# Decision for dispute CAC-UDRP-102949

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| Case number | CAC-UDRP-102949 |
| Time of filing | 2020-04-23 09:50:16 |
| Domain names | ISP-INTESASANPAOLO.COM |

## Case administrator

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| Organization | Iveta Špiclová (Czech Arbitration Court) (Case admin) |

## Complainant

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| Organization | Intesa Sanpaolo S.p.A. |

## Complainant representative

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| Organization | Perani Pozzi Associati |

## Respondent

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| Name | lina santos |

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided, and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant 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 classes 9, 16, 35, 36, 41, 42;

- 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; 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.

Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”: INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .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 them are now connected to the official website http://www.intesasanpaolo.com of Complainant.

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FACTUAL BACKGROUND

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

The Complainant is the leading Italian banking group and also one of the protagonists 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 26,1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,800 branches capillary and well distributed throughout the Country, with market shares of more than 15% in most Italian regions, the Group offers its services to approximately 11,8 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.000 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 Complainant is the owner of several registrations for the trademarks “INTESA” and “INTESA SANPAOLO” and also the owner of several domain names bearing the signs “INTESA SANPAOLO” and “INTESA”.

On January 3, 2020 the Respondent registered the disputed domain name.

The Complainant states 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 a matter of fact, ISP-INTESASANPAOLO.COM exactly reproduces Complainant’s well-known trademark “INTESA SANPAOLO”, with the mere addition of the term “ISP”, which represents the abbreviation of Complainant’s mentioned trademark.

In the view of Complainant, Respondent has no rights to the disputed domain name, and any use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant. Nobody has been authorized or licensed by the Complainant to use the disputed domain name.

The disputed domain name does not correspond to the name of the Respondent and, to the best of Complainants knowledge, the Respondent is not commonly known as “ISP-INTESASANPAOLO”.

Lastly, Complainant cannot find any fair or non-commercial use of the disputed domain name.

The disputed domain name was in the view of Complainant registered and is used in bad faith:

The Complainant’s trademarks “INTESA SANPAOLO” and “INTESA” are distinctive and well-known all around the world.

The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wordings “INTESA SANPAOLO” and “INTESA”, the same would have yielded obvious references to the Complainant.

This raises a clear inference of knowledge of the Complainant's trademark on the part of the Respondent. Therefore, it is more than likely that the disputed domain name would not have been registered if it were not for Complainant's trademark.

This is in the view of Complainant a clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating 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.

The disputed domain name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used. Consequently, Internet users, while searching for information on the Complainant's services, are confusingly led to the websites of the Complainant's competitors, sponsored on the websites connected to the disputed domain name.

Therefore, the Complainant deems that the Respondent has registered and is using the disputed domain name in order to intentionally divert traffic away from the Complainant's website.

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

A. Identical or confusingly similar with Complainant's trademark

The Complainant owns "Intesa Sanpaolo" trademark registrations effective in various jurisdictions.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain name incorporates the entire Complainant's trademark "Intesa Sanpaolo" with adding the letters "ISP" divided by the sign "-" at the beginning of the disputed domain name.

As stated in WIPO Overview 3.0 “where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element” (see par. 1.8).

In the present case, the Complainant’s trademark is clearly recognizable in the disputed domain name and the addition of the generic letters "ISP" divided by an minus sign from the trademark "Intesa Sanpaolo” of Complainant does not lead to a different conclusion.

The .com domain zone shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The Respondent did not respond.

When a respondent remains completely silent in the face of a prima facie case that it lacks any rights or legitimate interests in respect of a domain name, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. Here the Complainant has presented an abundance of evidence to show that the Respondent has no plausible right or legitimate interest in respect of the disputed domain name and the Panel so finds.

The disputed domain name redirects to a parking page with commercial links and previous panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use (see e.g. CAC Case No. 102862 and WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe).

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

The Panel believes that Respondent registered the disputed domain name with full knowledge of Complainant's rights. The disputed domain name was registered more than ten years after the registration of the trademarks and the domain names of the Complainant and Complainant used it widely since then.

Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. If the Respondent had carried even a basic Google search in respect of the wording “INTESA SANPAOLO”, the same would have yielded obvious references to the Complainant.

Besides, the evidence on record shows that the disputed domain name redirects to a parking page with commercial links. Respondent’s use of the disputed domain name for a parking page is in itself sufficient to support a finding of bad faith use as Respondent is intentionally attempting to attract Internet users to its website for commercial gain, and is thus creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent’s website, in accordance with paragraph 4(b)(iv) of the Policy.

All the circumstances of this dispute demonstrate that the Respondent targeted the Complainant by incorporating Complainant’s trademark with adding three letters at the beginning of the disputed domain name.

Besides, the Complainant contends that the Respondent choose to register the domain names to create a confusion with domain name used by the Complainant. The Panel agrees with Complainant.

Based on the above, the Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

## PANELLISTS

| Name | **Jan Christian Schnedler, LL.M.** |
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DATE OF PANEL DECISION 2020-05-16

Publish the Decision