Decision for dispute CAC-UDRP-102516

Case number	CAC-UDRP-102516
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Domain names	BINTESASANPAOLO.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	Lidia Galbiati

OTHER LEGAL PROCEEDINGS

To the best of her knowledge, the Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

For the purpose of this Complaint, the Complainant relies on the following earlier trademarks:

- INTESA SANPAOLO, International registration No. 920896, of March 7, 2007, duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42;

- INTESA SANPAOLO, EU registration No. 5301999 filed on September 8, 2006 and granted on June 18, 2007, duly renewed, in classes 35, 36 and 38;

- INTESA SANPAOLO (figurative), EU registration No. 5421177, filed on October 27, 2006 and granted on November 5, 2007, duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42;

- INTESA, International trademark registration No. 793367, of September 4, 2002, duly renewed, in class 36;

- INTESA, EU trademark registration No. 12247979, filed on October 23, 2013 and granted on March 5, 2014, in classes 9, 16,

35, 36 38, 41 and 42;

- BANCA INTESA SANPAOLO, EU trademark registration No. 5302377, filed on September 8, 2006, granted on July 6, 2007, duly renewed, in classes 35, 36 and 38;

- BANCA INTESA, Italian trademark registration No. 362017000132887, filed on December 18, 1997, granted on June 20, 2000, duly renewed, in classes 9, 16, 36, 41 and 42;

- INTESA SANPAOLO, Italian trademark registration No. 1042140, filed on February 2, 2007, granted on March 7, 2007, duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42.

Moreover, the Complainant is also the owner of several domain names comprising its marks, which all redirect to the Complainant's official website at www.intesasanpaolo.com.

FACTUAL BACKGROUND

The Complainant is the leading Italian banking group and one of the protagonists in the European financial arena. The Complainant is the result of a merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups. The Complainant has a market capitalisation exceeding 40,9 billion euro.

In Italy, the Complainant acts through a network of approximately 4,100 branches distributed throughout the country, with market shares of more than 16 % in most Italian regions. The Complainant offers its services to approximately 11,8 million Italian customers. The Complainant has a strong presence also in Central-Eastern Europe with a network of approximately 1,100 branches and over 7,3 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, the Russian Federation, China and India.

The disputed domain name was registered on 19 March 2019.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

According to the Complainant, the disputed domain name is identical, or at least confusingly similar, to the Complainant's trademarks INTESA SANPAOLO and INTESA, since it exactly reproduces the well-known trademark INTESA SANPAOLO, with the mere addition of the initial letter "b". Hence, the Complainant maintains that the disputed domain name is a clear example of typosquatting.

The Complainant further argues that the Respondent has no rights or legitimate interests in the disputed domain name, as the Complainant did not authorize the Respondent to reflect its trademarks in the disputed domain name, nor the Complainant's trademarks were ever licensed to the Respondent. Moreover, the disputed domain name is passively held and therefore there is no evidence of a fair or non-commercial use of it.

The Complainant points out that the disputed domain name has been registered and is being used in bad faith. The Complainant's trademarks are distinctive and well-known internationally. The fact that the Respondent registered a confusingly similar domain name is a clear indication that at the time of the registration of the disputed domain name the Respondent was aware of the Complainant's trademark. Accordingly, there is a strong presumption that the disputed domain name would not have been registered if it did not coincide with the Complainant's trademark.

As far as use in bad faith is concerned, the Complainant maintains that the disputed domain name is not used in connection with a bona fide offering of goods and services. The fact that the disputed domain name is currently not actively used cannot exclude bad faith. Under certain circumstances, which the Complainant affirms to be present in this case, passive

holding amounts to use in bad faith.

Furthermore the fact that the disputed domain name coincides with a well-known third party's trademark makes any possible use of the domain name inconceivable. The risk of a wrongful use of the disputed domain name is even higher in the present case, since the Complainant is a bank and the use of the disputed domain name could have dramatic impacts on the Complainant's costumers and on their savings.

Lastly, the Complainant points out that the Respondent could use the disputed domain name for the purpose of transferring it to the Complainant for valuable consideration in excess of the documented out-of pocket costs, which would also be evidence of use in bad faith.

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 the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

In particular, the Panel notes that in the present case the Complaint was filed in English rather than in Italian, which is the language of the Registration Agreement. When the CAC received the Registrar Verification answers, it notified the Complainant of the language of the Registration Agreement and requested the Complainant to either request a change of language from Italian to English, or to re-file the Complaint with another UDRP provider, as the CAC did not provide for the necessary technical support in Italian. The Complainant submitted an amended Complaint, requesting to conduct the proceedings in English for the following reasons:

- English is an international language comprehensible to a wide range of Internet users worldwide. Since the spirit of Paragraph 11 of the Rules seems to be to ensure fairness in the selection of language by giving full considerations to the parties' level of comfort with each language, English seemed to be the fair language in the present proceeding.

- the UDRP proceedings have been started because the Respondent deliberately registered a domain name incorporating a well-known registered trademark, legitimately owned and used worldwide by the Complainant since many years.

In any event, the Complainant mentioned that it would accept as a fair way of proceeding, the fact that:

- the Complaint is filed in English;
- a possible Response is filed either in English or in Italian;
- a Panel familiar with both languages is appointed to decide this case.

According to Paragraph 11 of the Rules, the Panel has the power to determine that the language of the UDRP proceedings is a language different from that of the Registration Agreement, having regard to the specific circumstances of the case.

In this case, being the Respondent an Italian individual, and being the Registration Agreement in Italian, Italian was certainly

the most appropriate language to deal with.

It is however worth mentioning that pursuant to Paragraph 10(b) and (c) of the Rules, the Panel shall 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. Therefore, Paragraph 10(b) and (c) of the Rules refers to two equally important requirements, fairness in the treatment of the parties and expeditiousness.

As to fairness towards the Respondent, the Panel is of the opinion that fairness is ensured even if the current UDRP proceedings are conducted in English. As a matter of fact, the Panel has found one recent case precedent, between the same parties and referring to a domain name very similar to the one at stake, where the Panel requested the CAC to notify the Complainant's request of language change to the Respondent in Italian. Notwithstanding this, the Respondent failed to submit a reply, or to object to the language change (see Decision of 15 May 2019 on CAC Case No. 102425, Intesa San Paolo S.p.A. vs. Lidia Galbiati, for the domain name <intesasanpaolobanking.com>). In that case, the domain name contained one English term "banking", which denotes at least some knowledge of English by the Respondent. In that case, likewise in the current one, the domain names were registered under the gTLD ".com", which, by definition, is gTLD used for domain names addressed to the international public that usually knows English.

Since the Respondent was already involved in a very similar UDRP case, with the same issues regarding the language change, that were notified to her also in Italian, it is evident that the Respondent is now familiar with the procedure and with the rights conferred to the Respondent to object to the language change and to the merits of the Complainant's contentions within a specific deadline. In view of this familiarity, when the Respondent received the Complaint, she could have filed a reply, even in Italian (the Complainant itself stated that it had no objections to accept a Response in Italian, and the CAC appointed a Panel who is familiar with both languages). However, the Respondent decided not to file a Response, nor to object to the request of language change.

As to expeditiousness, in view of the circumstances explained above, it is highly likely that a notification in Italian of the request of change of the language of the proceeding from Italian to English, would only have had, this time, the sole effect to further extend the deadline to file a Response, without any significant impact on the proceedings. The same would apply if the Panel were to deny the language change, as the Complainant would have to translate its Complaint in Italian, not considering the fact that the UDRP should be re-filed with another provider, as indicated by the CAC in its Notification of Deficiencies in Complaint.

For all the reasons explained above, the Panel is of the opinion that no further notification to the Respondent of the change of language should be made, and that the proceedings may continue in English, as requested by the Complainant. This decision is based on the fact that, according to the Panel, the Respondent was given a fair opportunity to present her case, which she deliberately decided not to take, and that any other different Panel's decision would have a significant negative impact on the expeditiousness of the proceedings.

PRINCIPAL REASONS FOR THE DECISION

I. Confusing similarity of the disputed domain name

The Complainant has provided sufficient evidence of the fact that it owns rights over the registered trademarks "Intesa Sanpaolo" and "Banca Intesa SanPaolo" since long time before the creation of the disputed domain name. The disputed domain name is confusingly similar to the trademark INTESA SANPAOLO as it incorporates this trademark entirely, preceded by the letter "b". In UDRP proceedings It is generally recognized that the first requirement under the Policy is satisfied when a domain name includes the Complainant's trademark. This is particularly true in this case, where the trademark INTESA SANPAOLO is distinctive and renown. Moreover, not only the first letter "b" should be perceived as a typosquatting, but it is also the first letter of the word "bank", which is the field where the Complainant operates: the Complainant is usually called "Banca Intesa" or "Banca Intesa SanPaolo" in Italy. Therefore, Internet users, when viewing the disputed domain name will certainly be misled as to its origin and will believe that <bintesasanpaolo.com> originates from the Complainant.

For all these reasons, the Panel is satisfied that the first condition under the Policy is met.

II. The Respondent's lack of rights or legitimate interests in the disputed domain name

While the overall burden of proof under the Policy rests on a complainant, it is generally recognized that, in order to prove a respondent's lack of rights or legitimate interest in the domain name, it is sufficient for the complainant to make out a prima facie case to shift the burden of proof to the respondent. This is so because proving a third party's negative fact, such as the respondent's lack of rights or legitimate interest, would otherwise result in an almost impossible task for the complainant.

In the instant case, the Complainant has indicated that the Respondent is not one of its licensees and that the Respondent was never authorized to reflect the Complainant's trademarks in a domain name. There is no evidence in the file that the Respondent has been commonly known by the disputed domain name: the Complainant has provided the results of a Google search, where it clearly appears that the name "Intesa Sanpaolo" is always linked to the Complainant.

The Respondent is not using, nor is making preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. At the time of the drafting of the Complaint, the disputed domain name did not lead to an active web page, and the Panel has verified that this is the case also today. The fact that the disputed domain name is passively held, does not have an impact on the Respondent's lack of rights and legitimate interests in the disputed domain name. As a matter of fact, absent any authorization by the Complainant and by the relevant authorities (considering that the Complainant is a financial institution that needs accreditation), the Respondent cannot make any whatsoever use of the disputed domain name in connection with a bona fide offering of goods or services.

In view of the foregoing, the Panel is satisfied that also the second condition under the Policy is met.

III. Bad faith

When assessing the third requirement under the Policy, the panel must evaluate whether the complainant has successfully proved that the respondent acted in bad faith, both at the time of the registration of the domain name, and during its use.

As far as registration in bad faith is concerned, the Panel notes that the disputed domain name incorporates a quite distinctive and well-known trademark belonging to the Complainant. Moreover, in the disputed domain name, the Complainant's trademark is preceded by a letter "b", which is the abbreviation of "bank". The Respondent is Italian and she was clearly aware of the Complainant's trademark and reputation at the time of the registration of the disputed domain name. Hence, the disputed domain name was clearly not registered by chance but with an illegitimate purpose.

Whatever is that purpose, the unauthorised registration of the disputed domain name was made in bad faith.

As far as use in bad faith is concerned, the Respondent is not using the disputed domain name.

As indicated in Paragraph 3.3. of the WIPO Overview of Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), "[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Whilst panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put".

In the instant case: (i) the Complainant's trademarks are distinctive and enjoy high reputation in the banking and financial fields, (ii) the Respondent could not have been unaware of said reputation, due to the fact that the disputed domain name is an intentional misspelling of the Complainant's trademarks, and the Respondent is Italian, (iii) the Respondent failed to

submit a response, (iv) the Respondent was already involved in another UDRP proceeding involving a domain name infringing the Respondent's earlier trademarks, and (v) any possible use of the disputed domain name would result in an attempt to unduly take unfair advantage from the distinctive character and reputation of the Complainant's trademark, or in a consumer's fraud or other illegitimate activity. Thus, the Respondent is holding the disputed domain name in bad faith.

In light of the above, the Panel is satisfied that also the third and last requirement under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BINTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2019-07-13

Publish the Decision