Decision for dispute CAC-UDRP-102026

Case number	CAC-UDRP-102026
Time of filing	2018-06-01 08:56:10
Domain names	intesasanpaolo-bank.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	Marco Castone

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of a range of relevant trade marks. For instance, it holds the mark 'INTESA SANPAOLO' as an EUTM (5301999), granted in 2007 and subsequently renewed, in a number of classes (including financial affairs).

FACTUAL BACKGROUND

The Complainant is a banking company, which took its present form in 2007 after a merger. It has a very significant presence in Italy (from which it originates and has its seat) and also in a number of other jurisdictions, in Europe and elsewhere. It has supplied evidence of its international and transnational activities. It operates websites at various other domain names e.g. <INTESASANPAOLO.COM> and variants with different TLDs or with a hyphen between INTESA and SANPAOLO.

The Respondent is an individual with an address in Italy, and registered the disputed domain name on 22 May 2018.

PARTIES CONTENTIONS

The Complainant submits that the disputed domain name is 'almost identical' to its trade mark, noting that the only addition is of the descriptive word 'bank'. It declares that the Respondent has not been authorised or licensed to use its mark, and

that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Finally, it contends that the disputed domain name was registered and is used in bad faith, highlighting the distinctiveness of the text, the blocking of the website provided by the Respondent by 'Google Safe Browsing', the alleged use of the disputed domain name for phishing (Internet fraud using a website appearing to be that of a financial institution for unlawful purposes). In the alternative, it argues that there is no possible legitimate use of the disputed domain name.

No administratively compliant response has been filed. An e-mail sent to the Respondent's address (as per WHOIS records) was successfully relayed. The Respondent never accessed the online platform.

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).

The disputed domain name is not identical to any of the marks held by the Complainant. However, it is confusingly similar. The Panel first disregards the generic TLD, in accordance with the well established practice of UDRP Panels, for the purposes of assessing para 4(a)(i) of the UDRP. The hyphen and additional string 'bank' is not only descriptive, but relates to the activities of the Complainant (including those for which it enjoys trade mark protection in the EU and elsewhere). As the Panel has held in a number of earlier cases (CAC Case 101929 Credit Agricole SA v Pilar Rodrigues, CAC Case 101555 O'Neill Brand S.à r.l v DVLPMNT Marketing, Inc.), and as is set out in the current (3rd) edition of the WIPO Jurisprudential Overview at para 1.8, it is well established that the addition of a generic or descriptive term to that term in which a Complainant has rights is unlikely to be a barrier to a finding of confusing similarity.

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).

The Respondent has not participated in these proceedings. The Panel is not aware of any information that would suggest rights or legitimate interests in respect of the disputed domain name. In addition, the Complainant has stated that the Respondent is not affiliated with nor authorised by it.

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).

The Panel notes the submissions made by the Complainant regarding phishing. However, it must first be noted that no specific evidence of such has been provided or even argued. This is not therefore a case like CAC Case 101161 Teva Pharmaceutical Industries v Amy Kinjo, CAC Case 100921 Teva Pharmaceutical Industries v Whois Privacy Protection Service, or CAC Case 101390 Bollore v Roy, where the Complaint has included prima facie evidence of such. Here, the Complainant relies upon the identification of the site by Google Safe Browsing. However, this cannot be treated as particularly relevant by a Panel, especially in the absence of any information that would disclose the basis on which Google (or another entity not party to these proceedings) reached this conclusion. For instance, was Google's decision on the basis of specific evidence, or an algorithmic process, or user reports, or some combination of the above? It is well established that a well-argued assertion by a Complainant in an uncontested case should be given due weight, but this is not such a case. Compare it with, for instance, an earlier case concerning the same Complainant, where the Panel was able to take into account a credible allegation that the Respondent was seeking to deceive users into providing personal information: CAC Case 101676 Intesa Sanpaolo v Kara Turner.

The Panel would in any event be able to find that this case is one of 'passive holding', where it is not possible to identify a situation where use would realistically be in good faith (see WIPO Jurisprudential Overview 3.0, para 3.2 including its summary of the 'Telstra' line of cases (WIPO AMC Case D2000-0003 Telstra Corporation Limited v Nuclear Marshmallows). The Panel notes that something resembling this point is included in the Complainant's submissions, though the authorities

emphasised by the Complainant and supplied as annexes tend to relate to the earlier and much weaker points concerning phishing. One of the factors in the Telstra test is that the Complainant's mark 'has a strong reputation and is widely known'. The Complainant has provided sufficient evidence of such, through its annexes on its activities and records of Google searches. The Panel agrees that the mark is distinctive, and has been in use for many years; the Respondent has provided contact details in Italy, where the Complainant, which has a global reputation, has its longest-established operations. Moreover, the Respondent has, through its failure to participate in these proceedings, 'provided no evidence whatsoever of any actual or contemplated good faith use by it' of the disputed domain name. The lack of an active website or any other relevant evidence means that the Panel cannot make any further assumptions about actual or contemplated good faith use.

The Panel does not consider the Complainant's further submission regarding paragraph 4(b)(i) (registration primarily for the purpose of selling, renting, or otherwise transferring) as no evidence has been provided in support of this contention.

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.

The Panel however notes that Annex C of the Complainant's submission (concerning the Google Safe Browsing warning) was provided in Italian, whereas the rest of the materials appeared in English (or, in the case of trade mark registrations, in multiple languages including English). The language of the present administrative proceedings is English. On this occasion, the Panel was able to reproduce the warning in English and so not require the use of paragraph 11(b) of the UDRP Rules (requiring a party to supply a translation) nor paragraph 8 of the CAC Supplemental Rules (allowing for the disregarding of untranslated material).

PRINCIPAL REASONS FOR THE DECISION

In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name. On the other hand, it is clear that the Complainant has rights in respect of the trade mark INTESA SANPAOLO, and that the addition of the text 'bank' does not prevent a finding of confusing similarity. The Panel can find for the reasons set out above that the disputed domain name was registered and is being operated in bad faith. The requirements for the acceptance of a Complaint under paragraph 4 of the UDRP have therefore been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO-BANK.COM**: Transferred

PANELLISTS

Name	**Prof Daithi Mac Sithigh**

DATE OF PANEL DECISION 2018-06-25

Publish the Decision