Decision for dispute CAC-UDRP-101433

Case number	CAC-UDRP-101433
Time of filing	2017-02-13 10:40:43
Domain names	BANKSANPAOLO.COM

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	Pearson Solutions Inc. - Freyr Thorsson

Respondent representative

Organization	Core Holdings Legal Department - Latam

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following “INTESA“, “INTESA SANPAOLO“, “SANPAOLO IMI & device“, “BANCA INTESA SANPAOLO“ and “BANCA INTESA“ trademarks in several classes and domain names bearing “INTESA SANPAOLO“ phrase.

-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”, granted on June 18, 2007, in classes 35, 36 and 38;

-EU trademark registration n. 005421177 “INTESA SANPAOLO & device”, granted on November 5, 2007, in classes 9, 16, 35, 36, 38, 41 and 42

-International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed until September 4, 2022, in connection with class 36;

-EU trademark registration n. 002803773 “INTESA”, granted on November 17, 2003 and duly renewed until August 7, 2022, in connection with class 36;

-US trademark registration n. 4196961 “INTESA”, granted on August 28, 2012, in connection with class 36;

- International trademark registration n. 714661 “SANPAOLO IMI & device”, granted on May 27, 1999 and duly renewed until May 27, 2019, in classes 9, 35, 36 and 42;

-EU trademark registration n. 001182716 “SANPAOLO IMI & device”, granted on July 19, 2000 and duly renewed until May 24, 2019, in classes 9, 35, 36 and 42;

-International trademark registration n. 831572 “BANCA INTESA”, granted on June 24, 2004 and duly renewed, in class 36;

-EU trademark registration n. 005302377 “BANCA INTESA SANPAOLO”, granted on July 6, 2007 and duly renewed, in classes 35, 36 and 38.

FACTUAL BACKGROUND

The Complainant is a 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.

The Complainant 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).

The Respondent, Pearson Solutions Inc.-Freyr Thorsson, acts on behalf of Core Holdings Ltd which sponsors a charity under the legal name of „Banco San Paolo de Alimentos“ (San Paolo Food Bank). The said charity was conceived in 2014 under the guidance of several Catholic institutions in Latin America, and especially in the Republic of Colombia. As a project, it is directly sponsored by 3 major nonprofit Catholic organizations headquartered in Colombia and a private, for profit, organization established in the island of Curacao, Netherlands Antille.

On December 28, 2016, the Respondent registered the domain name <banksanpaolo.com> and uses the domain to carry out a food bank project.

On January 31, 2017, the Complainant has sent a cease and desist letter to the Respondent and the Respondent did not comply with the Complainant’s request.

In March 2017, the Respondent and the Complainant tried to settle the matter amicably. However, they have failed to finalize the settlement process and on the date of March 30, 2017 the Respondent has submitted its Response petition.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. The Domain Name is identical or confusingly similar to the EU and IR trademarks of the Complainant and also to the Complainant's registered domain names bearing the "INTESA SANPAOLO" phrase within.
The Complainant provides a list of its registered trademarks and domain names and claims that the disputed domain name <banksanpaolo.com> exactly reproduces the trademarks "BANCA INTESA" and "BANCA INTESA SANPAOLO" while it is highly similar to the other trademark registrations owned by the Complainant.

2. The Respondent has no rights or legitimate interests in the Domain Name.
The Complainant claims that the domain name at stake does not correspond to the name of the Respondent and it is not commonly known as "BANKSANPAOLO" and not any fair or non-commercial uses of the Respondent have been found.

3. The Domain Name has been registered and is being used in bad faith.
The Complainant referred to the deliberate provision of false/misleading services and "phishing" financial information. Not complying with the Complainant's settlement request after receiving the cease and desist letter was also shown as an activity of bad faith.

RESPONDENT:

1. As concerns the purported identicalness or confusing similarity of the Domain Name to the trademark of the Complainant:

The Respondent alleged that the Complainant has not proved that the Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights since the Complainant's registered trademarks all include the distinctive "INTESA" phrase and none of them consists of the "SANPAOLO" phrase itself but only alongside with the "INTESA" phrase. Moreover, the incorporation of the phrase "BANK" shall also not be taken into account as a fact increasing confusing similarity since it is used by the Respondent in the same way with the dictionary meaning of the phrase "BANK".

2. As concerns the Respondent's purported lack or rights or legitimate interests:

Firstly, the Respondent stated that the term "San Paolo", meaning "Saint Paul" in English, refers to a public term and therefore the Complainant may not have universal monopoly on the subject term. Secondly, considering that the Respondent is providing information regarding a food bank project under a religious catholic identity, the Respondent has legitimate interest on use of the phrase "BANKSANPAOLO". Moreover, the Respondent is a non-profit making company and does not have any commercial gain from its services provided under the <banksanpaolo.com> domain name.

3. As concerns the purported bad faith at registration and use of the domain name:

The Respondent alleged that, in registering the Domain Name, it was motivated by an independent intent, unrelated to the Complainant. The Respondent did not intent to attract internet users to its website. To the contrary, the Respondent did its best to dispel any possible confusion about the source of the website and increased its security after a hacker activity was reported. The Complainant nowhere argues that Respondent is its „competitor". The Respondent claims that it had no knowledge of the Complainant at the time it registered the Domain Name. The Complainant offers no facts, evidence, or case support that the Respondent, would have had either actual or constructive knowledge of the Complainant at the time it registered the Domain Name. Finally, not responding to the cease and desist letter does not show bad faith of the applicant.

4. Reverse domain name hijacking:

The Respondent states that it duly carried out its duties and also pursued a peaceful settlement attempt in good faith which allegedly failed due to the Complainant. The Respondent claims that it is the Complainant who is acting in bad faith.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is 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 not, to the satisfaction of the Panel, shown that the Respondent has 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 not, to the satisfaction of the Panel, shown that 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 the UDRP Policy were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

A. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

B. The Respondent has no rights or legitimate interests in respect of the domain name; and

C. The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

As regards paragraph 4(a)(i) of the UDRP Policy, it is well established that the generic TopLevel Domains (“gTLDs”) may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy. The Panel noted that the Complainant does not have any established rights on the stand-alone “SANPAOLO” trademark which is a geographical term and also the Italian translation of the “Saint Paul” in English. The Complainant holds certain registered trademarks which contain the “SANPAOLO” phrase together with other dominant and distinguishing elements such as “INTESA”, “BANCA INTESA” and “IMI”. The Panel finds that the disputed domain name is not identical with the Complainant’s trademarks; however, it may be evaluated as confusingly similar particularly to the Complainant's "SANPAOLO IMI" and “BANCA INTESA SANPAOLO” to a certain extent despite the fact that the Panel does not take into evaluation the weak distinctive character of the “SANPAOLO” phrase and notes that these trademarks include other dominant elements such as “IMI” and “INTESA”.

The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademarks. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is open to a Respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [the Respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you [the Respondent] are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the Respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the Complainant will have failed to discharge its burden of proof and the Complaint will fail.

The Respondent submits that it has a legitimate interest in the disputed domain name because it consists of an ordinary word of “BANK” which the Respondent, like any other registrant, was entitled to register as a domain name, provided that it is genuinely used for purposes coming within the ordinary meaning of the word and not to copy or trade off the Complainant’s trademark and provided also that it is not being used to target or do damage to the Complainant. Therefore, the Panel concludes that there does not exist any valid reason to prevent the Respondent to use the word “BANK”.

Moreover, in relation to the word “SANPAOLO”, it is clear that it is a commune in the Province of Brescia, in the Lombardy region of Italy and as also mentioned within the Response petition “San Paolo”, referring to “Saint Paul” in English, is a name of a Catholic saint. Therefore it shall be considered as a public word. Considering that “SANPAOLO” refers to a religion related term, the Panel concludes that Respondent succeeds to prove its legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue by showing that it gives information regarding a non-profit making food bank project.

Evaluation of the Panel remains the same on the basis of the explanations above for a combined used of “BANKSANPAOLO” within the disputed domain name.
The Panel’s conclusion, therefore, is that the Complainant did not establish a prima facie case for the second of the three elements that it must establish whereas the Respondent has put forward that it has a legitimate interest in the disputed domain name.

C. Registered and Used in Bad Faith

Given the fact that the Complainant has failed to satisfy the burden of proof of paragraph 4(a)(ii) of the UDRP Policy, the Panel does not need to inquire into the Respondent’s registration or use of the disputed domain name in bad faith (paragraph 4(a)(iii) of the UDRP Policy).

Nevertheless, the Panel notes that the Complainant must prove both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(i) circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of

selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the site or location.

The Complainant has presented an argument that the Respondent both registered and used the disputed domain name in bad faith. Its principal argument is that, the Respondent intents to divert traffic away from the Complainant's website, in order to attract commercial gain. Moreover, the Complainant claimed that the Respondent is using the web site for „phishing" financial information to defraud the Complainant's customers.

The Respondent clearly depicts within its Response petition that the similarity of the website layout to the Complainant's website occurred out due to a „hacker activity" which was promptly dispelled by the Respondent. Considering that this „hacker activity" was avoided by the Respondent upon receiving the report of the hosting company, the Respondent did not have any intention to „phishing" financial information or to attract, for commercial gain, Internet users from the Complainant's website.

The Panel notes that the Complainant does not provide sufficient convincing argumentation or evidence that any other circumstances of bad faith at registration or during use of the disputed domain name are present.

The Panel has given careful attention to all that has been put on behalf of the Complainant and finds that none of it shows that the disputed domain name was either registered or used in bad faith.

The Complainant has thus not established the third of the three elements that it must establish under paragraph 4(a)(iii) of the UDRP Policy.

D. Reverse Domain Name Hijacking

The Respondent has raised the issue of whether the Complainant may have engaged in Reverse Domain Name Hijacking. Finally, the Panel finds that the Complaint was not brought in bad faith and did not constitute an abuse of the administrative procedure. The Panel notes that lack of success of a complaint is not itself sufficient for a finding of Reverse Domain Name Hijacking. Although the Complainant's arguments under paragraphs 4(a) (ii) and (iii) of the UDRP Policy failed, they did not fail by such an obvious margin that the Complainant must have appreciated that this would be the case at the time of filing the Complaint.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **BANKSANPAOLO.COM**: Remaining with the Respondent

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2017-04-19

Publish the Decision