Decision for dispute CAC-UDRP-101482

Case number	CAC-UDRP-101482
Time of filing	2017-04-05 09:41:22
Domain names	SANPAOLO.XYZ

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	Domain Manager

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided between the same parties and relating to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of several trademark registrations containing the term “SANPAOLO”, in particular Brazilian trademark no. 817513876 registered on 12.08.1997 for services in class 36, where the term SANPAOLO is registered in stylized letters and international trademark no. 714661 (SANPAOLO IMI where the terms SANPAOLO IMI are registered in stylized letters) registered on 27.05.1999 for goods and services in classes 9, 35, 36 and 42.

FACTUAL BACKGROUND

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

1. The Complainant 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.. It is the leading Italian banking group in all business areas (retail, corporate and wealth management) and is among the top banking groups in the Euro zone, with a market capitalization exceeding 36,8 billion Euro. In Italy, it offers its services to approximately 11.1 million customers, thanks to a network of approximately 4,000 branches capillary and well distributed throughout Italy. Moreover, the Complainant has a strong presence in Central-Eastern Europe with a network of approximately 1.200 branches and over 7,8 million customers. In addition, the international

network specialized 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. According to Complainant's non-contested allegations, at this day consumers generally refer to the Complainant also as "Sanpaolo".

2. The Complainant contends that its trademarks "SANPAOLO" and "SANPAOLO IMI" are distinctive and well known all around the world. Moreover, it is the owner of various domain names including the wording "SANPAOLO", in particular <SANPAOLO.COM>, <SANPAOLO.NET>, <SANPAOLO.BIZ>, <SANPAOLO.XXX>, <SANPAOLO.INFO> that are connected to the Complainant's official website www.intesasanpaolo.com.

3. The Disputed Domain Name <SANPAOLO.XYZ> was created on June 2, 2016 and - according to the Complainant's non contested allegations – it resolves to a parking page promoting/sponsoring amongst others banking and financial services, also from the Complainant's competitors.

4. On July 13, 2016, the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the Disputed Domain Name to the Complainant. So far, the Respondent did not comply with this request.

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 UDRP 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 UDRP 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 UDRP 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

1. The Panel finds that the Disputed Domain Name <SANPAOLO.XYZ> is identical to the Complainant's trademark (i.e. Brazilian trademark no. 817513876). Many Panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety. This is the case in the case at issue where the Complainant's registered trademark "SANPAOLO" is fully included in the Disputed Domain Name. Moreover, the Panel finds that the contested Domain Name is also confusingly similar to the Complainant's international trademark no. 714661 "SANPAOLO IMI", because it incorporates a dominant feature (i.e. SANPAOLO) of the Complainant's international trademark. In fact, according to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition at point 1.7 "in cases where a domain name incorporates the entirety of a trademark, or where at least 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". This Panel shares said view.

2. In the absence of any Response, or any other information from the Respondent indicating the contrary, the Panel further holds that the Complainant successfully presented its prima facie case and that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name <SANPAOLO.XYZ>.

In particular, the Respondent is not affiliated with nor authorized by the Complainant in any way, and he is not related in any way to the Complainant's business. In addition, the Respondent is not commonly known by the Disputed Domain Name. Finally, the website to which the Disputed Domain Name resolves is a parking page with pay-per-click links sponsoring amongst others banking and financial services. Such use can neither be considered as bona fide offering of goods or services nor 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 or service mark at issue.

3. Finally, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith.
The Respondent has intentionally registered the Disputed Domain Name which totally reproduces the Complainant's trademark SANPAOLO. By the time the Disputed Domain Name was registered, it is unlikely that the Respondent did not have knowledge of the Complainant's rights on its trademarks. The Complainant also proved that the Respondent is using the Disputed Domain Name to lead to a parking page, with pay-per-click links sponsoring - amongst others - banking and financial services, that represented the core business of the Complainant (and for which its registered trademarks are used). These facts, including the failure to submit a response also confirm that the Disputed Domain Name is used to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's web site 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 web site or location, or of a product or service on the Respondent's web site or location.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SANPAOLO.XYZ**: Transferred

PANELLISTS

Name	**Dr. Federica Togo**

DATE OF PANEL DECISION 2017-05-29

Publish the Decision