Decision for dispute CAC-UDRP-101711

Case number	CAC-UDRP-101711
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Domain names	INTESANPAOLO-CONVALIDA-RECAPITI.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	MARCO PERFETTI

OTHER LEGAL PROCEEDINGS

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

FACTUAL BACKGROUND

The Complainant, Intesa Sanpaolo S.p.A., is one of the leading Italian banking group in the European financial arena. Intesa Sanpaolo was formed as a result of the merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two Italian banking groups. Intesa Sanpaolo is among the top banking groups in the eurozone, with a market capitalization exceeding 50.1 billion euro.

The Complainant owns a network of approximately 4,600 branches distributed throughout the Italy, with market shares of more than 13% in most Italian regions. The Complainant offers its services to approximately 12.3 million customers. The Complainant also has a strong presence in Central-Eastern Europe with a network of approximately 1,100 branches and over 7.7 million customers. The complainant also owns a network specialized in supporting corporate customers 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 produced evidence that it is the owner of the following registrations for the trademarks “INTESA SANPAOLO” and “INTESA”:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;

- EU trademark registration n. 005301999 “INTESA SANPAOLO”, applied on September 08, 2006 and granted on June 18, 2007, in classes 35, 36 and 38;

- EU trademark registration n. 005421177 “INTESA SANPAOLO & device”, applied on October 27, 2006 and granted on November 5, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;

- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in connection with class 36;

- U.S. trademark registration n. 4196961 “INTESA”, filed on June 30, 2011 and granted on August 28, 2012, in connection with class 36;

- EU trademark registration n. 012247979 “INTESA”, filed on October 23, 2013 and granted on March 5, 2014, in connection with classes 9, 16, 35, 36 38, 41 and 42.

On September 21, 2017, the Respondent registered the domain name <INTESANPAOLO-CONVALIDA-RECAPITI.CLOUD>.

The disputed domain name is currently not in use

PARTIES CONTENTIONS

The Respondent did not reply to the Complainant's contentions.

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

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant is the owner, among others, of the following registrations for the trademarks “INTESA SANPAOLO” and “INTESA”; identified above.

The Complainant is also the owner of numerous domain names bearing the signs “INTESA SANPAOLO” and “INTESA”: <INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ>, <INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ> and <INTESA.COM>,< INTESA.INFO>,< INTESA.BIZ>,<INTESA.ORG>, <INTESA.US>, <INTESA.EU>, <INTESA.CN>,< INTESA.IN>, <INTESA.CO.UK>,<INTESA.TEL>,<INTESA.NAME>,<INTESA.XXX>,<INTESA.ME>. All of these domain names are connected to the official website of the Complainant at <intesasanpaolo.com>.

The disputed domain < INTESANPAOLO-CONVALIDA-RECAPITI.CLOUD> is confusingly similar to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”. The disputed domain name contains the term INTESANPAOLO, which is a combination of the suffix “INTESA” and prefix of SANPAOLO. This combination is confusingly similar to the Complainant’s INTESA and INTESA SANPAOLO trademarks.

Furthermore, the disputed domain name contains the generic terms “convalida” (which is the Italian language word for “validation”) and “recapiti” (which is the Italian language word for “addresses”) both descriptive and even allude to the online banking services offered by the Complainant to its clients. Finally, the disputed mark contains the gTLD “.CLOUD”.

The addition of generic terms and a TLD to a mark in order to form a domain name does not sufficiently distinguish the disputed domain name from the Complainant's trademarks. See, among others, M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts, WIPO Case No. D2015-1384, <daiwikresorts.com>, Nintendo of America Inc. v. Fernando Sascha Gutierrez, WIPO Case No. D2009-0434, <unlimitedwiidownloads.com> and Hoffmann-La Roche Inc. v. Wei-Chun Hsia, WIPO Case No. D2008-0923, <yourtamiflushop.com>; Wiluna Holdings, LLC v. Edna Sherman, FA 1652781 (FORUM Jan. 22, 2016) (Finding the addition of a generic term and gTLD is insufficient in distinguishing a disputed domain name from a mark under Policy 4(a)(i).). Furthermore, the addition of a gTLD such as “.CLOUD” does not distinguish the domain name. (see Crocs, Inc. v. [Registrant], FA 1043196 (FORUM Sept. 2, 2007) (determining that “the addition of a ccTLD is irrelevant to the Policy 4(a)(i) analysis, as a top-level domain is required of all domain names”); see also Bloomberg Finance L.P. v. Cesar R Shepard, FA 1742833 (FORUM Sept. 5, 2017) (“Respondent’s <bloomberg.pw> domain name is identical to Complainant’s mark because it merely appends the top-level domain (TLD) “.pw” to the fully incorporated mark.”).

Consequently, the Panel finds that the Complainant has shown that the disputed domain name is confusingly similar to the “INTESA SANPAOLO” and “INTESA” trademarks in which the Complainant has rights.

B. Rights or Legitimate Interests

Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 3.0”), paragraph 2.1.

In the present case, the Complainant has demonstrated to the Panel that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent had failed to assert any such rights or legitimate interests.

The Panel finds that the Complainant has established a prima facie case in this regard, inter alia, since the Complainant has not licensed or otherwise permitted the Respondent to use the “INTESA SANPAOLO” and “INTESA” trademarks, or a variation thereof, as the respondent clearly did.

The Respondent has not submitted a response and did not provide any evidence to show any rights or legitimate interests in the disputed domain name that is sufficient to rebut the Complainant’s prima facie case.

In the circumstances of this case, and in light of the Respondent’s lack of use of the disputed domain name, set out in more detail below, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant must show that the Respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence, which shows that the Respondent registered the disputed domain name long after the Complainant has registered its trademarks “INTESA SANPAOLO” and “INTESA“ in the EU in 2007 and 2013, respectively. The evidence provided by the Complainant shows that, by 2017, when the disputed domain name was acquired by the Respondent, the Complainant was well known in Italy, where the Respondent resides. According to the evidence filed by the Complainant, the Complainant has owned registrations for the “INTESA SANPAOLO” and “INTESA“ in the EU since 2007 and 2013, respectively. It is suggestive of the Respondent’s bad faith in these particular circumstances that the trademark, owned by the Complainant, was registered long before the registration of the disputed domain name (Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735; Skattedirektoratet v. Eivind Nag, WIPO Case No. D2000-1314).

The disputed domain name is not used for any bone fide offerings of goods or services. More particularly, the evidence provided by the Complainant indicates that the Respondent has registered or acquired the domain name with knowledge of the Complainant, primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of Complainant (par. 4(b)(i) of the Policy).

UDRP decisions confirmed 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 (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574). In particular, the consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith.

Based on the evidence presented to the Panel, including the late registration of the disputed domain name in view of the fame the Complainant's trademark has in Italy, the evidence of reputation of the Complainant and the Complainant’s trademark, the failure of the Respondent to respond to the Complaint, the Panel finds that the disputed domain name was registered and is being used in bad faith.

Accordingly, having regard to the circumstances of this particular case, the Panel finds that the Complainant has met its burden under paragraph 4(a)(iii) of the Policy.

Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name < INTESANPAOLO-CONVALIDA-RECAPITI.CLOUD> be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESANPAOLO-CONVALIDA-RECAPITI.CLOUD**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2017-11-24

Publish the Decision