

ADMINISTRATIVE PANEL DECISION

Banca Monte dei Paschi di Siena S.p.A. v. David Muniz
Case No. D2022-2791

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 David Muniz, United States of America.

2. The Domain Name and Registrar

The disputed domain name <montedeipaschi-mps.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 29, 2022. On July 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 30, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 August 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 23, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 28, 2022.

The Center appointed Cherise Valles as the sole panelist in this matter on September 1, 2022. 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 the fourth largest commercial and retail bank in Italy with 2,000 branches, 26,000 employees and 5.1 million customers all over the world (Annex 2 of the Complaint). The Complainant's activity covers many fields: traditional banking, asset management and private banking (mutual funds, wealth management, pension funds, and life insurance policies), investment banking, business financing (project finance, merchant banking, and financial counseling), with a focus on family accounts and small and medium businesses. The Complainant has a large number of branches, offices and subsidiaries in Italy and in other countries such as China, Russian Federation, India, Türkiye (Annex 3 of the Complaint).

The Complainant also offers online banking services through its websites at "www.mps.it" (in Italian) and "www.gruppomps.it" (in English), allowing its customers to check their bank accounts and to conduct bank transactions on the Internet. Of great importance in carrying out its activity is its registration of trademarks and domain names, with the aim of distinguishing its products and services from those offered by other banks. Over the years, the Complainant has registered several trademarks consisting of the terms "montepaschi" or "monte dei paschi", in combination with other terms. These trademarks (Annex 4a of the Complaint provides a partial listing) recall the company name of the Complainant (Banca Monte dei Paschi di Siena S.p.A.). The Complainant also owns several trademarks with "mps" (Annex 4b of the Complaint), which is the acronym of Monte dei Paschi di Siena.

The Complainant's trademarks are registered and used in connection with different services, under international classes 36 and 38: insurance, credit, stock brokerage and banking services. Annexes 4a and 4b of the Complaint show that the trademarks are valid in Italy and in many other countries around the world. The Complainant, amongst others, has the following trademark registrations (the "Trademarks"):

- International trademark registration for MONTE DEI PASCHI DI SIENA BANCA DAL 1472, registration no. 587684, registered on June 12, 1992;
- International trademark registration for MPS, registration no. 824744, registered on April 14, 2004;
- International trademark registration for MPS MONTE DEI PASCHI DI SIENA BANKING GROUP, registration no. 598096, registered on February 10, 1993.

The Complainant has also registered several domain names with national and international extensions containing the terms "montepaschi", or "mps" (collectively referred to as the "Montepaschi Domain Names"), including the following:

- <montedeipaschidisiena.com> (registered on July 9, 2001);
- <montedeipaschidisiena.it> (registered on July 9, 2001);
- <montedeipaschi.com> (registered on April 14, 1998);
- <montedeipaschi.it> (registered on April 23, 2008);
- <montedeipaschi.mobi> (registered on June 18, 2010);
- <montedeipaschi.org> (registered on July 6, 2010);
- <mps.it> (registered on November 20, 1997);
- <mpsbank.com> (registered on April 14, 1998).

The disputed domain name <montedeipaschi-mps.com> was registered on September 29, 2021. The disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

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

- The disputed domain name is confusingly similar to the Complainant's registered trademarks, in light of the fact that it incorporates the Complainant's marks.

The Respondent lacks rights or legitimate interests in the disputed domain name.

- The Complainant states that the Respondent should be considered as having no rights or legitimate interests in the disputed domain name. The Complainant has never licensed or otherwise permitted the Respondent to register any domain name that included its trademarks.

The disputed domain name has been registered and is being used in bad faith.

- The Complainant asserts that the disputed domain name was registered and is being used in bad faith. The mere fact of registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to that mark is itself evidence of bad faith registration and use.

The Complainant requests the Panel to issue a decision finding that the disputed domain name be transferred to the Complainant, in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

In terms of paragraph 4(a) of the Policy, for a complaint to succeed, the complainant must prove each of the following 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 or is being used in bad faith.

The Respondent has failed to file a Response in this proceeding. The Panel may draw appropriate inferences from the available evidence submitted by the Complainant.

A. Identical or Confusingly Similar

To prove this element, the Complainant must have relevant UDRP rights in a trademark and the disputed domain name must be identical or confusingly similar to such trademark.

Given the Complainant's trademark registrations as detailed above, the Panel finds that the Complainant has established its trademark rights for the purposes of paragraph 4(a)(i) of the Policy.

The disputed domain name incorporates a dominant element of the Complainant's trademark MONTE DEI PASCHI DI SIENA BANCA DAL 1472 and it incorporates the Complainant's trademark MPS in its entirety. Moreover, two dominant elements of the Complainant's trademark MPS MONTE DEI PASCHI DI SIENA BANKING GROUP are recognizable in the disputed domain name.

As stated in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element".

It is standard practice when comparing a disputed domain name to a complainant's trademark not to take the Top Level Domain ("TLD") into account. See section 1.11.1 of the [WIPO Overview 3.0](#), which states that the "applicable TLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and, as such, is disregarded under the first element of the confusing similarity test". In the present case, the TLD "com" is disregarded under the first element of the confusing similarity test.

In the light of the foregoing, the Panel finds that the disputed domain name is confusingly similar to the Complainant's Trademarks and that the Complainant has met its burden with respect to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a non-exhaustive set of circumstances, any of which, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate a respondent's rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy, namely:

"[a]ny of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, whether on the basis of the non-exhaustive examples set out in paragraph 4(c) of the Policy or on any other basis, and the Panel draws inferences from this failure, where appropriate, in accordance with paragraph 14(b) of the Rules.

It is recognised in cases under the Policy that it is sufficient for a complainant to make a *prima facie* case under the second element of the Policy, not rebutted by the respondent, that the respondent has no rights or legitimate interests in the domain name concerned (see section 2.1 of the [WIPO Overview 3.0](#)). If a respondent fails to rebut such a *prima facie* case by demonstrating rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy, or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In this case, it appears that the Complainant has established the requisite *prima facie* case.

To the best of the Complainant's knowledge, the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has never provided any third party with authorization to register and/or use a domain name comprising the terms "montedeipaschi" and/or "mps". Moreover, the disputed domain name does not resolve to a website from which any interest in its use by the Respondent may be inferred.

On the evidence before the Panel, it appears that there has never been any relationship between the Complainant and the Respondent. The Respondent does not seem to be licensed, or otherwise authorized, be it directly or indirectly, to register or use the Complainant's trademarks in any manner, including in, or as part of, the disputed domain name.

In light of the foregoing, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and concludes that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

For this element, the Complainant is required to prove that the disputed domain name was registered and that it was used in bad faith. The term "bad faith" is "broadly understood to occur where a respondent takes unfair advantage of, or otherwise abuses, a complainant's mark". See section 3.1 of the [WIPO Overview 3.0](#). Paragraph 4(b) of the Policy sets out four non-exhaustive examples of circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, namely:

- (i) circumstances indicating that the respondent registered or 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 the documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

Previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typographical errors or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

Furthermore, the nature of the disputed domain name, combining dominant elements of the Complainant's trademarks and incorporating the Complainant's trademark MPS in its entirety, carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

There is no evidence that the Respondent ever prepared to use the disputed domain name in good faith. The disputed domain name currently resolves to an inactive page. Prior UDRP panels have held that the non-use of a domain name would not prevent a finding of bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *CBS Broadcasting, Inc. v. Dennis Toeppen*, WIPO Case No. [D2000-0400](#).

The Respondent has not participated in the administrative proceeding and has not answered the Complainant's contentions. The fact that the Respondent has decided not to provide any legitimate explanation or to assert any alleged good faith motivation in respect of the registration and use of the inherently misleading disputed domain name in the face of the Complainant's contentions can be regarded as an indicator of registration and use in bad faith.

Accordingly, the Panel concludes that the Complainant has satisfied its burden of showing bad faith registration and use of the disputed domain name under 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 <montedeipaschi-mps.com> be transferred to the Complainant.

/Cherise Valles/

Cherise Valles

Sole Panelist

Date: September 15, 2022