# Decision for dispute CAC-UDRP-101797

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| Case number | CAC-UDRP-101797 |
| Time of filing | 2017-12-14 08:53:51 |
| Domain names | INTESAINVEST.COM |

## Case administrator

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

## Complainant

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| Organization | Intesa Sanpaolo S.p.A. |

## Complainant representative

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| Organization | Perani Pozzi Associati |

## Respondent

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| Name | Mic Yeh |

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant submitted evidence that it is the registered owner of the following trademarks:

- International trademark registration n. 1027279 “BANCA INTESA”, registered on November 18, 2009, in connection with classes 9, 16, 35, 36, 41 and 42 (figurative mark with word elements; various denominations under the Madrid protocol);

- EU trademark registration n. 12247979 “INTESA”, filed on October 23, 2013 and registered on March 5, 2014, in connection with classes 9, 16, 35, 36 (including banking services, insurances, and financial affairs), 38, 41, and 42;

- US trademark registration n. 4196961 “INTESA”, filed on June 30, 2011 and registered on August 28, 2012, in connection with class 36 (including banking services).

FACTUAL BACKGROUND

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

The Complainant asserts that it is a leading Italian banking group and also one of the protagonists in the European financial

arena. The Complainant 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.

The Complainant asserts that consumers commonly identify the Complainant as “INTESA”, the typical abbreviation of its business name.

The Complainant asserts that it belongs to the top banking groups in the Euro zone, with a market capitalisation exceeding 48,3 billion euro, and that it is the undisputed financial/banking leader in Italy in all business areas (retail, corporate and wealth management). The Complainant asserts that it has a network of approximately 4,800 branches, which are distributed throughout the Country, with market shares of more than 16% in most Italian regions. The Complainant asserts that the Intesa Group offers its services to approximately 12,6 million customers. The Complainant further asserts that it has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,6 million customers. Finally, the Complainant asserts that its 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 submitted evidence that it is the registered owner of the trademarks mentioned above under "Identification of rights".

The Complainant further asserts that it is the owner of various domain names consisting of the term "INTESA" and different domain extensions (including INTESA.com, INTESA.eu, INTESA.org, INTESA.cn, INTESA.co.uk, etc. However, the Complainant did not submit evidence of these assertions.

On September 12, 2017, the Respondent registered the domain name <INTESAINVEST.COM>.

The Complainant further asserts that its lawyers have sent a cease and desist letter to the Respondent on October 30, 2017 (a copy of this letter was submitted by the Complainant). According to the Complainant, the Respondent did not reply to this cease and desist letter.

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PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT'S CONTENTIONS:

I. The disputed domain name is confusingly similar to the protected mark.

The manner in which the disputed domain name is confusingly similar to the protected mark:

Mark combined with generic term

II. The Respondent does not have any rights or legitimate interest in the disputed domain name.

Categories of issues involved:

Inactive website

III. The disputed domain name has been registered and is being used in bad faith. Categories of issues involved:

Holding domain name for purposes of selling, licensing or renting

Offer to public

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

The disputed domain name <INTESAINVEST.COM> consists of the registered INTESA mark(s) of the Complainant, with the addition of the generic word 'INVEST'. There is also the addition of the '.com' suffix, which may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

As a result, given the above elements and given the distinctiveness of the INTESA marks and the generic or descriptive character of the word 'INVEST' for banking services or financial services (covered by the Complainant's INTESA trademarks), the Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

B. Rights or legitimate interests

The Respondent did not file an administratively compliant (or any) response. In such circumstances, the Panel finds from the facts put forward that:

The Respondent does not appear to have any trademarks, rights, or legitimate interests associated with the INTESA trademarks or with the word "INTESA", either separately or in combination with the word "INVEST".

There is no evidence that the Respondent is commonly known by the INTESA trademarks. The Respondent does not seem to have any consent to use the INTESA trademarks. The disputed domain name does not seem to correspond to the name of the Respondent.

There is no evidence to show that the Respondent may have used the disputed domain name for any bona fide offering of goods or services of its own. Also, there is no evidence to show any demonstrable preparations to use the domain name or a name corresponding to the disputed domain name in connection with such bona fide offering of goods or services.

There is no evidence to show that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks at issue.

The website available through the disputed domain name links to another website where the disputed domain is being

offered for sale.

On the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

C. Bad faith registration and use

The Panel notes that the INTESA trademarks in which the Complainant has rights predate the registration of the disputed domain name.

The Complainant asserts that its trademarks “INTESA” are distinctive and well-known around the world. The Complainant submitted evidence that a Google search for the term 'INTESA" results in multiple search results linked to the Complainant. The fact that the Respondent registered a domain name that is confusingly similar to these distinctive and well-known trademarks indicates that the Respondent had knowledge of the Complainant’s trademarks at the time of registration of the disputed domain name. This is not disputed by the Respondent.

The Complainant submitted evidence that the disputed domain name links to a website ("Uniregistry.com") through which the disputed domain name is offered for sale. The fact that the Respondent offers a domain name for sale that is confusingly similar to the distinctive and well-known trademarks of the Complainant, indicates that the Respondent has knowledge of the Complainant’s trademarks at the time of offering this domain name for sale. Absent any contestation by the Respondent, the Panel accepts that the Respondent registered the domain name primarily for the purpose of selling it to the Complainant or to a competitor of the Complainant for valuable consideration in excess of out-of-pocket costs directly related to the domain name.

There is no indication before the Panel that the Respondent has been authorised or licensed by the Complainant to use the INTESA trademarks in the Respondent's domain name. The Panel further notes that the Respondent did not file any response and thus did not object to any of the contentions made by the Complainant.

In light of these facts, combined with the international business presence of the Complainant and the fact that the Respondent combined the Complainant's trademark "INTESA" with the term "INVEST" (the Panel notes that the Complainant's marks are registered for banking and financial services), the Panel finds that it is highly unlikely that the Respondent would not have been aware of the unlawful character of the disputed domain name at the time of its registration and use.

In the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel believes from the facts in this case that the Respondent had the INTESA trademarks in mind when registering and subsequently using the disputed domain name.

For all of the reasons set out above, the Panel determines that the disputed domain name was registered and is being used in bad faith within the meaning of 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. **INTESAINVEST.COM**: Transferred

## PANELLISTS

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| Name | **Bart Van Besien** |

DATE OF PANEL DECISION 2018-01-22

Publish the Decision