Decision for dispute CAC-UDRP-101881

Case number	CAC-UDRP-101881
Time of filing	2018-02-13 13:06:42
Domain names	TR-INTESASANPAOLO.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	Cyber Operations Team

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

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, renewed;

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

- 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, renewed;

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 http://www.intesasanpaolo.com.

On December 1, 2017, the Respondent registered the disputed domain name <TR-INTESASANPAOLO.COM>.

FACTUAL BACKGROUND

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

The Complainant is an Italian leader banking group and also one of the protagonists in the European financial arena. .

Intesa Sanpaolo is among top banking groups in the euro zone, with a market capitalisation exceeding 46,4 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.

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On December 1, 2017, the Respondent registered the disputed domain name <TR-INTESASANPAOLO.COM>.

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

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

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant makes the following contentions:
(i) that the disputed domain name is identical or confusingly similar to the Complainant’s Trademarks;

(ii) that the Respondent has no rights nor any legitimate interests in respect of the disputed domain name; and
(iii) that the disputed domain name has been registered and are being used in bad faith.

The Complainant argues that, given the fact that the Complainant has trademarks rights on the sign "INTESA SANPAOLO" since 2006 and that the disputed domain name is composed of the Complainant's trademark reproduced in its entirety together with the adjunction of the two letters "TR", the disputed domain name is identical or confusingly similar to the Complainant's trademark.

The Complainant alleges that the Respondent has not been authorized nor licensed by the Complainant to use its trademarks, nor that the disputed domain name correspond to the name of the Respondent and use it in a fair or non-commercial use. Indeed, the Complainant states that the Respondent has no rights nor any legitimate interest in respect of the disputed domain name.

The Complainant further argues that The Complainant's trademark "INTESA SANPAOLO" is distinctive and well known all around the world and that 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. The Complainant further states that the disputed domain name is not used for any bone fide offering and that the fact that it is not connected to any web site is constitutve of the passive holding of a domain name (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., concerning just the case of a bank).

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED, THE RESPONDENT IS THEREFORE IN DEFAULT.

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

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

The Complainant has submitted evidence of its prior rights on the “INTESA SANPAOLO” sign in the form of Trademarks and domain names.

The disputed domain name consists of Complainant’s “INTESA SANPAOLO” Trademarks, together with the two letter "TR".

First, the applicable Top Level Domain in a domain name such as ".com" is viewed as a standard registration requirement

and, as such, is disregarded under the confusing similarity test. See RX America, LLC v. Matthew Smith, WIPO Case No. D2005-0540; Sanofi-Aventis v. US Online Pharmacies, WIPO Case No. D2006-0582.

Second, the disputed domain name reproduces the Complainant's Trademarks in its entirety together with the two letter "TR". This is sufficient to find confusing similarity in the sense of the Policy. See, Valero Energy Corporation and Valero Marketing and Supply Company v. Valero Energy, WIPO Case No. D2017 0075; M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts, WIPO Case No. D2015 1384; and ERGO Versicherungsgruppe AG v. Idealist, WIPO Case No. D2008-0377 (the combination of the trademark ERGO in the second level of a domain name together with the term "finance" made the Domain Name confusingly similar to the trademark in question).

Based on the evidence provided by Complainant, decisions of prior UDRP panels cited above, and the Panel's own analysis, the Panel finds that the requirement of paragraph 4(a)(i) of the Policy has been met.

Consequently, the Panel finds that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in the disputed domain name by demonstrating any of the following:
(i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trade mark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent comes forward with relevant evidence of rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Respondent is not affiliated or connected to the Complainant in any way nor has it been authorized and licensed by the Complainant to register and use the disputed domain name which incorporates the Trademarks. It does not appear to have any independent right to the disputed domain name. There is no evidence that the Respondent is commonly known by the disputed domain name. The disputed domain name refers to an erreor page.

The Panel finds that the Complainant has made out a prima facie case. The Respondent has not filed a response and is therefore in default, thus, the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name.

For all the foregoing reasons, this Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

Pursuant to the Policy (paragraph 4(a)(iii)), The Complainant must show that the Respondent registered and is using the disputed domain name in bad faith.

The Panel finds that the Respondent must have been aware of the Complainant and its reputation in the "INTESA SANPAOLO" Trademarks at the time the Respondent registered the disputed domain name. The Complainant has submitted evidence, which shows that the Respondent registered the disputed domain name long after the Complainant registered its trademark. According to the evidence filed by the Complainant, the Complainant has owned a registration for the "INTESA

SANPAOLO" trademark since at least the year 2006. It is suggestive of the Respondent's bad faith in these particular circumstances that the "INTESA SANPAOLO" Trademarks, owned by the Complainant, were registered long before the registration of the disputed domain name (Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735). In the WIPO Overview 3.0, section 3.2.2 states as follows:

"Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark."

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the dispued domain name is also a significant factor to consider (as stated in section 3.1.1 of WIPO Overview 3.0). The disputed domain name falls into the category stated above and the Panel finds that registration is in bad faith.

The "INTESA SANPAOLO" sign is distinctive, thus, it refers directly and only to the Complainant's Trademarks. There is no obvious reason, nor has the Respondent offered an explanation, for the Respondent to register a domain name that combines a reproduction of the Trademarks in its entirety and the adjunction of two letters unless there was an intention to create a likelihood of confusion between the disputed domain name and the Complainant's "INTESA SANPAOLO" Trademarks.

The disputed domain name is confusingly similar to the Complainant's trademark. Previous UDRP panels have found that " [a] likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site" (Edmunds.com, Inc. v. Triple E Holdings Limited, WIPO Case No. D2006-1095). To this end, prior UDRP panels have established that attracting Internet traffic by using a domain name that is identical or confusingly similar to a registered trademark may be evidence of bad faith under paragraph 4(b)(iv) of the Policy.

Ultimately, the evidence reveals that the Respondent has taken advantage of the Complainant's "INTESA SANPAOLO" Trademarks to intentionally attempt to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademark as to source, sponsorship, affiliation or endorsement of the Respondent's websites. As held in recent UDRP decisions, involving similar circumstances namely Aktiebolaget Electrolux v. Muneer Mohamed of Cairo, WIPO Case No.D2015-0874 and Aktiebolaget Electrolux v. eletroluxmedellin.com, Domain Discreet Privacy Service / Luis Rincon, supra such conduct of deliberately misleading and diverting Internet users is undoubtedly evidence of bad faith registration and continued bad faith use.

Accordingly, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith 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. **TR-INTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2018-03-26