Decision for dispute CAC-UDRP-101547

Case number	CAC-UDRP-101547
Time of filing	2017-05-25 09:54:41
Domain names	WWWBANCAPROSSIMA.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	Balticsea LLC

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following registrations for the trademark “BANCA PROSSIMA”:

- EU trademark registration n. 005743208 “BANCA PROSSIMA”, filed on 8 March 2007, granted on 16 January 2008 and duly renewed, in connection with classes 35, 36 and 41;

- EU trademark registration n. 005804232 “BANCA PROSSIMA”, filed on 2 April 2007, granted on 17 January 2008 and duly renewed, in connection with classes 35, 36, 38 and 41;

- EU trademark registration n. 005804133 “BANCA PROSSIMA IMPRESE SOCIALI E COMUNITÀ”, filed on 2 April 2007, granted on 17 January 2008 and duly renewed, in connection with classes 35, 36 and 41;

- EU trademark registration n. 009050527 “BANCA PROSSIMA PER LE IMPRESE SOCIALI E LE COMUNITÀ”, filed on 23 April 2010 and granted on 14 September 2010, in connection with classes 9, 16, 35, 36, 41 and 42.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The Complainant is the leading Italian banking group.

Intesa Sanpaolo is the company resulting from the merger 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 44,7 billion euro.

The Complainant has a network of approximately 3,900 branches throughout the Country and has approximately 11.1 million customers.

Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,7 million customers.

Moreover, the Complainant's international network specialised in supporting corporate customers is present in 28 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.

One of Complainant’s subsidiaries is Banca Prossima S.p.A., which is a bank entirely dedicated to the non-profit world.

The Complainant is the owner of several registrations for the trademark “BANCA PROSSIMA".

Moreover, the Complainant is also the owner, among others, of the following domain names bearing the sign “BANCA PROSSIMA”: “BANCAPROSSIMA.COM", "BANCAPROSSIMA.ORG", "BANCAPROSSIMA.EU", "BANCAPROSSIMA.INFO", "BANCAPROSSIMA.NET", "BANCAPROSSIMA.BIZ", "BANCAPROSSIMA.IT”. All of them are pointing to the main Complainant’s website.

On 8 June 2010, the Respondent registered the Disputed domain name “WWWBANCAPROSSIMA.COM”.

The Complainant contends that it is obvious that the domain name at issue is confusingly similar to the Complainant’s trademarks.

The Complainant asserts that the domain name “WWWBANCAPROSSIMA.COM” exactly reproduces the trademark “BANCA PROSSIMA”, with the mere addition of letters “www” before the verbal portion “BANCA”. The Complainant observes that such difference is clearly a minor and merely descriptive variation of the cited trademark, used by the Complainant to identify its online banking service for the enterprises.

The Complainant submits that the Respondent has no rights on the Disputed domain name. The Complainant claims that any use of the trademark “BANCA PROSSIMA” has to be authorized by the Complainant and that nobody has been authorized or licensed to use the Disputed domain name.

The Complainant points out that the Disputed domain name does not correspond to the name of the Respondent and, to the best of the Complainant's knowledge, the Respondent is not commonly known as “WWWBANCAPROSSIMA”.

The Complainant adds that it does not find any fair or non-commercial uses of the Disputed domain name.

The Complainant states that the Disputed domain name was registered and is being used in bad faith.

The Complainant contends that its trademark “BANCA PROSSIMA” is distinctive and well known all around the world.

The Complainant observes that the fact that the Respondent has registered a domain name that is confusingly similar to the

Complainant's trademark indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the Disputed domain name.

The Complainant points out that if the Respondent had carried a basic Google search in respect of the wording "BANCA PROSSIMA", the search would have yielded obvious references to the Complainant.

The Complainant adds that the Disputed domain name is not used for any bona fide offering of goods or services.

The Complainant argues that there are 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.

The Complainant points out that the Disputed domain name is connected to a website sponsoring, among others, banking and financial services.

The Complainant contends that 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.

The Complainant argues that the Respondent has registered and is using the Disputed domain name with the aim of diverting traffic away from the Complainant's web site.

The Complainant highlights the damages connected to above mentioned situation and points out that the Respondent is remunerated by the sponsoring activity carried out using the Disputed domain name.

The Complainant underlines that on 28 April 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 Complainant states that the Respondent did not comply with the above mentioned 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 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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the Disputed domain name, the Complainant has to demonstrate that:

(i) The Disputed domain name 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 Disputed domain name; and

(iii) The Disputed domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The Complainant has established that it has rights in the trademark BANCA PROSSIMA and has argued that the addition in the Disputed domain name of the acronym "www" is not sufficient to avoid confusion.

The Panel agrees with the Complainant's argument that the addition of the prefix "www", which is the acronym of "World Wide Web" is not sufficient to avoid confusion. See, for example, WIPO Case D2017-0351.

Moreover, it is well established that merely adding a TLD to a trademark is not sufficient to distinguish a domain name from a trademark. See, for example, CAC Case No. 100831.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the Disputed domain name.

The Respondent has no connection or affiliation with the Complainant.

The Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademark.

The Respondent does not appear to be commonly known by the name “WWWBANCAPROSSIMA” or by a similar name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the Disputed domain name, nor any use in connection with a bona fide offering of goods or services.

Indeed, the Respondent is using the Disputed domain name for a webpage containing sponsored links to third parties' websites.

In fact, the Respondent is using the Disputed domain name to divert Internet users to the websites of the Complainant's competitors.

Taking into account the fact that the Respondent has no connection or affiliation with the Complainant, and that the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademark, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the Disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the Disputed domain name was registered in bad faith and that it has been used in bad faith.

In particular, the Panel accepts the Complainant's unchallenged assertions that the Respondent is using the Disputed domain name with the aim of intentionally attracting, for commercial gain, Internet users to the websites of the Complainant's competitors, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website.

Indeed, it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark BANCA PROSSIMA when registering the Disputed domain name. If the Respondent had legitimate purposes in registering and using the Disputed domain name it would have responded to the Complainant's "cease and desist" letter, or filed a Response in this proceeding.

The Panel observes that at the bottom of the page associated with the Disputed domain name appears a disclaimer including the following text "[...] The Sponsored Listings displayed above are served automatically by a third party. Neither the service provider nor the domain owner maintain any relationship with the advertisers [...]".

It is well established that third-party generated material “automatically” appearing on the website associated with a domain name may form a basis for finding bad faith. Only if the respondent has made positive efforts aimed at avoiding links which target the complainant’s trademark the bad faith might be excluded. See, for example, WIPO case No. D2015-0783.

No efforts in this sense were made by the Respondent. Therefore, the above mentioned disclaimer is not sufficient for avoiding bad faith.

Accordingly, the Panel finds that the Disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **WWWBANCAPROSSIMA.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2017-07-02

Publish the Decision