Decision for dispute CAC-UDRP-102600

Case number	CAC-UDRP-102600
Time of filing	2019-07-29 09:27:18
Domain names	wwwbanca5.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

Organization	Domain Privacy Guard Sociedad Anonima Ltd

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 the owner of the following registrations for the trademark “BANCA 5”:

- EU trademark registration no. 16411671 “BANCA 5 & device”, applied on February 28, 2017 and granted on July 13, 2017, in classes 9, 16, 35, 36, 41 and 42;

- EU trademark registration no. 12669461 “BANCA5”, applied on March 6, 2014 and granted on July 30, 2014, in classes 16, 35 and 36;

- Italian trademark registration no. 1616792 “BANCA 5”, applied on March 31, 2014 and granted on December 18, 2014, in class 36; and

- Italian trademark registration no. 1616793 “INTESA SANPAOLO BANCA 5”, applied on March 31, 2014 and granted on December 18, 2014, in class 36.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

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 capitalization exceeding 33 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,100 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 11.8 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1,100 branches and over 7.3 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.

The disputed domain name was registered on July 26, 2018.

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 15(a) of the Rules for the Policy instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that a complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by a respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(2) respondent has no rights or legitimate interests in respect of the domain name; and

(3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Rights

The Complainant contends that it is the owner of the following registrations for the trademark "BANCA 5":

- EU trademark registration no. 16411671 "BANCA 5 & device", applied on February 28, 2017 and granted on July 13, 2017, in classes 9, 16, 35, 36, 41 and 42;

- EU trademark registration no. 12669461 "BANCA5", applied on March 6, 2014 and granted on July 30, 2014, in classes 16, 35 and 36;

- Italian trademark registration no. 1616792 "BANCA 5", applied on March 31, 2014 and granted on December 18, 2014, in class 36; and

- Italian trademark registration no. 1616793 "INTESA SANPAOLO BANCA 5", applied on March 31, 2014 and granted on December 18, 2014, in class 36.

The Panel notes that trademark registrations with the EUIPO and the Italian Patent Office (UIBM) are sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the mark BANCA 5.

The Complainant further contends that the disputed domain name is confusingly similar to its mark BANCA 5 on the grounds that the disputed domain name exactly reproduces Complainant's well-known trademark BANCA 5 with the mere addition of letters 'www,' that is a clear example of typosquatting.

The Panel finds that the disputed domain name incorporates entirely the Complainant's mark BANCA 5 adding non-distinctive letters 'WWW' and the gTLD '.com' which do not add any distinctiveness to the disputed domain name. The Panel agrees with the Complainant, and thus it finds that the disputed domain name is confusingly similar to the Complainant's mark BANCA 5.

No rights or legitimate interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also Advanced International

Marketing Corporation v. AA-1 Corp, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that it has never granted the Respondent any right to use the 'BANCA 5' trademark within the disputed domain name; the disputed domain name does not correspond to the name of the Respondent; the Respondent is not commonly known by the disputed domain name; and there has been no fair or non-commercial uses of the disputed domain name (Complainant has proved this by a screenshot of the disputed domain name's resolving website).

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Complainant argues that Respondent had actual knowledge of Complainant's rights in the BANCA 5 mark prior to registration of the disputed domain name. Although panels have not generally regarded constructive notice to be sufficient for a finding of bad faith, actual knowledge of Complainant's rights in the mark prior to registering the disputed domain name is adequate to find bad faith under Policy paragraph 4(a)(iii). See Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (FORUM Feb. 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding paragraph Policy paragraph 4(a)(iii) of bad faith, the Panel here finds actual knowledge through the name used for the domain and the use made of it."). Registration of a domain name that uses a well-known and famous mark may be evidence of actual knowledge of complainant's rights in the mark per Policy paragraph 4(a)(iii). See Snap Inc. v. Deepika Priyadarshinie / entsl, FA 1788600 (Forum June 21, 2018) (finding the respondent had actual knowledge of the complainant and its rights in the claimed mark due to the fame of the mark, established by the complainant's submission of numerous articles regarding the success of the complainant's product). Complainant has provided the Panel with exhibits that show the strength of the BANCA 5 mark and how the BANCA 5 mark has been used in commerce. Therefore, the Panel infers that Respondent had actual knowledge of the Complainant's rights in the BANCA 5 mark prior to registration of the disputed domain name which constitutes bad faith per Policy paragraph 4(a)(iii).

Complainant further contends that the disputed domain name is not used for any bona fide offerings of goods or services; the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site; particularly the disputed domain name is connected to a website sponsoring, among others, banking and financial services.

Use of a disputed domain name in an attempt to create a likelihood of confusion and pass off as a complainant may be evidence of bad faith registration and use per Policy paragraph 4(b)(iv). See Sandhills Publishing Company v. sudeep banerjee / b3net.com, Inc., FA 1674572 (FORUM June 17, 2016) (finding that the respondent took advantage of the confusing similarity between the <machinerytraderparts.com> domain name and the complainant's MACHINERY TRADER mark, which indicates bad faith registration and use pursuant to Policy paragraph 4(b)(iv)). Complainant argues that Respondent took advantage of the confusing similarity nature of the disputed domain name and Complainant's mark to confuse Internet users into thinking Respondent is affiliated with Complainant. Complainant provides a screenshot of the disputed domain name's resolving website which features the BANCA 5 mark in connection with banking and financial services. Therefore, the Panel finds that Respondent registered and used the disputed domain name in bad faith per Policy paragraph 4(b)(iv).

The Panel agrees with the Complainant and finds that the above constitutes bad faith registration and use of the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **WWWBANCA5.COM**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2019-08-27

Publish the Decision