Decision for dispute CAC-UDRP-102152

Case number	CAC-UDRP-102152
Time of filing	2018-09-17 14:32:52
Domain names	INTESAINVESTBK.COM, INTESAINVESTSBK.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Albert Rae

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant has adduced evidence that it is the owner of the following registrations for the trademarks “INTESA”:

-U.S. trademark registration n. 4196961 “INTESA”, filed on June 30, 2011 and registered on August 28, 2012, in connection with class 36;

-International trademark registration n. 793367 “INTESA”, registered on September 4, 2002 and duly renewed, in connection with class 36;

-EU trademark registration n. 17197443 “INTESA INVEST AD BEOGRAD”, filed on September 12, 2017 and registered on January 24, 2018, in connection with class 9, 16, 35, 36, 41 and 42; and

-Serbian trademark application n. 74254 “INTESA INVEST BEOGRAD”, filed on July 12, 2017 and registered on February 20, 2018, in connection with classes 9, 16, 35, 36, 41 and 42.

Complainant is also the owner of, inter alia, the following domain names consisting of the INTESA trademark: <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> and <intesa.me>, as well as <intesainvest.eu>, <intesainvest.it>, <intesainvest.rs>.

FACTUAL BACKGROUND

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

Complainant is a leading Italian banking group 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. It is among the top banking groups in the euro zone, with a market capitalisation exceeding 41,9 billion euro, and a leader in Italy in many business areas (retail, corporate and wealth management). Complainant has a network of approximately 4,600 branches capillary and well distributed throughout Italy, with market shares of more than 17% in most Italian regions. Complainant offers its services to approximately 12,0 million customers. Complainant has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,7 million customers. Moreover, the international network specialised 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.

Respondent is an individual residing in the United Kingdom. No further details about the Respondent are known.

The disputed domain names were registered on April 11, 2018. They are not resolving and are thus being passively held.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Complainant asserts that the disputed domain names are identical or at least confusingly similar to a trademark or service mark in which the Complainant has rights. Complainant submits that the disputed domain names exactly reproduce the trademark INTESA with the addition of the generic words “invest(s)” and “bk” (an acronym for the word “bank”), both merely descriptive and even alluding of the banking services offered by the Complainant to its clients. Complainant also submits that the disputed domain names are also almost identical to the trademark “INTESA INVEST BEOGRAD”, as they share the most distinctive portion.

Complainant further states that the Respondent has no rights in the disputed domain names. Complainant asserts that Respondent has nothing to do with Intesa Sanpaolo and that any use of the trademarks “INTESA” and “INTESA INVEST BEOGRAD” has to be authorized by the Complainant. Complainant states that it has not authorized or licensed Respondent to use the domain names at issue. Complainant also asserts that the domain names do not correspond to the name of the Respondent and, to the best of our knowledge, Respondent is not commonly known as “INTESAINVESTBK” or “INTESAINVESTSBK”. Complainant also argues that the contested domain names are not used for any bone fide offerings. Finally, Complainant also submits it has not found any fair or non-commercial uses of the domain names at stake.

Complainant also states that the disputed domain names were registered and are used in bad faith. In this regard, Complainant underlines that Complainant’s trademark is distinctive and well known all around the world. It argues that the fact that Respondent has registered two domain names that are confusingly similar to Complainant’s trademark indicates that the Respondent had knowledge of Complainant’s trademark at the time of registration of the disputed domain names. In addition, Complainant argues that if Respondent had carried out a basic Google search in respect of the terms “INTESA INVEST”, the same would have yielded obvious references to the Complainant. Complainant submits that this raises a clear inference of knowledge of Complainant’s trademark on the part of the Respondent. Therefore, it is more than likely that the domain names at issue would not have been registered if it were not for Complainant’s trademark.

Complainant submits that the present circumstances of this case indicate that Respondent has registered or acquired the

disputed domain names primarily for the purpose of selling, renting, or otherwise transferring the domain name registrations to the Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain names (par. 4(b)(i) of the Policy).

Complainant submits that the disputed domain names are not used for any bone fide offerings, even if they are not connected to any website, and that many UDRP decisions have acknowledged that the passive holding of a domain name with knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use (citing Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, and the "WIPO Overview of WIPO Views on Selected UDRP Questions" at paragraph 3.3.). Complainant underlines that 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 domain names that would not amount to an infringement of the complainant's trademark rights. In this regard, Complainant holds that its trademark is renowned and that it is objectively not possible to understand what kind of use the Respondent could make with domain names that exactly correspond to the Complainant's trademarks and that results so similar to the Complainant's domain names currently used to provide online banking services for its clients.

Complainant therefore argues that the passive holding of the disputed domain names has to be considered a use in bad faith: «The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests» (WIPO Case No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., concerning a bank).

Complainant is of the view that given the nature of the disputed domain names, there is a risk that Respondent registered them with the intention of using them for "phishing" purposes, in order to induce and divert the Complainant's legitimate customers to its website and steal their money. It also argues that even excluding any "phishing" purposes or other illicit use of the disputed domain names, there is no other possible legitimate use of the disputed domain names. Complainant submits that Respondent's primary intention is to resell the disputed domain names to Complainant, which constitutes evidence of registration and use in bad faith, according to paragraph 4(b)(i) of the Policy.

Finally, Complainant highlights that on April 24, 2018, Complainant's representatives sent to the Respondent a cease and desist letter asking for the voluntary transfer of the disputed domain names. Respondent never replied.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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

Complainant has, to the satisfaction of the Panel, shown that Respondent does not have rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

Complainant has, to the satisfaction of the Panel, shown that the disputed domain names have been registered and are 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 the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the disputed domain names are confusingly similar to Complainant's trademark. Complainant's INTESA trademark is clearly recognizable in the disputed domain names. The addition of the generic term "invest(s)" and the letters "bk" (which presumably refer to "bank") do not prevent a finding of confusing similarity with Complainant's trademark. On the contrary, the addition of these terms increases the confusing similarity with Complainant's trademark as they refer to services provided by Complainant. The top-level domain ".com" is generally disregarded under the identity or confusing similarity test, as it is a functional element.

Complainant has therefore satisfied paragraph 4(a)(i) of the Policy.

The Panel also finds that Respondent does not have rights to or legitimate interest in the disputed domain names. Complainant has asserted that Respondent is not affiliated to Complainant nor he has been authorized by Complainant to use Complainant's trademark, in the disputed domain names or otherwise. There is no evidence that Respondent is commonly known by the disputed domain names or a name corresponding to the disputed domain names, in accordance with paragraph 4(c)(ii) of the Policy.

Respondent's passive holding of the disputed domain names cannot be considered neither a bona fide offering of goods or services or a legitimate, noncommercial or fair use of the disputed domain names, in accordance with paragraph 4(c)(i) and 4(c)(ii) of the Policy. In this regard, the Panel is of the view that given Complainant's goodwill and renown in relation to banking and the nature of the disputed domain names, it is not possible to conceive a plausible circumstance in which Respondent could legitimately use the disputed domain names, as such use would invariably result in misleading diversion and taking unfair advantage of Complainant's rights.

Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

The Panel finds that Respondent registered and used the disputed domain names in bad faith. As far as bad faith registration is concerned, Complainant's trademarks predate the registration date of the disputed domain names and are known around the world, including in the United Kingdom, where Respondent is based. Furthermore, the nature of the disputed domain names, which incorporate Complainant's trademark in conjunction with terms that refer to Complainant's activities, strongly suggest that Respondent had awareness of Complainant's rights at the time of registration of the disputed domain names. The Panel finds that, on balance of probabilities, Respondent registered the disputed domain names with Complainant's rights in mind and that he did so with the intention of taking advantage of such rights.

The Panel also finds that Respondent's passive holding of the disputed domain names constitutes in the circumstances of this case use in bad faith. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. In this regard, the Panel has taken into account the strength of Complainant's trademark in connection with banking and related services, the nature of the disputed domain names which also refer to Complainant's activities and the fact that Respondent failed not only to respond Complainant's cease and desist letter but also to take part in these proceedings.

Complainant has therefore 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. **INTESAINVESTBK.COM**: Transferred
2. **INTESAINVESTSBK.COM**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2018-10-23

Publish the Decision