Panel Decision for dispute CAC-ADREU-005372

Case number	CAC-ADREU-005372
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Domain names	cassadirisparmiodelveneto.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Intesa Sanpaolo S.p.A.

Respondent

Organization / Name	Iwebment Media Limited, James Jackson

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is the owner of trademarks consisting of or comprising “CASSA DI RISPARMIO DEL VENETO”, including the following trademark and domain names:

- Italian trademark registration CASSA DI RISPARMIO DEL VENETO, filed on July 9, 2004 and granted on March 13, 2008 - No. 68433
Domain name: CASSADIRISPARMIODELVENETO.IT registered on May 14, 2004
CASSADIRISPARMIO.NET
CASSADIRISPARMIO.INFO
CASSADIRISPARMIO.BIZ all registered on May 12, 2004
All the above titles are earlier than the contested domain name CASADIRISPARMIODELVENETO.EU

The company name CASSADIRISPARMIODELVENETO is also taken into consideration even though it concerns Cassa di Risparmio del Veneto S.p.a. which is an independent entity (a different bank) because the latter is controlled by the actual complainant. This Panel believes that multiple complainants are possible if the positions against the same domain name are somehow connected and interdependent. It is interesting to refer to the arguments put forward in the case 05429 in which three co-complainants were allowed. The Panel in that case clearly stated that:
“The present Complaint was not initiated by one, but by three different Complainants. The Panel in CAC Case No. 4881 JETPILOT has held in its decision that the .eu Alternative Dispute Resolution Rules (the "ADR Rules") do not allow multiple (unrelated) entities to file a single complaint as co-complainants, and therefore decided to consider only one of these co-complainants as “the Complainant” of its case. This handling of multiple complainants is somewhat similar to the approach taken in a decision under the Uniform Domain Name Dispute Resolution Policy (UDRP) in the case Sanofi-aventis, Sanofi-Aventis Deutschland GmbH v. Andrey Mitrofanov, WIPO Case No.D2007-1772.
In various other UDRP decisions, however, the respective panels have accepted complaints by multiple complainants based on agency, licensing, or affiliate relationships (see, for example, Staples, Inc., Staples The Office Superstore, Inc., and Staples Contract and Commercial, Inc. v. SkyLabs Corporation and DL Enterprises, WIPO Case No. D2004-0220; ITT Manufacturing Enterprises, Inc., ITT Corporation v. Douglas Nicoll, Differential Pressure Instruments, Inc., WIPO Case No. D2008-0936; Costco Wholesale Corporation and Costco Wholesale Membership Inc. v. Yezican Industries and Domains By Proxy, Inc., WIPO Case No. D2007-0638). In the decision Ken Done, Ken Done & Associates Pty Ltd., and Ken Done Down Under Pty Ltd. v. Ted Gibson (eResolution Case No. AF-0638) the Panel held that a UDRP complaint may be submitted by multiple related parties if there are common interests in a single domain name – a condition that is clearly satisfied in the present proceeding.

Therefore, Intesa SanPaolo alone or together with CassadiRisaprmiodel Veneto Spa put forward the same interests in the contested domain names and claim the same rights on the trademark/denomination based on different titles (i.e. trademark and domain names in the name of the holding company Banca Intesa San Paolo, on the one hand, and the Company name of Cassa di Risparmio del Veneto in the case of CassadiRisparmiodelVeneto S.p.a., on the other).

A. COMPLAINANT

The Complainant states that the disputed domain name is identical to the prior Complainant's trademark and domain names.

With reference to rights or legitimate interest, the Complainant asserts that the Respondent's trade name is not identical or similar to CASSA DI RISPARMIO DEL VENETO. Furthermore, both IWEBMENT MEDIA and/or JAMES JACKSON are not commonly known as CASSA DI RISPARMIO DEL VENETO. When the Complaint was filed there was no commercial use of CASSADIRISPARMIODELVENETO.EU by the Respondent.

The Complainant also stated that the contested domain name was registered in bad faith. Although it considers it has proven the lack of legitimate interest on the Respondent (and thus an element sufficient to obtain the assignment of the domain name), the Complainant still wishes to make a complete assessment of the case and to claim that the Respondent is in bad faith for the following reasons:
i) the domain name was (is) not currently in use and it has never been used since its registration;
ii) there is no evidence of any preparation for a legitimate commercial or non-commercial use of the disputed domain name;
the respondent was involved in two previous proceedings in which the Panelist ordered the transfer of the disputed domain name registered by the Actual Respondent to the Complainant, and in those cases the Complainants underlined the Respondent's frequent speculation in domain names.

B. RESPONDENT

The Respondent failed to file its Response within the established deadline.

DISCUSSION AND FINDINGS

According to Article 21(1) of the Regulation, the Complainant must show that the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law (1) and that the disputed domain name has been registered by its holder without rights or legitimate interest in the name; or has been registered or is being used in bad faith (2).

1 - The Complainant has provided evidence of ownership of both the Italian Registered Trademark and of a few domain names all comprising the denomination CASSA DI RISPARMIO DEL VENETO.

The Panel finds that the Domain Name is therefore identical to the previous trademark and domain names owned by the Complainant.

In comparing the Complainant's marks to the Domain Name with reference to CASSADIRISPARMIODELVENETO.eu, it should be taken into account that the suffixes, including the .eu top level domains, may be excluded from consideration as being merely a functional component of a domain name.

In view of the above, the Panel finds that the Complainant has proven that the Domain Name is identical to the trademarks and domain name in which the Complainant has rights in accordance with Article 21(1) of the Regulation.

2 - The Complainant must show that the Respondent has no rights or legitimate interests in respect of the Domain Name or that the Domain Name has been registered or is being used in bad faith. This double OR clause, i.e. Legitimate interest OR Bad Faith, on the one hand, and Registered OR used in bad faith, on the other, makes the Complainant's job easier.

The Complainant wished to prove both elements:

The Complainant has only the onus to indicate a possible lack of legitimate interest while the Respondent, in order to prevail, should prove the real existence of its Legitimate Interest. It is more a basis of a possible defence rather than a proper Complainant's full attack. However, the Complainant in this case has proven that the Respondent's Legitimate Interest was probably lacking because, in accordance with Article 21.2 of the Regulation and Article B.11.e of the ADR Rules, any of the following elements was not applicable:

(a) prior to any notice of an alternative dispute resolution (ADR) procedure, the Respondent has used the domain name or a name

corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;
(b) Respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or Community law;
(c) Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognized or established by national and/or Community law.
The Respondent decided not to join the proceeding and, therefore, the arguments put forward by the Complainant on the lack of Legitimate Interest not contested by the missing Respondent have to be taken as proven.

The Panel observes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks.

Furthermore, there is no indication before the Panel that the Respondent is commonly known by the Domain Name, has made preparations to use the Domain Name in connection with the offering of goods or services, or that it intends to make a legitimate, non-commercial or fair use of the Domain Name.

Complainant has also proved bad faith in the following circumstances:
a) The disputed domain name has never been used since its registration in 2006;
b) A similar pattern related to the Respondent has been ascertained in previous cases regarding other EU domain names that have been transferred to those Complainants.
All in all, in the Panel's view, the aforesaid elements constitute evidence of registration in bad faith pursuant to Article 21.3 (b) (ii) of the Regulation and Paragraph B 11 (f) (2) (ii) of the ADR Rules.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name CASSADIRISPARMIODELVENETO be transferred to the Complainant

PANELISTS

Name	Massimo Cimoli

DATE OF PANEL DECISION 2009-06-17

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant has provided evidence of ownership of a the Italian registered trademark CASSADIRISPARMIODELVENETO and of a few identical domain names. Furthermore, the Complainant is the parent company controlling Cassa di Risparmio del Veneto S.p.a.
i)
The Panel finds that the Complainant has established a prima facie lack of rights or legitimate interest of the Respondent in the disputed domain name. Mainly, it has proven that the Respondent is not known as Cassa di Risparmio del Veneto and it has never used the disputed domain name for commercial or non-commercial activities.
The Panel also finds that the disputed domain name has been registered in bad faith since it has not been used in a relevant way for over two years from its registration. Moreover, the Complainant has pointed out that the Respondent registered other EU domain names that were later transferred to the Complainants in the relative arbitration proceedings. Last, but not least, the Respondent's decision not to join the proceeding can be interpreted in the above-described scenario as another element of bad faith.