Decision for dispute CAC-UDRP-101435

Case number	CAC-UDRP-101435
Time of filing	2017-03-03 09:30:48
Domain names	INTESASANPAOLO-PRIVATE.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	PASQUALE AMITRANO

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other 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 “INTESA SANPAOLO” and “INTESA SANPAOLO PRIVATE BANKING”.

-International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;
-EU trademark registration n. 005301999 “INTESA SANPAOLO”, applied on September 08, 2006 and granted on June 18, 2007, in classes 35, 36 and 38;
-EU trademark registration n. 005421177 “INTESA SANPAOLO & device”, applied on October 27, 2006 and granted on November 5, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;
-EU trademark registration n. 006067789 “INTESA SANPAOLO PRIVATE BANKING”, applied on July 4, 2007 and granted on May 20, 2008, in classes 9, 16, 35, 36, 38, 41 and 42;
-EU trademark registration n. 006067862 “INTESA SANPAOLO PRIVATE BANKING & device”, applied on July 4, 2007 and granted on June 6, 2008, in classes 9, 16, 35, 36, 38, 41 and 42;
-EU trademark registration n. 006069603 “INTESA SANPAOLO PRIVATE BANKING & device”, applied on July 4, 2007 and granted on May 20, 2008, in classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

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

Apart from the trademarks, the Complainant is also the owner, among others, of the following domain names bearing the signs “INTESA SANPAOLO” and “INTESA SANPAOLO PRIVATE BANKING”: “INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ” and INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ”, INTESASANPAOLOPRIVATE.COM, INTESASANPAOLOPRIVATE.INFO, INTESASANPAOLOPRIVATE.EU, INTESASANPAOLOPRIVATE.IT, SANPAOLOPRIVATE.COM, SANPAOLOPRIVATE.IT, SANPAOLOPRIVATE.INFO, SANPAOLOPRIVATE.ORG, SANPAOLOPRIVATE.EU, SANPAOLOPRIVATE.NET and SANPAOLOPRIVATE.BIZ. All of them are now connected to the official website www.intesasanpaolo.com.

On January 16, 2017, the Respondent registered the Disputed Domain Name INTESASANPAOLO-PRIVATE.COM.

The Complainant asserts that it is more than obvious that the Disputed Domain Name is identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA SANPAOLO PRIVATE BANKING”.

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 WHOIS PRIVACY PROTECTION SERVICE, INC. has nothing to do with Intesa Sanpaolo. In fact, any use of the trademarks “INTESA SANPAOLO” and “INTESA SANPAOLO PRIVATE BANKING” 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 Complainant further asserts that the Disputed Domain Name does not correspond to the name of the Respondent and, to the best of its knowledge, WHOIS PRIVACY PROTECTION SERVICE, INC. is not commonly known as “INTESASANPAOLO-PRIVATE”.

Lastly, the Complainant does not find any fair or non-commercial uses of the Disputed Domain Name.

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

The Complainant argues that the domain name INTESASANPAOLO-PRIVATE.COM was registered and is used in bad faith, as the Respondent had knowledge of the Complainant’s trademark at the time of registration of the Disputed Domain Name, the Disputed Domain Name is not used for any bone fide offerings and the risk of a wrongful use of the Disputed Domain Name is even higher in the present case, since the Complainant has already been targeted by some cases of phishing in the past few years.

Lastly, the Complainants informs that on February 6, 2017 the Complainant’s attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the Disputed Domain Name to their client. The Respondent never replied to such communication.

In the light of the above, the Complainant concludes that the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

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 Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

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

The Panel finds that the Disputed Domain Name “intesasanpaolo-private.com” is confusingly similar to the Complainant's "INTESA SANPAOLO" and "INTESA SANPAOLO PRIVATE BANKING" trademarks, since (1) the Disputed Domain Name incorporates the Complainant's trademark "INTESA SANPAOLO" in its entirety and the mere addition of the generic term "private" is not capable to dispel the confusing similarity arising from the Complainant's trademarks incorporation in the Disputed Domain Name and (2) the Disputed Domain Name also incorporates the Complainant's trademark "INTESA SANPAOLO PRIVATE BANKING" and the mere omission of the generic term "banking" as well is not capable to dispel the confusing similarity arising from the Complainant's trademarks incorporation in the Disputed Domain Name. In fact, the Disputed Domain Name somehow corresponds to both of the Complainant's trademarks showing similarities with each of them.

Moreover, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent so far has neither made use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the Disputed Domain Name, nor is the Respondent commonly known thereunder. The Disputed Domain Name so far apparently has not yet been used by the Respondent whatsoever (so-called “passive holding”). Many UDRP panels have recognized that the mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase, may not of itself confer rights or legitimate interests in a disputed domain name. Accordingly, the Panel has no difficulty in finding that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Finally, the Complainant points to the fact, and the Panel agrees with this line of argumentation, that given the reputation of the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA SANPAOLO PRIVATE BANKING” all around the world and given that the Respondent has registered a domain name that actually is kind of a combination of those two trademarks,

clearly indicates that the Respondent had knowledge of the Complainant's trademarks at the time of the registration of the Disputed Domain Name. Also, there is a consensus view among UDRP panellists that a passive holding of a disputed domain name may, in appropriate circumstances, be consistent with the finding of bad faith, in particular in circumstances in which, for example, a complainant's trademark is well-known, and there is no conceivable use that could be made of the disputed domain name that would not amount to an infringement of the complainant's trademark rights. In the case at hand, in the absence of any other reasonable explanation as to why the Respondent should rely on the Disputed Domain Name and against the background that the Respondent has brought forward nothing in substance relating to the intended use of the Disputed Domain Name that would have allowed the Panel to hold for Respondent, the Panel finds that the Respondent has registered and is making use of the Disputed Domain Name in a manner which at least takes unjustified and unfair advantage of the Complainant's "INTESA SANPAOLO" and "INTESA SANPAOL PRIVATE BANKING" trademarks' fame and must, therefore, be considered as registered and being used in bad faith within the meaning of the Policy. In this context, it also carries weight in the eyes of the Panel that the Respondent had made use of a Privacy Service apparently in an attempt to conceal his true identity. Such behavior at least throws a light on the Respondent which supports the finding of a registration and making use of the Disputed Domain Name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO-PRIVATE.COM**: Transferred

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2017-04-24

Publish the Decision