Decision for dispute CAC-UDRP-101899

Case number	CAC-UDRP-101899
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Domain names	INTESASANPAOLOCRYPTOCURRENCIES.COM, INTESASANPAOLOCRYPTOCURRENCY.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	Kleos srl

OTHER LEGAL PROCEEDINGS

There are no other proceedings the Panel is aware of.

IDENTIFICATION OF RIGHTS

The Complainant relies on its name and mark INTESA SANPAOLO and in particular, its many national, regional and international registered marks. Its primary International Mark, is No. 920896, the word mark “INTESA SANPAOLO”, granted on 7 March 2007 in classes 9, 16, 35, 36, 38, 41 and 42 and registered in over 60 countries.

It also has many registered EUTMs (formerly CTMs) and relies on, by way of example, its trade mark No. 5301999, the word mark INTESA SANPAOLO, applied for on 8 September 2006 and granted on 18 June 2007 in classes 35, 36 and 38 as well as trade mark No. 5421177, INTESA SANPAOLO, the word and device mark, applied for on 27 October 2006 and granted on 5 November 2007 in classes 9, 16, 35, 36, 38, 41 and 42.

It has a substantial portfolio of national registered marks, often with the word mark followed by country and service designations.

It is also the owner of an extensive portfolio of domain names including the mark and with the gTLDs: .COM, .ORG, .EU, .INFO, .NET, .BIZ and also in hyphenated form as INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ. All of which resolve to the official website http://www.intesasanpaolo.com.

FACTUAL BACKGROUND

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The Complainant is an Italian banking consortium called Intesa Sanpaolo S.p.A, which arose from a merger in 2007 between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two Italian banking groups. Intesa Sanpaolo has a market capitalisation of over €46.4 billion, and is a market leader in Italy, in business banking (including retail, corporate and wealth management). It has a network of approximately 4,800 branches in Italy and approximately 12.6 million customers. Intesa Sanpaolo also has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7.6 million customers. Its international network is focused on corporate customers and is established in 26 countries worldwide but with a presence in the Mediterranean rim.

On November 9, 2017, the Respondent registered the disputed domain names <INTESASANPAOLOCRYPTOCURRENCIES.COM> and <INTESASANPAOLOCRYPTOCURRENCY.COM>.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

THE DISPUTED DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The disputed domain names are identical, or – at least – confusingly similar, to the Complainant's name and mark "INTESA SANPAOLO". In fact, <INTESASANPAOLOCRYPTOCURRENCIES.COM> and <INTESASANPAOLOCRYPTOCURRENCY.COM> exactly reproduce the word trade mark with the addition of the generic words "cryptocurrency" and "cryptocurrencies", both of which are merely descriptive but may allude to the online banking services offered by the Complainant. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first UDRP element (see, among other, M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts, WIPO Case No. D2015-1384, <daiwikresorts.com>, Nintendo of America Inc. v. Fernando Sascha Gutierrez, WIPO Case No. D2009-0434, <unlimitedwiidownloads.com> and Hoffmann-La Roche Inc. v. Wei-Chun Hsia, WIPO Case No. D2008-0923, <yourtamiflushop.com>).

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

The Respondent has no rights in the disputed domain names, since KLEOS SRL has nothing to do with the Complainant. No-one has been authorized or licensed by the Complainant to use the disputed domain names. The disputed domain names do not correspond to the name of the Respondent and it is not commonly known as the disputed domain names. Lastly, there are no fair or non-commercial uses of the disputed domain names based on their home-pages or otherwise.

THE DISPUTED DOMAIN NAMES WERE REGISTERED AND ARE USED IN BAD FAITH

The disputed domain names were registered and are used in bad faith. The Complainant's name and marks are distinctive and well-known all around the world. The fact the Respondent has registered two domain names confusingly similar to them, indicates the Respondent had knowledge of the Complainant's name and marks at the time of registration of the disputed domain names. In addition, if the Respondent had carried even a basic Google search in respect of the word mark "INTESA SANPAOLO", the results would have yielded 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 names would not have been registered if it were not for Complainant's trade mark. This is a clear evidence of registration of the disputed domain names in bad faith.

In addition, the disputed domain names are not used for any bona fide offerings. More particularly, the circumstances indicate the Respondent has registered or acquired the domain names primarily for the purpose of selling, renting, or otherwise transferring them to the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain names (para. 4(b)(i) of the Policy). The disputed domain names are not used for any bona fide offerings, even if they are not connected to any websites. In fact, countless UDRP decisions confirm that the passive holding of a domain name with knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, and the consensus view on this point, as reflected in the "WIPO Overview of WIPO Views on Selected UDRP Questions" at paragraph 3.2 (passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, panels have tended to make such findings in circumstances in which, for example, a complainant's mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the complainant's trade mark rights). As regards the first factor, the Complainant has already proved the renown of its trademarks. As to the second factor, it must be noted that it is not possible to understand what kind of use the Respondent could legitimately make with a domain name which exactly corresponds to the Complainant's trademarks and to offer or provide online banking services for enterprise. In the light of the above, the present case meets the requirements and the passive holding of the contested domain name has to be considered a use in bad faith. See Comerica Inc. v. Horoshiy, Inc., D2004-0615 (The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would likely be the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in a manner as yet undetermined at an uncertain future date, does not negate the Respondent's bad faith. On the contrary, it raises the spectre of continuing bad faith abuse by Respondent of Complainant's name and mark and related rights and legitimate business interests).

There is a greater risk of a wrongful use of the disputed domain names in the present case, due to phishing. Such a practice consists of attracting the customers of a bank to a web page which imitates the real page of the bank, with a view to having customers disclose confidential information like a credit card or bank account number, for the purpose of unlawfully charging such accounts or withdrawing from them. Some clients of the Complainant have received e-mail messages asking, by the means of web pages which were very similar to the Complainant's ones, the sensitive data of the clients, like user ID, password etc. Some clients have been cheated of their savings. In the present case, the Complainant believes that the current owner may have registered the disputed domain names with a "phishing" purpose, in order to induce and divert the Complainant's legitimate customers to its website and steal their money and the above could be easily verified given the particular nature of the disputed domain names (Complainant's trademark + descriptive terms alluding of the online currencies).

Even excluding any "phishing" purposes or other illicit use of the disputed domain names in the present case, we can see no other possible legitimate use of the disputed domain names. The sole further aim of the owner of the disputed domain names might be to resell them to the Complainant, which represents, evidence of the registration and use in bad faith, according to par. 4(b)(i). 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.

RESPONDENT:

The Respondent says it has registered and acquired many various domain names since 1996/1997, and continues to register domains aimed at new technological sectors, both productive and virtual. As the technology of blockchain is currently the newest and most innovative technology and is in continuous and constant evolution, it decided to register various domains with extension .com. In the crypto and coin sector it has registered, for example, all the words that match the letters of the Greek alphabet, English words combined with bits, coins, numbers, adjectives and so on.

The Respondent says that what must be emphasized in the present dispute is that there can be no danger of confusion or

deception in an area which is not within the competence of the Complainant and the Complainant does not offer blockchain or cryptocurrency.

The Respondent says the Complainant cannot claim exclusive ownership of domains bearing words in common use, for example INTESA means agreement, SANPAOLO is the name of a saint, combined together CRYPTOCURRENCIES or CRYPTOCURRENCY.

It says Blockchain technology is only the technology that underlies cryptocurrencies, but it does not mean wanting to operate in decentralized currencies that have nothing to do with centralized entities such as banks, which due to their institutional appearance have been kept far from the sector in question.

The Respondent says that only after 12 months has the Complainant sought to claim the legitimate ownership of domains that they had not even remotely thought of or imagined before. It therefore claims the full legitimacy of the registration of the two disputed domain names the subject of this dispute.

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

Decision

1. Identical or Confusingly Similar

There are two issues here. The first question that arises is whether Complainant has a trademark or service mark on which it may rely. For the purposes of the UDRP, trade mark rights attach to registered marks and a Complainant with a registered right has standing under the UDRP. Registered marks are assumed to be valid and the fact that a mark is descriptive or generic to a greater or lesser degree is regarded as a matter for the courts in the nation state where it is registered. See Bettinger, Domain Name Law and Practice, 2nd Ed. P.1342, para. IIIE211. Further, for the UDRP, the geographic location of the mark is not relevant to it as a requirement for standing. Where there are registered marks and extensive use, there are often also parallel common law trade mark rights arising from that use, even reflexively where the Complainant is in a civil law country, see Palais Stephanie WIPO D.2009 -1394 (fairness required that even in a civil law country comparable rights be recognized as they would be protected by unfair competition laws). A very small selection of the Complainant's registered rights are relied upon and these marks are enumerated and described above and are sufficient for standing.

The second issue that arises for consideration under the first element is whether the disputed domain names, registered by the Respondent, are identical or confusingly similar to the trade marks that the Complainant owns.

In this analysis, the gTLD (the words to the right of the dot or the suffix) is ignored. This test typically involves a side-by-side

comparison of the domain name and the relevant trade mark. Identity is a very strict test and means what it says. Similarity is a broader test and in some cases, such assessment may also entail consideration of the visual, aural and phonetic similarities between a complainant's trade mark and the disputed domain name to ascertain confusing similarity.

Here the Complainant argues that the disputed domain names are confusingly similar to its name and marks as they incorporate the word mark and merely add the generic words CRYPTOCURRENCIES.COM and CRYPTOCURRENCY.COM and that those additional words should be ignored for the similarity analysis.

The Respondent contends that the disputed domain names are comprised of common and generic/descriptive terms to which it has merely added other generic/descriptive terms.

Most panels have found that the addition of generic/descriptive terms to a trade mark does not impact the similarity analysis where the Complainant's mark remains clearly visible within the disputed domain name and especially where the additional terms are relevant to the Complainant's business. See Lufthansa WIPO D2008 -1276 (Lufthansaholidays.com). This can also go to an argument on weakness such that the mark as such cannot found any claim to exclusivity. Essentially this argument is that the marks are weak and descriptive and so the Complainant must tolerate other very descriptive uses by other traders and cannot and does not have an exclusive monopoly on the words in terms of their common meaning. Alternatively, that a highly descriptive mark added to other highly descriptive terms may not reference or leverage the Complainant's name and reputation. This issue is relevant to the second factor below but the Panel finds that a determination of it is not necessary under Policy 4(a)(i) as this portion of the Policy considers only whether the Complainant has rights in the mark and whether the disputed domain name is identical or confusingly similar to the Complainant's mark.

In this case, the disputed domain names are confusingly similar to the word marks relied on. Further, based on the evidence of market capitalisation and market dominance together with geographical presence, the panel finds that the Complainant's name and marks are well-known or famous marks. This is also relevant to the factors below, where it will be considered further.

Accordingly, the Panel finds that Respondent's disputed domain names are confusingly similar to the registered marks under Policy 4(a)(i) and the Complainant has made out the first of the three elements that it must prove.

2. Legitimate rights and interests

It is now well established that here the Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii), and then the burden shifts to the Respondent to show it does have rights or legitimate interests. See Belupo.com WIPO D2004-0110 and Hanna-Barbera Prods., Inc. v. Entm't Commentaries, FA 741828 (FORUM Aug. 18, 2006).

The Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain names, first, because the Respondent is not commonly known by them and as the Complainant has not authorized or licensed the Respondent to make use of its trade mark. Where a respondent does not counter these points, such arguments are found to be dispositive of Policy 4(c)(ii) in favor of complainants. Here, as the record shows, the Respondent is called KLEOS SRL. Moreover, there is no evidence that the Respondent was authorized or permitted by the Complainant to use its name and marks in a domain name or in any other way. The Panel therefore finds that the Respondent is not commonly known by the disputed domain names under Policy 4(c) (ii).

The Respondent's principal argument is that the disputed domain names are made up of generic or descriptive words and were selected in good faith and without intent to free-ride, trade on or reference the Complainant. Any registrant who is first in time, is entitled to register and use a domain name that is generic or descriptive of its services and there are many cases where panelists who decide these cases, including the present panelist, have applied that principle. But at the same time, it is equally clear that this must be genuinely what the registrant has done; registering a confusingly similar domain name must not be used as a guise for targeting a complainant's trade mark rights. It is sometimes difficult to decide on conflicting facts whether the domain name registrant is genuinely using a common or descriptive expression or not.

In the present case, there are several features of the evidence that tilt the balance against the Respondent. Firstly, the trade mark is not weak, that is, highly descriptive generally or in the sense used in the mark and the disputed domain names.

While in Italian, Intesa originally meant Agreement and San Paulo, St Paul, respectively; these may be considered their primary meanings. However, in the Complainant's name and trade mark and certainly by its very substantial use, this term has acquired a secondary meaning –also called acquired distinctiveness—that is, they reference the Complainant and its services as a badge of trade origin. It is this secondary meaning-- not the primary meanings --that the Respondent intended to leverage. This is clear and obvious in this case.

Put another way, is it really likely that 'Agreements of St Paul' was the meaning intended by the Respondent or was it the well-known Complainant bank? And when added to terms about bitcoins and blockchain offerings? The answer is clear and the Respondent has intended to, and has, targeted the Complainant.

Here neither the Complainant (nor indeed other EU regulated banks and financial institutions) currently offer these kinds of products and services so there is no bona fide referential or nominative use here. Indeed, there is no use here at all. Nor is there evidence of intended or/preparation for bona fide use. Indeed the Respondent's position on use is not very clear. We cannot see any means of generating revenue, but that does not mean that revenue will not be generated in future from the disputed domain names – possibly after this dispute has been resolved. The Respondent's case seems to be that it was first to conceive and to register the generic and descriptive disputed domain domain names – and that the Complainant had failed to register them. This seems to be part of its case that it has a large portfolio and trades in generic and descriptive names. We assume this is used for Pay Per Click or other revenue or for sales to interested parties. We are not told. This however does not support any bona fide or legitimate use – and instead tends against it and registering with intent to sell to a Complainant with rights is an enumerated factor for bad faith and is dealt with under the third element below.

However, it must be noted that passive holding alone is now a neutral factor. Since the Clara Case in 2009, WIPO Case D 2009-1580, WIPO panels have accepted registration and use of generically worded domains for use in PPC schemes and even for resale, but only where this is based on the generic meaning. See Bettinger (above) at p. 1373 and para. IIIE.284-5 and see Rive.com, FORUM Case No. 1501995 and Versona.com, FORUM No. 491557 and Arrigo.com FORUM Case No. 1493536 (The Panel agrees the Respondent's Policy 4 (a) (ii) rights and legitimate interests rests on the fact that it registers and sells generic domain names). However, the proviso is that the meaning relied on must be the truly generic/descriptive/common meaning and not any secondary meaning referencing the Complainant. As noted above, 'Agreements of St Paul' was not the meaning intended here and the Complainant is targeted. Therefore the registration for sale by the Respondent targeted the Complainant's trade mark and goodwill to advance its own business at the risk of diminishing the Complainant's business. That is not a legitimate use of the disputed domain names.

The role of the Panel is to decide this dispute on the balance of probabilities and, applying that standard of proof, the Panel finds that on the balance of probabilities, the Respondent has not made a bona fide offering of goods or services or any legitimate non-commercial or fair use of the disputed domain names. The Complainant has succeeded on the second element under the Policy 4(a).

3. Bad Faith

It will have been seen from the foregoing findings that it would be difficult for the Respondent to resist the conclusion that it registered or used the disputed domain names in bad faith and, in all probability, both. The reasons for those conclusions have already been explained and it is not necessary to repeat them in detail here, other than to say that Respondent has adopted the Complainant's name and mark. It is well established now that this third element of Policy 4(a) may be met by a showing of one or more of the illustrative and non-exhaustive examples of bad faith activities in Policy 4(b) (i) –(iv) and these are sale, blocking, disrupting or confusing.

As the Complainant submits, use for these purposes is now accepted to include passive holding in certain circumstances based on the line of authority proceeding from the Telstra case (above). This case is authority for the proposition that

passive holding may be bad faith use where (i) the Complainant's mark is well-known with a strong reputation; (ii) the Respondent has not provided evidence of actual or good faith use; (iii) and (iv) the Respondent either attempted to conceal its identity or provided false or misleading information and (v) there is no conceivable good faith use for the disputed domain names by the Respondent. As Bettinger explains (above) at p. 1416 paras. IIIE.378, the focus is the Respondent's intent to target the trade mark value of the domain name.

For reasons discussed above, we find that the Respondent's intent was clearly to unfairly target the trade mark value in the domain names and that Telstra factors (i), (ii), (iv) and (v) are made out here. We do not consider the Respondent put forward an honest case when it asserted it has selected the primary as opposed to secondary meaning of the word mark. The fact that the Complainant is so well-known is a dominant factor and the Respondent is also Italian. The evidence is that the Complainant is ubiquitous in Italy. We can find no bona fide use and there is no conceivable good faith use by the Respondent.

Accordingly, the Panel finds for reasons already explained that Respondent has engaged in both bad faith registration and use of the domain names under Policy 4(b)(iv).

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted and accordingly, it is ordered that the disputed domain names shall be transferred from the Respondent to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLOCRYPTOCURRENCIES.COM**: Transferred
2. **INTESASANPAOLOCRYPTOCURRENCY.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2018-04-17

Publish the Decision