

## ADMINISTRATIVE PANEL DECISION

Banca Mediolanum S.p.A. v. Name Redacted  
Case No. D2024-3650

### 1. The Parties

The Complainant is Banca Mediolanum S.p.A., Italy, represented by Bird & Bird Società tra Avvocati s.r.l., Italy.

The Respondent is Name Redacted. <sup>1</sup>

### 2. The Domain Name and Registrar

The disputed domain name <bancamediolanum.live> is registered with NameCheap, Inc. (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 10, 2024. On September 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 10, 2024, 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 (Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 11, 2024, 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 amended Complaint on September 17, 2024. On September 24, 2024, a third party contacted the Center by email, informing that it had been the victim of an identity threat and had never registered the disputed domain name.

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<sup>1</sup>The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

The Center verified that the Complaint together with the amended 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 September 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 9, 2024. The Respondent did not submit any response but only sent to the Center an email informing that he was not involved in the registration of the disputed domain name and that he had been the victim of an identity theft.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on October 17, 2024. 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 an Italian joint-stock company part of the Mediolanum banking group, which provides banking, financial and insurance products and services. The Complainant was established in Italy in 1997 as a multi-channel bank and subsequently acquired various other companies operating in the same field, both in Italy and in other European Union Member States. As of June 2024, the Complainant’s group managed assets for a total of EUR 129.5 billion, with a net income of approximately EUR 450 million, and could count on a total of approximately 1,865 million clients.

The Complainant is the owner of various BANCA MEDIOLANUM or MEDIOLANUM trademarks in Italy, the European Union, and the United Kingdom, among which:

- BANCA MEDIOLANUM, European Union Trade Mark No. 015131551, registered on July 13, 2016, for goods and services in classes 9, 18, 25, 35, 36 and 41.

The Complainant is also the owner of the domain name <bancamediolanum.it>, registered on April 1, 1998, which is used for the Complainant’s corporate website, and of other domain names all containing the term “mediolanum” coupled with other descriptive elements.

The disputed domain name was registered on July 4, 2024, and is passively held.

#### **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 identical or at least confusingly similar to the Complainant’s mark. It further contends that the Respondent lacks rights or legitimate interests in the disputed domain name, as the Complainant never authorized the Respondent to include its BANCA MEDIOLANUM trademark in the disputed domain name. Moreover, the Respondent is not commonly known by the disputed domain name, which clearly refers to the Complainant and to its mark only.

The disputed domain name does not resolve to an active website. Accordingly, the Respondent is not making a bona fide use of the disputed domain name. Finally, the Respondent cannot claim any rights or

legitimate interests in the disputed domain name because the disputed domain name is identical to the Complainant's mark and tradename.

Lastly, the Complainant maintains that the disputed domain name has been registered and is being used in bad faith. The Complainant's mark is distinctive and well known and the Respondent could not ignore the existence of the Complainant's mark at the time of the registration of the disputed domain name. The registration of a domain name identical to a third party's mark amounts to registration in bad faith.

With respect to use in bad faith, the Complainant points out that the Complainant operates in a highly regulated field. Thus, any possible use of the disputed domain name in good faith by the Respondent is implausible.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions, but a third party informed the Center, upon receiving the notification of the Complaint, that it had been the victim of identity theft and was not at all involved with the registration of the disputed domain name.

## **6. Discussion and Findings**

### **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.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available 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.

In particular, the Complainant has indicated that it has no link with the Respondent and that it never authorized the Respondent to make use of its trademark in any manner, including as part of the disputed domain name. Furthermore, the Respondent does not appear to have been commonly known by the disputed domain name and nothing in the case file supports this circumstance.

The disputed domain name is identical to the Complainant's mark. UDRP Panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

At the time of the filing of the Complaint, the disputed domain name did not resolve to an active website. Accordingly, the Respondent was not using the disputed domain name in connection with a bona fide offering of goods or services or for a legitimate noncommercial or fair use.

Furthermore, the record contains unrebutted information that the registrant of the disputed domain name has engaged in identity theft, by adopting a third party's personal name and address. Panels have held that the use of a domain name for illegal activity (here, impersonation, or other types of fraud such as identity theft) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Accordingly, 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 is identical to the Complainant's BANCA MEDIOLANUM mark and that this mark is distinctive and renown in its field in Italy, as also recognized in at least the following previous UDRP decisions: *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Banca Mediolanum S.p.A. v. Carlo Pascarella, Carlo Pascarella*, WIPO Case No. [D2020-0161](#); *Banca Mediolanum S.p.A. v. Rita Esposto/ BlueHost.com- Inc*, WIPO Case No. [D2010-0966](#).

It appears that the true registrant of the disputed domain name has stolen the identity of a third party along with its address, and has used a phone number that is Italian, thus demonstrating a familiarity with the Italian environment. Accordingly, it is more likely that the Respondent was aware of the Complainant and of its BANCA MEDIOLANUM mark at the time of the registration of the disputed domain name.

The registration of a domain name identical to a third party's earlier renown trademark, being aware of such mark and without rights or legitimate interests amounts to registration in bad faith. Moreover, the indication of false contact details, noted to be in breach with the Registration Agreement, is also another indication of bad faith.

As far as use in bad faith is concerned, the Panel notes that the disputed domain name is not actively used.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, and the composition of the disputed domain name, 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.

Moreover, as also indicated in section 3.4 of the [WIPO Overview 3.0](#), the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, etc. In the case at issue, the Complainant operates in the banking and financial fields and any legitimate use of the disputed domain name by an unauthorized third party is implausible. Rather, there is a significant risk that the Respondent could use the disputed domain name to send phishing emails to obtain sensitive or confidential information, or to solicit payments, or for any other fraudulent reason.

In light of the foregoing, the Panel finds that the Complainant has established the third element 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 <bancamediolanum.live> be transferred to the Complainant.

*/Angelica Lodigiani/*

**Angelica Lodigiani**

Sole Panelist

Date: October 31, 2024