Decision for dispute CAC-UDRP-102260

Case number	CAC-UDRP-102260
Time of filing	2018-12-18 09:10:59
Domain names	INTESASANPAOLO.DIGITAL, INTESASANPAOLO.LINK

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	anna somma

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following registrations for the trademark INTESA SANPAOLO:

- International trademark registration n. 920896 INTESA SANPAOLO, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42;

- EU trademark registration n. 5301999 INTESA SANPAOLO, applied on September 8, 2006, granted on June 18 and duly renewed, 2007, in classes 35, 36 and 38;

- EU trademark registration n. 5421177 INTESA SANPAOLO & device, applied on October 27, 2006, granted on November 5, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

The disputed domain names <INTESASANPAOLO.DIGITAL> and <INTESASANPAOLO.LINK> were registered on October 28, 2018, in the name REDACTED FOR PRIVACY. Neither domain name resolves to an active website. Upon the Complaint being filed, the Registrar identified the Respondent as ANNA SOMMA.

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

The Complainant is the leading Italian banking group. The Complainant's trademark INTESA SANPAOLO is distinctive and well known all around the world. The Respondent must have been aware of the Complainant's mark when registering the disputed domain names.

Neither REDACTED FOR PRIVACY nor the underlying registrant (since identified as ANNA SOMMA) has anything to do with the Complainant. Any use of the trademark INTESA SANPAOLO has to be authorized by the Complainant; nobody has been authorized or licensed by the Complainant to use the domain names (which do not correspond to the name of the Respondent) and the Complainant was not able to find any fair or non-commercial uses of the disputed domain names. Accordingly, the Respondent has no rights or legitimate interests in respect of the disputed domain names, which were registered and are being used in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark 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 names (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 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 UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

A respondent is not obliged to participate in a proceeding under the Policy but if it fails to do so, asserted facts may be taken as true and reasonable inferences may be drawn from the information provided by the complainant: Reuters Limited v. Global Net 2000, Inc., WIPO Case No. D2000-0441.

Ignoring the gTLDs ".digital" and ".link", usually considered inconsequential for the purposes of paragraph 4(a)(i)of the Policy, the Panel finds that the disputed domain names <INTESASANPAOLO.DIGITAL> and <INTESASANPAOLO.LINK> are identical to the Complainant's INTESA SANPAOLO trademark . Those gTLDs are nevertheless relevant when considering paragraphs 4(a)(ii) and (iii) of the Policy, since they convey to Internet users an official connection with the Complainant.

The INTESA SANPAOLO mark is distinctive and widely known. The Complainant's assertions are sufficient to constitute a prima facie showing of absence of rights or legitimate interests in respect of the disputed domain names on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show that it does have rights or legitimate interests in the disputed domain names. See Cassava Enterprises Limited, Cassava Enterprises (Gibraltar) Limited v. Victor

Chandler International Limited, WIPO Case No. D2004-0753. The Respondent has made no attempt to do so.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The fact that the Respondent has registered two domain names that are not only identical to the Complainant's distinctive and well-known trademark but also have gTLDs which convey an official association with the Complainant establishes that the Respondent did so with knowledge of the Complainant's trademark. Further, the Complainant's mark is so well-known that there is no conceivable use that could be made of the disputed domain names that would not amount to infringement of the Complainant's trademark rights. The passive holding of a domain name under such circumstances is evidence of bad faith registration and use. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, and WIPO Jurisprudential Overview 3.0 at paragraph 3.3. The Panel finds that the disputed domain names were registered and are being used in bad faith.

Conclusions

The Panel hereby finds that all three elements under paragraph 4(a) of the Policy were met:

i. the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

ii. the Respondent has no rights or legitimate interests with respect to the disputed domain names; and

iii. the disputed domain names have been registered and are 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. **INTESASANPAOLO.DIGITAL**: Transferred
2. **INTESASANPAOLO.LINK**: Transferred

PANELLISTS

Name	**Alan Limbury**

DATE OF PANEL DECISION 2019-01-14

Publish the Decision