Decision for dispute CAC-UDRP-102047

Case number	CAC-UDRP-102047
Time of filing	2018-06-13 12:27:58
Domain names	intesasanpaolocity.com

Case administrator

Name	Sandra Lanczová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	vildan erdogan

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns the following registrations for the trade mark INTESA SANPAOLO:
• International trade mark registration number 920896 for INTESA SANPAOLO, registered on 7 March 2007 in classes 9, 16, 35, 36, 38, 41 and 42.
• EU trade mark registration number OO5301999 for INTESA SANPAOLO, registered on 18 June 2007 in classes 35, 36 and 38.
• EU trade mark registration number 005421177 for INTESA SANPAOLO and device registered on 5 November 2007 in classes 9, 16, 35, 36, 38, 41 and 42.

The Complainant has an EU trade mark application number 017803875 for INTESA SANPAOLO CITY, filed on 13 February 2018, for classes 9, 16, 35, 36, 41 and 42.

The Complainant also owns numerous domain names including the mark INTESA SANPAOLO including <INTESASANPAOLO.COM> and <INTESA-SANPAOLO.COM> that are connected to the official website.

FACTUAL BACKGROUND

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

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

The Complainant is a leading Italian banking group, which was formed by the merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. It has a strong presence in Central-Eastern Europe and has an international network spread across 26 countries, including in the Mediterranean area, the United States, Russia, China and India.

The Complainant owns registrations for the trade mark INTESA SANPAOLO that predate the registration of the disputed domain name. It also has a trade mark application for INTESA SANPAOLO CITY, filed on 13 February 2018.

The Respondent registered the disputed domain name <INTESASANPAOLOCITY.COM> on 13 February 2018.

On 21 February 2018, the Complainant sent the Respondent a cease and desist letter, asking for the voluntary transfer of the disputed domain name. The Complainant did not receive a reply.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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:

(i) The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

(ii) The Respondent has no rights or legitimate interests in the disputed domain name.

(iii) The disputed domain name has been registered and used in bad faith.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Complainant asserts that the disputed domain name is identical to the Complainant’s trade marks INTESA SANPAOLO and INTESA SANPAOLO CITY, as it exactly reproduces them.

It is well established that the generic top level suffix .com may be disregarded when considering whether a disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

The Panel is satisfied that the Complainant is the owner of registered trade marks for INTESA SANPAOLO, which predate the registration of the disputed domain name. The Complainant also has a trade mark application, for INTESA SANPAOLO CITY that was filed the same day as the Respondent's registration of the disputed domain name.

The disputed domain incorporates entirely the Complainant's the well-known trade mark INTESA SANPAOLO, and is identical to the mark INTESA SANPAOLO CITY, which is the subject of the Complainant's application for a trade mark. The Panel finds that the domain name is confusingly similar to the Complainant's trade mark INTESA SANPAOLO and that the requirements of paragraph 4(a)(i)of the Policy have been met.

B. NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant submits that the Respondent has no rights in the disputed domain name. It asserts that:

(i) The Domain Administrator, PrivacyGuardian.org, has nothing to do with the Complainant.
(ii) Any use of the trade marks INTESA SANPAOLO and INTESA SANPAOLO CITY must be authorised by the Complainant. The Complainant has not authorised or license anyone to use the disputed domain name.
(iii) The disputed domain name does not correspond to the name of the Respondent, nor is the Domain Administrator, PrivacyGuardian.org commonly known as INTESASANPAOLOCITY and there is no fair or non-commercial use of the disputed domain name.

The Complainant has not authorised the Respondent to use the Complainant's trade marks in the disputed domain name, nor does the disputed domain name correspond to the Respondent's name, nor is there any evidence of any fair or non-commercial use of the disputed domain name.

The Complainant has established a prima facie case that the Respondent has not rights or legitimate interests in the disputed domain name. The burden of proof now shifts to the Respondent. The Respondent has not filed a Response nor disputed any of the Complainant's submissions. The Respondent has made no claims to neither having any relevant prior rights of its own, or to having become commonly known by the disputed domain name. There is no evidence that the Respondent has used or has been preparing to use the disputed domain name in connection with a bona fide offering of goods or services, or for a legitimate non-commercial or fair use, without intent for commercial gain.

The Panel finds that the Complainant has shown that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii)of the Policy have been met.

C. REGISTERED AND IS USED IN BAD FAITH

The Complainant asserts that the disputed domain name was registered and used in bad faith and says:

(i) The Complainant's trade marks INTESA SANPAOLO and INTESA SANPAOLO CITY are distinctive and well known all around the world. The Respondent's registration of a confusingly similar domain name indicates that the Respondent knew of the Complainant's trade marks when registering the disputed domain name.

(ii) If the Respondent had carried out a basic search for INTESA SANPAOLO, it would have yielded obvious references to the Complainant. This raises a clear inference of the Respondent's knowledge of the Complainant's trade marks and the likelihood that the disputed domain name would not have been registered but for Complainant's trade marks. This is a clear evidence that the disputed domain name was registered in bad faith.

(iii) The disputed domain name is not used for any bone fide offering and was registered or acquired primarily for the

purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, or to a competitor of Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name (Paragraph 4(b)(i) of the Policy).

(iv) The disputed domain name links to a parking page where it is offered for sale for USD 950.00. Although Respondent's offer for sale of the disputed domain name was not made specifically to Complainant or its competitor, offers for sale to the public may still constitute evidence of bad faith under the Policy. (See, United Artists Theatre Circuit Inc. v. Domains for Sale Inc., (WIPO Case No. D2002-0005).)

(v) In addition, offers to sell to the public at large domain names that are identical or confusingly similar to marks of others may constitute bad faith. (See, United Feature Syndicate, Inc. v. All Business Matters, Inc. (aka All Business Matters.com) and Dave Evans (WIPO Case No. D2000-1199); Alloy Rods Global, Inc. v. Nancy Williams (WIPO Case No. D2000-1392); Dell Computer Corporation v. Alex and Birgitta Ewaldsson (WIPO Case No. D2000-1087); eBay Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd. (WIPO Case No. D2000-1463).)

(vi) The fact that the disputed domain name has been registered by a person that does not use them but publicly offers them for rent or sale is evidence of a bad faith activity in prejudice of Internet community and of the owner of the trademarks used as domain names. (See, TV Globo Ltda. v. Radio Morena, (WIPO Case No. D2000-0245).)

(vii) Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances that can constitute evidence of a Respondent's bad faith in registering and using a domain name. The consensus view of WIPO UDRP panellists is that bad faith may in, some cases, be found in other conduct carried out by a domain name holder. 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 disputed domain name that would not amount to an infringement of the complainant's trade mark rights.

(viii) The Complainant has renowned trade marks. It is not possible to understand what kind of legitimate use the Respondent could make of the disputed domain name, which corresponds to the Complainant's trade marks. (See, Microsoft Corporation v. Superkay Worldwide, Inc. (WIPO Case No. D2004-0071); Telstra Corporation Limited v. Nuclear Marshmallows (WIPO Case No. D2000-000); Veuve Clicquot Pnsardin, Maison Fondée en 1772 v. The Polygenix Group Co. (WIPO Case No. D2000-0163); Veuve Clicquot Pnsardin, Maison Fondée en 1772 v. The Polygenix Group Co. (WIPO Case No. D2000-0163); and Benetton Group S.p.A. v. Azra Khan (WIPO Case No. D2002-0810).)

(ix) Further, the Complainant's trade mark application for INTESA SANPAOLO CITY was filed on 13 February 2018, the same day on which the disputed domain name was registered. Such circumstances are suspicious, given that INTESA SANPAOLO CITY is a business identifier of the Complainant which has been used for several months. It is therefore highly probable that the Respondent received (or was aware of) an insider information concerning the Complainant's imminent trade mark filing. This suggests opportunistic bad faith. (See Ezcommerce Global Solutions, Inc. v. Alphabase Interactive (WIPO Case D2002-0943).)

(x) Anticipating a trade mark registration after the mark has become popular among the public, as the Respondent did in the present case, does not elevate a Respondent's right or legitimate interest. (See Ceasars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon (WIPO Case D2003-0615).) Speculation involving a big financial institution such as Intesa Sanpaolo is very frequent due to the high number of on line banking users and the Complainant has been part of other WIPO Cases where the Panellists have ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations.

There appears no legitimate reason for the Respondent registering the disputed domain name that is confusingly similar the Complainant's registered trade mark INTESA SANPAOLO, and which is identical to the name INTESA SANPAOLO CITY. Taking into account the Complainant's distinctive trade mark INTESA SANPAOLO, and that the Respondent registered the disputed domain name the same day that the Complainant filed an application for the mark INTESA SANPAOLO CITY, the Panel finds that the Respondent must have been aware of the Complainant's rights when registering the disputed domain

name. Further, the disputed domain name is being offered for sale for USD 950.00, which is clear evidence of bad faith use.

Taking these matters into account, the Panel finds that that the Respondent has registered and has used the disputed domain name in bad faith, and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLOCITY.COM**: Transferred

PANELLISTS

Name	**Mrs Veronica Bailey**

DATE OF PANEL DECISION 2018-07-21

Publish the Decision