Decision for dispute CAC-UDRP-102000

Case number	CAC-UDRP-102000
Time of filing	2018-05-21 13:35:55
Domain names	INTESASANPAOLO31265.TOP

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	Kara Turner

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns the following “INTESA SANPAOLO” trademark registrations:

-- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;
-- EU trademark registration n. 5301999 “INTESA SANPAOLO”, granted on June 18, 2007, in classes 35, 36 and 38; and
-- EU trademark registration n. 5421177 “INTESA SANPAOLO” (with design), granted on November 5, 2007, in classes 9, 16, 35, 36, 38, 41 and 42.

The disputed domain name was registered on January 7, 2018, i.e. the Complainant’s trademark registrations cited above predate the registration of the disputed domain name.

FACTUAL BACKGROUND

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

Complainant is the leading Italian banking group and also one of the protagonists in the European financial arena. Intesa

Sanpaolo 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.

Intesa Sanpaolo is among the leading banking groups in the Euro zone, with a market capitalisation exceeding 46.4 billion euro. In Italy it has a network of approximately 4,800 branches, offering its services to 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. Moreover, its international network specialised in supporting corporate customers is present in 26 countries, including the United States, Russia, China and India.

Complainant contends that Respondent is not affiliated with Complainant nor authorized by Complainant in any way to use the trademark “INTESA SANPAOLO”. Complainant does not carry out any activity for, nor has any business with Respondent. Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that Respondent is not related in any way to Complainant’s business. According to Complainant, there is no fair or non-commercial use of the disputed domain name because it does not resolve to an active website.

Complainant further contends that Respondent has registered the disputed domain name in bad faith. Its trademark “INTESA SANPAOLO” is distinctive and well known around the world. The fact that Respondent has registered a domain name that is confusingly similar to this distinctive brand name indicates that Respondent had positive knowledge of Complainant’s trademark at the time of registration of the disputed domain name. In addition, if Respondent had performed even a basic Google search in respect of the phrase “INTESASANPAOLO”, the search results would have shown obvious references to Complainant.

On March 30, 2018, Complainant’s attorneys sent a cease and desist letter to Respondent, asking for the voluntary transfer of the disputed domain name to their client. This letter could not be relayed to Respondent because the e-mail address which Respondent had used to register the disputed domain name does not exist.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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 Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant has, to the satisfaction of the Panel, shown 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

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

Except for the space between “INTESA” and “SANPAOLO” (which for technical reasons cannot be represented in an internet domain name) and the suffix ".pro" (which is also owed to the technical requirements of the domain name system), the only difference between Complainant’s trademark “INTESA SANPAOLO” and the disputed domain name is the number “31265”, which has no apparent meaning at all. Despite this number Complainant’s trademark is easily recognised within the disputed

domain name. The Panel therefore finds the disputed domain name to be confusingly similar to the “INTESA SANPAOLO” mark in which Complainant has rights.

The Panel further finds that Complainant successfully submitted prima facie evidence that Respondent has neither made any use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by Respondent.

The Panel also finds that the Complainant successfully submitted prima facie evidence that Respondent was aware of Complainant's rights in the well-known designation “INTESA SANPAOLO” when registering the disputed domain name. Again, this prima facie evidence was not challenged by Respondent, which supports the conclusion that the disputed domain name was REGISTERED in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Given the fact that the disputed domain name does not resolve to an active website the primary question of this proceeding is whether or not Respondent has also USED the disptued domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). Complainant's case regarding such bad faith use is that Respondent is effectively engaged in “passive holding” of the disputed domain name within the terms originally established by Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. The panel in Telstra noted that the question as to which circumstances of “passive holding” may constitute use in bad faith cannot be answered in the abstract. This question may only be determined on the basis of the particular facts of each case. A panel should give close attention to all the circumstances of the Respondent's behaviour, and a remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith (cf. Sanofi-aventis v. Gerard Scarretta, WIPO Case No. D2009-0229; Mount Gay Distilleries Limited v. shan gai gong zuo shi, CAC Case No. 100707; RueDuCommerce v. TOPNET, CAC Case No. 100617; INFRONT MOTOR SPORTS LICENCE S.r.l. v. VICTOR LEE, CAC Case No. 100385).

With this approach in mind, the Panel has identified the following circumstances as material to the issue in the present case:

(i) Complainant's trademark has a history of more than 10 year (with an even longer history of its two predecessors Banca Intesa S.p.A. and Sanpaolo IMI S.p.A.), a strong reputation, is highly distinctive (particularly in countries outside Italy) and is widely known;

(ii) Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name, nor can the Panel conceive of any such good faith use;

(iii) Respondent has used false contact data (namely a non-existing email address) to register the disputed domain name; and

(iv) taking into account the nature of the disputed domain name the Panel cannot conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

Given all of these circumstances the Panel finds that the manner in which the disputed domain name is being used constitutes use in bad faith. The requirements of paragraph 4(a)(iii) of the Policy 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. **INTESASANPAOLO31265.TOP**: Transferred

PANELLISTS

Name	Dr. Thomas Schafft

DATE OF PANEL DECISION 2018-07-08

Publish the Decision