Decision for dispute CAC-UDRP-102503

Case number	CAC-UDRP-102503
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Domain names	intesasanpaolos.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	Coil services (Byron King)

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

EU trademark registration no.5301999 INTESA SANPAULO filed on 8 September 2006 and registered on 18 June 2007 for various services in classes 35, 36 and 38.

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 protagonists 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, billion euro, and leader in Italy in many 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. Intesa Sanpaolo 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 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 a number of trade mark registrations in a number of jurisdictions for the trademarks INTESA SANPAOLO and INTESA. This includes the EU trademark registration referred to above.

The Complainant is the owner of the following domain names: <INTESASANPAOLO.COM>, <INTESASANPAOLO.ORG>, <INTESASANPAOLO.EU>, <INTESASANPAOLO.INFO>, <INTESASANPAOLO.NET>, <INTESASANPAOLO.BIZ>, <INTESA-SANPAOLO.COM>, <INTESA-SANPAOLO.ORG>, <INTESA-SANPAOLO.EU>, <INTESA-SANPAOLO.INFO>, <INTESA-SANPAOLO.NET> and <INTESA-SANPAOLO.BIZ>. All of them are connected to the Complainant's official website located at http://www.intesasanpaolo.com.

On 20 February 2019 the Respondent registered the disputed domain name <INTESASANPAOLOS.COM>.

The Respondent has registered the disputed domain name in name of "Coil services (Byron King)". The Respondent is not commonly known by the name "INTESASANPAOLOS" and had no known rights to the name.

The disputed domain name does not divert users to a website and it appears there has been no usage of the domain name by the Respondent .

On 4 March 2019 the Complainant’s attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the disputed domain name to their client. The Respondent never replied to such communication.

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.

PRINCIPAL REASONS FOR THE DECISION

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

1) the disputed domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and
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.

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant claims registered rights over a number of trade marks. However the Panel has focused on one trade mark registration in particular, being EU trademark registration no.5301999 INTESA SANPAULO for various financial and other services in classes 35, 36 and 38.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a single trademark in a single jurisdiction that predates the registration of the disputed domain name (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijike KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436).

The next question is whether the disputed domain name is confusingly similar to INTESA SANPAULO.

INTESA SANPAULO is a distinctive sign in both Italian and English. The SANPAULO element translates from Italian into English as "Saint Paul", which has no obvious meaning in relation to financial services.

The subtraction of a space and addition of an "S" does nothing to distinguish the disputed domain name from this distinctive trademark. A consumer will likely ignore both these differences, which are of no significance. To an English speaker the addition of an "S" after INTESASAULO would only indicate a plural form or ownership. For example, that a website relates to multiple 'Intesa Sanpaulo branches' or its content is 'Intesa Sanpaulo's'. Hence the addition of "S" after nouns in domain names in this manner are likely to contribute nothing of meaningful significance in the eyes of a web-user.

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

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name bears no resemblance to the disputed domain name. Further, the disputed domain name does not resolve to a website.

There is simply no basis to conclude that the Respondent has rights or interests in the disputed domain name.

BAD FAITH

The Complainant correctly asserted that the passive holding of a domain name may, in appropriate circumstances, be aan indicative of bad faith. It will be so indicative when all the circumstances of the Respondent's behaviour indicates he or she is acting in bad faith (Telstra Corporation Ltd v. Nuclear Marshmallows D2000-0003 (WIPO February 18, 2000)).

In this sense the fact of passive holding is not often of central concern in a case such as the present where the domain name was not registered years ago, but just over mere 4 months ago. What is of concern is that;

(a). INTESA SANPAULO is a well known and distinctive mark;
(b). As discussed above, there is almost no distinction to be drawn between this mark and the disputed domain name.

These facts indicate that the Respondent knew of the said trade mark before seeking to register the disputed domain name and its passiveness only further confirms its lack of bona fides. Further, there is no response from the Respondent to contradict this inference that the Panel draws under Rule 14(b) and (5)(a) of the UDRP Rules.

As the Panel has found the Respondent had such prior knowledge of the INTESA SANPAULO trade mark at the time of registering the disputed domain name it can only follow that its purpose in registering the disputed domain name was to opportunistically profit from such confusing similarity. The Respondent targeted the Complainant's well known name for this purpose. Such opportunism has been recognised as bad faith by numerous panels, the Panel refers to the commentary of the learned Gerald M Levine, Domain Name Arbitration, Legal Corner Press, 1st ed. 2015, pp. 258 to 259.

Therefore in consideration of all the circumstances the disputed domain name has been 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. **INTESASANPAOLOS.COM**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2019-07-08

Publish the Decision