Decision for dispute CAC-UDRP-101774

Case number	CAC-UDRP-101774
Time of filing	2017-11-20 09:21:19
Domain names	INTESASANPAOLOBITCOIN.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

Name	PAOLO VIAFORA

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.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following registrations for the trademark “INTESA SANPAOLO”:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007, in classes 9, 16, 35, 36, 38, 41 and 42, covering also Australia, China, United States of America, Japan, Russian Federation and many others;

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006 and granted on June 18, 2007, in classes 35, 36 and 38;

- EU trademark registration n. 5421177 “INTESA SANPAOLO & device”, applied on October 27, 2006 and granted on November 5, 2007, in classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

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

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.

Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 48,3 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,800 branches capillary and well distributed throughout the Country, with market shares of more than 16% in most Italian regions, the Group offers its services to approximately 12.6 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,6 million customers. Moreover, the international network specialised in supporting corporate customers is present in 26 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 is holder of numerous registered trademarks with the terms INTESA SANPAOLO.

Moreover, the Complainant is also the owner, among the 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>.

Nobody has been authorized or licensed by the above mentioned banking group to use the trademarks or the domain name at issue.

On November 2, 2017, the Respondent registered the domain name INTESASANPAOLOBITCOIN. COM.

The domain name was connected to a website sponsoring, among others, banking and financial services, for whom the Complainant’s trademarks are registered and used.

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

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

It is more than obvious that the disputed domain name is almost identical to the Complainant's trademark, as it exactly reproduces the wording "INTESA SANPAOLO" with the addition of the descriptive term "bitcoin", the renown worldwide cryptocurrency and digital payment system.

Accordingly, the Panel finds that the domain name is confusingly similar to the Complainant´s registered trademarks.

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

The Respondent has no rights on the disputed domain name, since PAOLO VIAFORA has self-evidently nothing to do with Intesa Sanpaolo.

The disputed domain name does not correspond to the name of the Respondent and the Respondent is obviously not commonly known as "INTESASANPAOLOBITCOIN".

Any fair or non-commercial use of the disputed domain name is not recognizable, especially as of now the website participates in a domain parking program and is for sale on the SEDO Platform.

Overall, the Panel can find no evidence to demonstrate that the Respondent has a legitimate right or interest in the disputed domain name.

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

The Complainant's trademark "INTESA SANPAOLO" is distinctive and 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. If the Respondent had carried out even a basic Google search in respect of the wording "INTESA SANPAOLO", the same would have yielded obvious references to the Complainant. 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 disputed domain name would not have been registered if it were not for the Complainant's trademark.

In addition, the disputed domain name was not used for any bona 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 web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website (par. 4(b)(iv) of the Policy).

The domain name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used. Internet users, while searching for information on the Complainant's services, were redirected confusingly to websites of the Complainant's competitors, sponsored on the websites connected to the disputed domain name. Therefore, it is more than likely that the Respondent has registered and used the disputed domain name in order to intentionally divert traffic away from the Complainant's website.

The former use of the disputed domain name, which allows accessing to the websites of the Complainant's competitors, also through the Complainant's trademark, causes, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones. The Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity have been remunerated.

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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLOBITCOIN.COM**: Transferred

PANELLISTS

Name	**Prof. Dr. Lambert Grosskopf, LL.M.Eur.**

DATE OF PANEL DECISION 2017-12-13

Publish the Decision