Decision for dispute CAC-UDRP-101716

Case number	CAC-UDRP-101716
Time of filing	2017-10-16 13:02:54
Domain names	BANCAIMY.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.
Organization	Banca IMI S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	Lin Yi Shi Lan Shan Qu Yi Shang Wang Luo Ke Ji Fu Wu You Xian Gong Si

OTHER LEGAL PROCEEDINGS

The Panel is unaware of other legal proceedings, pending or otherwise, which relate to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant BANCA IMI is the owner of the rights in the company name BANCA IMI as well as in numerous domains and trademarks, such as inter alia the following domain name: BANCAIMI.COM This domain is connected to the official website of the complainant. This domain name is in use by the Complainant BANCA IMI.

The Complainants are the owners, among others, of the following registrations for the trademark “BANCA IMI” :

- International trademark registration n. 996715 “BANCA IMI”, granted on January 23, 2009, in connection with class 36, also covering China;
- EU trademark registration n. 2459071 “BANCA IMI & device”, filed on November 12, 2001, granted on January 9, 2003 and duly renewed, in connection with classes 36 and 38;
- EU trademark registration n. 2459089 “BANCA IMI”, filed on November 12, 2001, granted on February 14, 2003 and duly renewed, in connection with classes 36 and 38;
- EU trademark registration n. 6298401 “BANCA IMI”, filed on September 21, 2007, granted on July 16, 2008 and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42;

- EU trademark registration n. 6298971 “BANCA IMI & device”, filed on September 21, 2007, granted on July 17, 2008 and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

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

The Complainants are Intesa Sanpaolo S.p.A. and Banca IMI S.p.A.

Intesa Sanpaolo S.p.A. 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 50,1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,600 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 12.3 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.

Banca IMI S.p.A. is 100% controlled by Intesa Sanpaolo and is part of its Corporate and Investment Banking division. Banca IMI was created in October 2007 from the merger of Banca Caboto and the former Banca IMI, two of Italy's most important financial institutions in terms of their history, performance, and activities in Investment Banking and Capital Markets. The unification of these two institutions took place at the time of the Banca Intesa-Sanpaolo IMI merger, which led to the creation of Intesa Sanpaolo itself.

Banca IMI is active in investment banking, structured finance and capital markets, operating in the main national and international markets, through offices in Milan, a Rome and a London branch, and a subsidiary, Banca IMI Securities Corporation, based in New York. In structured finance, Banca IMI enjoys a position of historical leadership in the Italian market and a solid international track record. In developing this business, the Bank also leverages the extensive portfolio of relationships that Intesa Sanpaolo Group has built up in Italy and around the world. Banca IMI is a major dealer in the equity and bond markets; it provides publicly traded companies with an efficient Corporate Broking service, and supplies clients with specialized advisory services in financial risk management

The Complainants are the owners, among the others, of the following domain names:

BANCAIMI.COM, BANCAIMI.IT, BANCAIMI.ORG, BANCAIMI.BIZ, IMIBANCA.COM, IMIBANCA.NET, IMIBANCA.ORG, IMIBANCA.BIZ, IMIBANCA.INFO, IMIBANCA.IT, IMIBANCA.EU, IMIBANK.COM, IMIBANK.NET, IMIBANK.ORG, IMIBANK.BIZ, IMIBANK.INFO, IMIBANK.EU, IMIBANK.IT.

On April 12, 2016, the Respondent registered the domain name <BANCAIMY.COM>.

The Complainants contend that 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 its website, by creating a likelihood of confusion with the Complainants’ trademark. The domain name is now connected to a web site containing pornographic images, videos and links.

The website contains several sponsored links offering pornographic items. Therefore, there is a clear commercial gain for the owner of the domain name, who is trading on the reputation of Intesa Sanpaolo and Banca IMI. In fact, Internet users, while looking for Complainants’ website in order to get some information on their banking services, may chance upon the Respondent’s website. Moreover, the Respondent’s conduct is evidently causing dilution and tarnishment to the Complainants’ mark and image.

According to the Complainants, there is no coincidence that this speculation has involved big financial institutions such as the Complainants. In fact, the diversion practice in banking realm is very frequent due to the high number of on line banking users.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainants have, 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 Complainants have rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, 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 Complainants have, 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

PRINCIPAL REASONS FOR THE DECISION

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the Disputed domain name should be transferred or cancelled:

(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.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Disputed domain name is confusingly similar to the Complainants' Trademark, company name and domain. This finding is based on the well established practice in evaluating the existence of a likelihood of confusion of disregarding the top-level suffix in the domain name (i.e. ".com"), and holding that in cases of mere typosquatting, where the domain name in question is a mere variation of a famous name, and in this case, is pronounced identically to the name of the Complainant BANCA IMI, there is a likelihood of confusion due to the confusing similarity of the names. Such typographical errors can easily be made by internet users, especially when languages which may not be the users' native language are involved. This was the case e.g. in the decision Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc, WIPO Case n. D2001-1314 concerning the domain names <duetschebank.com> and <duetsche-bank.com>". It was concluded that these names also were confusingly

similar. The same reasoning applies to the case on hand.

The Panel therefore comes to the conclusion that the Complainants have satisfied the requirement under paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the Disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP which has been concluded e.g. in WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

The Complainants have put forward that the Respondent is not commonly known by the Disputed domain name. Neither is the Respondent in any way related to the Complainants. Nor has the Respondent been granted an authorization or license to use the Disputed domain name by the Complainants. This has not been contested by the Respondent. Instead, the Respondent failed to provide any information or evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the Disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

The Panel therefore also concludes that the Respondent did not establish any right or legitimate interest to the Disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainants have therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainants have established that the Disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainants have successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the Disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the Disputed domain name. On the contrary, the evidence provided by the Complainants show that the domain name is used to direct traffic to erotic websites.

In the past it has been held that it could be potentially catastrophic if even a small number of internet users should believe that a complainant is actually associated with pornography if this is not the case (WIPO Case No. D2003-0557; Miroglio S.p.A. v. Mr. Alexander Albert W. Gore). In WIPO Case No. D2000-0079; Motorola, Inc. v. NewGate Internet, Inc. it was also held that “while many adult sex sites are perfectly legal and constitute bona fide offerings of goods or services, the use of somebody else’s trademark as a domain name (or even as a meta-tag) clearly does not constitute a bona fide offering of goods or services when the website owner has no registered or common law rights to the mark, since the only reason to use the trademark as a domain name or meta-tag is to attract customers who were not looking for an adult sex site, but were instead looking for the products or services associated with the trademark. Such use of a trademark can create customer confusion or dilution of the mark, which is precisely what trademark laws are meant to prevent. And actions that create, or tend to create, violations of the law can hardly be considered to be bona fide”.

The Panel finds that this applies in the case on hand.

The Respondent is also in no way commonly known under the Disputed domain name.

None of the prima facie evidence was challenged by the Respondent.

In the absence of a Response and given the reputation of the Complainants and their trademarks, company name and

domain as supported by the Complainants' evidence, the Panel must conclude that the Respondent was fully aware of the Complainants' trademarks, domain and company name "BANCA IMI" (respectively "BANCAIMI") at the time of registering the Disputed domain name <BANCAIMY.COM>.

Therefore, the Panel concludes that the Respondent has registered and is using the Disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainants have therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BANCAIMY.COM**: Transferred

PANELLISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2017-12-06

Publish the Decision