Decision for dispute CAC-UDRP-102754

Case number	CAC-UDRP-102754
Time of filing	2019-10-30 09:18:42
Domain names	intesasanpaoloonline.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	Martin Duccato

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is an Italian-based banking group with an international business and is the owner, among others, of the following registrations for the trademarks “INTESA” and “INTESA SANPAOLO”:

• International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in class 36;
• International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in class 36, also covering the United States of America;
• EU trademark registration n. 12247979 “INTESA”, applied on October 23, 2013 and granted on March 5, 2014, in classes 9, 16, 35, 36, 38, 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.

The Complainant is also the owner, among the others, of the following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”: <intesasanpaolo.com>, <intesasanpaolo.org>, <intesasanpaolo.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> 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 which are now connected to the official website < www.intesasanpaolo.com>.

FACTUAL BACKGROUND

The disputed domain name <intesasanpaoloonline.com> was registered on 1 July 2019 and resolves to a website that provides inter alia links to competitors of the Complainant.

There is no information available about the Respondent except that which is provided in the Complaint and the Registrar's WhoIs.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant's submissions are set out below.

RESPONDENT:

No response was received from the Respondent.

RIGHTS

The Complainant relies on its rights in its INTESA SANPAOLO and INTESA trademarks established through its ownership of its portfolio of trademark registrations described above and its use of the mark in business. The Complainant states that it is the leading Italian banking group with a market capitalization exceeding 38.1 billion, approximately 3,900 branches offering offers its services to approximately 11,8 million customers. It also has a strong international presence. In Central-Eastern Europe it has a network of approximately 1.100 branches and over 7,2 million customers. It 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 submits that 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 INTESA as it exactly reproduces INTESA SANPAOLO trademark, with the mere addition of the English descriptive term "online".

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant submits that the Respondent has no rights in the disputed domain name; that any use of the trademarks "INTESA SANPAOLO" and "INTESA" must be authorized by the Complainant; that Complainant has not authorized or licensed anyone to use the disputed domain name.

The Complainant adds that the disputed domain name does not correspond to the name of the Respondent, that to the best of Complainant's knowledge, the Respondent is not commonly known as "intesasanpaoloonline"; and referring to the home page to which the disputed domain name resolves, that there is no evidence of any fair or non-commercial uses of the disputed domain name.

BAD FAITH

The Complainant submits that the disputed domain name was registered and is used in bad faith arguing that its INTESA SANPAOLO and INTESA trademarks are distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to the Complainant's trademarks indicates that at the time of

registration, the registrant had knowledge of them.

In addition, Complainant submits that even a basic Google search in respect of the words “INTESA SANPAOLO” and “INTESA”, would have yielded obvious references to the Complainant. The Complainant submits in an annex to the Complaint an extract of a Google search in support of its assertion and argues that it is more than likely that the disputed domain name would not have been registered if it were not for Complainant’s trademark.

The Complainant adds that the disputed domain name is not used for any bona fide offerings of goods or services. Instead, 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 (par. 4(b)(iv) of the Policy).

The disputed domain name resolves to a website sponsoring, among others, banking and financial services, for which the Complainant’s trademarks are registered and used. Consequently, Internet users, while searching for information on the Complainant’s services, are intentionally misdirected to competitor’s websites, diverting traffic away from the Complainant’s website. The Complainant submits that several decisions of panels established under the Policy have held that the registration and use of a domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy including Encyclopaedia Britannica Inc. v. Shedon.com, WIPO Case No. D2000-0753 (“Respondent’s Ownership of a site which is a mis-spelling of Complainant’s britannica.com site and which Respondent used to hyperlink to a gambling site demonstrates Respondent’s bad faith registration and use of the britannnica.com domain name”).

The Respondent adds that the practice of using domain names to divert Internet traffic is very frequent in the banking realm due to the high number of online banking users and the Complainant has already been party in other cases under the Policy where the panels have ordered the transfer or the cancellation of the disputed domain names, detecting bad faith registration and use.

Finally, the Complainant asks this Panel to note that on 31 July 2019 the Complainant’s attorneys sent to the Respondent a cease and desist letter asking for the voluntary transfer of the disputed domain name and the Respondent did not comply with the Complainant’s demand.

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

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).

The Complainant has provided convincing evidence of its rights in the INTESA and INTESA SANPAOLO marks through its abovementioned trademark registrations.

The disputed domain name contains both the INTESA and INTESA SANPAOLO marks in their entirety and exactly reproduces “INTESA SANPAOLO” trademark, with the mere addition of the English descriptive term “online” and the gTLD extension. The word "online" is generic and the TLD extension may be ignored for the purposes of comparison.

In the circumstances this Panel finds that the disputed domain name is confusingly similar to the INTESA and INTESA SANPAOLO trademarks in which the Complainant has rights.

The Complainant has therefore succeeded in the first element of the test in paragraph 4(a)(i) of the Policy.

The Complainant has, to the satisfaction of this Panel made out a prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy) arguing that any use of the trademarks INTESA SANPAOLO and INTESA must be authorized by the Complainant but Complainant has not authorised or licensed anyone to use the disputed domain name.

The Complainant adds that the disputed domain name does not correspond to the name of the Respondent and, to the best of Complainant's knowledge, the Respondent is not commonly known as "intesasanpaoloonline"; and referring to the home page to which the disputed domain name resolves, that there is no evidence of any fair or non-commercial uses of the disputed domain name.

In such circumstances, it is well established that the burden of production shifts to the Respondent to establish his rights or legitimate interests. The Respondent has not filed any Response and has therefore failed to discharge the burden of production.

This Panel finds therefore that the Complainant has established on the balance of probabilities that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has therefore succeeded in the second element of the test in paragraph 4(a)(ii) of the Policy.

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.

The dominant and only distinctive elements of the disputed domain name are the words "INTESA SANPAOLO" and "INTESA" which are the Complainant's distinctive trademarks. Additionally as the Complainant submits even a basic Google search in respect of the words "INTESA SANPAOLO" and "INTESA", the would have yielded obvious references to the Complainant. Furthermore the Complainant's Internet domain names would have become apparent when the disputed domain name was being registered. It is therefore improbable that the disputed domain name was registered without the registrant being actually aware of the Complainant, its business and its rights in the trademarks that were intentionally incorporated into the disputed domain name. This Panel finds therefore that on the balance of probabilities the disputed domain name was registered to intentionally take advantage of the Complainant's reputation and goodwill.

This Panel is fortified in this conclusion by manner in which the disputed domain name has been subsequently used in bad faith to misdirect Internet traffic to competitors of the Complainant.

The Complainant has therefore succeeded in the third element of the test in paragraph 4(a)(iii) of the Policy and is entitled to the reliefs sought.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLOONLINE.COM**: Transferred

PANELLISTS

Name	**Mr James Jude Bridgeman**

DATE OF PANEL DECISION 2019-12-06

Publish the Decision