Decision for dispute CAC-UDRP-101606

Case number	CAC-UDRP-101606
Time of filing	2017-07-19 09:59:03
Domain names	SANPAOLOIMISPA.INFO

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	Shenzhen Wanbaoshenxu Trade Ltd

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings, pending or decided, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the 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, i.a. covering China and Union Trademark registration n. 1182716 “SANPAOLO IMI & device”, filed on May 24, 1999, granted on July 19, 2000 and duly renewed until May 24, 2019, in classes 9, 35, 36 and 42.

FACTUAL BACKGROUND

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

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

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.

The Complainant is among the top banking groups in the euro zone, with a market capitalisation exceeding 46,4 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,900 branches 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. The Complainant 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. Given the above, at this day consumers still refer to the Complainant also as "SANPAOLO IMI".

The Complainant is the owner, among others, of the following registrations for the trademark "SANPAOLO IMI":

- 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, i.a. covering China;

- Union Trademark registration n. 1182716 "SANPAOLO IMI & device", filed on May 24, 1999, granted on July 19, 2000 and duly renewed until May 24, 2019, in classes 9, 35, 36 and 42.

Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the sign "SANPAOLO IMI": SANPAOLOIMI.COM, SANPAOLOIMI.BIZ, SANPAOLOIMI.ORG, SANPAOLOIMI.MOBI, SANPAOLOIMI.EU and SANPAOLOIMI.US. All of them are now connected to the official website http://www.intesasanpaolo.com.

On December 27, 2016, the Respondent registered the domain name SANPAOLOIMISPA.INFO.

It is more than obvious that the disputed domain name at issue is identical to the Complainant's trademarks and domain names previously mentioned. As a matter of fact, SANPAOLOIMISPA.INFO is identical to "SANPAOLO IMI", with the mere addition of letters "SPA", which are the acronym of the Italian expression "Società Per Azioni" ("company limited").

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME

The Respondent has no rights in the disputed domain name, since the Respondent has nothing to do with the Complainant. In fact, any use of the trademark "SANPAOLO IMI" has to be authorized by the Complainant. Nobody has been authorized or licensed by the Complainant to use the disputed domain name at issue.

The disputed domain name at stake does not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as "SANPAOLOIMISPA".

Lastly, we do not find any fair or non-commercial use of the disputed domain name at stake (see www.sanpaoloimispa.info).

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

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

The Complainant's trademark "SANPAOLO IMI" is distinctive and well-known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to it indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wording "SANPAOLO IMI", the same would have yielded obvious references to the Complainant. The Complainant submits an extract of a Google search in support of its allegation. This raises a clear inference of knowledge of the Complainant's trademark on the part of the Respondent. Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant's trademarks. This is a clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its web site (par. 4(b)(iv) of the Policy).

First of all, several services can be detected, but not in good faith: in fact, the disputed domain name is connected to a website promoting several HI-FI and digital products, which clearly bears the denomination “SANPAOLO IMI” in the home-page.

Consequently, internet users, while searching for information on the Complainant’s services, are confusingly led to the website of the Respondent, which is exploiting the renown of the “SANPAOLO IMI” trademark in order to sell its products online.

While it is true that the disputed domain name does not resolve to a website of a competing organization, nor to a website sponsoring the same services for which the trademark “SANPAOLO IMI” has been registered and is used, it is also undeniable that SANPAOLOIMISPA.INFO is presently being used in bad faith.

In fact, although “The use of the name does not, on the face of it, appear to be directed to inflicting any deliberate damage on the Complainant […] it does appear, inescapably, to be directed to "free-ride" on and profit from the Complainant’s reputation in its mark” (see WIPO Case No. D2002-0960, AT&T Corp. v. Yong Li).

In this view, it shall not be necessary for the Panel to find any sustained confusion of users as to the Complainant’s association with the products commercialized in the website connected to the disputed domain name.

Indeed, consistent WIPO case-law confirms that Panellists use to adopt the comments of the Ticketmaster cases: “By such use the Respondent intentionally attempts to attract Internet users to an on-line location, which creates a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of that location. The fact that such confusion may be dispelled [...] does not negate the fact of initial confusion” (see Ticketmaster Corp. v. Iskra Service, Case No. D2002-0165, Ticketmaster Corp. v. Polanski, Case No. D2002-0166 and Ticketmaster Corp. v. Dotsan, Case No. D2002-0167).

The Respondent’s commercial gain is evident, since it is obvious that the Respondent’s activity is for its own profit.

Further, it is no coincidence that this speculation has involved a big financial institution such as the Complainant. In fact, the diversion practice in banking realm is very frequent due to the high number of on line banking users. In fact, it has also to be pointed out that the Complainant has already been part of other WIPO cases where the Panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations. A list of the WIPO cases in which the Complainant has been part is attached to the Complaint.

Lastly, it shall be underlined that – on May 30, 2017 – the Complainant’s attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the contested domain name to their client. Despite such communication, the Respondent did not comply with the above request.

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

REQUEST FOR ENGLISH TO BE THE LANGUAGE OF THIS ADMINISTRATIVE PROCEEDING

The Complainant requests English to be the language of the administrative proceeding at issue, for the followings reasons:

1) First of all, the Complainant is an Italian company, while the Respondent is Chinese. Consequently, the present Complaint was written in English, an international language comprehensible to a wide range of internet users worldwide. Since the spirit of Paragraph 11 of the Rules seems to be to ensure fairness in the selection of language by giving full considerations to the parties' level of comfort with each language, English is deemed the fair language in the present proceeding.

2) The website connected to the disputed domain name is in English language, so there is no doubt the Respondent is English-speaking.

Hence, for the reasons described above, the Complainant hereby requests the Panellist to maintain English as proceeding language.

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.

The language of the Registration Agreement is Chinese. However, in view of the circumstances of the case, including the fact that the website linked to the disputed domain name is in English, and the fact that the Respondent has been given a fair chance to object but has not done so, the Panel determines in accordance with paragraph 11(a) of the UDRP Rules that the language of the proceeding be English.

PRINCIPAL REASONS FOR THE DECISION

1.
The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks. Firstly, it merely consists of the trademark "sanpaoloimi" followed by "spa", which is the abbreviation for "public limited company" in Italy, which is a descriptive term, and which could indeed be the corporate form of the Complainant. The top level domain name ".info" is to be disregarded in this respect, as it is clearly descriptive.

2.
In the absence of any Response of the Respondent indicating the contrary, the Panel further holds that the Complainant successfully presented prima facie proof that the Respondent has no rights or legitimate interests in respect of the disputed domain name. In particular, the Respondent is not affiliated with nor authorized by the Complainant in any way to use the disputed domain name, and he is not related in any way to the Complainant's business. Moreover, the Respondent has not demonstrated any preparations to use the disputed domain name in connection with a bona fide offering of goods or

services. The disputed domain name is used for the offer of technical devices, thus for commercial reasons. Therefore, the Panel is of the view that the disputed domain name was registered by the Respondent with the mere intention to obtain financial advantage of the similarity between the disputed domain name and the trademark of the Complainant.

3.
Finally, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

The Panel is convinced that the Respondent has intentionally registered the disputed domain name using the Complainant's trademark "Sanpaolo Imi". By the time the disputed domain name was registered, there is no doubt that the Respondent knew the Complainant's name, business, and/or rights in the trademark "Sanpaolo Imi". The Complainant further provided evidence that the Respondent is using the disputed domain name for own commercial purposes. Therefore, the Panel's is convinced that the disputed domain name is used to intentionally attempt to attract, for commercial gain, internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of the products on the Respondent's website.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SANPAOLOIMISPA.INFO**: Transferred

PANELLISTS

Name	**Dominik Eickemeier**

DATE OF PANEL DECISION 2017-09-05

Publish the Decision