Decision for dispute CAC-UDRP-102232

Case number	CAC-UDRP-102232
Time of filing	2018-11-28 09:59:48
Domain names	intesabancasapaolo.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	Milen Radumilo

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it is the owner of certain trademark registrations that consist of or contain the mark INTESA SANPAOLO (the "INTESA SANPAOLO Trademark"), including Int'l Reg. No. 920,896 for the mark INTESA SANPAOLO (registered March 7, 2007) and EU Reg. No. 5,301,999 for the mark INTESA SANPAOLO (registered September 8, 2006).

FACTUAL BACKGROUND

Complainant states that it is "the leading Italian banking group and also one of the protagonists in the European financial arena"; that it is "among the top banking groups in the euro zone, with a market capitalisation exceeding 34,2 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management)"; that it has "a network of approximately 4,400 branches" serving "approximately 11,9 million customers… 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 disputed domain name was created on September 22, 2018, and is being used in connection with a website that offers

links to services competitive with Complainant.

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i) of the Policy: Complainant states that the disputed domain name is confusingly similar to the INTESA SANPAOLO Trademark because, inter alia, the domain name "exactly reproduces the wording 'INTESA SANPAOLO', with the deletion of letter 'n' in the verbal portion 'Sanpaolo' and the addition of the word 'banca' (the Italian for 'bank') between the verbal portions 'Intesa' and 'Sanpaolo'"; and "[c]onsidering the banking and financial context in which the Complainant operates, it is undeniable that INTESABANCASAPAOLO.COM will result even more confusingly similar to the business carried out under the trademark 'INTESA SANPAOLO', as it will be interpreted by internet users as a reference to the safety of Complainant's internet banking."

Paragraph 4(a)(ii) of the Policy: Complainant states that Respondent has no rights or legitimate interests in respect of the disputed domain name because, inter alia, "PERFECT PRIVACY, LLC has nothing to do with Intesa Sanpaolo"; "any use of the trademark 'INTESA SANPAOLO' has to be authorized by the Complainant"; "[n]obody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue"; "[t]he domain name at stake does not correspond to the name of the Respondent and, to the best of [Complainant's] knowledge, PERFECT PRIVACY, LLC is definitely not commonly known as 'INTESABANCASAPAOLO'"; and Complainant "do[es] not find any fair or non-commercial uses of the domain name at stake."

Paragraph 4(a)(iii) of the Policy: Complainant states that the disputed domain name was registered and is being used in bad faith because, inter alia, the INTESA SANPAOLO Trademark "is distinctive and well known all around the world"; "the domain name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used"; and Respondent did not respond to a demand letter sent by Complainant on October 17, 2018.

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

Identical or Confusingly Similar

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the INTESA SANPAOLO Trademark.

As to whether the disputed domain name is identical or confusingly similar to the INTESA SANPAOLO Trademark, the relevant comparison to be made is with the second-level portion of the disputed domain name only (i.e., "intesabancasapaolo") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview of WIPO Overview 3.0, section 1.11.1".

Here, the disputed domain name contains the INTESA SANPAOLO Trademark (absent a single letter "n") with the addition of the word "banca". As set forth in section 1.7 of WIPO Overview 3.0, "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing." Further, section 1.8 of WIPO Overview 3.0 states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Rights or Legitimate Interests

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "PERFECT PRIVACY, LLC has nothing to do with Intesa Sanpaolo"; "any use of the trademark 'INTESA SANPAOLO' has to be authorized by the Complainant"; "[n]obody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue"; "[t]he domain name at stake does not correspond to the name of the Respondent and, to the best of [Complainant's] knowledge, PERFECT PRIVACY, LLC is definitely not commonly known as 'INTESABANCASAPAOLO'"; and Complainant "do[es] not find any fair or non-commercial uses of the domain name at stake."

WIPO Overview 3.0, section 2.1, states: "While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

Registered and Used in Bad Faith

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the Policy: (i) circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily 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 that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

Complainant does not specify which, if any, of the enumerated factors is applicable here. However, numerous panels under the UDRP have found the registration and use of a domain name that is confusingly similar to a complainant's trademark to constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy where, as here, the domain name is associated with monetized parking pages that could be construed as associated with the complainant. See, e.g., Wal-Mart Stores, Inc. v. Whois Privacy, Inc., WIPO Case No. D2005 0850; Columbia Pictures Industries, Inc. v. North West Enterprise, Inc., WIPO Case No. D2006-0951; and Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. Private Whois Service, WIPO Case No. D2011-1753.

Further, Respondent's failure to respond to Complainant's demand letter is additional evidence of bad faith. Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party, WIPO Case No. D2000-0330; and RRI Financial, Inc., v. Ray Chen, WIPO Case No. D2001-1242.

Accordingly, the Panel finds that Complainant has proven the third and final element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESABANCASAPAOLO.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2019-01-02

Publish the Decision