Decision for dispute CAC-UDRP-102575

Case number	CAC-UDRP-102575
Time of filing	2019-07-19 08:51:26
Domain names	intesasanpaolo.agency

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	Pavel StinfoConsulting

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has adduced evidence that it is the owner of, among others, the following registered trademarks “INTESA SANPAOLO” and “INTESA”:

- International trademark registration No. 920896 “INTESA SANPAOLO” of 7 March 2007 in Class 36 of the Nice Classification Scheme (Class 36 includes financial services);
- International trademark registration No. 924099 “INTESA SANPAOLO & device” of 27 March 2007, also in Class 36;
- EU trademark registration No. 5301999 “INTESA SANPAOLO” of 18 June 2007 in Classes 35, 36 and 38;
- Peruvian trademark registration No. 32896 “INTESA” of 18 July 2003 in Class 36.

The Complainant is further the owner of, among others, the following domain names which integrate the above marks:

INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ and INTESA.COM, INTESA.INFO, INTESA.BIZ, INTESA.ORG, INTESA.US, INTESA.EU, INTESA.CN, INTESA.IN, INTESA.CO.UK, INTESA.TEL, INTESA.NAME, INTESA.XXX, INTESA.ME.

These domain names are all linked to the Complainant's main website at <www.intesasanpaolo.com>.

FACTUAL BACKGROUND

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

The Complainant, Intesa Sanpaolo, is Italy's leading Italian banking group and a significant player at European level including in central and Eastern Europe, with a network of over 1,000 branches and over 7 million customers there. Intesa Sanpaolo is the company resulting from the merger of 1 January 2007 between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups. Its market capitalization exceeds €33 billion and its presence extends to the United States, Russia, China and India.

On 7 June 2019 the Respondent registered the domain name <INTESASANPAOLO.AGENCY>.

On 14 June 2019 the Complainant's representatives sent the Respondent a cease and desist letter asking for the voluntary transfer of the domain name at issue. The Respondent did not comply with the above request. Instead, by an e-mail to the Complainant and the CAC Case Administrator of 19 July 2019, the Respondent suggested settling the dispute upon payment by the Complainant of €35,000 to the Respondent for transfer of the disputed domain name. The Complainant did not accept this offer and instead forwarded it to the Panel for its consideration.

The Complainant adduced detailed evidence showing: the scope and scale of its banking and related activities, the content of its websites, a long list of ADR proceedings it has undertaken in order to protect its brand, and a screenshot of the webpage associated with the disputed domain name, dated 16 July 2019. The webpage is an internet service provider parking page but containing links related to banking services, all in Italian.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT:

IDENTICAL OR CONFUSINGLY SIMILAR REGISTRATION AND USE

The disputed domain name is identical, or – at least – confusingly similar, to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA". In fact, <INTESASANPAOLO.AGENCY> exactly reproduces its well-known trademark "INTESA SANPAOLO".

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has no rights in the trademarks "INTESA SANPAOLO" and "INTESA" or to make any use of them. Any use must be authorized by the Complainant. Their use in the disputed domain name is unauthorized.

The disputed domain name does not correspond to the name of the Respondent and, to the best of the Complainant's knowledge, Domains By Proxy, LLC is not commonly known as "INTESASANPAOLO" either.

Lastly, there is no indication of any fair or non-commercial uses of the disputed domain name, particularly from the screenshot of the webpage associated with it.

REGISTERED AND USED IN BAD FAITH

The disputed domain name was registered and is used in bad faith for the following reasons:

The Complainant's trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and well-known around the world. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. In addition, even a basic Google search in respect of "INTESA SANPAOLO" and "INTESA" would have yielded obvious references to the Complainant. This raises a clear inference of knowledge of the Complainant's trademark on the part of the Respondent. Therefore, it is more than likely that the disputed domain name would not have been registered if it were not for the Complainant's trademark. This is clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bona fide offerings. More particularly, the circumstances indicate that, by 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 (cf. paragraph 4(b)(iv) of the Policy). Notably, the disputed domain name in which the Complainant's trademarks are used links to other sites sponsoring, among others, banking and financial services.

Consequently, Internet users, while searching for information on the Complainant's services, are confusingly led to the websites of the Complainant's competitors. The Complainant hence claims that the Respondent has registered and is using the disputed domain name in order to intentionally divert traffic away from the Complainant's website. The Complainant invoked several past ADR decisions to substantiate the presence of bad faith in these circumstances, among them Microsoft Corporation v. StepWeb, WIPO Case No. D2000-1500 and The Vanguard Group, Inc v. Venta, WIPO Case No. D2001-1335.

The Complainant claims that the harm it suffers consists in its present clients being misled and new ones potentially being lost. The Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated. Moreover, it is no coincidence that the speculative registration and use of the disputed domain name here involves a major financial institution such as Intesa Sanpaolo. In fact, diversion of traffic in this way is very frequent within the banking sector due to the high number of online banking users. This is also shown by the many instances in which the Complainant has already resorted to ADR.

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

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

As referred to under "Factual Background" above, an e-mail exchange took place between the Parties and the Case Administrator. This occurred after commencement of this proceeding but before the time limit for the Respondent to submit a response had expired. The Complainant expressly requested that the Panel receive this exchange.

The Panel reviewed the exchange and concluded that the Respondent's offer to negotiate a settlement, and the terms suggested, namely a payment of €35,000 by the Complainant to the Respondent in return for transfer to the former, were pertinent to the proceeding. It then by a Non Standard Communication (NSC) adverted the Parties of this conclusion and informed them that it was the Panel's intention to treat the exchange, which the Panel attached to the NSC, as part of the Case File and to do so as a submission made by the Complainant in support of its case. The Panel furthermore explained in the NSC that it did not intend to treat the Respondent's communication during the exchange as being in lieu of a Response.

Having set forth its intended approach in this way, the Panel specifically invited the Respondent to make any submissions it wished on it and set a date for doing so (no submission was received) as well as a new projected decision date.

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

This is a clear case of cybersquatting, as shown by the extensive and compelling evidence the Complainant has adduced.

The stem of the disputed domain name is identical to the Complainant's registered trademark “INTESA SANPAOLO” save for omission of the space between the words. The addition of the DNS Top Level Domain identifier ".AGENCY" does not diminish the identicality of the stem but instead misleadingly adds a term to it that is relevant within the sector concerned, i.e. banking.

From the conjunction of the two there is a manifest possibility and indeed likelihood that an internet user could be confused into believing that there is an association between those responsible for the disputed domain name and its website and the Complainant banking group, whereas there is none.

The Panel in this regard accepts the Complainant's uncontested assertation that the use of the Complainant's trademark(s) is unauthorized and that the Respondent has no relation of his own to the names contained in them. Nor is there any indication that the Respondent has any other legitimate interest in using the Complainant's trademarks.

As to the third criterion under the Policy, that of bad faith registration and use of the disputed domain name, the Panel acknowledges the distinctive and internationally well-known nature of the Complainant’s trademarks and accepts the extreme improbability of the Respondent happening upon the idea of registering that particular string of characters without foreknowledge. The Complainant recognizes that there might conceivably nevertheless be some bona fide reason for the Respondent's having done so, but, equally, points out that none is apparent.

To the contrary, the Respondent's own suggestion to negotiate a settlement of this proceeding on the basis of a payment by the Complainant to him of €35,000 in return for its transfer provides explicit evidence of the Respondent's intention to obtain unjustified commercial gain through holding and using the disputed domain name which incorporates the Complainant's registered trademarks.

It is to provide a recourse against precisely this kind of situation that the Policy was devised.

Such conclusive evidence of bad faith dispenses with the need to consider the Complainant's other contentions in this regard in any depth. The Panel, for good order, simply notes that the Complainant did make out sufficiently potent grounds to suggest intentional deviation of internet traffic to the commercial disadvantage of the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO.AGENCY**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2019-09-01

Publish the Decision