Decision for dispute CAC-UDRP-102396

Case number	CAC-UDRP-102396
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Domain names	onlineintesasanpaolo.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Abayomi Ajileye

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is owner of a large intellectual property rights portfolio, comprising among the others:

TRADEMARKS

- International trademark registration no. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42, based on the Italian TM no. 1042140, covering also Australia, China, United States of America, Japan, Russian Federation and many others;

- EU trademark registration no. 005301999 “INTESA SANPAOLO”, filed on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38;

- EU trademark registration no. 005421177 “INTESA SANPAOLO & device”, filed on October 27, 2006, granted on November 5, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42.

DOMAIN NAMES

INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ and INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ.

All such domain names are resolving to INTESASANPAOLO.COM used as main domain name and website of the Complainant.

COMPANY NAME / TRADE NAME

The Complainant is carrying on business and providing its services under the company name INTESA SANPAOLO S.P.A., a financial institution resulting from the merger of two banks Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. effective as of January 01, 2007. INTESA SANPAOLO has become a distinctive identifier used in trade which consumers associate with the Complainant’s services.

The above-mentioned trademarks, domain names and company name are hereinafter collectively referred to as the INTESA SANPAOLO Trademark.

The Complainant has proved its rights in the INTESA SANPAOLO Trademark for the purposes of the Policy.

FACTUAL BACKGROUND

The Complainant, Intesa Sanpaolo S.p.A., is a leading Italian banking group and one of the top players of the European financial arena, born from the merger of Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. effective as of January 1, 2007.

The Complainant is among the largest financial institutions in the Euro zone with a market capitalisation exceeding 34,9 billion euro and is the undisputed leader in all business areas (retail, corporate and wealth management) in Italy. Thanks to a network of approximately 4,200 branches capillary and well distributed throughout Italy with market shares of more than 16 % in most Italian regions, the Complainant offers its services to approximately 11,9 million customers. The Complainant has also 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 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 Complainant owns several trademarks and domain names, all of them characterized by the presence of the distinctive and well-known wording "INTESA SANPAOLO".

The disputed domain name was registered on January 12, 2019, hence well after the registration of the INTESA SANPAOLO Trademark, by an individual identified as Abayomi Ajileye, located in Nigeria.

The disputed domain name resolves to a parking page containing PPC links to third parties' sites which relate to products and services competing with the Complainant's products and services.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT'S CONTENTIONS

On the first UDRP element the Complainant affirms 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 "online". Furthermore, considering the banking and financial context in which the Complainant operates, it is undeniable that the disputed domain name 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 Complainant's internet banking.

On the second UDRP element the Complainant contends that the Respondent, an individual identified as Abayomi Ajileye, has nothing to do with the Complainant, nor has been authorized or licensed to use the INTESA SANPAOLO Trademark or to register or use the disputed domain name. The disputed domain name does not correspond to the Respondent's name, nor is this latter commonly known by the disputed domain name. Since the disputed domain name is parked, there is no fair or non-commercial use of the disputed domain name.

On the third UDRP element the Complainant contends that, considering the distinctiveness and reputation of the INTESA SANPAOLO Trademark, it is unlikely that the Respondent had no knowledge of the Complainant's mark at the time of the registration of the disputed domain name. The Complainant has submitted an extract of a search carried out by the same on the well-known search engine Google with the keywords "INTESA SANPAOLO" and alleges that had the Respondent performed a basic search on Google, he should have yielded obvious references to the Complainant. Hence, according to the Complainant, it is most likely that the Respondent registered and has used the disputed domain name having in mind the Complainant and the INTESA SANPAOLO Trademark and with the clear intention to take advantage of the reputation of the same by creating a likelihood of confusion between such mark and the disputed domain name. The Complainant also contends that the use of the disputed domain name which resolves to a parking page containing links that redirect to websites related to products and services competing with the Complainant's products and services is not to be considered a good faith use under the Policy and the UDRP case law.

RESPONDENT'S 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

REQUIREMENTS OF PARAGRAPH 4(A) OF THE POLICY

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements to obtain the transfer or the revocation of the domain name:

(1) the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
(3) the disputed domain name has been registered and is being used in bad faith.

1. THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has provided sufficient documentary evidences to demonstrate to be owner of the INTESA SANPAOLO Trademark since 2006.

In assessing identity or confusing similarity the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, because it incorporates the entirety of the Complainant's INTESA SANPAOLO Trademark and differs from such mark by merely adding the generic and descriptive term "ONLINE" and the top-level domain name ".COM".

In UDRP cases where the relevant trademark is recognizable within the disputed domain name, Panels agree that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element (see paragraph 1.7 WIPO Overview 3.0).

UDRP panels also agree that the top-level domain is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant's trademark as it is a technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

2. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent (see paragraph 2.1 of the WIPO Overview 3.0: "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 Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain name, nor is affiliated to the Complainant in any form.

The disputed domain name was registered on January 12, 2019 by Abayomi Ajileye, located in Nigeria. There is no evidence that the Respondent has been commonly known by the disputed domain name.

Moreover, the disputed domain name resolves to a parking page containing PPC links to third parties' sites which relate to products or services competing with the Complainant's products or services. Such uses of the domain name are clearly not a legitimate non-commercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's mark.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy

and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

3. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Respondent registered the disputed domain name which is to be considered confusingly similar to Complainant's mark, since it wholly incorporates the INTESA SANPAOLO Trademark. The addition of the generic and descriptive term “ONLINE” and the TLD “.COM” (technical requirement of the registration) are not sufficient elements to escape the finding of confusing similarity between the disputed domain name and the Complainant’s mark.

Considering that the Complainant provides banking and financial services online as well, the Respondent's choice to add the generic and descriptive term "ONLINE" to the trademark of the Complainant shows his clear intention to enhance such likeliness of confusion for the Internet users who are seeking or expecting the Complainant.

Given the distinctiveness and reputation of the Complainant's prior mark (the Complainant has demonstrated that the INTESA SANPAOLO Trademark is frequently subject of cybersquatting), it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant's rights in such well-known mark and the intention to exploit such reputation by diverting traffic away from the Complainant’s website.

Even assuming that the Respondent had no knowledge of the Complainant’s prior mark at the time of registration of the disputed domain name (which is quite unlikely), it omitted to verify that the disputed domain name would have infringed the Complainant's earlier rights or, even worse, it verified it and deliberately proceeded with the infringing registration and use.

The Complainant has submitted the results of a search carried out on Google search engine regarding the term “INTESA SANPAOLO”, all of them related to the Complainant. Should the Respondent have performed a similar search on the Internet before registering the disputed domain name, he would have easily learnt about the Complainant’s activities and trademark registered and used worldwide.

This Panel highlights that, according to paragraph 2 of the Policy, it is the Respondent’s responsibility to determine whether the domain name registration infringes or violates third party's rights (“By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights”). By registering the disputed domain name confusingly similar with the Complainant’s well-known mark, the Respondent has violated, inter alia, the cited provision of the Policy.

The disputed domain name resolves to a parking page. While the sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) does not in and of itself constitute bad faith, in the present case, considering that the website associated to the disputed domain name contains PPC links related to products and services competing with the products and services of the Complainant, the Panel finds that, by registering and 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 or a product or service on his website (Paragraph 4(b)(iv) of the Policy).

The Respondent has submitted a Response in this administrative proceeding providing any evidence of actual or contemplated good faith use.

Taken into account all circumstances of this case, the Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ONLINEINTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2019-04-25

Publish the Decision