Decision for dispute CAC-UDRP-102374

Case number	CAC-UDRP-102374
Time of filing	2019-03-07 11:28:28
Domain names	INTESASANPAOLOBLOCKCHAIN.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	Pankaj Tanwar

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

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, covering also Australia, China, United States of America, Japan, Russian Federation;

- EU trademark registration n. 5301999 “INTESA SANPAOLOargument 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 & deviceargues applied on October 27, 2006, granted on November 5, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42.

Moreover, the Complainant is also the owner of the following domain names bearing the sign “INTESA SANPAOLO”: “INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ” and INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ”. All of them are now connected to the official website <www.intesasanpaolo.com>.

FACTUAL BACKGROUND

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The Complainant is the leading Italian banking group and also one of the protagonists in the European financial arena. The Complainant 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 eurozone, with a market capitalization exceeding 34,9 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,200 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. Complainant has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,5 million customers. Moreover, the international network specialized 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.

On December 21, 2018, the Respondent registered the disputed domain name.

The Respondent send a Response on March 30, 2019.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant states that it is more than obvious that the disputed domain name at issue is almost identical to the Complainant's trademark, as it exactly reproduces the wording "INTESA SANPAOLO", with the mere addition of the word "Blockchain", which – according to the dictionary – "is a type of decentralized database system based on linking together previous records in secure blocks of information".

Considering the banking and financial context in which the Complainant operates, it is undeniable that <INTESASANPAOLOBLOCKCHAIN.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.

The Complainant states furthermore that the Respondent has no rights in the disputed domain name since WhoisGuard, Inc. has nothing to do with Intesa Sanpaolo. In fact, any use of the trademark "INTESA SANPAOLO" has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue.

The disputed domain name does not correspond to the name of the Respondent and, to the best of Complainant knowledge, WhoisGuard, Inc. is definitely not commonly known as "INTESASANPAOLOBLOCKCHAIN".

Lastly, Complainant does not find any fair or non-commercial uses of the disputed domain name.

The disputed domain name was in the view of Complainant registered in bad faith and is also being used in bad faith.

The Complainant's trademark "INTESA SANPAOLO" is in in the view of Complainant distinctive and well-known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to it indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wording "INTESA SANPAOLO", the same would have yielded obvious references to the Complainant. The Complainant submits, an extract of a Google search in support of its allegation.

In addition, the disputed domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website (par. 4(b)(iv) of the Policy).

The disputed domain name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant’s trademarks are registered and used.

The current use of the disputed domain name, which allows accessing to the web sites of the Complainant’s competitors, also through the Complainant’s trademark, causes, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones.

The Respondent’s commercial gain is evident in the view of Complainant since it is obvious that the Respondent’s sponsoring activity is being remunerated.

It shall be underlined in the view of Complainant that on January 23, 2019 the Complainant’s representatives sent to the Respondent a C&D letter, requesting the voluntary transfer of the disputed domain name at issue. The Respondent never complied with the Complainant’s requests.

RESPONDENT:

The Respondent filed the following Response:

"Hello,
It is my pleasure to hear from you !
With due respect, what complainant is saying is not true. I have no intention to damage credibility and violation of trademark and i was not aware of any bank like this in Italy as i am from India and i can see there is a huge difference between INTESA SANPAOLO & INTESASANPAOLOBLOCKCHAIN as complaint is working in banking & Financial industry and i am working in Blockchain industry. I have registered this domain because i am working in blockchain industry and planning to make a dynamic blockchain website which will help me & my community to be aware about blockchain and my website is underdevelopment. I have spent lot of efforts and money for developing this website which is underdevelopment.
Complainant telling that website can confuse users of his clients and damage the business which is not true as my website is under development and the website is parked for free temporarily by the domain registrar. You may check yourself. I am not getting any financial benefits from free parked domain and below the website it is clearly mentioned that this ads are from third party and the owner of this domain has not relation with above ads as i am not getting paid for the free parked domain by Namecheap .
There is no relation between INTESA SANPAOLO & INTESASANPAOLOBLOCKCHAIN , as my domain name is in single word, if it is like this then no one will be able to use any name in this world.
Rest i have put lots of effort in it, And as a middle class person from India i did not do it intentionally, i do not have money to fight with such big companies, whatever you will decide, with respect I will accept and i wish you understand my situation too.
Thank You,
Pankaj Tanwar"

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

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.

From the evidence provided, and not contested by the Respondent, the Complainant owns a number of trademark registrations for the mark "INTESA SANPAOLO".

The disputed domain name reproduces the Complainant’s registered Trademark INTESA SANPAOLA in its entirety and adds the generic term “Blockchain" at the end of the disputed domain name and the gTLD suffix “.com".

Many UDRP panels have found that a domain name is confusingly similar to a complainant’s trademark where the domain name incorporates the complainant’s trademark in its entirety (e.g.Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack, WIPO Case No. D2015-0070; Chloé S.A.S. v. DVLPMNT Marketing, Inc., WIPO Case No. 2014-0039). The Panel shares this view in the case at issue where the Complainant’s registered very long trademark INTESA SANPOALO is fully included in the disputed domain name and combined with the addition of the generic term "Blockchain", and the gTLD suffix “.com”.

The Panel agrees with the Complainant that the addition of the generic term "blockchain" without space or hyphen at the end of the disputed domain name and the gTLD “.com” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademark and does not change the overall impression of the designation as being connected to the trademark INTESA SANPOALO, as the trademark INTESA SANPOALO at the more important beginning of the disputed domain name is the only distinctive part of the disputed domain name.

Moreover, as the word “Blockchain” refers to a type of decentralized database system based on linking together previous records in secure blocks of information, which can be used in the banking sector and is, therefore, a term closely connected to the Complainant’s business, it therefore exaggerates the impression that Respondent is somehow affiliated with Complainant.

The Respondent argues that there is no relation between INTESA SANPAOLO & INTESASANPAOLOBLOCKCHAIN, as the disputed domain name is only a single word, is not convincing in the view of the Panel, especially considering the length of the trademark and the identical part of the disputed domain name.

Accordingly, the Panel finds for the Complainant under paragraph 4(a)(i) of the Policy.

Next, the Panel finds, that the Respondent lacks rights or legitimate interest in the disputed domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the domain name, the burden shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name.

The Complainant has stated that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant also stated that it has not licensed nor allowed the Respondent to use the disputed domain name or its Trademarks.

The Panel finds that the Complainant has established a prima facie case in this regard, inter alia, due to the fact that the Complainant has not licensed or otherwise permitted the Respondent to use the "INTESA SANPAOLO" trademark, or a variation thereof.

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

The Respondent states in his Response, that he has registered the disputed domain name because he is working in the blockchain industry and is planning to make a dynamic blockchain website which will help him & his community to be aware about blockchain. The Respondent does not explain at all why he registered the disputed domain name including the long trademark of Complainant for this

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Panel finds for the Complainant under paragraph 4(a)(ii) of the Policy.

The Panel believes furthermore that Respondent registered the disputed domain name with knowledge of Complainant's rights. The disputed domain name was registered more than ten years after the registration of the trademarks and the domain names of the Complainant and Complainant used it widely since then.

Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. Respondent states that he is from India and does not know the INTESA SANPAOLO trademark, but if the Respondent had carried even a basic Google search in respect of the wording "INTESA SANPAOLO", the same would have yielded obvious references to the Complainant.

Besides, the evidence on record shows that the disputed domain name redirects to a parking page with commercial links. Respondent's use of the disputed domain name for a parking page is in itself sufficient to support a finding of bad faith use as Respondent is intentionally attempting to attract Internet users to its website for commercial gain, and is thus creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's website, in accordance with paragraph 4(b)(iv) of the Policy.

Lastly, Respondent did not respond to the cease and desist letter sent on January 23, 2019, requesting the voluntary transfer of the disputed domain name.

On these grounds, the Panel concludes that the Respondent has registered and is using 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. **INTESASANPAOLOBLOCKCHAIN.COM**: Transferred

PANELLISTS

Name	**Jan Christian Schnedler, LL.M.**

DATE OF PANEL DECISION 2019-04-16

Publish the Decision