Decision for dispute CAC-UDRP-102144

Case number	CAC-UDRP-102144
Time of filing	2018-09-06 10:01:56
Domain names	intesasanpaolo3-convalida.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 other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the registrations for the trademarks “INTESA SANPAOLO” and “INTESA”, as follows:
- 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”, applied on September 8, 2006 and granted on June 18, 2007, in classes 35, 36 and 38;
- EU trademark registration n. 5421177 “INTESA SANPAOLO & device”, applied on October 27, 2006 and granted on November 5, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;
- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in connection with class 36;
- U.S. trademark registration n. 4196961 “INTESA”, filed on June 30, 2011 and granted on August 28, 2012, in connection with class 36;
- EU trademark registration n. 12247979 “INTESA”, filed on October 23, 2013 and granted on March 5, 2014, in connection with classes 9, 16, 35, 36 38, 41 and 42.

Moreover, the Complainant is the owner, among others, of the domain names bearing the signs “INTESA SANPAOLO” and “INTESA”, as follows:

INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ and INTESA.COM, INTESA.INFO, INTESA.BIZ, INTESA.ORG, INTESA.US, INTESA.EU, INTESA.CN, INTESA.IN, INTESA.CO.UK, INTESA.TEL, INTESA.NAME, INTESA.XXX, INTESA.ME.

All of them are connected with the official website www.intesasanpaolo.com.

FACTUAL BACKGROUND

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

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.

The Complainant is one of the leading protagonists in the European financial arena. Therefore, Intesa Sanpaolo is a leading Italian banking group among the top banking groups in the euro zone, with a market capitalization exceeding 46,1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). It has a network of approximately 4,500 branches capillary and well distributed throughout the Country, with market shares of more than 18% in most Italian regions, the Group offers its services to approximately 12 million customers.

Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,5 million customers. Moreover, the international network specialized in supporting corporate customers is present in 25 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 Respondent registered the disputed domain name on June 18, 2018.

The Complainant’s Representative sent a cease and desist letter to the Respondent on June 26, 2018 requesting the Respondent the voluntary transfer of the disputed domain name but the Respondent did not reply nor transferred voluntarily the disputed domain name.

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

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

The disputed domain name is confusingly similar to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA". The disputed domain name reproduced the well-known trademark "INTESA SANPAOLO" with the addition of the generic words "convalida" (the Italian for "validation") and number "3".

Where the relevant trademark is recognizable in the disputed domain name, the addition of other generic words can not prevent a finding of the Panel that the disputed domain name is confusingly similar to the first and second part of the disputed domain name.

The Panel therefore finds that the disputed domain name is 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).

B. THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Respondent does not correspond to the name nor the Respondent has any other rights to the disputed domain name. The use of the trademarks "INTESA SANPAOLO" and "INTESA" has to be authorized by the Complainant. The Respondent did not evidence any such authorization or license accorded by the Complainant.

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant's trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and based on the registered trademark well-known all around the world. The Respondent should have had knowledge of the Complainant's trademark at the time of registration of the disputed domain name because it has registered a disputed domain name that is confusingly similar to them. Moreover, if the Respondent should had carried only a basic Google search in respect of the wordings "INTESA SANPAOLO" and "INTESA", the same would had led the Respondent to all obvious references to the Complainant. This is a clear evidence of registration of the disputed domain name in bad faith.

The disputed domain name is not used for any bona fide offerings, even if it is not connected to any web site. The passive holding of a disputed domain name with knowledge that this domain name infringes another party's trademark rights is the evidence of bad faith registration and use.

The Respondent has registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant as the owner of the trademark and service mark or to a competitor of Complainant. So that the disputed domain name is not used for any bona fide offerings but for a valuable covering of the Respondent's out-of-pocket costs which are directly and obviously related to the disputed domain name.

The Panel is therefore convinced that the overall circumstances of this case suggest that the disputed domain name was registered and is being used in bad faith and the Complainant has satisfied 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. **INTESASANPAOLO3-CONVALIDA.COM**: Transferred

PANELLISTS

Name	**JUDr. Vojtěch Trapl**

DATE OF PANEL DECISION 2018-10-16

Publish the Decision