Decision for dispute CAC-UDRP-103031

Case number	CAC-UDRP-103031
Time of filing	2020-04-30 09:46:50
Domain names	INTESASANPAOLO-INTE.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	luca RAGNOLO

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of a number of international and EU trade marks for INTESA SANPAOLO and INTESA including the following trade mark: EU word trade mark for INTESA SANPAOLO under number 5301999 in classes 35, 36, 38. This trade mark was registered on 18 June 2007.

FACTUAL BACKGROUND

The Complainant, Intesa Sanpaolo S.P.A. is an Italian multinational bank with a business address at Piazza San Carlo 156, Turin, Italy. It provides retail, corporate and wealth management services. The Complainant is the registered owner of a number of international and EU trade marks for INTESA SANPAOLO and INTESA including the following trade mark:

- EU word trade mark for INTESA SANPAOLO under number 5301999 in classes 35, 36, 38. This trade mark was registered on 18 June 2007.

The Complainant has used the INTESA SANPAOLO mark in global business since in or around 2007. It operates its main company website at <intesasanpaolo.com>.

The Respondent is Luca Ragnolo with a business address at Via Rigatella 20 80100 Napoli AG Italy. He is the registered owner of the disputed domain name <intesasanpaolo-inte.com>. The disputed domain name was registered on 18 October 2019.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant asserts it has registered rights in the EU word trade mark for INTESA SANPAOLO described above. It explains that it first used INTESA SANPAOLO in 2007 following a merger between Banca Intessa and Grupo Sanpaolo IMI. It further explains that its brand has gained substantial renown worldwide through global use of the INTESA SANPAOLO brand. It submits that it is considered one of the top banks in the Eurozone, in addition it asserts that it carries out substantial business in Central Eastern Europe, the United States, Russia, China and India.

The Complainant submits that the disputed domain name is identical or confusingly similar to its trade mark. It explains that the disputed domain name <intesasanpaolo-inte.com> reproduces its trade mark but for the inclusion of “inte”. In respect of this point, the Complainant notes that “inte” is probably a reference to “Intesa” the verb in its trade mark.

The Complainant claims that the Respondent has no rights or legitimate interest in the disputed domain name, the Respondent registered the disputed domain name in 2019 at least a decade after the Complainant registered its trade mark. It confirms that its organisation has not licensed or authorised the use of its trade mark in the disputed domain name.

The Complainant asserts that to the best of its knowledge the Respondent is not commonly known by the name “INTESASANPAOLO-INTE”.

The Complainant refers to the screenshot of <intesasanpaolo-inte.com> which contains a list of links to the Complainant’s competitors, submitted as evidence that the Respondent is not using the disputed domain name for a bona fide reason or non-commercial use.

The Complainant asserts that the disputed domain name <intesasanpaolo-inte.com> was registered and is used in bad faith.

The Complainant submits that its trade mark “INTESA SANPAOLO” is distinctive and well-known worldwide. It asserts that the Respondent was aware of the Complainant’s registered trade mark rights when it registered the disputed domain name.

The Complainant argues that if the Respondent had carried out a basic Google search it would have discovered evidence of the Complainant’s mark. The Complainant provides an extract from a Google search of INTESA SANPAOLO. The Complainant notes that this evidence raises a clear inference of knowledge of the Complainant’s trade mark by the Respondent. Accordingly, the Complainant explains that this is clear evidence that the disputed domain name was registered in bad faith.

The Complainant asserts that the disputed domain name is not used for a bona fide offering. Referring to 4(b)(iv) of the Policy, the Complainant notes 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 website.

The Complainant submits that the disputed domain name directs Internet users to the Complainant’s competitors via sponsored links. Therefore, the Complainant asserts that the Respondent has registered and is using the disputed domain name to intentionally divert traffic away from the Complainant’s website. In support of this point, the Complainant relies on a number of WIPO decisions that confirm the registration and use of a domain name to re-direct Internet users to websites of

competing organisations constitute bad faith registration and use under the Policy.

The Complainant notes that the current use of the disputed domain name which directs Internet users to the Complainant's competitors through the use of the Complainant's trade mark damages its trade mark, misleads its current customers and may result in it losing new customers.

The Complainant asserts that it is clear that the Respondent is making a commercial gain, as the sponsored activity being carried out by the Respondent is being remunerated.

In addition, on 4 November 2019 the Complainant submits that its attorneys sent a cease and desist letter to the Respondent requesting voluntary transfer of the disputed domain name. The Respondent did not comply with this request.

Therefore, the Complainant submits that the Respondent has engaged in abusive domain name registration and bad faith use has been established in accordance with the third element of the Policy.

RESPONDENT:

The Respondent did not submit an administratively compliant response.

RIGHTS

The Complainant has established that it owns EU word trade mark registration INTESA SANPAOLO number 5301999 in classes 35, 36 and 38 registered on 18 June 2007.

The Complainant's registered INTESA SANPAOLO trade mark is wholly contained in the disputed domain name. In fact, the disputed domain name is identical to the Complainant's trade mark apart from the addition of "inte". The Panel finds that the "inte" element is not material in these circumstances and does not function as a distinguisher.

Accordingly, the Panel finds that the disputed domain name is identical or confusingly similar to the trade mark for the purposes of paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

There is no evidence to suggest that the Complainant has licensed or authorised the Respondent to use its INTESA SANPAOLO trade mark or that the Respondent is commonly known by the disputed domain name or is using the website to which the disputed domain name resolves for a bona fide or legitimate non commercial purpose.

It appears that the disputed domain name is being used without authorisation, to re-direct Internet users to a parking page which includes website links to competitors of the Complainant. In the absence of any explanation to the contrary the Panel infers that this is for the Respondent's own commercial gain and does not represent a bona fide or legitimate use of the INTESA SANPAOLO mark.

For these reasons and as set out under "Bad Faith" below the Panel finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to respond or to rebut this case and for this reason and as set out under "Bad Faith" below, the Panel finds that the Complainant succeeds under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainant has demonstrated that it owns registered trade mark rights in the INTESA SANPAOLO trade mark as described above. The disputed domain name was registered on 18 October 2019 more than a decade after the Complainant's word mark INTESA SANPAOLO was first used in Italy and after it was registered as a European trade mark in 2007. Considering the degree of distinctiveness of the INTESA SANPAOLO mark and also the degree of renown of the

Complainant's mark in Italy, it seems to the Panel more likely than not that the Italian based Respondent was aware of the Complainant's mark when he registered the disputed domain name.

In this case the Respondent has used the disputed domain name to divert Internet users to the Complainant's competitors, via what appear to be sponsored links at the website to which the disputed domain name resolves. Under Paragraph 4(b)(iv) of the Policy it is evidence of registration and use in bad faith to attract Internet users intentionally for commercial gain to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location. It appears to the Panel that this is precisely the circumstance here and that absent any explanation from the Respondent it is more likely than not that the Respondent gains commercially from this arrangement.

The fact that the Respondent did not respond to the Complainant's cease and desist e-mail of 14 November 2019 only serves to reinforce the Panel's view of the Respondent's bad faith in this case.

Accordingly, the Panel finds that the Complainant has demonstrated that the disputed domain name was registered and used in bad faith and the Complainant succeeds under 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

The Complainant owns registered trade mark rights for its INTESA SANPAOLO mark. The disputed domain name wholly incorporates this mark and as a result the disputed domain name is identical or confusingly similar to the Complainant's trade mark.

There is no evidence that the Respondent was permitted to use the Complainant's INTESA SANPAOLO trade mark and no evidence that it was making a bona fide or non-commercial use of the disputed domain name. The Respondent use of the mark to divert Internet users to the Complainant's competitors is not considered a legitimate business.

The disputed domain name was registered at least a decade after the first use of the INTESA SANPAOLO mark in commerce in Italy and after its trade mark were registered. The INTESA SANPAOLO mark has an established reputation and is distinctive. As a result, it is likely that the disputed domain name was registered by the Italian based Respondent with prior knowledge of the Complainant's mark. The use of the disputed domain name to divert Internet users to a website featuring links to the Complainant's competitors together with the Respondent's failure to comply with the Complainant's pre-action cease and desist letter supports a finding that the disputed domain name was registered and 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. **INTESASANPAOLO-INTE.COM**: Transferred

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2020-06-03

Publish the Decision