Decision for dispute CAC-UDRP-102902

Case number	CAC-UDRP-102902
Time of filing	2020-02-13 11:47:12
Domain names	intesa-gestion.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	alain fred

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 is the holder of trademark rights for the following marks:

- INTESA, International trademark registration No. 793367, granted on September 4, 2002 and duly renewed, in class 36;
- INTESA, EU trademark registration No. 12247979, granted on March 5, 2014 in classes 9, 16, 35, 36, 38, 41 and 42;
- a figurative trademark including the words "Intesa Gestione Crediti", EU trademark registration No. 1277367, granted on January 3, 2003 and duly renewed in class 36.

FACTUAL BACKGROUND

The Complainant, Intesa Sanpaolo S.p.A., is an Italian banking group resulting from the merger (effective as of January 1, 2007) between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. The Complainant has a market capitalisation exceeding 39,3 billion euro and a network of approximately 3,800 branches in Italy. The Complainant also has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,2 million customers. Moreover, the Complainant’s 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 of the registered word mark INTESA in several classes in numerous countries all over the world, including in France where the Respondent is located. The Complainant also holds a European figurative trademark including the words “Intesa Gestione Crediti”.

The disputed domain name has been registered on October 2, 2019 by the Respondent. According to an undated screen print provided by the Complainant, the disputed domain name has been used to resolve to a website in French language. The website displays the word INTESA and appears to offer financial services similar to the Complainant’s services.

On November 12, 2019, the Complainant’s attorneys sent a cease and desist letter to the Respondent, 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.

PARTIES' CONTENTIONS:

COMPLAINANT: The Complainant considers the disputed domain name to be confusingly similar to trademarks in which it has rights. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent does not use the disputed domain name in connection with any legitimate use. Also, according to the Complainant, the Respondent has not been authorized to register or use the disputed domain name. Finally, the Complainant considers that the disputed domain name was registered and is being used in bad faith. The Complainant contends that the Respondent knew, or at least should have known, of the existence of the Complainant’s trademarks. The Complainant further contends that the incorporation of the Complainant’s well-known trademark in the disputed domain name by the Respondent, coupled with a website reproducing the Complainant’s trademark and website layout, evidences bad faith registration and use.

RESPONDENT: The Respondent did not reply to the Complainant’s contentions.

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 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions

of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed, it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities, that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

2. The 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.

The Panel has therefore dealt with each of these requirements in turn.

1. Identity or confusing similarity

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant is the holder of the registered INTESA word marks and a figurative trademark including the words “Intesa Gestione Crediti”, which are used in connection with its business, it is established that there are trademarks in which the Complainant has rights.

The disputed domain name <intesa-gestion.com> incorporates the Complainant’s INTESA trademark in its entirety, merely adding a hyphen and the descriptive term “gestion”, the French word for “management”. In addition, the disputed domain name is similar to the textual components of the Complainant’s figurative INTESA GESTIONE CREDITI mark, merely leaving out the word “crediti” and the letter “e” in the word “gestion”. In these circumstances, the Panel finds that the confusing similarity is obvious.

It is well established that the Top Level Domains (“TLDs”) such as “.com” may be disregarded when considering whether the disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see section 1.11 WIPO Overview 3.0).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks. Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No rights or legitimate interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of proof to the Respondent (see section 2.1 WIPO Overview 3.0 and Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455; Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. The Respondent’s use and registration of the disputed domain name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Moreover, the Panel is of the opinion that the Respondent is not making a legitimate non-commercial or fair use of the

disputed domain name. According to an undated but uncontested screen print provided by the Complainant, the disputed domain name referred to a website offering financial services using the INTESA mark and mentioned cities in which the Complainant is located, including the city of the Complainant's registered offices.

UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on the Respondent (see section 2.13 WIPO Overview 3.0).

Based on the available record, the Panel finds that the Complainant has established a prima facie case, which was not refuted, and that the Respondent lacks rights or legitimate interests in the disputed domain name. Therefore, the Complainant has satisfied the second requirement that the Respondent has no rights or legitimate interests in the disputed domain name, under paragraph 4(a)(ii) of the Policy.

3. Bad faith

Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (see section 4.2 WIPO Overview 3.0 and e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070). In the instant case, the Panel finds that the Respondent must have had knowledge of the Complainant's rights in the INTESA trademark at the moment it registered the disputed domain name, since the Complainant's INTESA trademark is distinctive and widely used. The Panel also noticed that the website linked to the disputed domain name mentioned the Complainant's INTESA trademark in a way that is almost identical to the way the Complainant represents its INTESA mark on its official website. Apart from the almost identical font, the letter A is tilted to the right on both websites. This is a further indication of the Respondent's knowledge of the Complainant and its trademarks.

As mentioned before, the disputed domain name appeared to refer to a website offering financial services similar to the Complainant's services, mentioning the INTESA mark and cities in which the Complainant is located, including the city of the Complainant's registered offices.

The Complainant claims that this website was "clearly created in order to steal the confidential banking information of Complainant's clients", which is "undeniable evidence of phishing activity". However, the Complainant does not explain how the website linked to the disputed domain name may be used for such phishing activity. The Panel can only guess that the website's contact or connection pages included a request for personal information, but this is not demonstrated.

The Panel nevertheless finds that there are circumstances indicating that, by using the disputed domain name, 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 (par. 4(b)(iv) of the Policy).

UDRP panels have found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark:
- seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful;
- the lack of a respondent's own rights to or legitimate interests in a domain name;
- absence of any conceivable good faith use (see section 3.1.4 WIPO Overview 3.0).

In the present case, the Panel finds that the website linked to the disputed domain name is likely to cause confusion with the Complainant's INTESA mark. The uncontested lack of the Respondent's own rights to or legitimate interests in the disputed domain name has already been mentioned above. Finally, given the distinctive character and wide use of the Complainant's mark, the Panel finds it difficult to conceive any plausible good faith use of the disputed domain name by the Respondent in the future.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-GESTION.COM**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2020-03-19

Publish the Decision