Decision for dispute CAC-UDRP-107617

Case number	CAC-UDRP-107617
Time of filing	2025-05-29 09:35:41
Domain names	FIDEURAM.XYZ

Case administrator

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

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.

Respondent

Name	Yi Wei Ren

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

- EU trademark registration No. 014404958 “FIDEURAM”, applied on July 24, 2015 and granted on December 9, 2015, in classes 9, 16, 35, 36, 41 and 42;
- EU trademark registration No. 014003685 “FIDEURAM & device”, applied on April 27, 2015, granted on September 17, 2015, in classes 9, 16, 35, 36, 41 and 42;
- EU trademark registration No. 014001499 “FIDEURAM INTESA SANPAOLO PRIVATE BANKING”, applied on April 27, 2015, granted on September 17, 2015, in classes 9, 16, 35, 36, 41 and 42;
- Fideuram – Intesa Sanpaolo Private Banking S.P.A. is the owner of the International trademark registration No. 1220255 “FIDEURAM”, granted on May 15, 2014, in class 36, also covering China.

The Complainant is also the owner of the following domain names bearing the trademark “FIDEURAM”:

<fideurambanca.it>, <fideurambank.org>, <fideuramdirect.it>, <fideuramdirect.com>, <fideuramireland.com>, <fideuramluxprivate.lu>, <financierefideuram.com>, <fideuramkuk.it>, <fideuramintesasanpaoloprivatebanking.com>.

The filing and registration dates of the trademarks predate the registration date of the disputed domain name of November 4, 2024.

FACTUAL BACKGROUND

FACTUAL BACKGROUND

A. Complainant's Factual Allegations

The Complainant is the leading Italian banking group and also one of the protagonists in the European financial area. Intesa Sanpaolo is the company resulting from the merger 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 83, 4 billion euro, and the undisputed leader in Italy, in all business areas. It has 3,000 branches capillary with market shares of more than 13% in most Italian regions, serving 14 million customers. It has 900 branches in Central-Eastern Europe with 7.5 million customers. Fideuram – Intesa Sanpaolo Private Banking is the Intesa Sanpaolo Private Banking Division.

B. Respondent's Factual Allegations

The Respondent has defaulted in this UDRP administrative proceedings and has consequently made no factual allegations. The Respondent is Yi Wei Ren, based at the address of Xin An Jie Dao Rong Chuang Guang Chang, Huai An Shi, Jiang Su, Post Code 223002, China.

The disputed domain name was registered on November 4, 2024 by the Respondent, as confirmed by the Registrar. At the time of filing of the Complaint, the disputed domain name redirects to a parking page in which the same is offered for sale.

PARTIES CONTENTIONS

A. COMPLAINANT

Language of the Proceedings

With respect to the language of the proceedings, the Panel notes as follows:

The Complaint is written in English. According to the registrar's verification response ('the RVR'), the language of the registration agreement for the disputed domain name is Chinese. Following the RVR, and at the request of CAC, the Complainant submitted a request for English to be the language of this administrative proceeding, on the following grounds:

First of all, the Complainant is an Italian company, while the Respondent is a Chinese citizen and the language of the registration agreement is Chinese. Given the above, the present Complaint was written in English, an international language comprehensible to a wide range of Internet users worldwide, including the ones living in Italy and in China.

Since the spirit of Paragraph 11 of the Rules seems to be to ensure fairness in the selection of language by giving full considerations to the parties' level of comfort with each language, English seemed to be the fair language in the present proceeding.

Furthermore, it is not possible to ignore that the present dispute has been started because the Respondent deliberately registered a domain name which is identical to a well-known registered trademark legitimately owned and used in Italy and China by the Complainant and its parent company Fideuram – Intesa Sanpaolo Private Banking from several years. It is inconceivable that the Respondent was not aware of such circumstance when it registered the disputed domain name.

The Complainant's contentions can be summarized as follows:

I. The disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights

The Complainant contends that the disputed domain name is identical or confusingly similar to its trademarks. It exactly reproduces the well-known trademark "FIDEURAM", resulting obviously confusing and misleading for Internet users, who might think that it is somehow connected to Intesa Sanpaolo S.p.A. and Fideuram Intesa Sanpaolo Private Banking, which is not true.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name on the grounds: i) the disputed domain name does not correspond to the name of the Respondent; ii) the Respondent is not commonly known as "FIDEURAM"; iii) the Respondent has not any fair or non-commercial uses of the disputed domain name.

III. The Respondent registered and is using the disputed domain name in bad faith

The Complainant's trademarks "FIDEURAM" and "FIDEURAM INTESA SANPAOLO PRIVATE BANKING" 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 had knowledge of the Complainant's trademarks 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 wordings "FIDEURAM" and "FIDEURAM INTESA SANPAOLO PRIVATE BANKING", the same would have yielded obvious references to the Complainant.

The Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed 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 disputed domain name (par. 4(b)(i) of the Policy). The disputed domain name redirects to a parking page in which the

same is offered for sale.

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

B. RESPONDENT

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 language of the registration agreement is Chinese. The Complainant has requested that the language of proceedings be English. The Respondent did not respond on the issue of the language of the proceedings and did not reject the Complainant's request.

The Panel is given discretion under Paragraph 11 of the Rules to determine the appropriate language of the administrative proceeding. Paragraph 10 of the Rules mentions that the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case. Based on the following factors, the Panel has decided that it would be fair and equitable to all parties to have the language of the proceedings be English:

- Complaint was written in English, an international language comprehensible to a wide range of internet users worldwide, including the ones living in Italy and in China;
- While determining the language of the administrative proceedings, the Panel has a duty to consider who would suffer the greatest inconvenience as a result of the Panel's determination. On the one hand, the determination of English as the language of this administrative proceeding – a widely spoken language – is unlikely to cause the Respondent any inconvenience. The determination of Chinese as the language of this administrative proceeding, on the other hand, is very likely to cause the Complainant inconvenience, and to interfere with the overall due expedition of the proceedings under the Rules (See Burberry Limited v Fei Cheng, CAC-UDRP-106643).

- The Complainant has requested that the language of proceedings be English. The Respondent did not respond to reject the Complainant's request.

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 provides that in order to be entitled to a transfer of the disputed domain name; the Complainant shall prove the following three elements:

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(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.

Based on the above regulations under the Policy, what the Panel needs to do is to find out whether each and all of the above-mentioned elements are established. If all the three elements are established, the Panel will make a decision in favor of the Complainant. If the three elements are not established, the claims by the Complainant shall be rejected.

The Respondent did not submit the Response containing any argument against what the Complainant claimed and to show his intention to retain the disputed domain name as required by the Policy and the Rules. If the Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint. In view of the situation, the Panel cannot but make the decision based primarily upon the contentions and the accompanying exhibits by the Complainant, except otherwise there is an exhibit proving to the contrary.

I. Identity or Confusing Similarity

Pursuant to Paragraph 4(a) (i) of the Policy, a Complainant must prove that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

A. Complainant has rights in a trademark or service mark

The Complainant has provided evidence of ownership of valid trademark registrations for the trademark “FIDEURAM”, “FIDEURAM & device” and “FIDEURAM INTESA SANPAOLO PRIVATE BANKING”, which was registered in European Union in 2015 in classes 9, 16, 35, 36, 41 and 42 with EU registration No. 014404958, 014003685 and 014001499. The trademarks are still valid and their registration dates predate the registration date of the disputed domain name, i.e. November 4, 2024. The Complainant therefore has rights in the trademarks “FIDEURAM”, “FIDEURAM & device” and “FIDEURAM INTESA SANPAOLO PRIVATE BANKING”.

B. The disputed domain name should be identical or confusingly similar to the trademark or service mark

The disputed domain name contains the Complainant's trade mark “FIDEURAM” in its entirety. The trademark “FIDEURAM & device” of the Complainant contains design, which are not the dominant portion of the trademarks. Design elements are incapable of representation in domain names and largely disregarded for purposes of assessing identity or confusing similarity (See WIPO Jurisprudential Overview 3.0, paragraph 1.10).

As to the generic Top Level Domain “.xyz”, it is viewed as a standard registration requirement and as such can be disregarded for the purpose of assessing identity or confusing similarity (See WIPO Jurisprudential Overview 3.0, paragraph 1.11.1).

Therefore, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights according to paragraph 4(a)(i) of the Policy. Accordingly, the Complainant has proven that the first element required by paragraph 4(a) of the Policy is established.

II. Rights or Legitimate Interests of the Respondent

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name on the grounds: i) the disputed domain name does not correspond to the name of the Respondent; ii) the Respondent is not commonly known as “FIDEURAM”; iii) the Respondent has not any fair or non-commercial uses of the disputed domain name.

Once the 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 (See WIPO Jurisprudential Overview 3.0, paragraph 2.1).

Paragraph 4(c) of the Policy lists a number of circumstances which can be taken to demonstrate a respondent’s rights or legitimate interests in a domain name. However, the Respondent has failed to meet that burden. The Respondent did not submit any evidence to demonstrate any of the above circumstances.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has proven that the second element required by paragraph 4(a) of the Policy is established.

III. Bad Faith

Paragraph 4(a) (iii) of the Policy provides that the disputed domain name has been registered and is being used in bad faith.

A. The disputed domain name has been registered in bad faith

The Panel finds that the Respondent had knowledge of the Complainant’s trademarks at the time of registration of the disputed domain name, considering the following circumstances:

- WIPO Jurisprudential Overview 3.0 mentions that noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant’s mark. The Panel believes that before registration of the disputed domain name, the Respondent had made searches for the wording “FIDEURAM” and known it is the trademark of the

Complainant.
- The Complainant claims that trademarks “FIDEURAM” and “FIDEURAM & device” are distinctive and well known all around the world. The Complainant carried Google search in respect of the wording “FIDEURAM”, which revealed the information on the Complainant and its trademarks. The Respondent had knowledge of the Complainant’s trademarks.

In view of the above circumstances, the Panel holds that the Respondent had knowledge of the Complainant’s trademarks at the time of registration of the disputed domain name. As the domain name would cause confusion to internet users, it should have avoided the registration, which is considered as good faith, rather it registered the disputed domain name. The Respondent deliberately sought to cause such confusion.

The evidence provided by the Complainant shows that the disputed domain name is offered for sale at the price of USD $1,450 in the website of GoDaddy. The Respondent’s offer for sale of the disputed trademark is the evidence of registration of the disputed domain name in bad faith, which is the circumstance of bad faith mentioned in Paragraph 4(b)(i)of the Policy (See below).

Accordingly, the Panel finds that the disputed domain name has been registered in bad faith.

B. The disputed domain name is being used in bad faith

Paragraph 4(b) of the Policy lists four alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent. Circumstance (i) indicates that you have registered or you have acquired the 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 that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name.

The evidence provided by the Complainant shows that the disputed domain name is offered for sale at the price of USD $1,450 in the website of GoDaddy. The Respondent’s offer for sale of the disputed trademark convinces the Panel that the disputed domain name is being used in bad faith, which meets the circumstance mentioned in Paragraph 4(b)(i).

Regarding the Complainant’s contention on bad faith, the Respondent should rebut it, but it did not make any response, which strengthened the Panel’s findings on its bad faith.

In view of all above, the Panel finds that the disputed domain name has been registered and is being used in bad faith according to paragraph 4(a)(iii) of the Policy. Therefore, the Complainant has proven that the third element required by paragraph 4(a) of the Policy is established.

Decision

For all the foregoing reasons, in accordance with paragraph 4(a) of the Policy and Rule 15 of the Rules, the Panel orders that the disputed domain name <fideuram.xyz> be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FIDEURAM.XYZ**: Transferred

PANELLISTS

Name	**Yunze Lian**

DATE OF PANEL DECISION 2025-07-07

Publish the Decision