Decision for dispute CAC-UDRP-102317

Case number	CAC-UDRP-102317
Time of filing	2019-01-29 08:29:36
Domain names	SHOPPINGEVINCIBANCA5.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Nanci Nette

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant is the owner of “BANCA 5” trademark registrations including “BANCA 5 & device” and “BANCA 5 LA BANCA A PORTATA DI MANO Gruppo Intesa Sanpaolo & device” in several jurisdictions, including but not limited to the following:
- European Union trademark registration n. 12669461 for “BANCA 5“, filed on March 6, 2014 and granted on July 30, 2014;
- European Union trademark registration n. 16411671 “BANCA 5 & device”, filed on February 28, 2017 and granted on July 13, 2017;
- European Union trademark registration n. 16203218 “BANCA 5 LA BANCA A PORTATA DI MANO Gruppo Intesa Sanpaolo & device”, filed on December 23, 2016 and granted on May 5, 2017;
- Italian trademark registration n. 1616792 “BANCA 5”, filed on March 31, 2014 and granted on December 18, 2014

FACTUAL BACKGROUND

The Complainant, Intesa Sanpaolo S.p.A., is the leading Italian banking group. Complainant is among the top banking group in the Eurozone, with a market capitalization exceeding 34 billion euro. The Complainant has a network of approximately 4,400 branches throughout Italy, with market shares of more than 16% in most Italian regions. The Complainant offers its services to approximately 11.9 million customers in Italy. The Complainant also has a strong presence in Central-Eastern

Europe with a network of approximately 1,100 branches and over 7.5 million customers. Moreover, the Complainant has also expanded internationally with a network specialized in supporting corporate customers and is now 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.

Complainant owns – among others – Banca 5 S.p.A., an Italian company which offers banking and financial services to retailers goods, through the brand "BANCA 5".

The disputed domain name was registered on July 3, 2017, and presently resolves to an active website with a directory of website links.

PARTIES CONTENTIONS

The Respondent did not file a Response.

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. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner.

The Complainant has provided evidence of its trademarks' registrations of the BANCA 5 mark in the EU and Italy.
A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The disputed domain name <SHOPPINGEVINCIBANCA5.COM> integrates the Complainant's BANCA 5 trademark in its entirety (see Wal-Mart Stores, Inc. v. Kuchora, Kal, WIPO Case No. D2006-0033; Hoffmann-La Roche Inc. v. Andrew Miller, WIPO Case No. D2008-1345). The generic term "SHOPPINGEVINCI" does not serve to distinguish the disputed domain name from the Complainant's trademark. The Complainant has also provided evidence that "SHOPPINGEVINCI" is a slogan in the Italian language that stands for "shopping and win". The disputed domain name thus means "shopping and win Banca 5," which the evidence shows was a promotional slogan used by the Complainant years ago for a prize contest offered online.

The Panel, therefore, finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to show that the Respondent has no rights or interests in respect of the domain name.

Once the Complainant establishes a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the Respondent to show that it has rights or legitimate interests in respect to the disputed domain name (see WIPO Overview 3.0, paragraph 2.1).
In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant has provided evidence that the Complainant has rights in the BANCA 5 trademark and has been using the same for the trademark extensively. The Complainant has shown that the Respondent, is known by the name Nanci Nette and is not commonly known by the disputed domain name, nor has Complainant authorized or licensed the Respondent to use the BANCA 5 mark in any manner. See M. Shanken Commc'ns v. WORLDTRAVELERSONLINE.COM, FA 740335 (Nat. Arb. Forum Aug. 3, 2006) (finding that the respondent was not commonly known by the <cigaraficionada.com> domain name under Policy 4(c)(ii) based on the WHOIS information and other evidence in the record). The Complainant also had not authorized or licensed Respondent to use its trademark in any way.

The Respondent has not submitted a response and did not provide any evidence to show any rights or legitimate interests in the disputed domain name to rebut the Complainant's prima facie case.

The Respondent use of the disputed domain name to host a parked page comprising PPC links does not represent a bona fide offering of goods since the links selected by the Respondent appears to capitalize on the reputation and goodwill of the Complainant's mark.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the Complainant to show that its domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.
The Complainant has submitted evidence that the Respondent registered the disputed domain name long after the Complainant registered its trademarks. The Complainant's evidence has shown that it owned the trademark since 2014 whereas the disputed domain name was registered in 2017. Under these circumstances, the Complainant's prior registered trademark is suggestive of the Respondent's bad faith (see Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735).
The Complainant provided evidence showing that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 Respondent's website or location or of a product or service on the Respondent's website or location. Complainant has provided evidence that the Complainant's trademark is being used to host a parked page comprising PPC links. At first glance these links are mostly related to shopping malls, stores, and other non-banking activities. Without the Respondent's response, it is difficult to assess if the use of such PPC links was generated automatically given the disputed domain name is of the slogan "shopping to win" in the Italian language or that the links were selected to capitalize on the goodwill that the Complainant has in its mark. Admittedly, the links, which relate to various retail options may lead customers of the Complainant' who are from the retail sector to be confused as to the sponsorship, affiliation or endorsement of the Respondent's website. As such, and without the Respondent's position on the matter, the Panel finds that the balance weighs towards the Complainant and the Panel is willing to make a finding that the

evidence shows that the Respondent was aware of the Complainant and its trademark and has registered and is using the disputed domain name in bad faith. (See Encyclopaedia Britannica Inc. v. Shedon.com, WIPO Case No. D2000-0753; Edmunds.com v. Ultimate Search, Inc., WIPO Case No. D2001-1319; and Netwizards, Inc. v. Spectrum Enterprises, WIPO Case No. D2000-1768). The Panel's position is strengthened by the fact that the mark BANCA 5, and the slogan "shopping e vinci BANCA 5" especially in the Italian language, appears to be distinctive of the Complainant, and it is difficult to find what good faith use the Respondent can have of the disputed domain name.

Further, the addition of the term "SHOPPINGEVINCI" to the disputed domain name is within the Complainant's field of commerce or indicating services related to the BANCA 5 mark which likely triggers an inference of affiliation with the Complainant and does not constitute fair use of the disputed domain name. (See WIPO Overview 3.0, section 2.5.1.; Costco Wholesale Corporation and Costco Wholesale Membership, Inc. v. Kenneth Terrill (WIPO Case No. D2010-2124)). To this end, the Complainant has provided evidence that the said term was used as a promotional slogan for an online prize competition several years earlier, which also strongly suggests that Respondent is well aware of the Complainant's mark and registered the disputed domain name in bad faith and with clear knowledge of the Complainant and its mark in order to capitalize on the same.

Based on the evidence presented to the Panel, including the registration of the disputed domain name long after the registration of the Complainant's marks, the confusing similarity between the disputed domain name and the Complainant's marks, the Respondent's use of the disputed domain name, the Respondent's failure to present any credible rationale for registering the disputed domain name, and the fact that under the circumstances of this particular case there is no plausible good faith use the Respondent can put the disputed domain name to, the Panel finds that the disputed domain name was registered and is 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. **SHOPPINGEVINCIBANCA5.COM**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2019-03-09

Publish the Decision