

## **ADMINISTRATIVE PANEL DECISION**

Banca Mediolanum S.p.A. v. Domain Privacy, Domain Name Privacy Inc  
Case No. D2024-3652

### **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 Domain Privacy, Domain Name Privacy Inc, Cyprus.

### **2. The Domain Name and Registrar**

The disputed domain name <bancomediolanum.online> is registered with Communigal Communications Ltd. (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 11, 2024, 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 September 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 3, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 4, 2024.

The Center appointed Johan Sjöbeck as the sole panelist in this matter on October 8, 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 has submitted evidence that it is the owner of a number of trademark registrations, including the following European Union Trademark registrations:

BANCA MEDIOLANUM (word), with registration number 015131551, and registration date July 13, 2016, for class 9, 18, 25, 35, 36 and 41.

BANCA MEDIOLANUM (figurative), with registration number 014747059, and registration date March 29, 2016, for class 9, 18, 25, 35, 36 and 41.

MEDIOLANUM (word), with registration number 004671764, and registration date October 3, 2006, for class 35, 36 and 38.

MEDIOLANUM (figurative), with registration number 013598065, and registration date May 18, 2015, for class 9, 16, 18, 25, 35, 36, 38 and 41.

M MEDIOLANUM (figurative), with registration number 013822911, and registration date August 14, 2015, for class 9, 16, 18, 25, 35, 36, 38 and 41.

The disputed domain name <bancomediolanum.online> was registered by the Respondent on July 18, 2024. The website, to which the disputed domain name resolves, displays sponsored commercial pay-per-click links.

#### **5. Parties' Contentions**

##### **A. Complainant**

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

The Complainant is the parent company of Mediolanum Group, which provides banking, financial and insurance products and services in Italy and other countries. The Complainant was established in Italy in 1997 as a multi-channel bank that has become soon one of the most innovative operators on the banking market. In the same year, Mediolanum International Funds was established in Ireland: its business focuses on the production and packaging of the mutual funds distributed in various European countries. In 2000 Banca Mediolanum started the process of expansion abroad by acquiring Fibanc banking group in Spain, where it now operates as Banco Mediolanum S.A. The growth in Europe continued in 2001 with the acquisition of Bankhaus August Lenz & Co in Germany and Gamax Holding AG in Luxembourg and Western International Life Insurance Company Ltd, which then changed its name to Mediolanum International Life and concentrates on developing products under Irish law, especially life policies, which are then distributed on the European market through branches in Italy, Spain and Germany.

In 2014 the Complainant was awarded the Italian Banking Association prize for innovation in banking services. In 2015, following the merger of Mediolanum S.p.A. into Banca Mediolanum S.p.A., the Complainant, has become the parent company of the Mediolanum Group. Nowadays Banca Mediolanum means a group of companies that provides a wide range of services through user-friendly solutions based on new technologies, including current accounts, debit and credit cards, mortgages and loans, saving investments solutions, but also insurance, retirement, and real estate products and services.

The Complaint is based on the Complainant's prior rights in and to the trademarks BANCA MEDIOLANUM and MEDIOLANUM, which are extensively used and known, in particular for banking and financial services.

The Complainant's official website is "www.bancamediolanum.it". The Complainant, directly or through affiliated companies of the Mediolanum Banking Group, operates other official websites through domain names such as <mediolanumprivatebanking.it>, <mediolanuminvestmentbanking.it>, <mediolanumfiduciaria.it>, <mediolanumassicurazioni.it>, <mediolanumgestionefondi.it>, <mediolanuminternationalfunds.it>, <mediolanumvita.it> <mediolanuminternationallife.it>, and <fondazionemediolanum.it>

Numerous UDRP panels have recognized that incorporating a trademark can be sufficient to establish that a disputed domain name is at least confusingly similar to a registered trademark. The disputed domain name almost reproduces the Complainant's mark and trade name BANCA MEDIOLANUM, and fully incorporates the Complainant's mark MEDIOLANUM, which are both clearly recognizable within the disputed domain name, in which "banco" is the masculine variation of "banca" (Italian for "bank") or the Spanish and Portuguese for "bank". Therefore, it can be concluded that the disputed domain name is almost identical and in any case confusingly similar to the Complainant's trademarks BANCA MEDIOLANUM and MEDIOLANUM, and this circumstance cannot be counterbalanced by the generic Top-Level Domain ("gTLD") ".online" which is in fact a registration requirement and as such it can be disregarded under the first element confusing similarity test.

In addition, it cannot be ignored that the disputed domain mirrors the trade name and trademark of the Complainant's Spanish subsidiary Banco Mediolanum S.A., which is fully owned by the Complainant. Thus, when confronted with the disputed domain name, internet users and consumers in general would clearly associate it with the Complainant's business and would be led to think about the disputed domain name as a domain name of the Complainant that has been created to operate an official Banca Mediolanum website. In light of the above, the Complainant argues that the disputed domain name is confusingly similar to the Complainant's BANCA MEDIOLANUM and MEDIOLANUM trademarks.

The Complainant has neither authorized, nor given its consent to, anyone to register and use the disputed domain name. The disputed domain name clearly targets the Complainant's trademarks BANCA MEDIOLANUM and MEDIOLANUM, which are well known in the field of financial and banking services. See *Banca Mediolanum S.p.A. v Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Angelo Passseri*, WIPO Case No. [D2021-1068](#); *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](#).

Moreover, the Respondent cannot be known by the disputed domain, which clearly refers to the Complainant's trademarks BANCA MEDIOLANUM and MEDIOLANUM. There is no evidence that the Respondent has any rights or legitimate interests in the BANCO MEDIOLANUM name, or that the Respondent is commonly known by the disputed domain name.

Moreover, the disputed domain name resolves to a parking page hosting banking and financial services-related links. The said parking page features links that redirect visitors to third parties' websites, including websites of competitors of the Complainant. Moreover, one of the featured links is entitled "Conto Deposito Mediolanum", which suggests a connection with the Complainant's current account products "Conto Mediolanum" and "Conto Deposito". Another link is entitled "Mediolanum Accesso" (Italian for "Mediolanum Access"), which suggests a connection to the access page of Banca Mediolanum on-line banking services. Obviously, such use of the disputed domain name is neither a bona fide offering of goods nor a legitimate noncommercial or fair use and, therefore, it cannot confer any rights or legitimate interests. Moreover, two of these links, namely those entitled "Conto Deposito Mediolanum" and "Mediolanum Accesso" are evidently related to the Complainant's business and are based on the "trademark value" of the term "MEDIOLANUM". Therefore, the disputed domain name and its use are clearly capitalizing on the Complainant's trademark and are misleading Internet users.

Bad faith registration and use of a domain name by a respondent may also result from the fact that its good faith use is in no way plausible considering the specificity of the activity of the complainant and to which the

disputed domain name refers. The highly regulated banking and financial activities of the Complainant under the trade name and trademark BANCA MEDIOLANUM render implausible any good faith by the Respondent in registering and using the disputed domain name.

Actually, the disputed domain name creates a likelihood of confusion with the Complainant's trademarks MEDIOLANUM and BANCA MEDIOLANUM and diverts visitors to websites of competitors of the Complainant, potentially allowing the Respondent to obtain revenues via pay-per-click advertising links or unfair advantage by attracting visitors that are looking for the Complainant. It is worth noting that even if the links featured on the Respondent's website were created by a third party, such as the registrar of the disputed domain name, and even if the Respondent itself might not have directly profited from pay-per-click revenues generated by the links hosted by the page, such circumstances would not prevent the finding of bad faith. A domain name registrant cannot in fact disclaim responsibility for the contents appearing on a website using its domain name, taking also into account that in domain name registration agreements, registrants undertake not to infringe third party rights, and registrants have the option not to have the domain name resolving to a parked page featuring pay-per-click advertisements or links to third-party advertising, products or services or other kind of contents.

All the above considered, it is to be concluded that the disputed domain name has been registered and is being used by the Respondent in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainant must prove each of the following:

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

### **A. Identical or Confusingly Similar**

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

From the submitted evidence it is clear that the Complainant is the owner of the registered trademarks BANCA MEDIOLANUM and MEDIOLANUM. Hence, the Panel concludes that the Complainant has shown rights in respect of a trademark for the purposes of the Policy.

It is standard practice to disregard the gTLD under the confusingly similar test. The disputed domain name incorporates the Complainant's trademarks MEDIOLANUM and BANCA MEDIOLANUM in their entirety, save for the second letter "a" in the term "banca" which is replaced by the letter "o". The term "banco" is the masculine form of the Italian word "banca", which means "bank" in English. The Panel finds that the misspelling of the term "banca" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademarks.

Having the above in mind, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademarks and that the Complainant has proven the first requirement of the Policy under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

The Complainant must show that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) the Respondent uses or has made preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services prior to the dispute; or
- (ii) the Respondent is commonly known by the disputed domain name, even if the Respondent has not acquired any trademark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

From the submitted material, it is clear that the Complainant's trademark registrations for BANCA MEDIOLANUM and MEDIOLANUM predate the Respondent's registration of the disputed domain name. The Complainant has not licensed, approved, or in any way consented to the Respondent's registration and use of the trademarks in the disputed domain name. There is no evidence in the case file indicating that the Respondent has used or made any preparations to use the disputed domain name in connection with a bona fide offering of goods or services prior to the dispute. On the contrary, the Complainant has submitted evidence that the Respondent is using the disputed domain name, which is confusingly similar to the Complainant's trademarks, to display sponsored commercial pay-per-click links competing with or capitalizing on the Complainant's trademarks.

Although given the opportunity, the Respondent has not rebutted the Complainant's prima facie case. The Respondent has not submitted any evidence indicating that it is the owner of any trademark or that it is commonly known by the disputed domain name. Furthermore, there is no evidence indicating that the Respondent intends to make a legitimate, noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

The Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy or otherwise, any rights or legitimate interests in respect of the disputed domain name. In light of the above, there is no evidence in the case that refutes the Complainant's submissions, and the Panel concludes that the Complainant has also proven the requirement under paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use include without limitation:

- (i) circumstances indicating the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) circumstances indicating that the disputed domain name was registered in order to prevent the owner of a trademark or service mark from reflecting the mark in a corresponding disputed domain name, provided there is a pattern of such conduct; or
- (iii) circumstances indicating that the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the disputed domain name has intentionally been used in an attempted to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website or location.

As previously noted, the Complainant's trademark registrations predate the registration of the disputed domain name. Given that the disputed domain name incorporates the Complainant's trademarks in their entirety, except for the substitution of the second letter "a" in the term "banca" with the letter "o", it is inconceivable that that the Respondent coincidentally registered the disputed domain name without any knowledge of the Complainant. In light of the above and in the absence of any evidence to the contrary, the Panel agrees with the Complainant that the Respondent knew or should have known of the Complainant's trademarks when registering the disputed domain name.

Furthermore, the Complainant has provided evidence that the disputed domain name resolves to a parking website with sponsored commercial pay-per-click links that compete with or capitalize on the Complainant's trademarks and redirect Internet users and consumers to competitors of the Complainant. Hence, the evidence and the circumstances in the case indicate that the disputed domain name has been registered and used by the Respondent in an attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the website or of a product or service on that website.

Based on the evidence presented in the Complaint, which the Respondent has not contested, the Panel is convinced, on the balance of probabilities, that the Respondent registered and used the disputed domain name with the Complainant's trademarks in mind. There is no evidence in the case file that refutes the Complainant's submissions, and the Panel concludes that the Complainant has proved the requirements under paragraph 4(b) of the Policy and that the disputed domain name has been registered and used in bad faith.

## **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 <bancomediolanum.online> shall be transferred to the Complainant.

*/Johan Sjöbeck/*

**Johan Sjöbeck**

Sole Panelist

Date: October 16, 2024