Decision for dispute CAC-UDRP-102918

Case number	**CAC-UDRP-102918**
Time of filing	**2020-02-20 12:26:36**
Domain names	**gruppobancaintesasanpaolo.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**intesa Sanpaolo S.p.A.**

Complainant representative

Organization	**Perani Pozzi Associati**

Respondent

Name	**Patrizia Bonetti**

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant submitted evidence that it is the registered owner of the following trademarks which incorporate the term “INTESA SANPAOLO” (hereafter the "Trademark" or the “Trademarks”). Said trademarks are registered in several countries around the world:

- 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.);
- 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. 5344544 “GRUPPO INTESA SANPAOLO” (word trademark), applied on September 28, 2006, registered on July 6, 2007 and duly renewed, valid for various classes including class 36 (“financial affairs”; etc.); and
- EU trademark registration n. 5302377 “BANCA INTESA SANPAOLO” (word trademark), applied on September 8, 2006, registered on July 6, 2007 and duly renewed, 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., two Italian banking groups. The Complainant claims to be among the top banking groups in the euro zone, with a market capitalization exceeding 39,3 billion euros. The Complainant claims to have a network of approximately 3,800 branches, with market shares of more than 15 % 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 1.000 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 SANPAOLO”, “GRUPPO INTESA SANPAOLO”, and “BANCA INTESA SANPAOLO” and different domain extensions (including 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, gruppointesasanpaolo.com, gruppointesasanpaolo.info, gruppointesasanpaolo.biz, gruppointesasanpaolo.org, gruppointesasanpaolo.net, gruppointesasanpaolo.eu, bancaintesasanpaolo.com, bancaintesasanpaolo.biz, bancaintesasanpaolo.info, bancaintesasanpaolo.net, bancaintesasanpaolo.org, bancaintesasanpaolo.eu, bancaintesasanpaolo.it and bancaintesasanpaolo-group.com. 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 this assertion.

The disputed domain name was registered on September 8, 2019.

The domain is currently not in use.

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

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that a complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
(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.

1. Confusing similarity

The disputed domain name consists of the Complainant's Trademark(s), mentioned above, adding the terms “gruppo banca”, “gruppo”, or “banca”, depending on the specific Trademark, and the “.com” suffix.

All of the above-mentioned Trademarks of the Complainant are fully incorporated in the disputed domain name. In other words, every term that is used in the disputed domain name can also be found in at least one of the Complainant’s Trademarks; whether it be:
o GRUPPOBANCAINTESASANPAOLO (i.e. Complainant’s Trademarks n. 920896 and 5301999);
o GRUPPOBANCAINTESASANPAOLO (i.e. Complainant’s trademark n. 5344544); or
o GRUPPOBANCAINTESASANPAOLO (i.e. Complainant’s trademark n. 5302377).

The terms “gruppo banca” translate into “banking group”, which is the Complainant’s core business. The Panel notes also that the Complainant’s Trademarks are specifically registered for financial services. 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 the Trademarks 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 a 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 Respondent did not file an administratively complaint (or any) response.

The Complainant contends that:
(1) The Respondent has not been granted any license or authorisation to make any use of the Complainant’s Trademark(s), or to register or use the disputed domain name.
(2) The Respondent is not known under the disputed domain name, and the disputed domain name does not correspond with the name of the Respondent.
(3) The disputed domain name redirects to a page without any substantial content except an error message. The Respondent has not made any use of the disputed domain name since its registration, which confirms that the Respondent

has no demonstrable plan to use the disputed domain name.
The contentions of the Complainant are not contested by the Respondent.

The Panel finds that the Complainant has at least made a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

This finding is based on a combination of the following facts and arguments:

(1) the Respondent does not seem to be related to the Complainant, and seems not to have received any license or authorization to use the Complainant's Trademarks or any variation of it;

(2) the Respondent does not seem to be commonly known by the disputed domain name, nor does the name of the Respondent correspond with the disputed domain name; and

(3) there is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name (or has any future plans to do so), without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks at issue. 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. At the time of filling the complaint, the disputed domain name had been registered for over 5 months, which, according to the Panel, should be enough time for the Respondent to make use of the disputed domain name or demonstrate its rights or legitimate interests.

The Panel notes that the contentions of the Complainant are not contested by the Respondent. The Respondent did not provide evidence that it has rights or legitimate interests in the disputed domain name (the Respondent could, inter alia, have provided evidence of the factors mentioned in paragraph 4(c) of the Policy, but did not do so).

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

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 Trademarks and the scope of these Trademarks.

The Complainant asserts that its Trademarks are distinctive and well-known. 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, Russia, China and India. These claims are not contested by the Respondent. The Complainant has submitted evidence that a Google search for the terms "INTESA SANPAOLO", "GRUPPO INTESA SANPAOLO" and "BANCA INTESA SANPAOLO" results in multiple search results linked to the Complainant (including the first search result). The Complainant further asserts that it is more than likely that the Respondent had knowledge of the Complainant's Trademark at the time of registration of the disputed domain name, and that the disputed domain name at issue would not have been registered if it were not for Complainant's Trademarks. The Complainant sees no other reason that the Respondent has registered the disputed domain name than to sell the domain name to the Complainant or to one of its competitors. According to the Complainant, this assertion is reinforced by the fact that the disputed domain name refers to an empty web page. The Complainant argues that the passive holding of a disputed domain name may be regarded as use in bad faith, especially when 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.

The Panel finds that there is sufficient evidence to conclude that the disputed domain name was registered and is being used in bad faith. 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 Trademarks of the Complainant in mind when registering and using the disputed domain name.

The registration of the Complainant's Trademarks predate the registration of the disputed domain name.

The disputed domain name is currently not in use. At the time of filling the complaint, the disputed domain name had been registered for over 5 months, which, according to the Panel, should be enough time for the Respondent to make a bona fide use 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 Trademarks and the scope of these Trademarks. The Panel points to the fact that the Complainant has trademark rights to the terms "INTESA SANPAOLO", "GRUPPO INTESA SANPAOLO", and "BANCA INTESA SANPAOLO" for banking and financial services in the home country of the Respondent (i.e. Italy). Moreover, the home country of the Respondent is also the home country of the Complainant, which increases the likeliness that the Respondent had knowledge of the existence of the Complainant, its activities and its Trademarks.
All of the Complainant's Trademarks are fully incorporated in the disputed domain name. In other words, every term that is used in the disputed domain name can also be found in at least one of the Complainant's Trademarks. Moreover, the Respondent chose to register a domain name consisting of the name of the Complainant in combination with the terms "gruppo" and "banca", which literally translates into "banking group", which is the Complainant's core business.

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 terms "INTESASANPAOLO" independently from the Complainant's Trademarks, let alone in combination with the terms "gruppo" and "banca". 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 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. **GRUPPOBANCAINTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2020-04-08

Publish the Decision