

ADMINISTRATIVE PANEL DECISION

Banca Monte dei Paschi di Siena S.p.A. v. iqra shamim, LIUSUAN PADILLA ORTE

Case No. D2023-3233

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 iqra shamim, LIUSUAN PADILLA ORTE, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <mps-online.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 27, 2023. On July 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 27, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Contact Privacy Inc. Customer 0166610505) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 31, 2023, providing 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 July 31, 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 August 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 7, 2023. On September 28, 2023, a third party sent an informal email communication to the Center.

The Center appointed Marilena Comanescu as the sole panelist in this matter on October 6, 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, founded in 1472, claims that it is the world's oldest bank still in operation. Currently, the Complainant is the fourth largest commercial and retail bank in Italy and it is present internationally with 2,000 branches, 26,000 employees and 5.1 million customers. The Complainant's services range over various fields from traditional banking to asset management, from investment banking to innovative business financing.

The Complainant owns numerous trademark registrations for MPS alone or in combination with other wordings, "MPS" being the acronym of the Complainant's company name. *Inter alia*, the Complainant owns the International Trademark registration number 824744, for the word MPS, registered on April 14, 2004, designating, *inter alia*, the United States, Japan, China, Australia, Türkiye, Ukraine, United Kingdom, Switzerland, Spain, Benelux and covering services in Nice class 36.

The Complainant offers online banking services through its many websites, the main one being available at "www.mps.it". The Complainant also owns domain names incorporating the MPS trademark together with the term "online", such as <mpsonline.it> registered on November 18, 2009 and <mpsonline.eu> registered on January 19, 2017.

The disputed domain name, <mps-online.com>, was registered on February 27, 2023, and at the time of filing the Complaint, it did not resolve to an active website.

On September 28, 2023, a third party sent an informal email communication to the Center indicating that it has received the Center's written communication sent by postal mail and asking about the present proceeding. However, although the Center replied on October 3, 2023, and asked a clarification of his/her relationship (if any) with the Respondent, no further communication was received.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its trademarks because it is formed of the well-known MPS mark with the additional term "online", a term indicating an activity available on or performed using the Internet or other computer network; that the Respondent has no rights or legitimate interests in the disputed domain name; and that the Respondent registered and is using the disputed domain name in bad faith, particularly, due to the Complainant's use since 1472 and its substantial goodwill, notoriety and reputation in the MPS trademark, the Respondent was certainly aware of the Complainant at the time of registering the disputed domain name and therefore the Respondent registered the disputed domain name primarily for the purpose of selling, transferring the same to the Complainant or to a competitor of it for valuable consideration in excess of the documented out-of-pocket costs or to prevent the trademark holder from reflecting its trademark in a domain name.

B. Respondent

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

6. Discussion and Findings

In view of the absence of a Response, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other term here, "-online", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The composition of the disputed domain name, in this case being the reproduction of the Complainant's distinctive and widely known trademark together with a term associated with the Complainant's banking services, carries a risk of implied affiliation. Prior UDRP panels have held that where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#).

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the disputed domain name was registered in bad faith, with knowledge of the Complainant and its trademark particularly because it incorporates the Complainant's distinctive trademark used for more than 500 years, and registered since at least 2004, together with a non-distinctive term, *i.e.*, "online". Also, the disputed domain name is very similar to the Complainant's domain names, such as <mpsonline.it>, registered since 2009.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

At the time of filing of the Complaint, the disputed domain name resolved to an inactive page.

UDRP panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. While UDRP panels will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3.

The Panel notes the long-standing use, distinctiveness and reputation of the Complainant's trademark in its field; the composition of the disputed domain name; the Respondent's failure to provide a response in this proceeding and to provide any evidence of actual or contemplated good-faith use; the Respondent's use of a privacy service and provision of false contact details to the Registrar, and finds that, in the circumstances of this case, the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Having reviewed the record, the Panel concludes to the Respondent's bad faith under the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <mps-online.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: October 20, 2023