Decision for dispute CAC-UDRP-103012

Case number	CAC-UDRP-103012
Time of filing	2020-04-30 09:45:36
Domain names	INTESASANPAOLOSONDAGGI.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

Organization	Vovici Corporation

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the registrant, among others, of the following trademarks:

- International trademark registration No. 920896 “INTESA SANPAOLO”, registered on March 7, 2007, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;

- International trademark registration No. 793367 “INTESA”, registered on September 4, 2002, for goods and services in class 36;

- EU trademark registration No. 5301999 “INTESA SANPAOLO”, registered on June 18, 2007, for goods and services in classes 35, 36 and 38;

The disputed domain name was registered by the Respondent on September 14, 2011.

FACTUAL BACKGROUND

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

The Complainant underlines that it is the leading Italian banking group.

The Complainant points out that it is the company resulting from the merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups.

The Complainant submits that it is among the top banking groups in the euro zone, with a market capitalisation exceeding 26,1 billion euro.

The Complainant declares that it has a network of approximately 3.800 branches throughout Italy and has approximately 11,8 million customers.

The Complainant states that it has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,2 million customers.

Moreover, the Complainant's 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 SANPAOLO" and "INTESA".

Moreover, the Complainant is also the owner, among others, of the following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”: 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, 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 pointing to the main Complainant’s website.

On September 14, 2011, the Respondent registered the domain name INTESASANPAOLOSONDAGGI.COM.

The Complainant argues that it is more than obvious that the disputed domain name is identical, or confusingly similar, to the Complainant’s trademarks.

The Complainant observes that the disputed domain name exactly reproduces the well-known trademark “INTESA SANPAOLO”, with the mere addition of the Italian descriptive term "SONDAGGI", which means “SURVEYS”.

The Complainant submits that the Respondent has no rights on the disputed domain name.

The Complainant points out that any use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant and that nobody has been authorized or licensed by the Complainant to use the disputed domain name.

The Complainant adds that the disputed domain name does not correspond to the name of the Respondent and that, to the best of its knowledge, the Respondent is not commonly known as “INTESASANPAOLOSONDAGGI”.

The Complainant highlights the passive holding of the disputed domain name and asserts that it does not find any fair or non-commercial uses of the disputed domain name.

The Complainant considers that the disputed domain name was registered and is used in bad faith.

The Complainant contends that the trademarks “INTESA SANPAOLO” and “INTESA” are distinctive and well known all around the world.

The Complainant argues that 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 trademarks at the time of registration of the disputed domain name.

The Complainant adds that if the Respondent had carried out even a basic Google search in respect of the words "INTESA SANPAOLO" and "INTESA", the same would have yielded obvious references to the Complainant.

The Complainant notes that this fact raises a clear inference of the Respondent's knowledge of the Complainant's trademarks.

The Complainant assumes that it is more than likely that the disputed domain name was registered with the Complainant's trademarks in mind.

The Complainant adds that the disputed domain name is not used for any bona fide offering of goods or services.

The Complainant argues that some circumstances indicate that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name.

The Complainant notes that countless UDRP decisions confirmed that the passive holding of a domain name with knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use.

The Complainant underlines that the consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. In particular, the Complainant notes that panels have tended to make such findings in circumstances in which, for example, a complainant's mark is well-known, and there is no conceivable use that could be made of the disputed domain name that would not amount to an infringement of the complainant's trade mark rights.

The Complainant notes that it has demonstrated the renown of its trademarks and that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which is so similar to the Complainant's domain names.

The Complainant states that it has already been targeted by some cases of phishing in the past few years.

The Complainant considers that, even excluding any "phishing" purposes or other illicit use of the domain name in the present case, no other possible legitimate use of the disputed domain name can be found.

The Complainant points out that the Respondent could also try to resell the disputed domain name to the Complainant, and this fact would represent an evidence of the registration and use in bad faith, according to paragraph 4(b)(i) of the Policy.

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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) The disputed domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership, among others, of the registered trademark "INTESA SANPAOLO", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

The disputed domain name differs from the Complainant's trademark "INTESA SANPAOLO" only by the addition of the Italian descriptive word "SONDAGGI", and of the top-level domain ".COM".

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case, the Italian descriptive term "SONDAGGI" has no impact on the distinctive part "INTESA SANPAOLO". It is well established that where the relevant trademark is recognizable within the domain name, the addition of other terms would not prevent a finding of confusing similarity.

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark "INTESA SANPAOLO".

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [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 trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

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

In particular, the Complainant states that:

- 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;

- the Respondent is not commonly known as "INTESASANPAOLOSONDAGGI";

- the Respondent is not using for any fair or non-commercial use the disputed domain name.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, the disputed domain name is not used in any active

website.

Taking into account that the disputed domain name does not correspond to the name of the Respondent, that the Respondent is not commonly known as the disputed domain name, that the Complainant has not authorized or licensed the Respondent to use the disputed domain name, that the disputed domain name is not used in any active website, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] 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 [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

The Panel observes that it is well established that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative. Therefore, even where a complainant is not able to demonstrate the literal application of one of the above-mentioned scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behaviour detrimental to the complainant’s trademark would also satisfy the complainant’s burden.

Taking into account the distinctiveness and reputation of the trademark “INTESA SANPAOLO”, the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark “INTESA SANPAOLO” when registering the disputed domain name. Other panels considered that knowledge of a corresponding mark at the time of the domain name’s registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100) and the Panel share this view.

The fact that the disputed domain name is not currently used does not prevent a finding of bad faith (see, for example, WIPO Case No. D2018-1264). Previous panels have indeed confirmed that the prerequisites under paragraph 4(a)(iii) of the Policy

can be met under the doctrine of passive holding, giving close attention to all circumstances of the Respondent's behaviour (see, for example, WIPO Case No. D2000-0003).

Without the need to assess whether paragraph 4(b)(i) of the Policy is applicable to the present case, the Panel, having taken into account the distinctiveness and reputation of the Complainant's trademark, the fact that no response to the Complaint has been filed, and the passive holding of the disputed domain name, considers that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLOSONDAGGI.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2020-06-07

Publish the Decision