are confusingly led to the websites of the Complainant's competitors, sponsored on the websites connected to the domain name at issue.

Therefore, the Complainant deems that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant's web site.

Several WIPO decisions stated that the registration and use of a domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy. See, e.g., *Encyclopaedia Britannica Inc. v. Shedon.com*, WIPO Case No. D2000-0753 ("Respondent's Ownership of a site which is a mis-spelling of Complainant's britannica.com site and which Respondent used to hyperlink to a gambling site demonstrates Respondent's bad faith registration and use of the britannica.com domain name"); *YAHOO! INC. v. David Murray*, Case No. D2000-1013 (finding bad faith where respondent chooses a domain name similar to the complainant's mark for a site which offers services similar to the complainant); *Edmunds.com v. Ultimate Search, Inc.*, WIPO Case No. D2001-1319 ("Registration and use of a domain name to redirect Internet users to websites of competing organizations constitutes bad faith registration and use under the Policy"); *Netwizards, Inc. v. Spectrum Enterprises*, WIPO Case No. D2000-1768 ("Registration and continued use of the contested domain name for re-directing Internet users, i.e. particularly customers and potential customers of the Complainant, from the Complainant's website to the website of...a company which directly competes with the Complainant, constitutes bad faith registration and use"); *Oly Holigan, L.P. v. Private*, Case No. FA0011000095940 (finding bad faith where respondent used the disputed domain name to "redirect the Complainant's consumers and potential consumers to commercial websites which are not affiliated with Complainant"); *Marriott International, Inc. v. Kyznetsov*, Case No. FA0009000095648 (finding bad faith where respondent registered the domain name <marriottrewards.com> and used it to route internet traffic to another website that "promotes travel and hotel services . . . identical to the services offered by the Complainant"); *Zwack Unicom Ltd v. Duna*, WIPO Case No. D2000-0037 (respondent's linking to complainant's competitor held to constitute bad faith); *Schneider Electric SA v. Ningbo Wecans Network Technology Co., Ltd, Ningbo Eurosin International Trade Co., Ltd.*, Case No. D2004-0554; *Microsoft Corporation v. StepWeb*, Case No. D2000-1500; *Baudville, Inc. v. Henry Chan*, Case No. D2004-0059; *National City Corporation v. MH Networks LLC*, Case No. D2004-0128.

The current use of the disputed domain name, which allows accessing to the web sites of the Complainant's competitors, also through the Complainant's trademark, causes, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones. So, the Respondent's conduct is even worse (see WIPO Decisions n. D2000-1500, *Microsoft Corporation v. StepWeb*, and D2001-1335, *The Vanguard Group, Inc v. Venta*).

The Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated.

It is no coincidence that this speculation has involved a big financial institution such as the Complainant. In fact, the diversion practice in banking realm is very frequent due to the high number of online banking users. In fact, it has also to be pointed out that the Complainant has already been part of other WIPO Cases where the panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations.

The Complainant summarized, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ..."

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

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

It is necessary for the Complainant, if he is to succeed in this administrative proceeding, to prove each of the three elements referred to in paragraph 4(a) of the Policy, namely that:

- (i) the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interest 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 will proceed to establish whether the Complainant has discharged the burden of proof in respect of the three elements referred to above.

With respect to Complainant's rights, the alleged registration of the disputed domain name without rights or legitimate interest and bad faith, the Panel holds as follows:

The Complainant is the leading Italian financial institute. It is the company resulting from the merger (2019) between SISALPAY and Banca 5 two of well-known Italian banking groups.

It is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the abovementioned trademarks. In particular, the domain name at issue exactly reproduces the trademark “MOONEY”, with the mere addition of the Italian word “ASSICURAZIONI” (meaning “insurances”) and of the term “SISAL”, with obvious reference to the Complainant's trademarks “SISALPAY” and to payment services offered by Mooney S.p.A., for which the above-mentioned trademarks have been registered and are used.

Reference is made also to: CAC case N° 101036, Boehringer Ingelheim Pharma GmbH & Co. KG vs. SKYRXSHOP - <dulcolax.xyz> and WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI

HUSADA.

In addition, the disputed domain name is not used for any bona fide offerings. More particularly, there are present circumstances indicating that, by using the domain name, the Respondent has registered or acquired the domain name primarily for the purpose of fraud, selling or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name (paragraph 4(b)(i) of the Policy).

Several services can be detected on Respondent's website, but not in good faith: in fact, the domain name is connected to a website similar to the Complainant's official website and sponsoring, among others, financial services, for whom the Complainant's trademarks are registered and used. Therefore, the Complainant deems that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant's web site.

Several WIPO decisions stated that the registration and use of a domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy. See, e.g., YAHOO! INC. v. David Murray, Case No. D2000-1013 (finding bad faith where respondent chooses a domain name similar to the complainant's mark for a site which offers services similar to the complainant); Edmunds.com v. Ultimate Search, Inc., WIPO Case No. D2001-1319 ("Registration and use of a domain name to redirect Internet users to websites of competing organizations constitutes bad faith registration and use under the Policy").

As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademarks. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which do exactly correspond to the Complainant's trademarks and that result so similar to the Complainant's domain names currently used by the latter to provide online financial services.

In the light of the above, the present case completely matches to the above requirements and the redirection of the disputed domain name to a competitive website has to be considered as a use in bad faith: «The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests» (Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., concerning just the case of a bank).

The risk of a wrongful use of the domain name at issue is even higher in the present case, since the Complainant has already been targeted by some cases of phishing in the past few years. Such a practice consists of attracting the customers of an insurance or bank to a web page which imitates the real page of it, with a view to having customers disclose confidential information like a credit card or bank account number, for the purpose of unlawfully charging such bank accounts or withdrawing money out of them (see Decisions CAC UDRP No. 104215 <intesaturkey.com>, No. 103177 <INTESASANPAOLO-ALERT.COM> and No. 103209 <INTESASANPAOLO-SECURE.COM>).

Also, in the present case, the Complainant believes that the current owner registered the disputed domain name with the "phishing" purpose, in order to induce and divert the Complainant's legitimate customers to its website and steal their money.

Even excluding any "phishing" purposes or other illicit use of the domain name in the present case, anyway the Panel could find no other possible legitimate use of the disputed domain name. The sole further aim of the owner of the domain name under consideration might be to resell it to the Complainant, which represents, in any case, an evidence of the registration and use in bad faith, according to paragraph 4(b)(i) of the Policy.

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ASSICURAZIONISISALMOONEY.COM**: Transferred

PANELLISTS

Name	Dr. jur. Harald von Herget
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DATE OF PANEL DECISION	2022-08-05
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Publish the Decision