Decision for dispute CAC-UDRP-101712

Case number	CAC-UDRP-101712
Time of filing	2017-10-06 12:43:38
Domain names	INTESA-CERTIFICA-NUMERO.CLOUD

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	MARIANGELA ESPOSITO

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

In this proceeding, the Complainant relies on the following trademarks:
- Intesa (word) International Registration No. 793367, registered on September 04, 2002;
- Intesa (word) US registration No. 4196961, registered on August 28, 2012;
- Intesa (word) EU registration No. 012247979, registered on March 5, 2014;
- Intesa Sanpaolo (word) International Registration No. 920896, registered on March 07, 2007;
- Intesa Sanpaolo (word) EU registration No.00 5301999, registered on June 18, 2007;
- Intesa Sanpaolo & device EU registration No 005421177, registered on November 05, 2007.

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 states that it is the leading Italian banking group and one of the protagonists in the European financial

arena.

Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 50,1 billion euro. It is the leader in Italy in all business areas (retail, corporate and wealth management) and has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,7 million customers.

The Complainant owns a number of trademarks that include the “Intesa” and “Intesa Sanpaolo” elements and numerous domain names bearing the signs “INTESA” and “INTESA SANPAOLO”.

The disputed domain name intesa-certifica-numero.cloud was registered by the Respondent on September 21, 2017.

The Complainant claims that the disputed domain name is confusingly similar to the Complainant’s “INTESA” and “INTESA SANPAOLO” trademarks. The disputed domain name consists of the distinctive term “INTESA” with the addition of the generic words “certifica” (the Italian for “certify”) and “numero” (the Italian for “number”), both merely descriptive and even alluding of the login online banking services offered by the Complainant to is clients, thus, the relevant trademark is recognizable within the disputed domain name.

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

The Complainant states that the Respondent has nothing to do with Intesa Sanpaolo, has not been authorized or licensed to use the “Intesa” marks and is not commonly known as “INTESA-CERTIFICA-NUMERO”.

The Complainant also notes that there is no any fair or non-commercial use in this case.

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The disputed domain name is not actively used.

The Complainant states that the trademarks “INTESA” and “INTESA SANPAOLO” are distinctive and well known all around the world and the very fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name.

The Complainant alleges that the Respondent knew about the Complainant and its trademarks and the disputed domain name would not have been registered if it were not for Complainant’s trademark.

This, in the view of the Complainant, is a clear evidence of registration of the domain name in bad faith.

The Complainant refers to UDRP decisions as well as the “WIPO Overview of WIPO Views on Selected UDRP Questions” that confirm that the passive holding of a domain name with knowledge that the domain name infringes another party’s trademark rights is evidence of bad faith registration and use.

The Complainant also highlights the fact that it has already been targeted by some cases of phishing in the past few years and the circumstances of the present case, in the opinion of the Complainant, indicate that the disputed domain name was registered with the phishing purpose (Complainant’s trademark + descriptive terms alluding of the online banking services offered by the Complainant itself).

Besides, the Complainant argues that any legitimate use of the disputed domain name by the Respondent is inconceivable.

Therefore, the Complainant believes that that the Respondent registered the disputed domain name with the “phishing” purpose or to resell it to the Complainant and this confirms bad faith registration and use.

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

A. Identical or confusingly similar with Complainant's trademark

The Complainant is the owner of numerous trademark registrations incorporating the "Intesa" element.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain name incorporates the "Intesa" element combined with the "Certifica" and "Numero" elements.

These additional elements can be considered as descriptive ("certifica" the Italian for "certify" and "numero" the Italian for "number") in relation to the Complainant's banking services.

It is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity under the first element (see par. 1.8 of WIPO Overview 3.0).

The Complainant's "Intesa" mark is clearly recognizable within the disputed domain name and the addition of the "certifica" and "numero" elements does not avoid the confusion since they do not sufficiently distinguish the disputed domain name from the Complainant's trademark (see e.g. CAC Case No. 101676 and CAC Case No. 101609).

The suffix .cloud shall be disregarded under the confusing similarity test.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110 and CAC Case No. 101284.

The Complainant stated that the Respondent was not known by the disputed domain name, was not in any way authorized by the Complainant and there was no fair use or non-commercial use of the disputed domain name.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and case Vertical Solutions Management, Inc. v. webnet-marketing, inc., no. FA 95095, National Arbitration Forum).

The Panel finds that the Complainant has shown a prima facie case that has not been rebutted by the Respondent and, therefore, satisfied the second requirement of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

In the present case, the disputed domain name is not actively used.

It is well established that the non-use or passive holding of a domain name does not prevent the panel from finding bad faith registration and use (see par. 3.3 of WIPO Overview 3.0). One has to look at the circumstances of a case taking into account, in particular, the degree of distinctiveness or reputation of the Complainant's mark and the implausibility of any good faith use to which the domain name may be put (see e.g. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246; CAC Case No. 101435 and CAC Case No. 101691).

The Panel is of the opinion that the following circumstances have to be taken into account in this case:
- The Complainant's trademark registrations predate registration of the disputed domain name;
- The Complainant's trademarks are distinctive and strong, in particular in Italy and Europe;
- The Respondent is from Italy and it is hard, if not impossible, to imagine that the Respondent was not aware of the Complainant and its trademarks at the date of registration of the disputed domain name. All circumstances of this case indicate that the Respondent intentionally chose to register the domain name incorporating the Complainant's mark;
- The disputed domain name itself suggests some sort connection with the Complainant's business by using common banking terms, namely "certifica" (the Italian for "certify") and "numero" (the Italian for "number"). The Panel finds that in such a case any attempt to actively use the disputed domain name would inevitably lead to a likelihood of confusion to the source, sponsorship, affiliation, or endorsement of the web site (see Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D 2002-0131);
- Taking into account all of the above it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, in particular, in the absence of any response and clarifications from the Respondent.

The Panel notes that the disputed domain name was registered by the Respondent on September 21, 2017 and one may

argue that the Respondent simply did not have enough time to put the disputed domain name into genuine use and at this stage it is too early to make a definite conclusion.

However, the Panel rejects this reasoning in the present case.
As it was stated in one of the previous UDRP decisions “to argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent’s bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant’s goodwill and business” (see Comerica Inc. v. Horoshiy, Inc., WIPO Case No. D2004-0615).

The Panel believes that given the nature of the Complainant’s business (banking services) and high risks associated with such business, including risks of financial fraud, it is sensible for the Complainant to act as soon as possible to prevent any cases of phishing or other fraud and the fact that the complaint was filed shortly after the registration of the disputed domain name is absolutely justifiable.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-CERTIFICA-NUMERO.CLOUD**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2017-11-14

Publish the Decision