Decision for dispute CAC-UDRP-102689

Case number	CAC-UDRP-102689
Time of filing	2019-09-30 09:19:52
Domain names	sanpaolointesa-groups.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	Marco Fabrone

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has evidenced to be the owner of the following trademark registrations:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 41 and 42;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38;
- EU trademark registration n. 5344544 “GRUPPO INTESA SANPAOLO”, filed on September 28, 2006, granted on July 6, 2007 and duly renewed, in classes 35, 36 and 38;
- Italian trademark registration n. 1042140 “INTESA SANPAOLO”, filed on February 2, 2007, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

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

PRELIMINARY REQUEST FOR ENGLISH TO BE THE LANGUAGE OF THIS PROCEEEDING

As requested by the CAC, the Complainant filed preliminary request in order to require English to be the language of the administrative proceeding at issue.

[1.] First of all, the present Complaint was written in English, 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.

[2.] It is true that there are no evidences of an agreement between the Complainant and the Respondent to the effect that the proceedings should be in English. However, it is not possible to ignore that the present dispute has been started because the Respondent deliberately registered a domain name which is identical to a well-known Italian registered trademark legitimately owned and used by the Complainant from several years all around the world. Since it is inconceivable that the Respondent was not aware of such circumstance when it registered the disputed domain name, the Complainant believes that a fair solution shall be – at least – to:

1) accept the Complaint as filed in English;
2) accept a Response in either English or Italian (or the preferable language of the Respondent, if any);
3) appoint a Panel familiar with both languages.

[3.] So, in accordance with the instructions submitted by the CAC, for the reasons described above, the Complainant requested the Panelist to maintain English the proceeding language or, at least, one of the languages accepted by the Panel.

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 capitalisation exceeding 34,9 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,900 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 7,2 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 is the owner, among others, of the following registrations for the trademarks "INTESA SANPAOLO" and "GRUPPO INTESA SANPAOLO":

-International trademark registration n. 920896 "INTESA SANPAOLO", granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 41 and 42;
- EU trademark registration n. 5301999 "INTESA SANPAOLO", applied on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38;
- EU trademark registration n. 5344544 "GRUPPO INTESA SANPAOLO", filed on September 28, 2006, granted on July 6, 2007 and duly renewed, in connection with classes 35, 36 and 38;
- Italian trademark registration n. 1042140 "INTESA SANPAOLO", filed on February 2, 2007, granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42.

Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”: INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.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. All of them are now connected to the official website http://www.intesasanpaolo.com.

On July 30, 2019, the Respondent registered the domain name <SANPAOLOINTESA-GROUPS.COM>.

It is more than obvious that the disputed domain name is identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “GRUPPO INTESA SANPAOLO”. As a matter of fact, <SANPAOLOINTESA-GROUPS.COM> exactly reproduces the well-known trademark “INTESA SANPAOLO”, with the mere inversion of the terms “INTESA” and “SANPAOLO”, and the addition of the word “groups”.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Respondent has no rights in the disputed domain name, and any use of the trademarks “INTESA SANPAOLO” and “GRUPPO INTESA SANPAOLO” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the disputed domain name.

Lastly, we do not find any fair or non-commercial uses of the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The disputed domain name was registered and is used in bad faith.

The Complainant’s trademarks “INTESA SANPAOLO” and “GRUPPO INTESA SANPAOLO” are distinctive and well-known all 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, if the Respondent had carried even a basic Google search in respect of the wordings “INTESA SANPAOLO” and “GRUPPO INTESA SANPAOLO”, the same would have yielded obvious references to the Complainant. The Complainant submited an extract of a Google search in support of its allegation. 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 Complainant’s trademark. This is a clear evidence of registration of a domain name in bad faith.

In addition, the disputed domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy).

The disputed domain name is not used for any bone fide offerings, even if it is not connected to any website, by now. In fact, countless UDRP decisions confirmed that the passive holding of a domain name with knowledge that the domain name infringes another party’s trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, enclosed as Annex E, and also the panels’ consensus view on this point, as reflected in the “WIPO Overview of WIPO Views on Selected UDRP Questions” at paragraph 3.2.).

In particular, the consensus view of WIPO UDRP panelists is that passive holding of a domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, panels have tended to make such findings in

circumstances in which, for example, a complainant's mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the complainant's trade mark rights.

As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademarks. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant's trademarks and that results so similar to the Complainant's domain names currently used by the latter to provide online banking services for enterprises.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain name has to be considered a use in bad faith: «The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests» (Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., concerning just the case of a bank).

The risk of a wrongful use of a domain name is even higher in the present case, since the Complainant has already been targeted by some cases of phishing in the past few years. Such a practice consists of attracting the customers of a bank to a web page which imitates the real page of the bank, with a view to having customers disclose confidential information like a credit card or bank account number, for the purpose of unlawfully charging such bank accounts or withdrawing money out of them. It happened that some clients of the Complainant have received e-mail messages asking, by the means of web pages which were very similar to the Complainant's ones, the sensitive data of the Clients, like user ID, password etc. Then, some of the Clients have been cheated of their savings.

Also in the present case, the Complainant believes that the current owner registered the disputed domain name with the "phishing" purpose, in order to induce and divert the Complainant's legitimate customers to its website and steal their money and the above could be easily verified given the particular nature of the disputed domain name (typosquatting).

Even excluding any "phishing" purposes or other illicit use of the domain name in the present case, anyway we could find no other possible legitimate use of <SANPAOLOINTESA-GROUPS.COM>. The sole further aim of the owner of the domain name under consideration might be to resell it to the Complainant, which represents, in any case, an evidence of the registration and use in bad faith, according to par. 4(b)(i) of the Policy («circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name»).

Lastly, it shall be noted that on August 28, 2019 the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the disputed domain name. Despite such communication, the Respondent did not comply with the above request.

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.

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

As regards the Complainant’s request that the language of proceeding be English, notwithstanding the fact that, as evidenced by the Domain Registrar's Verification, Italian is the language of the registration agreement of the disputed domain name, under Paragraph 11 of the Rules, the Panel is free to deviate from the language of the registration agreement depending on the particular circumstances of each case. Here, the Respondent has kept silent to any of the Complainant’s communication, including the sending of a cease-and-desist letter as well as the filing of the Complaint. Also, the disputed domain name is not registered e.g. under a country-code top level domain, but rather under the most common generic top level domain .com which is most often used in an international context. Against this background, the Panel is willing to accept to lead this proceeding in the world language English, given that the Respondent obviously has no disadvantages arising from doing so and is still treated equally and fair within the scope of Paragraph 10 of the Rules.

On the merits of this case, the Panel finds that the disputed domain name <sanpaolointesa-groups.com> is confusingly similar to the Complainant's "INTESA SANPAOLO" and "GRUPPO INTESA SANPAOLO " trademarks, since (1) the disputed domain name incorporates the Complainant's trademark "INTESA SANPAOLO" in its entirety and the mere addition of the descriptive term "groups" is not capable to dispel the confusing similarity arising from the Complainant's trademarks incorporation in the disputed domain name and (2) the disputed domain name also incorporates the Complainant's trademark "GRUPPO INTESA SANPAOLO" given that “gruppo” is the Italian term for “group”, so that again the mere addition of the descriptive term "gruppo" is not at all in contrast to the finding of confusing similarity arising from the Complainant's trademarks incorporation in the disputed domain name. In fact, the disputed domain name somehow corresponds to both of the Complainant's trademarks showing similarities with each of them.

Moreover, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent so far has neither made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate non-commercial or fair use of the disputed domain name, nor is the Respondent commonly known thereunder. The disputed domain name apparently has not yet been used by the Respondent whatsoever, but to redirect to a typical “under construction” website (so-called “passive holding”). Many UDRP panels have recognized that the mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase, may not of itself confer rights or legitimate interests in a domain name. Accordingly, the Panel has no difficulty in finding that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Finally, the Complainant points to the fact, and the Panel agrees with this line of argumentation, that given the reputation of the Complainant’s trademark “INTESA SANPAOLO” all around the world and given the fact that the Respondent has registered a domain name that actually is kind of a combination of two of Complainant’s trademarks clearly indicates that the Respondent had knowledge of the Complainant’s trademarks at the time of the registration of the disputed domain name. Also, there is a consensus view among UDRP panelists that a passive holding of a domain name may, in appropriate circumstances, be consistent with the finding of bad faith, in particular in circumstances in which, for example, a

complainant's trademark is well-known, and there is no conceivable use that could be made of the domain name and would not amount to an infringement of the complainant's trademark's rights. In the case at hand, in the absence of any other reasonable explanation as to why the Respondent should rely on the disputed domain name and given that the Respondent has brought forward nothing in substance relating to the intended use of the disputed domain name that would have allowed the Panel to hold for Respondent, the Panel finds that the Respondent has registered and is making use of the disputed domain name in a manner which at least takes unjustified and unfair advantage of the Complainant's "INTESA SANPAOLO" and "GRUPPO INTESA SANPAOLO" trademarks' fame and must, therefore, be considered as registered and being used in bad faith within the meaning of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SANPAOLOINTESA-GROUPS.COM**: Transferred

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2019-10-31

Publish the Decision