Decision for dispute CAC-UDRP-102919

Case number	CAC-UDRP-102919
Time of filing	2020-02-20 09:14:22
Domain names	intesasanpsolo.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	Gavin Kent

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant is the owner of a number of trademark registrations covering various jurisdictions including the following:

- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in connection with class 36;

- 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. 12247979 “INTESA”, filed on October 23, 2013 and granted on March 5, 2014, in connection with classes 9, 16, 35, 36 38, 41 and 42; and

- 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.

FACTUAL BACKGROUND

The following facts asserted by the Complainant and not contested by the Respondent:

The Complainant is the leading Italian banking group and also one of the most prominent figures 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 38,1 billion euro, and it is the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). With 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 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 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 disputed domain name is confusingly similar to the Complainant's trademarks as it reproduces the INTESASANPAOLO trademark but with the mere substitution of the letter "A" with the letter "S" in the „PAOLO" portion of the trademark. It also adds the .com TLD. Further, the disputed domain name is connected to a website sponsoring links to other businesses including banking and financial services. The Respondent thus has no rights or legitimate interests in the disputed domain name and it is not authorised to use the Complainant's trademark, it is not commonly known by the name, and it is not making a bona fide or fair use of the disputed domain name. Further, the use of a typographical variation of the Complainant's trademark for a domain name that resolves to a website with monetized links to the Complainant's competitors, indicates that the disputed domain name was registered and used in bad faith.

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

Trademark Rights and Identity or Confusing Similarity

Sufficient evidence has been submitted by the Complainant of its trademark rights in the words INTESA and INTESA SANPAOLO for various banking and other financial services. Further, the Complainant is the owner of the <INTESA.COM> and <INTESASANPAOLO.COM> domain names, amongst others, that incorporate its trademarks. These were created and registered long prior to the September 9, 2019 creation date of the disputed domain name. As such, the Panel finds that the Complainant possesses rights in its INTESA and INTESA SANPAOLO trademarks.

Next, UDRP panels have consistently held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011) („the mere addition of the words ‚Ninjago' and ‚Kai' is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant's trademark.").

In the present case, the disputed domain name consists of a typographical variation of the INTESA SANPAOLO trademark plus the „.com" TLD. The use of this descriptive phrase does not, in this case, reduce the confusing similarity between the disputed domain name and the Complainant's trademark. Aon Corporation v. Zeld Garino, Claim No. FA 1819274 (FORUM, December 31, 2018) (confusing similarity found where „Respondent adds the generic term ‚asset management' and the gTLD ‚.com' to Complainant's mark and [where] the words ‚asset management' are directly relevant to one of the services provided by the Complainant.").

In light of the above, the Panel concludes that the Complainant possesses rights to the INTESA trademark and that the disputed domain name is confusingly similar to such mark under Paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy directs an examination of the facts to determine whether a respondent has rights or legitimate interest in a domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or interests.

The first example, under Paragraph 4(c)(i), is where "before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services". Here, the Respondent is using the disputed domain name to resolve to a parking page that contains pay-per-click links which, in turn, redirect Internet users to a variety of third-party websites that are not associated with the Complainant but which may be associated with its competitors. Therefore, this Panel concludes that the Respondent is using the disputed domain name to seek pay-per-click revenue through those diverted Internet users who are trying to reach the Complainant but, due to the confusing similarity of the disputed domain name with the Complainant's trademark, end up at the Respondent's website instead. Past decisions under the Policy have held that such use of a confusingly similar domain name is not a bona fide offering of goods or services. See, e.g., Loro Piana S.p.A. v. Y. v. Oostendorp, CAC Case No. 101335 (use of a disputed domain name that copies the complainant's trademark to resolve to a pay-per-click website "cannot be considered a bona fide offering of goods or services....").

The second example, under Paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant has made an unrebutted prima facie case showing that the name used by the Respondent in the Whois record for the disputed domain name is Gavin Kent. This name does not bear any similarity to the words INTESA or SANPAOLO. There is no other evidence in the record to suggest that the Respondent is commonly known by the disputed domain name, that it is licensed or otherwise authorized to use the Complainant's trademark, or that it has acquired any trademark rights relevant thereto. As such, this sub-section of the Policy is of no help to the Respondent.

As to the third example, under Paragraph 4(c)(iii) of the Policy, there is no evidence 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 INTESA or INTESA SANPAOLO trademarks. As the disputed domain name resolves to a classic pay-per-click website with links to the Complainant's competitors, this does not rebut the assertion that its use is not fair as it does not fit in to any accepted category of fair use such as news reporting, commentary, political speech, education, nominative or generic use, etc.

In light of the above analysis, and with no Response or other submission in this case to rebut the Complainant's assertions,

this Panel finds that the facts of this case do not demonstrate that the Respondent has any rights or legitimate interest in any of the disputed domain name under Paragraph 4(a)(ii) of the Policy.

Bad Faith

Finally, the Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. Hallmark Licensing, LLC v. EWebMall, Inc., Case No. D2015-2202 (WIPO, February 12, 2016) ("The standard of proof under the Policy is often expressed as the ‚balance of the probabilities' or ‚preponderance of the evidence' standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.").

The Complainant first asserts that the Respondent was on actual notice of the INTESA and INTESA SANPAOLO trademarks at the time it registered the disputed domain name. The evidence in this case demonstrates that these trademarks have been used extensively around the world and have become well-known prior to the date on which the disputed domain name was created. Further, It has been held in prior decisions that a Respondent's activity can form the basis upon which to build a finding of bad faith domain name registration. 7-Eleven, Inc. v. charles rasputin, FA 1829082 (FORUM Mar. 9, 2019) (in relation to the domain name 7elevendelivered.com and others, „Respondent had actual knowledge of Complainant's rights in the 7 ELEVEN mark at the time of registering the infringing domain names. Actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain name can evince bad faith under Policy 4(a)(iii)."). The Complainant's trademarks are also rather distinctive and, with no explanation or submission from the Respondent, this Panel concludes that it is more likely than not that the phrase INTESA SANPAOLO has been used in the disputed domain name with knowledge of the Complainant's trademark rights.

Next, the Complaint asserts that the disputed domain name is being used for a pay-per-click website to divert users to the Complainant's competitors based upon confusion with its INTESA SANPAOLO trademark. Such activity has routinely been held to demonstrate bad faith use of a domain name that is confusingly similar to a complainant's trademark. Arla Foods Amba v. I S / ICS INC, 101764 (CAC Dec. 22, 2017) (bad faith is found in a case where "the Disputed domain name is pointing to a pay-per click website using advertisements and is not used with real content."). This is made worse, the Complainant claims, because it is a big financial institution with a high number of online users and it has been the target of quite a lot of user diversion through cybersquatting.

In light of the evidence presented and in accordance with paragraph 4(b)(iv) of the Policy, the Panel finds that the disputed domain name has been used in bad faith as it creates a likelihood of confusion with the INTESA and INTESA SANPAOLO trademarks and resolve to a website for the commercial gain of either the Respondent or of those entities to whom the pay-per-click links resolve. In Focus Do It All Group v. Athanasios Sermbizis, WIPO Case No. D2000-0923 the Panel found that "[I]t is enough that commercial gain is being sought for someone" for a use to be commercial".

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all of the elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPSOLO.COM**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2020-03-23