Decision for dispute CAC-UDRP-101773

Case number	CAC-UDRP-101773
Time of filing	2017-11-21 08:41:58
Domain names	sicurezzaintesasanpaolo214.com

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	Wuxi Yilian LLC

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the Disputed domain name.

IDENTIFICATION OF RIGHTS

In these proceedings, the Complainant relies on its following trademarks:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 2007, in classes 9, 16, 35, 36, 38, 41 and 42, also covering China;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 08, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38;
- EU trademark registration n. 5421177 “INTESA SANPAOLO & device”, applied on October 27, 2006, granted on November 5, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42.

It is worth noting that the Complainant also owns multiple registrations for the same trademark in many countries around the world, which have not been cited in these proceedings.

Further, the Complainant is also the owner, among others, of the following domain names bearing the sign “INTESA SANPAOLO”: “INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ” and INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ”. All of them are now connected to the official website <intesasanpaolo.com>.

FACTUAL BACKGROUND

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The Complainant is a large Italian banking group of companies, which emerged in 2007 from two other large Italian banking groups, Banca Intesa S.p.A. and Sanpaolo IMI S.p.A.

According to the evidence filed by the Complainant and not contested by the Respondent, the Complainant has thousands of branches and millions of customers in Europe, where it figures in the top banking groups. It is also well active in China, country of the Respondent.

The Complainant owns a significant portfolio of trademarks including the wording "INTESA SANPAOLO", among which notably an international registration dating back to 2007 and a couple of EU trademark registrations from 2006. It also owns a multitude of related domain names, like <intesasanpaolo.com>, since August 24, 2006.

The Disputed domain name <SICUREZZAINTESASANPAOLO214.COM> was registered on October 27, 2017 by the Respondent with CNOBIN INFORMATION TECHNOLOGY LIMITED.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

- the Disputed domain name is confusingly similar to its INTESA SANPAOLO trademark;
- the Respondent lacks rights or legitimate interests in the Disputed domain name, and;
- the Respondent registered and used the Disputed domain name in bad faith.

RESPONDENT:

No administratively compliant response has been filed.

RIGHTS

According to the Panel's view, the Disputed domain name <SICUREZZAINTESASANPAOLO214.COM> is highly similar to the Complainant’s International and EU Trademark Registrations for INTESA SANPAOLO and to its domain name <intesasanpaolo.com>. Indeed, the mere addition of the word “SICUREZZA” at the beginning of the word and of the number “214” at the end of the word is not sufficient to escape the finding of confusing similarity.

The Disputed domain name consists of the Complainant's trademark, accompanied by a generic term (SICUREZZA, i.e. SECURITY), which is also in Italian, a fact that increases the risk of confusion among the public. The number “214” could be anything related to the Complainant, including a number of a specific service or the number of a branch or operation team of the bank.

Further, the Complainant has presented a Google search on the expression INTESA SANPAOLO that provides several results, all of them being linked with the Complainant.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

NO RIGHTS OR LEGITIMATE INTERESTS

Since proving a negative fact is almost impossible, Panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the INTESA SANPAOLO trademark in a domain name, and that it had never licensed its trademark to the Respondent, who is not affiliated or doing any business with the Complainant.

Furthermore and finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the Disputed domain name.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the Disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore the Panel is satisfied that also the second requirement under the Policy is met.

BAD FAITH

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark (please see Google search, previously mentioned) and the fact that the Disputed domain name fully incorporates this trademark, it is clear that, at the time of the registration of the Disputed domain name, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the Disputed domain name resolves to a website, which bears the trademark of the Complainant and includes a typical bank login interface. Fraudulent use of a domain name clearly amounts to use in bad faith, especially when the complainant’s trademark has such a strong reputation that it is widely known, and when it is impossible to conceive any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate. These are exactly the circumstances that apply in the case at issue. The trademark INTESA SANPAOLO enjoys wide and extensive reputation. Thus, it is impossible to conceive any plausible active use of the Disputed domain name that would be legitimate.

Further, the Complainant has alleged and provided evidence that, the domain name <SICUREZZAINTESASANPAOLO214.COM> was registered and is being used in bad faith by the Respondent, who has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site.

Given what precedes, the Panel does not consider necessary to further analyze the Complainant’s submissions regarding an eventual “phishing” activity of the Respondent.

For all circumstances mentioned above, the Panel has concluded that the Disputed domain name was registered and used in bad faith, and thus also the third requirement under the Policy was met.

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

The Disputed domain name wholly incorporates the Complainant's trademark, accompanied by a generic term and a number. The Disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademark in the Disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the Disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the Disputed domain name with full knowledge of the Complainant's well-known trademark. His use of the Disputed domain name is in bad faith as there is no conceivable use of the Disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SICUREZZAINTESASANPAOLO214.COM**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2017-12-23

Publish the Decision