Decision for dispute CAC-UDRP-101603

Case number	CAC-UDRP-101603
Time of filing	2017-07-19 10:32:12
Domain names	INTESA-INTESA.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Giovanni Cusco

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

- EU trademark registration n. 2803773 “INTESA”, applied on August 7, 2002, granted on November 17, 2003 and duly renewed, in connection with class 36;
- EU trademark registration n. 12247979 “INTESA”, applied on October 23, 2013 and granted on March 5, 2014, in connection with classes 9, 16, 35, 36, 38, 41 and 42;
- U.S. trademark registration n. 4196961 “INTESA”, filed on June 30, 2011 and granted on August 28, 2012, in connection with class 36;
- International trademark registration n. 831572 “BANCA INTESA”, granted on June 24, 2004 and duly renewed, in class 36;
- EU trademark registration n. 779793 “BANCA INTESA”, applied on March 24, 2008, granted on November 15, 1999 and duly renewed, in classes 9, 16, 36, 38, 41 and 42;
- Italian trademark registration n. 1235313 “BANCA INTESA”, filed on December 14, 2007, granted on December 18, 2009 and duly renewed, in classes 9, 16, 36, 38, 41 and 42

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 46,4 billion euro, and leader in Italy in many business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,900 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 1.100 branches and over 7,7 million customers. Moreover, the international network specialised in supporting corporate customers is present in 27 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 widely known among consumers as “INTESA”.

The Complainant is the owner of the following domain names: <INTESA.COM>, <INTESA.INFO>, <INTESA.BIZ>, <INTESA.ORG>, <INTESA.US>, <INTESA.EU>, <INTESA.CN>, <BANCAINTESA.COM>, <BANCAINTESA.NET>, <BANCAINTESA.EU> and many others. All of them have been registered before the disputed domain name and they are now connected to the official website <intesasanpaolo.com>.

On June 1, 2016, the Respondent registered the disputed domain name <INTESA-INTESA.COM>.

The Respondent is not commonly known by the name "INTESA-INTESA" and had no known rights to the name.

The disputed domain name was used by the Respondent to connect to a website containing links to various banking and financial service providers, including the Complainant's competitors.

On July 5, 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.

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

Paragraph 4(a) of the Policy lists three elements that Complainant must prove to merit a finding that the domain name

registered by the Respondent be transferred to the Complainant:

1) the domain name is identical or confusingly similar to a trademark or service mark (“mark”) in which the Complainant has rights; and
2) the Respondent has no rights or legitimate interests in respect of the domain name; and
3) the domain name has been registered and is being used in bad faith.

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below

A. IDENTICAL OR CONFUSINGLY SIMILAR

As mentioned above the Complainant has numerous trade mark registrations for the word INTESA in multiple jurisdictions. INTESA-INTESA is, in essence, a repetition of this word.

The Panel finds the word "identical" in the Policy "carries its ordinary dictionary definition that the grammatical parts of the second level domain and trademark essentially correspond" (Gerald M. Levine, "Domain Name Arbitration", (1st ed, 2015) Legal Corner Press, New York at page 100). Here INTESA-INTESA does not directly correspond to INTESA. The former has the addition of a hyphen and repeats INTESA for a second time.

However the Panel does find that INTESA-INTESA is "confusingly similar" to INTESA. The facts are somewhat unusual in that the trademark has been repeated in the disputed domain name. However it is well established that domain names consisting merely of variations to a trademark that are "insufficient to prevent threshold Internet user confusion" will be held to be confusingly similar to the said trademark (See Apple Inc. v. Contact Privacy Inc. / Grand Slam Co. WIPO Case No. D2012-0844 citing WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 2nd Ed ("WIPO Overview 2.0") which is now superseded by "WIPO Over 3.0" that contains the same principle). The addition of a hyphen and repetition of the Complainant's trademark in the present matter falls under this principle. An internet user will observe nothing of any meaning when viewing the disputed domain name other than the Complainant's trade mark. The fact they will observe it twice will not alleviate confusion. It is not uncommon for a trade mark to appear twice in an e-mail or web address.

B. NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant must show that Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Respondent in a UDRP proceeding does not assume the burden of proof, but may establish a right or legitimate interest in a disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy:

a) that before any notice to the respondent of the dispute, he or she used or made 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;
b) that the respondent is commonly known by the domain name, even if he or she has not acquired any trademark rights; or
c) that the respondent is 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.

The Respondent has no connection or affiliation with the Complainant, which has not licensed or otherwise authorised the Respondent to use or apply for any domain name incorporating Complainant’s trademark. The Respondent does not appear to make any legitimate use of the disputed domain name for non-commercial activities. On the contrary, it appears that the Respondent has used the disputed domain name to direct consumers to a presumed sponsored link parking page suggesting general links to financial service providers.

The Respondent does not appear to have been commonly known by the disputed domain name.

The Respondent has not shown any facts or elements to justify prior rights and/or legitimate interests in the disputed domain name.

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND USED IN BAD FAITH

The Panel accepts that the Complainant has an international reputation in the INTESA trade mark in relation to financial services, especially in the European Union. The Panel refers in particular to the detailed business information contained in one of the annexures attached to the Complaint which clearly demonstrates the Complainant's extensive use of INTESA as a house brand of one of Europe's largest financial institutions. In such circumstances it is highly unlikely the Respondent was unaware of this reputation at the time of registering the disputed domain name.

It is also quite clear the disputed domain name is used to divert traffic web users to competing organizations. For example, one link on the Respondent's website is titled "Top 10 Banks". Given the Complainant's strong reputation mentioned in the Complaint, the use of the disputed domain name to host a site referring to other banks is clear evidence of registration and use in bad faith. The Panel finds this alone suffices for the purposes of the Policy without needing to go further and find that the website was used for commercial gain (although this does appear likely as such basic websites consisting almost entirely of links are generally used for parking and pay-per-click advertisements).

However the Panel does a make a further note that the link on the Respondent's website titled "Online Banking Services" is of particular concern. Such services can involve persons transferring of sums of money from the impersonal environment of their computer or mobile device. The risk of fraud in relation to such services is obvious and potentially damaging to consumers and financial services trade mark owners alike. In circumstances such as the present where;

(a). The Respondent has registered the disputed domain name that is confusingly similar to the house brand of a very well known bank; and
(b). The only use made of the domain name is, in itself, likely to mislead and misdirect consumers;

The Respondent's motivations must be treated with scepticism, especially when no light on such motive is cast by a response. Even when the Respondent first registered a domain name that simply repeated a well known financial services trade mark twice, given this risk of fraudulent use, it must be immediately questioned why he did so.

The disputed domain name was registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-INTESA.COM**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2017-08-21

Publish the Decision