Decision for dispute CAC-UDRP-102425

Case number	CAC-UDRP-102425
Time of filing	2019-04-02 08:10:42
Domain names	INTESASANPAOLOBANKING.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Lidia Galbiati

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 has proven to be the owner of the INTESA SANPAOLO and INTESA marks.

The Complainant is, inter alia, the owner of the following trademarks:

International trademark registration no. 920896 “INTESA SANPAOLO”, granted on March 07, 2007 and renewed, in classes 9, 16, 35, 36, 38, 41 and 42;
EUTM registration no. 5301999 “INTESA SANPAOLO”, granted on June 18, 2007 and renewed, in classes 35, 36 and 38;
EUTM registration no. 5421177 “INTESA SANPAOLO & device”, granted on November 5, 2007 and renewed, in classes 9, 16, 35, 36, 38, 41 and 42;
International trademark registration no. 793367 “INTESA”, granted on September 4, 2002 and renewed, in connection with class 36.

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 major players 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 38.0 billion euro, and is the undisputed leader in Italy in all business areas (retail, corporate and wealth management).

The Complainant is also the owner, inter alia, of the following domain names: intesasanpaolo.com, .org, .eu, .info, .net, .biz, intesa-sanpaolo.com, org, .eu, .info, .net, and many others. All of these are connected to the official website <intesasanpaolo.com>.

On January 7, 2019, the Respondent registered the domain name <intesasanpaolobanking.com>.

The disputed domain name apparently is not currently used.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that:

1. The disputed domain name is confusingly similar to the Complainant's trademarks

The Complainant contends that the disputed domain name <intesasanpaolobanking.com> is confusingly similar to its well-known and distinctive trademarks "INTESA SANPAOLO" and "INTESA".

The Complainant further affirms that, as a matter of fact, intesasanpaolobanking.com exactly reproduces the well-known trademark "INTESA SANPAOLO" with the mere addition of the word "banking", which is a clear reference to the Complainant's main business activity.

2. The Respondent does not have any rights or legitimate interest in the disputed domain name.
The Complainant contends that the Respondent is not commonly known by the disputed domain name and that the Respondent is not affiliated with or authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and is not related to the Complainant's business in any way. The Complainant does not carry out any activity for, nor has any business dealings with, the Respondent.

3. The disputed domain name has been registered and is being used in bad faith

The Complainant contends that owing to the renown of the Complainant's trademarks, it is presumable that the Respondent had actual knowledge of the Complainant's distinctive trademarks.

The Complainant further contends that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which exactly corresponds to the Complainant's trademarks and which is so similar to the Complainant's domain names currently used by the latter to provide online banking services for enterprise. In addition, the passive holding of the disputed domain name has to be considered a use in bad faith.

The Complainant finally notes that the Respondent did not reply to the cease and desist letter sent by the Complainant's attorneys.

RESPONDENT:

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

There are two procedural complications in this case. They are as follows:

(i) The Complainant filed the Complaint in English rather than in Italian (i.e. the language of the registration agreement); and
(ii) The CAC's online platform currently does not work in Italian.

Pursuant to paragraph 11(a) of the Rules, unless otherwise agreed by the parties, or otherwise specified in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. Paragraph 10(b) and (c) of the Rules requires the Panel to ensure that the proceeding takes place with due expedition and that the parties are treated fairly and given a fair opportunity to present their respective cases.

The language of the Registration Agreement for the disputed domain name is Italian. From the evidence on record, no agreement appears to have been entered into between the Complainant and the Respondent regarding the language issue. The Complainant filed its Complaint in English and then requested that English be the language of the proceeding.

The Panel notes that:

(a) the CAC has notified the Respondent of the proceeding solely in English;
(b) however (at this Panel's request), the CAC has notified the Respondent, in both Italian and English, of the Complainant's request for a change of the language from Italian to English;
(c) thus, the Respondent has been given the opportunity to present its case in this proceeding and to respond formally to the issue of the language of the proceeding;
(d) however, the Respondent has not responded to nor contested the Complainant's request for a change of the language from Italian to English.

Considering the above circumstances, the Panel finds that the choice of English as the language of the present proceeding is fair to both parties and is not prejudicial to either one of the parties in his or her ability to articulate the arguments for this case.

The Panel has also taken into consideration the fact that to require the Complaint and all supporting documents to be re-filed in Italian would cause an unnecessary burden of cost to the Complainant and would unnecessarily delay the proceeding.

Having considered all the above matters, the Panel determines under paragraph 11(a) of the Rules that (i) it will accept the Complaint and all supporting materials as filed in English; and (ii) English will be the language of the proceeding and the decision will be rendered in English.

In view of all of the above, 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) Confusing similarity

The Panel agrees with the Complainant's assertions that the addition of the descriptive term, “banking”, does not prevent the disputed domain name from being confusingly similar to the Complainant’s trademarks.

B) Lack of legitimate rights or interests

The disputed domain name is a distinctive, non-descriptive name. It is unlikely that the Respondent registered the disputed domain name without having the Complainant firmly in mind. The Complainant’s assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorized by the Complainant are sufficient to constitute a prima facie demonstration of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent. The burden of evidence therefore shifts to the Respondent to show, using tangible evidence, that it does have rights or legitimate interests in the disputed domain name. The Respondent has made no attempt to do so.

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

C) Registered or Used in Bad Faith

The Complainant gives sound bases for its contention that the disputed domain name was registered and has been used in bad faith.

Firstly, owing to the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademarks, and so the Panel finds on the balance of probabilities that the Respondent was aware of the Complainant’s trademarks when registering the disputed domain name.

Secondly, the Panel accepts the Complainant’s unchallenged assertion that the Respondent registered the disputed domain name with the aim of creating a likelihood of confusion with the Complainant’s trademark.

Thirdly, it appears from the document provided by the Complainant that the Respondent is passively holding the disputed domain name.

Fourthly, the Respondent has not responded to nor denied any of the assertions made by the Complainant in the cease and desist letter and in this proceeding.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLOBANKING.COM**: Transferred

PANELLISTS

Name	**Dr. Fabrizio Bedarida**

DATE OF PANEL DECISION 2019-05-16

Publish the Decision