

Decision for dispute CAC-UDRP-102001

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| Case number | CAC-UDRP-102001 |
| Time of filing | 2018-05-21 09:24:37 |
| Domain names | SECURE-INTESASANPAOLO.COM |

Case administrator

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| Name | Sandra Lanczová (Case admin) |
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Complainant

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

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| Organization | Perani Pozzi Associati |
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Respondent

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| Name | Ciro Migliaccio |
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is owner of a large intellectual property rights portfolio, comprising among the others:

THE TRADEMARKS

- International trademark registration no. 920896 "INTESA SANPAOLO", granted on March 07, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42, based on the Italian TM no. 1042140, covering also Australia, China, United States of America, Japan, Russian Federation and many others
- EU trademark registration no. 005301999 "INTESA SANPAOLO", filed on September 08, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38
- EU trademark registration no. 005421177 "INTESA SANPAOLO & device", filed on October 27, 2006, granted on November 5, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42.

THE DOMAIN NAMES

INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ and INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ.

All such domain names are resolving to INTESASANPAOLO.COM used as main domain name and website of the Complainant.

THE COMPANY NAME

The Complainant is carrying on business and providing its services under the company name INTESA SANPAOLO S.P.A., a financial institution resulting from the merger of two banks Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. effective as of January 01, 2007. INTESA SANPAOLO has become a distinctive identifier used in trade which consumers associate with the Complainant's services.

The above-mentioned trademarks, domain names and company name are hereinafter collectively referred to as the INTESA SANPAOLO Trademark.

The Complainant has proved its rights in the INTESA SANPAOLO Trademark for the purposes of the Policy.

FACTUAL BACKGROUND

The Complainant, Intesa Sanpaolo S.p.A., is a leading Italian banking group and one of the top players of the European financial arena, born from the merger of Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. effective as of January 01, 2007.

The Complainant is among the largest financial institutions in the Euro zone with a market capitalisation exceeding 46.4 billion euro and is the undisputed leader in all business areas (retail, corporate and wealth management) in Italy. Thanks to a network of approximately 4,800 branches capillary and well distributed throughout Italy with market shares of more than 16% in most Italian regions, the Complainant offers its services to approximately 12.6 million customers. The Complainant has also 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 owns several trademarks and domain names, all of them characterized by the presence of the distinctive and well-known wording "INTESA SANPAOLO".

The disputed domain name <SECURE-INTESASANPAOLO.COM> was registered on March 12, 2018, hence well after the registration of the INTESA SANPAOLO Trademark, by an individual identified as Ciro Migliaccio located in Italy.

The disputed domain name resolves to a parking page with pay-per-click (PPC) links redirecting to the Complainant's and its competitors websites.

The Complainant has sent a cease and desist letter to the Respondent without obtaining any response.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT'S CONTENTIONS:

The Complainant states that the disputed domain name is almost identical to INTESA SANPAOLO Trademark, as it exactly reproduces the wording "INTESA SANPAOLO" with the addition of the descriptive term "secure". Considering the banking and financial context in which the Complainant operates, the Complainant retains it undeniable that the disputed domain

name will create even more confusion with the business carried out under the INTESA SANPAOLO Trademark, as it will be interpreted by internet users as a reference to the safety of Complainant's internet banking.

The Complainant contends that the Respondent, an individual identified as Ciro Migliaccio, has nothing to do with the Complainant, nor has been authorized or licensed to use the INTESA SANPAOLO Trademark or to register or use the disputed domain name. The disputed domain name does not correspond to the Respondent's name, nor is this latter commonly known as "SECURE-INTESASANPAOLO". Since the disputed domain name is parked, there is no fair or non-commercial use of the disputed domain name.

The Complainant puts forward several circumstances which, according to it, amount to bad faith registration and use. First of all, considering the distinctiveness and reputation of the INTESA SANPAOLO Trademark, it is unlikely that the Respondent had no knowledge of the Complainant's mark at the time of the registration of the disputed domain name. The Complainant alleges, submitting an extract of a search carried out by the same on the well-known search engine Google with the keywords "INTESA SANPAOLO", that had the Respondent performed a basic search on Google, he should have yielded obvious references the Complainant. Hence, according to the Complainant, it is most likely that the Respondent registered and has used the disputed domain name having in mind the Complainant and the INTESA SANPAOLO Trademark and with the clear intention to take advantage of the reputation of the same by creating a likelihood of confusion between such mark and the disputed domain name.

Secondly, the Complainant contends that the use of the disputed domain name which resolves to a parking page and ultimately redirects to websites related to the Complainant and its competitors is not to be considered a good faith use under the Policy and the UDRP case law.

Finally, the Complainant highlights that the Respondent has never replied to the Complainant's cease and desist letter.

Consequently, the Complainant requests the transfer of the disputed domain name.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED BY THE RESPONDENT.

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) of the Policy requires the Complainant to prove each of the following three elements to obtain the transfer or the cancellation of the domain name:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

1. THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has provided sufficient documentary evidences to demonstrate to be owner of the INTESA SANPAOLO Trademark since 2006.

In assessing identity or confusing similarity the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, because it incorporates the entirety of the Complainant's INTESA SANPAOLO Trademark and differs from such mark by merely adding the generic and descriptive term "SECURE" and a hyphen to the second-level domain name and the top-level domain name ".COM".

In UDRP cases where the relevant trademark is recognizable within the disputed domain name, Panels agree that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element (see paragraph 1.7 WIPO Overview 3.0).

UDRP Panels also agree that the top-level domain is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant's trademark as it is a technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

2. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP Panels that the Complainant shall 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 (see paragraph 2.1 of the WIPO Overview 3.0: "where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element").

The Complainant contends to have no relationship whatsoever with the Respondent, an individual identified as Ciro Migliaccio. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain name.

There is no evidence available that the Respondent has been commonly known by the disputed domain name or has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The disputed domain name points to a parking page containing PPC links related to the Complainant and its competitors. Such use is not to be considered a bona fide offering of goods or services. Indeed, applying UDRP paragraph 4(c), Panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

3. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Respondent has registered the disputed domain name which is to be considered confusingly similar to Complainant's well-known mark, since it incorporates the INTESA SANPAOLO Trademark in its entirety and differs from it merely by adding the generic and descriptive term "SECURE", a hyphen between the word "SECURE" and the distinctive part of Complainant's mark (i.e. the wording "INTESA SANPAOLO") and the TLD ".COM" (which is disregarded for the purpose of determination of confusing similarity between the disputed domain name and the trademark of the Complainant as it is a technical requirement of registration).

Considering that the Complainant provides banking and financial services (even online), the Respondent's choice to add the generic and descriptive term "SECURE" to the trademark of the Complainant shows his clear intention to enhance such likelihood of confusion for the Internet users who are seeking or expecting the Complainant.

Given the distinctiveness and reputation of the Complainant's prior mark at least in the territory where both the Complainant and the Respondent are located (i.e. Italy), it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant's rights in such well-known mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

The Complainant has also submitted a Google search, alleging that "if the Respondent had carried even a basic Google search in respect of the wording <INTESA SANPAOLO>, the same would have yielded obvious references to the Complainant".

Provided that, due to the distinctiveness and reputation of the Complainant's mark in Italy (and in several countries), the Respondent most likely knew the Complainant and its mark even without a Google search, this Panel agrees with the Complainant and affirms that it is the Respondent's responsibility to determine whether his domain name registration infringes or violates someone else's rights (see paragraph 2 of the Policy).

Even assuming that the Respondent had no knowledge of the Complainant's prior mark (which is quite unlikely as mentioned earlier), he omitted to verify that the domain name would have infringed the Complainant's earlier rights or, even worse, he verified it and deliberately proceeded with the infringing registration and then use.

Moreover, the case file of this dispute shows that, during the registration of the domain name, the Respondent provided the Registrar with erroneous contact data (nonexistent postal address), since CAC's letter notifying the Respondent about this dispute returned back to CAC undelivered with the script "unknown".

Having registered the disputed domain name, which is confusingly similar to and, thus, infringing the Complainant's INTESA SANPAOLO Trademark, with fake data, the Respondent has also violated the paragraph 2 of the UDRP Policy: "By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations".

The disputed domain name resolves to a parking page. While the sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) does not in and of itself constitute bad faith, in the present case, considering that the website associated to the disputed domain name contains PPC links related to the Complainant and its competitors, the Panel finds that, by registering and using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website or a product or service on his website (Paragraph 4(b)(iv) of the Policy).

Finally, the Respondent has neither responded to the cease and desist letter of the Complainant, nor has submitted a Response in this administrative proceeding providing any evidence of actual or contemplated good faith use. Paragraph 14(b) of the Rules provides that: "If a Party, in the absence of exceptional circumstances, does not comply with any provision

of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate".

Taken into account all circumstances of this case, the Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (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. SECURE-INTESASANPAOLO.COM: Transferred

PANELLISTS

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| Name | Avv. Ivett Paulovics |
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DATE OF PANEL DECISION 2018-06-19

Publish the Decision