Decision for dispute CAC-UDRP-102263

Case number	CAC-UDRP-102263
Time of filing	2018-12-18 15:30:31
Domain names	4555553INTESASANPAOLO.INFO

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	Ida Ekkert

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant is the owner of a number of trademark registrations covering various jurisdictions including the following:

- 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, 2007 and duly renewed, 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;

- 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; and

- 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.

FACTUAL BACKGROUND

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

The Complainant is the leading Italian banking group and also one of the most prominent figures in the European financial arena. 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. Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 34,2 billion euro, and it is the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). With a network of approximately 4,400 branches capillary and well distributed throughout the Country, with market shares of more than 16% in most Italian regions, the Group offers its services to approximately 11,9 million customers. Intesa Sanpaolo also has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,5 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.

The disputed domain name is confusingly similar to the Complainant’s trademarks as it incorporates the entirety of the INTESA SANPAOLO name and merely adds a series of numbers plus the .info TLD. Although there is no website that resolves from the disputed domain name, the Respondent has no rights or legitimate interests in the disputed domain name as it is not authorized to use the Complainant’s trademark, it is not commonly known by the name, and it is not making a bona fide or fair use of the disputed domain name. Further, despite its lack of a resolving website, present circumstances indicate that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling it or for a phishing scheme.

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.

Furthermore, the Panel has been advised that the language of the registration agreement for the disputed domain name is Russian. However, the Complainant has submitted the Complaint and all of its annexes in the English language. The Complainant is an Italian company, while the Respondent is Russian. Consequently, the present Complaint was written in English, an international language comprehensible to a wide range of Internet users worldwide. The spirit of Paragraph 11 of

the Rules is to ensure fairness in the selection of language by giving full considerations to the parties' level of comfort with each language.

As the Respondent has failed to file a Response or any other manner of submission in this case and has also not objected to use of the English language for the pleadings, the Panel has decided to exercise its discretion under UDRP Rules 10 and 11(a) and hold that it is equitable and appropriate for the language of this decision to be English.

PRINCIPAL REASONS FOR THE DECISION

Trademark Rights and Identity or Confusing Similarity:

Sufficient evidence has been submitted by the Complainant of its trademark rights in the phrase INTESA SANPAOLO for various banking and other financial services. Further, the Complainant is the owner of multiple domain names that incorporate its trademark including <INTESASANPAOLO.COM> and <INTESA-SANPAOLO.COM>. All of the above were created and registered prior to the November 14, 2018 creation date of the disputed domain name. As such, the Panel finds that the Complainant possesses rights in its INTESA SANPAOLO trademark.

Next, UDRP panels have consistently held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011) („the mere addition of the words ‚Ninjago' and ‚Kai' is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant's trademark.").

In the present case, the disputed domain name consists of the INTESA SANPAOLO trademark preceded by the numbers „4555553". The use of these numbers does not, in this case, reduce the confusing similarity between the disputed domain name and the Complainant's trademark. Dell Inc. v. li de zhi c/o li de zhi / LiDezhi c/o Li dezhi, Claim No. FA 1790173 (FORUM, July 11, 2018) (confusing similarity found where „Two of the domain names in dispute merely tack seemingly random numbers on to the end of the DELL mark (i.e., dell024.com and dell138.com)...").

In light of the above, the Panel concludes that the Complainant possesses rights to the INTESA SANPAOLO trademark and that the disputed domain name is confusingly similar to such mark under Paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interest:

Paragraph 4(a)(ii) of the Policy directs an examination of the facts to determine whether a respondent has rights or legitimate interest in the disputed domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or interests.

The first example, under Paragraph 4(c)(i), is where "before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services". Here, the disputed domain name does not resolve to any website content as shown by the screenshot submitted into evidence by the Complainant. The lack of any website content or other use cannot, by definition, constitute a bona fide offering of goods or services and, thus, cannot support a claim of any rights or legitimate interests in a domain name. Guess IP Holder L.P. and Guess, Inc. v. xi long chen, FA 1786533 (FORUM June 15, 2018) ("The disputed domain name resolves to a parked [inactive] page with the message, ‚website coming soon!' The Panel finds that this use does not amount to a bona fide offering or good or services or a legitimate noncommercial or fair use per paragraph 4(c)(i) & (iii) of the Policy and Respondent does not have rights or legitimate interests with respect of the domain name.") This Panel finds that there is no evidence of record to indicate that the Respondent is using the disputed domain name in connection with the making of a bona fide offering of goods or services.

The second example, under Paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant has made an unrebutted prima facie case showing that the name used by the Respondent in the Whois record

for the disputed domain name is Ida Ekkert. This name does not bear any similarity to the words INTESA SANPAOLO or to the numerical characters used in the disputed domain name. There is no other evidence in the record to suggest that the Respondent is commonly known by the disputed domain name or that it has acquired any trademark rights relevant thereto. As such, this sub-section of the Policy is of no help to the Respondent.

As to the third example, under Paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the INTESA SANPAOLO trademark. Although the dispute domain name does not resolve to any website content, this does not rebut the assertion that its use is not fair as it does not fit in to any accepted category of fair use such as news reporting, commentary, political speech, education, nominative or generic use, etc.

In light of the above analysis, this Panel finds that the facts of this case do not demonstrate that the Respondent has any rights or legitimate interest in any of the disputed domain name under Paragraph 4(a)(ii) of the Policy.

Bad Faith:

Finally, the Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. Hallmark Licensing, LLC v. EWebMall, Inc., Case No. D2015-2202 (WIPO, February 12, 2016) ("The standard of proof under the Policy is often expressed as the ‚balance of the probabilities' or ‚preponderance of the evidence' standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.").

The Complainant first asserts that the Respondent was on actual notice of the INTESA SANPAOLO trademark at the time it registered the disputed domain name. The evidence in this case demonstrates that this trademark has been used extensively around the world and has become well-known prior to the date on which the disputed domain name was created. The trademark is also rather distinctive and, with no explanation or submission from the Respondent, this Panel concludes that it is more likely than not that the phrase INTESA SANPAOLO would be used in the disputed domain name with knowledge of the Complainant's trademark rights.

Next, the Complaint claims that „there are present circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant..." It further notes that the Complainant has been a target of phishing schemes in the past and goes on to say that „in the present case, the Complainant believes that the current owner registered the disputed domain name with the ‚phishing' purpose, in order to induce and divert the Complainant's legitimate customers to its website and steal their money and the above could be easily verified given the particular nature of the disputed domain name (Complainant's trademark + descriptive terms alluding of the online banking services offered by the Complainant itself)." However, the Complainant submits no evidence to support its assertions of phishing or an offer to sell the disputed domain name. Although, under Rules, par. 14(b), the Panel is entitled to accept assertions of fact as it considers appropriate, particularly in light of the Respondent's default, this Panel finds the claims of phishing and domain sale to be mere conclusory allegations that are not supported by any evidence. As such, the Panel will not consider them in this case.

However, the evidence submitted in this case does support the fact that the disputed domain name does not resolve to any website content and there is no evidence in the record to indicate that the disputed domain name has been used for any purpose at all. It is well accepted that the scenarios of paragraph 4(b) of the Policy are not exclusive and so Panels are free to consider other circumstances that may give rise to a finding of bad faith registraion and use. Beginning with the decision in Telstra Corporation Limited v. Nuclear Marshmallows, Case No. D2000-0003 (WIPO, February 18, 2000), many UDRP panels have held that, after considering all the circumstances of a given case, it is possible that a "[r]espondent's passive holding amounts to bad faith." The Telstra decision states that "paragraph 4(b) recognizes that inaction (e.g., passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith.... [I]n considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the Administrative Panel must give close attention to all the circumstances of the Respondent's behaviour.") See also, Autoshop 2 Di Battaglia Ferruccio C. S.N.C. v. Willamette RF Inc., WIPO Case No. D2004-

0250 (collecting cases citing Telstra); and Chartered Professional Accountants of Canada v. Zakaria Frouni, FA 1795339 (FORUM August 6, 2018) ("Respondent is simply passively holding the disputed domain name. Respondent's inactive use of the disputed domain name constitutes bad faith registration and use under paragraph 4(a)(iii) of the Policy.") In view of the evidence presented in this case, including the facts that the disputed domain name copies the Complainant's distinctive and well-known trademark and the non-use of the disputed domain name for over three months, the circumstances support the conclusion that Respondent registered and uses the non-resolving disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

In light of the above analysis, this Panel finds that the Respondent has registered and used the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **4555553INTESASANPAOLO.INFO**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2019-01-24

Publish the Decision