

ADMINISTRATIVE PANEL DECISION

Banco BPM S.P.A. v. Roman LEBON, David BRIE, Gonzalez Marc
Case No. D2022-3839

1. The Parties

The Complainant is Banco BPM S.P.A., Italy, represented by Bugnion S.A., Italy.

The Respondents are Roman LEBON, France, David BRIE, France, Gonzalez Marc, Benin.

2. The Domain Names and Registrars

The disputed domain names <bpmplatform.com>, <platformabpm.com>, and <popolarefinanza.com> are all registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 13, 2022. On October 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 17, 2022, 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 October 21, 2022.

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 Respondents of the Complaint, and the proceedings commenced on October 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 13, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on November 15, 2022.

The Center appointed Anne-Virginie La Spada as the sole panelist in this matter on November 18, 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 a bank based in Italy. It started its operations on January 1st, 2017, following the merger of Banco Popolare Soc Coop. and Banca Popolare di Milano. Following the merger, the Complainant became one of the largest banks in Italy.

Among other registrations, the Complainant owns the following trademark registrations:

- European Union Trademark registration No 5240478 for CREDITO POPOLARE, registered on August 4, 2006 in classes 9, 16, 35, 36, 38, 39, 41, and 42;
- Italian Trademark registration No 362017000052969 for BANCO POPOLARE, registered on January 31, 2018,;
- European Union Trademark registration No 015472939 for BANCO BPM, registered on May 26, 2016, in classes 9, 16, 35, 36, 38 and 41.

The Complainant owns a large number of trademarks including the terms CREDITO POPOLARE or BANCA POPOLARE followed by the name of an Italian city, as well as other marks including the term “popolare” such as POPOLARE ASSICURA.

The Complainant is also the owner of close to 100 domain names containing the terms “bpm” and “popolare”.

The Respondent Gonzalez Marc registered the disputed domain name <popolarefinanza.com> on January 31, 2022. The disputed domain name <popolarefinanza.com> is connected to a website purportedly offering banking and financial services under the name POPOLARE FINANZA.

The Respondent Romain Lebon registered the disputed domain name <piattaformabpm.com> on March 21, 2022. The disputed domain name <piattaformabpm.com> is connected to a website purportedly offering banking and financial services under the name PIATTA FORMA BPM. The website reproduces certain texts and images featured in the Complainant’s website <bancobpm.it>. Furthermore, the website designates the Complainant, as well as an entity allegedly named POPOLARE FINANZA, as PIATTA FORMA BPM’S partners. The name POPOLARE FINANZA is featured with a logo that is identical to the one featured on the website connected with the disputed domain name <popolarefinanza.com>.

The Respondent David Brie registered the disputed domain name <bpmiattaforma.com> on March 29, 2022. The disputed domain name <bpmiattaforma.com> is connected to a website purportedly offering banking and financial services under the name PACIFICO BANK ONLINE.

All three websites mention the same telephone number, and the websites at the disputed domain names <popolarefinanza.com> and <bpmiattaforma.com> mention the same address in Milan. There is no financial institution at the address (in Milan) mentioned in the websites connected to these two disputed domain names, according to the Complainant’s verification.

5. Parties' Contentions

A. Complainant

According to the Complainant, the disputed domain names are confusingly similar to its trademarks containing the elements POPOLARE and BPM, as they identically reproduce its trademarks with the mere addition of the descriptive terms "piattaforma" ("platform") and "finanza" ("finance"), terms that can be confused or associated with the other descriptive terms in the Complainant's trademarks like "banco" or "credito" ("bank" or "credit").

The Complainant further contends that the Respondents have no rights or legitimate interests in the disputed domain names, as the Respondents are not authorized by the Complainant to use the disputed domain names, and there is no indication that the Respondents are known under the disputed domain names. According to the Complainant, the Respondents have not used the disputed domain names in connection with any *bona fide* offering of goods or services, nor are the Respondents making any legitimate noncommercial or fair use of the disputed domain names.

Finally, the Complainant contends that the Respondents have used and registered the disputed domain names in bad faith. According to the Complainant, the disputed domain names are being intentionally used to host websites that convey the misleading impression that they are associated with the Complainant. This demonstrates, in the Complainant's eyes, an intention to take advantage of the goodwill and reputation of the Complainant.

B. Respondent

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

6. Discussion and Findings

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

- (i) the domain name registered by the respondent 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 respect of the domain name; and
- (iii) the domain name registered by the respondent has been registered and is being used in bad faith.

A. Consolidation of the Respondents

The Complainant has requested to be allowed to proceed against the three Respondents in a single complaint, because it believes that the disputed domain names are under common control.

The Panel will address first this procedural issue before turning to the material conditions set forth in paragraph 4(a) of the Policy.

According to section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies), (ii) the registrants' contact information, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (*e.g.*, where a registrant targets a specific

sector), (vi) any naming patterns in the disputed domain names, (vii) the relevant language/scripts of the disputed domain names, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).

In the present case, the factors suggesting common control are the following: the disputed domain names are registered with the same Registrar. Two of the websites connected to the disputed domain names <popolarefinanza.com> and <bpmiattaforma.com> indicate the same street address, whereas all of the disputed domain names indicate the same telephone number on their websites. The disputed domain names <piattaformabpm.com> and <popolarefinanza.com> seem to be related. Indeed, the website connected to the disputed domain name <piattaformabpm.com> suggests that the operator of the website has a partnership with the entity operating the website connected to the disputed domain name <popolarefinanza.com>. Furthermore, the disputed domain names <bpmiattaforma.com> and <piattaformabpm.com> were registered only days apart and are almost identical. Finally, all three domain names were registered in the name of the same privacy service with an address in Iceland.

On the other hand, the Respondents' contact details in the Whois records indicate different names, street addresses, telephone numbers, and email addresses. On the basis of the Annexes to the Complaint, the Panel did not see a strong similarity in the layout of the websites to which the disputed domain names resolved, though notes that each website allegedly operates in the same financial sector as the Complainant.

In view of the above, on the balance of probabilities, the Panel is of the view that the present case is sufficient for consolidation. The Panel will indeed allow it, because it considers that the indication of the same street address in two websites and the same telephone number in the three websites operated under the disputed domain names, and the presence of the same logo on two of such websites, combined with the choice of the same Registrar and the same privacy service provider, and the registration in the same timeframe, is unlikely to be coincidence. In addition, consolidation will not be detrimental to any of the Respondents. The Respondents did not file a response to the Complaint, and did not express any opposition to the consolidation, even though they received both a consolidation notice and Notification of the Complaint. Such being the case, the Panel considers that consolidation is fair and equitable to all Parties.

B. Identical or Confusingly Similar

The disputed domain name <popolarefinanza.com> incorporates partially the Complainant's trademarks BANCO POPOLARE or CREDITO POPOLARE, among other POPOLARE-formative trademarks in the Complainant's portfolio, insofar as it reproduces the term "popolare". This term, which means "popular" in Italian, is combined in the disputed domain name with the term "finanza" (meaning "finance" in Italian), whereas in the Complainant's mark, the term "popolare" is combined with the terms "banco" or "credito" (meaning respectively "bank" and "credit" in Italian).

The common element of the trademarks and the disputed domain name is thus the term "popolare". Such term has a limited inherent distinctiveness due to its being a dictionary word. However, it may nevertheless be considered as being the dominant element of the Complainant's family of POPOLARE-formative trademarks, as it remains the only constant trademarked element in the Complainant's family of POPOLARE-formative trademarks and the added elements BANCO and CREDITO are descriptive for financial institutions. The Panel is therefore of the view that the dominant feature of the Complainant's POPOLARE-formative trademarks is recognizable in the disputed domain name <popolarefinanza.com>.

The disputed domain names <bpmiattaforma.com> and <piattaformabpm.com> incorporate partially the Complainant's BANCO BPM mark, insofar as they reproduce the element BPM, and combine it with term "piattaforma" (meaning "platform" in Italian).

The most distinctive element of the Complainant's trademark BANCO BPM is the acronym BPM, which has no immediately perceivable meaning, whereas "banco" means "bank" in Italian. The Panel is therefore of the

view that the dominant feature of the Complainant's trademark BANCO BPM is recognizable in the disputed domain names <bpmplatform.com> and <platformbpm.com>.

In cases where a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. Also, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) to a domain name where the relevant trademark is recognizable within the disputed domain name is considered by panels to be confusingly similar to the relevant mark for purposes of the first element (see [WIPO Overview 3.0](#), sections 1.7 and 1.8). In the present case, the additions of the descriptive terms "finanza" ("finance"), or "piattaforma" ("platform"), do not prevent a finding of confusing similarity between the disputed domain names and the Complainant's trademarks.

UDRP panels accept that a generic Top-Level-Domain, such as ".com", may be disregarded when assessing whether a domain name is identical or confusing similar to a trademark (see [WIPO Overview 3.0](#), section 1.11.1).

The Panel finds accordingly that the Complainant has successfully established the requirement under paragraph 4(a)(i) of the Policy with respect to the disputed domain names.

C. Rights or Legitimate Interests

Based on the information submitted by the Complainant, the Respondents do not appear to have rights or legitimate interests in respect of the disputed domain names, nor has the Complainant granted to the Respondents any authorization to use the disputed domain names. Moreover, there is no evidence indicating that the Respondents are commonly known by the disputed domain names.

The Respondents do not appear to have operated any *bona fide* or legitimate business under the disputed domain names and are not making a noncommercial or fair use of the disputed domain names. According to the Complainant's verification, there is no financial institution at the street address indicated in the two websites to which the disputed domain names <popolarefinanza.com> and <bpmplatform.com> resolve. Moreover, the disputed domain name <platformbpm.com> displays the Complainant's BANCO BPM trademark and logo, as well as content from the Complainant's website. This website also displays the "Popolare Finanza" name and logo present on the website <popolarefinanza.com>. Such use further supports the apparent lack of rights or legitimate interests of the Respondents in the disputed domain names. Indeed, creating the appearance of a link with the Complainant can hardly be a legitimate or fair use.

Finally, the Respondents did not file a response to the Complaint. The Panel may draw from the lack of a Response the inferences that it considers appropriate, according to the Rules, paragraph 14(b).

In view of the above, the Panel finds that the Complainant has established a *prima facie* case that the Respondents lack rights or legitimate interests in the disputed domain names, and that the Respondents' silence corroborates such *prima facie* case.

Accordingly, the Panel finds that the Respondents have no rights or legitimate interests in the disputed domain names, and that the Complainant has satisfied the condition set out in paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Given that the trademark BANCO BPM of the Complainant is distinctive, that the Respondents supposedly offer banking and financial services (same/similar services offered by the Complainant), and that one Respondent claimed on its website to be in a partnership with the Complainant, the Panel accepts that the Respondents were aware of the existence of the Complainant and of its trademark at the time of the registration of the disputed domain names <bpmplatform.com> and <platformbpm.com>. Accordingly,

the Panel finds that such disputed domain names were registered in bad faith.

The Complainant has shown its ownership of a family of trademarks containing the term “popolare” combined with words in the banking field. Moreover, the Complainant’s corporate name and trademark BPM appear to be an acronym consisting of the term “popolare”, which is derived from the 2017-merger of Banco Popolare Soc Coop. and Banca Popolare di Milano (BPM). This to suggests that the Complainant’s predecessors used and were known by the term “popolare” and, considering the merger resulted in Complainant’s status as one of the largest banks in Italy, would further support an element of notoriety behind such term and the Complainant. The Panel finds it therefore likely that the Respondents were aware of the Complainant’s trademarks BANCO POPOLARE and/or CREDITO POPOLARE at the time of registration of the disputed domain name <popolarefinanza.com>.

Moreover, the Panel’s bad faith finding is reinforced given the disputed domain names’ incorporation of the trademarked terms “popolare” and “bpm” with words descriptive of the financial industry, creating disputed domain names that evoke the Complainant’s trademarks, indicating that the Respondents have used the terms “bpm” and “popolare” in the disputed domain names as source identifiers for the Complainant, so as to generate increased Internet traffic based on the association with the Complainant and its notoriety in the banking world. Similarly, taking into consideration the common scheme behind the disputed domain names to operate websites for alleged financial services that would directly compete with the Complainant, the Respondents were aware of and intended to target the Complainant.

Under paragraph 4(b)(iv) of the Policy, the use of a disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 a web site or location or of a product or service on the website or location, amounts to evidence of registration and use in bad faith.

For the reasons set out above, the Panel finds that the Respondents have registered and are using the disputed domain names in bad faith, and that the Complainant has satisfied the condition set forth in 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 names, <popolarefinanza.com>, <bpmpiattaforma.com>, and <piattaformabpm.com>, be transferred to the Complainant.

/Anne-Virginie La Spada/

Anne-Virginie La Spada

Sole Panelist

Date: December 19, 2022