Decision for dispute CAC-UDRP-102933

Case number	CAC-UDRP-102933
Time of filing	2020-02-26 10:28:24
Domain names	INTESASANPAOLO-GROUPHOME.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	rosario furno

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 is the owner, among others, of the following registrations for the trademark “INTESA SANPAOLO”:

- 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. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38;

- EU trademark registration n. 5344544 “GRUPPO INTESA SANPAOLO”, filed on September 28, 2006, granted on July 6, 2007 and duly renewed, in connection with classes 35, 36 and 38; and

-EU trademark registration n. 8158883 “INTESA SANPAOLO GROUP SERVICES”, applied on March 16, 2009, granted on September 24, 2009 and duly renewed, in classes 16 and 36.

FACTUAL BACKGROUND

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

The Complainant submits that the Complainant is:

- the leading Italian banking group and also one of the protagonists in the European financial arena;

- 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; and

- among the top banking groups in the euro zone, with a market capitalisation exceeding 39,3 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

In addition, the Complainant submits that:

- the complainant has a strong foothold not only in Italy but also in Central and Eastern Europe with a network of approximately 1.000 branches and over 7,2 million customers; and

- the Complainant has an 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 further asserts that:

- the Respondent is not known as by the disputed domain name;

- the Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks, or apply for registration of the disputed domain names by the Complainant; and

- the Respondent was aware of the Complainant when registering the disputed domain name on August 5, 2019.

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)
The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to the Complainant's trademarks (within the meaning of paragraph 4(a)(i) of the Policy). In particular, the Panel finds that the disputed domain name is almost identical to the Complainant's trademark "INTESA SANPAOLO".

In this regard, it shall be noted that <INTESASANPAOLO-GROUPHOME.COM> exactly reproduces the trademark "INTESA SANPAOLO", with the mere addition of the generic term "-GROUPHOME". The addition of "group" is a general description of a holding company and "home" a generic term that is commonly interpreted as the home page of a website of the Complainant. Both terms do not add a distinctive element to the disputed domain name, but, on the contrary, increases the likelihood of confusion between the domain name and the Complainant’s trademark.

(2)
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).

The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent, which did not file any Response to the Complaint.

As a matter of fact, there are no arguments why the Respondent could have own rights or legitimate interests in the disputed domain name. "INTESA SANPAOLO" definitely is a distinctive sign used by the Complainant both as business name and as trademark in order to denote its services. Therefore, the Panel accepts the contentions of the Complainant that the Respondent has no such rights or legitimate interests in <INTESASANPAOLO-GROUPHOME.COM>.

(3)
The Complainant has, to the satisfaction of the Panel, shown the disputed domain name to has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

There is no explanation proving that the Respondent has made use of, or demonstrable preparations to use, of the disputed domain name in connection with a bona fide offering of goods or services, nor that it is making a legitimate non-commercial or fair use of the disputed domain name, nor that is commonly known as <INTESASANPAOLO-GROUPHOME.COM>.

In the absence of a Response and given the considerable reputation of the Complainant and its trademarks, the Panel infers that the Respondent had the Complainant's trademarks in mind when registering the disputed domain name. As a matter of fact, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as an infringement of the Complainant’s rights under trademark law.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO-GROUPHOME.COM**: Transferred

PANELLISTS

Name	**Prof. Dr. Lambert Grosskopf, LL.M.Eur.**

DATE OF PANEL DECISION 2020-03-29

Publish the Decision