Decision for dispute CAC-UDRP-102690

Case number	CAC-UDRP-102690
Time of filing	2019-09-30 09:20:34
Domain names	JNTESASANPAOLO.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	jnts

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant submitted evidence that it is the registered owner of the following trademarks:

- International trademark registration n. 920896 “INTESA SANPAOLO” (word trademark), registered on March 7, 2007 and duly renewed, valid for various classes including class 36 (“financial affairs”; etc.), also covering the United States of America;

- International trademark registration n. 924099 “INTESA SANPAOLO” (figurative trademark with word elements), registered on March 27, 2007 and duly renewed, valid for various classes including class 36 (“financial affairs”; etc.), also covering the United States of America;

- International trademark registration n. 793367 “INTESA”, registered on September 4, 2002 and duly renewed, in connection with class 36 (“financial affairs”; etc.);

- EU trademark registration n. 5301999 “INTESA SANPAOLO” (word trademark), applied on September 8, 2006, registered on June 18, 2007 and duly renewed, valid for various classes including class 36 (“financial affairs”; etc.);

- EU trademark registration n. 12247979 “INTESA” (word trademark), applied on October 23, 2013 and registered on March 5, 2014, valid for various classes including class 36 (“financial affairs”; etc.).

FACTUAL BACKGROUND

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

The Complainant (“Intesa Sanpaolo”) is a well-known Italian banking group, which is also active in the rest of Europe. 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., which are two Italian banking groups. The Complainant claims to be among the top banking groups in the euro zone, with a market capitalization exceeding 34,9 billion euros. Besides banking, the Complainant is also active in other business areas such as retail, and corporate & wealth management. The Complainant claims to have a network of approximately 3,900 branches, with market shares of more than 16 % in most Italian regions. The Complainant claims to offer its services to approximately 11,8 million customers. The Complainant also claims to have ‘a strong presence’ in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,2 million customers. Moreover, the Complainant claims to have an international network specialized in supporting corporate customers in 25 countries, in particular in the Mediterranean area and areas where Italian companies are active, such as the United States, Russia, China and India.

The Complainant submitted evidence that it is the registered owner of the trademarks mentioned above under "Identification of rights".

The Complainant further asserts that it is the owner of various domain names consisting of the terms "INTESA" and “INTESA SANPAOLO”, and different domain extensions (including intesasanpaolo.com, intesasanpaolo.org, ntesasanpaolo.eu, intesasanpaolo.info, intesasanpaolo.net, intesasanpaolo.biz, intesa-sanpaolo.com, intesa-sanpaolo.org, intesa-sanpaolo.eu, intesa-sanpaolo.info, intesa-sanpaolo.net, intesa-sanpaolo.biz, 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, AND intesa.me. According to the Complainant, all of these domain names are connected to its official website www.intesasanpaolo.com. However, the Complainant did not submit evidence of these assertions.

The disputed domain name was registered on June 18, 2019.

The domain is currently not in use.

On July 11, 2019, the Complainant’s attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the disputed domain name. The Respondent did not comply with this request.

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

1. Identical or confusingly similar

The disputed domain name <JNTESASANPAOLO.COM> consists of the Complainant's registered trademark(s) "INTESA SANPAOLO", with the mere substitution of the letter "I" in the mark's first term "INTESA" with a "J". There is also the addition of the '.com' suffix, which may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

The Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous Panels have found that 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 burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then has to weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Panel notes that the Complainant contends that the Respondent was not authorised to use its trademark(s) "INTESA SANPAOLO". The Complainant further argues that the disputed domain name does not correspond to the name of the Respondent. The Respondent is not commonly known as "JNTESASANPAOLO". Lastly, Complainant contends that it has not found any fair or non-commercial uses of the disputed domain name by the Respondent.

The Respondent did not file an administratively compliant (or any) response. In such circumstances, the Panel finds from the facts put forward that:

The Respondent does not appear to have any rights or legitimate interests associated with the "INTESA SANPAOLO" trademark(s), nor with variations thereof such as "JNTESASANPAOLO".

There is no evidence that the Respondent is commonly known by the "INTESA SANPAOLO" trademark(s), or with variations such as "JNTESASANPAOLO". The Respondent does not seem to have any consent to use these trademarks or variations such as "JNTESASANPAOLO". The disputed domain name does not correspond to the name of the Respondent.

There is no evidence to show that the Respondent may have used the disputed domain name for any bona fide offering of goods or services of its own. Also, there is no evidence to show any demonstrable preparations to use the domain name or a name corresponding to the disputed domain name in connection with such bona fide offering of goods or services.

There is no evidence to show that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks at issue.

On the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith registration and use

The Complainant asserts that its trademarks “INTESA SANPAOLO” are distinctive and well-known. The Complainant submitted evidence that a Google search for the terms “INTESA SANPAOLO" results in multiple search results linked to the Complainant (including the first search result). The Complainant claims to be a well-known Italian banking group. The Complainant claims to rank among the top banking groups in the euro zone. The Complainant claims to offer its services to approximately 11,8 million customers worldwide. The Complainant claims to have an international network targeted to corporate customers in 25 countries, including the Mediterranean countries, the United States (the Panels notes that this is the home country of the Respondent), Russia, China and India. These claims are not contested by the Respondent.

The Complainant contends that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark(s), and that the disputed domain name would not have been registered if it were not for Complainant’s trademark(s). The Complainant contends that the incorporation of an almost identical term to its well-known mark(s) into the disputed domain name, coupled with an inactive website, is evidence of bad faith registration and use. The fact that the Respondent registered a domain name that is confusingly similar to these distinctive and well-known trademarks indicates that the Respondent had knowledge of the Complainant’s trademarks at the time of registration and use of the disputed domain name. The Respondent did not dispute these claims.

The Complainant contends that on July 11, 2019 the Complainant’s attorneys sent a cease and desist letter to the Respondent, requesting the voluntary transfer of the disputed domain name. The Respondent did not comply with this request.

The registration of the Complainant’s "INTESA SANPAOLO" trademarks predate the registration of the disputed domain name.

The Panel finds that, on the balance of probabilities, it may be expected that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence of the Complainant's “INTESA SANPAOLO” trademark(s) and the scope of these trademarks. The Panel points to the fact that the Complainant has trademark rights to the terms “INTESA SANPAOLO” for banking and financial services in the home country of the Respondent (i.e., the United States of America). The term(s) selected by the Respondent (“JNTESASANPAOLO”) seem to have no meaning in any language (including in the Respondent’s home country) and seem only selected for their similarity to the Claimant’s registered “INTESA SANPAOLO” trademark(s). Indeed, the disputed domain name is almost identical to the Complainant's trademark(s) "INTESA SANPAOLO", except the first letter of the domain name is the letter “J” instead of the letter “I”. The Panel notes that the Complainant's “INTESA SANPAOLO” trademark is in itself a combination of two earlier (separate) marks, following a merger of the Italian banks Banca Intesa S.p.A. (trademark “INTESA”) and Sanpaolo IMI S.p.A. (trademark “SANPAOLO”) in 2007. This makes it even more unlikely that the Respondent would have chosen the term “JNTESASANPAOLO” independently from the Complainant’s trademark(s). In light of this, it seems unlikely that the Respondent would not have been aware of the unlawful character of the disputed domain name at the time of its registration and use.

In the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel believes from the facts in this case that the Respondent had the "INTESA SANPAOLO" trademark(s) of the Complainant in mind when registering and subsequently using the disputed domain name.

For all of the reasons set out above, the Panel determines that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JNTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2019-11-05

Publish the Decision