Decision for dispute CAC-UDRP-102092

Case number	CAC-UDRP-102092
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Domain names	convalida-dominio-intesa-sanpaolo.com

Case administrator

Name	Sandra Lanczová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	marcone castrano

OTHER LEGAL PROCEEDINGS

According to the Complainant's best knowledge, no other proceedings have been commenced or decided in relation to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the holder of trademark rights for the word mark INTESA SANPAOLO, registered in numerous jurisdictions throughout the world (e.g. international trademark registration No. 920896 since March 7, 2007, covering products and services in classes 9, 16, 35, 36, 38, 41 and 42; and EU trademark registration No. 5301999 since June 18, 2007, covering products and services in classes 35, 36 and 38).

FACTUAL BACKGROUND

The Complainant, Intesa Sanpaolo S.p.A., is an Italian banking group. The Complainant operates one of the leading banks in Italy and has an international presence in Central-Eastern Europe, the Middle East and North Africa. The Complainant provides its services to millions of customers through more than 5,800 branches, of which approximately 1,100 are located outside of Italy.

The Complainant is the owner of the registered word mark INTESA SANPAOLO in several classes in numerous countries and regions all over the world, including Italy, the European Union and the United States of America.

The disputed domain name has been registered by the Respondent on May 22, 2018 using a proxy service. The disputed domain name currently does not resolve to an active website.

On June 6, 2018, the Complainant sent a notice letter to the Respondent via e-mail, notifying the Respondent of the Complainant's rights in the INTESA SANPAOLO mark and demanding the voluntary transfer of the disputed domain name and the cease and desist of any further potential trademark infringements. According to the Complainant, the Respondent did not respond to this notice letter.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant considers the disputed domain name to be confusingly similar to trademarks in which it has rights. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent does not use the disputed domain name in connection with any legitimate use. Also, according to the Complainant, the Respondent has not been commonly known by the disputed domain name. Finally, the Complainant considers that the disputed domain name was registered and is being used in bad faith. The Complainant contends that the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks and registered the disputed domain name for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name. The Complainant further contends that the Respondent has likely registered the disputed domain name for the purpose of "phishing" or other illicit use and that there is no plausible legitimate future use of the disputed domain name possible.

RESPONDENT:

The Respondent did not reply to the Complainant's contentions.

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 15 of the Rules provides that the panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.
The onus is on the complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions

of past UDRP panels, that the complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.

Thus, for the complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain name 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 disputed domain name; and

3. The disputed domain name has been registered and is being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

1. Confusing similarity of the disputed domain name with existing rights

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant is the holder of the registered INTESA SANPAOLO trademark, which is used in connection with its banking and financial services business, it is established that there is a trademark in which the Complainant has rights.

The Panel is of the opinion that the mere addition of non-distinctive text to a Complainant's trademark constitutes confusing similarity, as set out in paragraph 4(a)(i) of the Policy. The disputed domain name incorporate the Complainant's INTESA SANPAOLO trademark in its entirety, with the addition of hyphens and the non-distinctive prefixes "convalida" and "dominio", which are Italian words translating to "validation" and "domain" in English respectively. As a result, the addition of these prefixes does not add to the distinctiveness of the disputed domain name (see Karen Millen Fashions Limited v. Akili Heidi, WIPO Case No. D2012-1395; Belstaff S.R.L. v. Jason Lau, Sharing, WIPO Case No. D2012-0783; Lime Wire LLC v. David Da Silva/Contactprivacy.com, WIPO Case No. D2007-1168).

Additionally, it is well established that hyphens and the generic top-level suffix ".com" may be disregarded when considering whether a disputed domain name is confusingly similar to the trademark in which the Complainant has rights.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's INTESA SANPAOLO trademark.

Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No legitimate rights

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of proof to the Respondent (see Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455; Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. The Respondent's use and registration of the disputed domain name was

not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Moreover, the Panel is of the opinion that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. In fact, the Respondent is not making any use of the disputed domain name. The passive holding or non-use of a domain name is, in appropriate circumstances, evidence of a lack of rights or legitimate interests in the domain name (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; American Home Products Corporation vs. Ben Malgioglio, WIPO Case No. D2000-1602; Vestel Elektronik Sanayi ve Ticaret AS v. Mehmet Kahveci, WIPO Case No. D2000-1244).

Based on the available record, the Panel finds that the Complainant has established a prima facie case, which was not refuted, and that the Respondent lacks rights or legitimate interests in the disputed domain name. Therefore, the Complainant has satisfied the second requirement that the Respondent has no rights or legitimate interests in the disputed domain name, under paragraph 4(a)(ii) of the Policy.

3. Bad faith

The Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (see e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070). In the instant case, the Panel finds that the Respondent must have had knowledge of the Complainant's rights in the INTESA SANPAOLO trademark at the moment it registered the disputed domain name, since the Complainant's trademark is a widely known trademark, especially in Italy where the Respondent is residing, and the disputed domain name incorporates the Complainant's distinctive INTESA SANPAOLO trademark in its entirety.

The Respondent is not using the disputed domain name. According to the Panel, the passive holding of the disputed domain name may amount to bad faith when it is difficult to imagine any plausible future active use of the disputed domain name by the Respondent that would be legitimate and not infringing the Complainant's well-known mark or unfair competition and consumer protection legislation (See Inter-IKEA v Polanski, WIPO Case No. D2000 1614; Inter-IKEA Systems B.V. v. Hoon Huh, WIPO Case No. D2000 0438; Telstra Corporation Limited v. Nuclear Marshmallows, supra). The fact that a complainant's trademark has a strong reputation and is widely used and the absence of evidence whatsoever of any actual or contemplated good faith use are further circumstances that may evidence bad faith registration and use in the event of passive use of domain names.

In the present case, the Panel is of the opinion that the Complainant's trademark is distinctive and widely used, which makes it difficult to conceive any plausible legitimate future use of the disputed domain name by the Respondent. In view of the Complainant's activity in the financial and banking sector, misleading use of the disputed domain name poses a real threat to the Complainant and its clients.

Additionally, by using a proxy registration service, the Respondent has taken active steps to conceal its identity (see Fifth Third Bancorp v. Secure Whois Information Service, WIPO Case No. D2006-0696, where it was held that the use of a proxy registration service to avoid disclosing the identity of the real party in interest is also consistent with an inference of bad faith when combined with other evidence of evasive and irresponsible conduct).

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CONVALIDA-DOMINIO-INTESA-SANPAOLO.COM**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2018-08-22

Publish the Decision