Decision for dispute CAC-UDRP-101458

Case number	CAC-UDRP-101458
Time of filing	2017-03-03 09:50:06
Domain names	ALEXBANK.BIZ

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	buy domain

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following registrations for the trademarks “ALEXBANK” and “BANK OF ALEXANDRIA”:

-Egyptian trademark application n. 245180 “ALEX BANK”, filed on April 29, 2010, in relation with class 36;

-International trademark registration n. 965677 “BANK OF ALEXANDRIA” (in Latin and Arabian character), granted on May 6, 2008, in classes 9, 16, 35, 36, 38 41 and 42;

-Community trademark registration n. 6662944 “BANK OF ALEXANDRIA” (in Latin and Arabian character), filed on February 12, 2008 and granted on January 22, 2009, in classes 9, 16, 35, 36, 38 41 and 42;

-Community trademark registration n. 6433106 “BANK OF ALEXANDRIA”, filed on November 13, 2007 and granted on October 2, 2008, in classes 9, 16, 35, 36, 38 41 and 42;

-Italian trademark registration n. 1110440 “BANK OF ALEXANDRIA” (in Latin and Arabian character), filed on March 7, 2008

and granted on May 6, 2008, in classes 9, 16, 35, 36, 38 41 and 42.

Moreover, the Complainant owns, among the others, the domain names <ALEXBANK.COM>, <BANKOFALEXANDRIA.EU>, <BANKOFALEXANDRIA.IT> and <BANKOFALEXANDRIA.COM.EG>.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is the leading Italian banking group and also one of the protagonists in the European financial arena. Intesa Sanpaolo is the company resulting from the merger (effective as of January 1, 2007) between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups.

Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 36,3 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,000 branches capillary and well distributed throughout the Country, with market shares of more than 13% in most Italian regions, the Group offers its services to approximately 11.1 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.200 branches and over 7,8 million customers. Moreover, the international network specialised in supporting corporate customers is present in 29 countries, in particular in the Mediterranean area and those areas where Italian companies are most active, such as the United States, Russia, China and India.

The Complainant is the major shareholder of Bank of Alexandria (commonly known as “Alex Bank”), one of the largest banks in Egypt, with 210 branches across the country, a market share of almost 7% and assets of 5.2 billion Euros.

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

On January 24, 2017, the Respondent registered the disputed domain name “ALEXBANK.BIZ”.

The Complainant proclaims that: it is more than obvious that the disputed domain name is confusingly similar to the Complainant’s trademarks. In fact, the disputed domain name “ALEXBANK.BIZ” exactly reproduces the trademark “ALEXBANK”, while it is highly similar to the trademark “BANK OF ALEXANDRIA”, both owned by the Complainant.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant argues that: the Respondent has no rights on the disputed domain name, since “buy domain” has nothing to do with Intesa Sanpaolo. In fact, any use of the trademarks “ALEXBANK” and “BANK OF ALEXANDRIA” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the disputed domain name. The disputed domain name at stake does not correspond to the name of the Respondent and, to the best of our knowledge, “buy domain” is not commonly known as “ALEXBANK”. Lastly, we do not find any fair or non-commercial uses of the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

The Complainant finally contends that the disputed domain name “ALEXBANK.BIZ” was registered and is being used in bad faith.

The Complainant asserts that: its trademarks “ALEXBANK” and “BANK OF ALEXANDRIA” are distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant’s trademarks at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wordings “ALEXBANK” and

“BANK OF ALEXANDRIA”, the same would have yielded obvious references to the Complainant. This raises a clear inference of knowledge of the Complainant’s trademarks on the part of the Respondent. Therefore, it is more than likely that the disputed domain name would not have been registered if it were not for the Complainant’s trademarks. This is a clear evidence of registration of the disputed domain name in bad faith.

In addition, the disputed domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site (par. 4(b)(iv) of the Policy). Furthermore, the Complainant argues that the disputed domain name has been acquired by the Respondent for the purpose of selling the disputed domain name registration to the Complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name itself (par. 4(b)(i) of the Policy).

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

REQUEST FOR ENGLISH TO BE THE LANGUAGE OF THIS ADMINISTRATIVE PROCEEDING

It is true that the language of the registration agreement is Japanese.

However, the Complainant is an Italian company, while the Respondent is Chinese. Consequently, the present Complaint was written in English, an international language comprehensible to a wide range of Internet users worldwide. Since the spirit of Paragraph 11 of the Rules seems to be to ensure fairness in the selection of language by giving full considerations to the parties’ level of comfort with each language, English seemed to be the fair language in the present proceeding.

It is true that there are no evidences of an agreement between the Complainant and the Respondent to the effect that the proceedings should be in English.

Given the above, it is not possible to ignore that the present dispute has been started because the Respondent deliberately registered a domain name which is identical to a well-known registered trademark legitimately owned and used by the Complainant from several years all around the world. Since it is inconceivable that the Respondent was not aware of such circumstance when it registered the disputed domain name, the Complainant believes that a fair solution shall be – at least – to:

1) accept the Complaint filed in English;

2) accept a Response in either English, or Japanese, or Chinese (or the preferable language of the Respondent, if any);

3) appoint a Panel familiar with both languages.

So, in accordance with the instructions submitted by the CAC, for the reasons described above, the Complainant hereby requests the Case Manager to maintain English the proceeding language or, at least, one of the languages accepted by the Panel.

The Panel has discretion to determine the appropriate language of the proceedings on appointment. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Ed. The Complainant respectfully requests that the proceedings be conducted in English. See Zappos.com, Inc. v. Zufu aka Huahaotrade, Case No. D2008-1191 (WIPO Oct. 15, 2008) (holding that proceedings could be conducted in English even though the registration agreement was in Chinese where "the disputed domain resolves to a website [that] is exclusively in English, from which can be reasonably presumed that the Respondent has the ability to communicate in English in order to conduct his business over the website in English"). Moreover, conducting these proceedings in a language other than English will cause the Complainant to incur significant additional burden and delay to translate the Complaint and other documents. See SWX Swiss Exchange v. SWX Financial LTD, D2008-0400 (WIPO May 12, 2008) (in determining the language of the proceeding, "account should be taken of the risk that a strict and unbending application of paragraph 11 may result in delay, and considerable and unnecessary expenses of translating documents…"). Moreover, the current proceeding will have to be divided if it cannot be conducted solely in English, resulting in additional burden and delay.

Given Respondent's no objection to the Complainant's language request and its absence of Response to the Complaint, the Panel determines that English is the language for these proceedings.

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

i) The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

The Complainant is the owner of the above-listed registrations for the trademarks "ALEXBANK" and "BANK OF ALEXANDRIA".

Next, the Complainant argues that the disputed domain name <ALEXBANK.BIZ> is confusingly similar to the Complainant's mark. The Panel agrees that the disputed domain name differs from the mark by including eliminating spacing which domain name syntex requires, and appending the ".biz" generic top-level domain ("gTLD"). Such alterations have not been considered distinguishing under Policy ¶ 4(a)(i). See Bank of America Corporation v. Above.com Domain Privacy, FA 1629452 (FORUM Aug. 18, 2015) (finding that the <blankofamerica.com> domain name contains the entire BANK OF AMERICA mark and merely adds the gTLD '.com' and the letter 'l' to create a common misspelling of the word 'bank.'); see also Am. Int'l Group, Inc. v. Domain Admin. Ltd., FA 1106369 (FORUM Dec. 31, 2007) (finding that "spaces are impermissible and a generic top-level domain, such as '.com,' '.net,' '.biz,' or '.org,' is required in domain names"). Therefore, the panel finds that the disputed domain name <ALEXBANK.BIZ> is confusingly similar to the Complainant's [ALEX BANK] mark. As such, the Panel holds that <ALEXBANK.BIZ> is confusingly similar to the Complainant's ALEX BANK mark under Policy ¶ 4(a)(i).

ii) The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

The Respondent has no rights in the disputed domain name, since "buy domain" has nothing to do with Intesa Sanpaolo. In fact, any use of the trademarks "ALEXBANK" and "BANK OF ALEXANDRIA" has to be authorized by the Complainant. Nobody has been authorized or licensed by the Complainant's banking group to use the disputed domain name.

The disputed domain name does not correspond to the name of the Respondent and, to the best of the Panel's knowledge,

“buy domain” is not commonly known as “ALEXBANK”.

Lastly the Panel does not find any fair or non-commercial uses of the domain name at stake.

iii) The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

The disputed domain name “ALEXBANK.BIZ” was registered and is being used in bad faith.

The Complainant’s trademarks “ALEXBANK” and “BANK OF ALEXANDRIA” are distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant’s trademarks at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wordings “ALEXBANK” and “BANK OF ALEXANDRIA”, the same would have yielded obvious references to the Complainant. The Complainant submits, an extract of a Google search in support of its allegation. This raises a clear inference of knowledge of the Complainant’s trademarks on the part of the Respondent. Therefore, it is more than likely that the disputed domain name would not have been registered if it were not for the Complainant’s trademarks. This is a clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site (par. 4(b)(iv) of the Policy). Furthermore, the next paragraphs will demonstrate that the disputed domain name has been acquired by the Respondent for the purpose of selling the disputed domain name registration to the Complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name itself (par. 4(b)(i) of the Policy).

First of all, several services can be detected, but not in good faith: in fact, the disputed domain name is connected to a website sponsoring banking and financial services, for whom the Complainant’s trademarks are registered and used (see also the Complainant’s official site http://www.alexbank.com home page).

Consequently, Internet users, while searching for information on the Complainant’s services, are confusingly led to the websites of the Complainant’s competitors, sponsored on the websites connected to the disputed domain name.

Therefore, the Complainant deems that the Respondent has registered and is using the disputed domain name in order to intentionally divert traffic away from the Complainant’s web site.

Several WIPO decisions stated that the registration and use of a domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy. See, e.g., Encyclopaedia Britannica Inc. v. Shedon.com, WIPO Case No. D2000-0753 (“Respondent’s Ownership of a site which is a mis-spelling of Complainant’s britannica.com site and which Respondent used to hyperlink to a gambling site demonstrates Respondent’s bad faith registration and use of the britannnica.com domain name”); YAHOO! INC. v. David Murray, Case No. D2000-1013 (finding bad faith where respondent chooses a domain name similar to the complainant’s mark for a site which offers services similar to the complainant); Edmunds.com v. Ultimate Search, Inc., WIPO Case No. D2001-1319 (“Registration and use of a domain name to redirect Internet users to websites of competing organizations constitutes bad faith registration and use under the Policy”); Netwizards, Inc. v. Spectrum Enterprises, WIPO Case No. D2000-1768 (“Registration and continued use of the contested domain name for re-directing Internet users, i.e. particularly customers and potential customers of the Complainant, from the Complainant’s website to the website of…a company which directly competes with the Complainant, constitutes bad faith registration and use”); Oly Holigan, L.P. v. Private, Case No. FA0011000095940 (finding bad faith where respondent used the disputed domain name to “redirect the Complainant’s consumers and potential consumers to commercial websites which are not affiliated with Complainant”); Marriott International, Inc. v. Kyznetsov, Case No. FA0009000095648 (finding bad faith where respondent registered the domain name <marriottrewards.com> and used it to route internet traffic to another website that “promotes travel and hotel services . . . identical to the services offered by the

Complainant"); Zwack Unicom Ltd v. Duna, WIPO Case No. D2000-0037 (respondent's linking to complainant's competitor held to constitute bad faith); Schneider Electric SA v. Ningbo Wecans Network Technology Co., Ltd, Ningbo Eurosin International Trade Co., Ltd., Case No. D2004-0554; Microsoft Corporation v. StepWeb, Case No. D2000-1500; Baudville, Inc. v. Henry Chan, Case No. D2004-0059; National City Corporation v. MH Networks LLC, Case No. D2004-0128.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ALEXBANK.BIZ**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2017-04-12

Publish the Decision