

ADMINISTRATIVE PANEL DECISION

Banca Monte dei Paschi di Siena S.p.A. v. andrea galigno

Case No. D2023-0128

1. The Parties

The Complainant is Banca Monte dei Paschi di Siena S.p.A., Italy, represented by Rapisardi Intellectual Property, Italy.

The Respondent is Andrea Galigno, Italy.

2. The Domain Name and Registrar

The disputed domain name <area-montepaschi.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 11, 2023. On January 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 11, 2023, the Registrar transmitted by email to the Center its verification response registrant and contact information for the disputed domain name which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 12, 2023, the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on February 12, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 3, 2023.

The Center appointed Eva Fiammenghi as the sole panelist in this matter on February 8, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is one of the world's oldest banks. With 2,000 branches, 26,000 employees and 5.1 million customers it is one of the largest Italian banks.

The Complainant, throughout the years has registered several trademarks consisting of the wordings "montepaschi" or "monte dei paschi", alone or in combination with other words.

The Complainant owns, *inter alia*, the United States of America Trademark MONTEPASCHI (Registration No. 538308, registered on December 28, 1990) in International Class 36.

The Complainant also holds several domain names, including the domain name <montepaschi.com> (registered on September 7, 2001).

The disputed domain name <area-montepaschi.com> was registered on March 10, 2022 and it is inactive.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is almost identical to the Complainant's trademarks and domain name and highlights how the MOSTEPASCHI mark is well known around the world in the field of Banking industry.

The disputed domain name is confusingly similar to the MONTEPASCHI trademark in which the Complainant has rights, because it incorporates this trademark in its entirety, and the addition of the descriptive word "area" (which in both English and Italian has the meaning of "region", "zone") is not sufficient to avoid confusing similarity.

The Complainant asserts that the disputed domain name was registered for the only purpose of reselling the disputed domain name to the Complainant (or alternatively to one of its competitors) for a much higher sum with respect to the costs sustained for its registration, or, for disrupting the Complainant's business and reputation.

The Respondent is not affiliated with the Complainant and there is no evidence to suggest that the Respondent has registered the disputed domain name to advance legitimate interests.

The Complainant has never licensed or otherwise permitted the Respondent to use its trademark or to register any domain name including its trademark.

The Complainant requests that the disputed domain name be transferred to it.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must prove that:

- (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 was registered and is being used in bad faith.

These elements are discussed in turn below. In considering these elements, paragraph 15(a) of the Rules provides that the Panel shall decide the Complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the Panel deems applicable.

A. Identical or Confusingly Similar

In the present case, the disputed domain name <area-montepaschi.com> is confusingly similar to the Complainant's registered trademark MONTEPASCHI.

The Complainant has shown its own trademark rights in the MONTEPASCHI trademark.

It is clear that the disputed domain name incorporates in its entirety the MONTEPASCHI trademark to which the term "area" and a hyphen has been added.

It is well established that the addition of terms to a trademark in a domain name does not avoid a finding of confusing similarity. See, e.g., *eBay Inc. v. ebayMoving / Izik Apo*, WIPO Case No. [D2006-1307](#).

Moreover, it is well established that the generic Top-Level Domains ("gTLD") ".com", being a necessary component of a domain name, may be disregarded for the purpose of comparison under this ground. See, *F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The Panel finds that the first element of the Policy has been met.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant has to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent is not in any way affiliated with the Complainant, nor has the Complainant authorized or licensed the Respondent to use its trademarks, or to seek registration of any domain name incorporating its trademarks.

The Respondent has not made any submissions or any demonstrations that it has rights or legitimate interests in the disputed domain name.

In *Guerlain S.A. v. Peikang*, WIPO Case No. [D2000-0055](#), the panel stated that: "in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated *bona fide* or legitimate use of the domain name could be claimed by Respondent."

The Panel finds no evidence that the Respondent has used, or undertake any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

Likewise, no evidence has been adduced that the Respondent has been commonly known by the disputed domain name; nor, for the reasons mentioned above, is the Respondent making a legitimate noncommercial or fair use of the disputed domain name.

The Panel concludes, noting that the Respondent lacks any rights or legitimate interests in the disputed domain name, that the second element of the Policy has, therefore, been met.

C. Registered and Used in Bad Faith

The Panel, based on the evidence presented, accepts, and agrees with the Complainant's contention that the disputed domain name was registered and is being used in bad faith.

The Panel finds that the disputed domain name was registered and is being used in bad faith because it is obvious that the Respondent had knowledge of the Complainant and its trademark at the time it registered the disputed domain name. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity, as is the case here, can by itself create a presumption of bad faith. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 3.1.4.

The fact that the disputed domain name is inactive would not prevent a finding of bad faith, noting the distinctiveness and fame of the Complainant's mark, the fact that the Respondent has not denied, or even responded to the assertions of bad faith made by the Complainant's in this proceeding and, under the circumstances of the case, the implausibility of any good faith use to which the disputed domain name may be put.

Accordingly, the Panel finds, based on the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith. Therefore, the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <area-montepaschi.com> be transferred to the Complainant.

/Eva Fiammenghi/

Eva Fiammenghi

Sole Panelist

Date: February 22, 2023