Decision for dispute CAC-UDRP-103027

Case number	CAC-UDRP-103027
Time of filing	2020-05-12 09:37:11
Domain names	INTESASANPALO-CONVALIDA.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	Milen Radumilo

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings, either pending or decided, relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

For the purpose of this Complaint, the Complainant relies on the following earlier rights:

- International trademark registration no. 793367 INTESA, granted on September 4, 2002, in connection with class 36;

- International trademark registration no. 920896 INTESA SANPAOLO, granted on March 7, 2007 in connection with classes 9, 16, 35, 36, 38, 41 and 42;

- EU trademark registration no. 12247979 INTESA, filed on October 23, 2013, and granted on March 5, 2014, in classes 9, 16, 36, 38, 41 and 42;

- EU trademark registration no. 5301999 INTESA SANPAOLO, filed on September 8, 2006 and granted on June 18, 2007, in connection with classes 35, 36 and 38.

Moreover, the Complainant mentions that it is also the owner of various domain names including the distinctive signs

INTESA SAN PAOLO and INTESA, such as <intesasanpaolo.com>, <intesasanpaolo.org>, <intesasanpaolo.net>, <intesasanpaolo.info>, <intesasanpaolo.eu>, <intesasanpaolo.biz>, <intesa-sanpaolo.com>, <intesa-sanpaolo.org>, <intesa-sanpaolo.net>, <intesa-sanpaolo.info>, <intesa-sanpaolo.eu>, <intesa-sanpaolo.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 these domain names redirect to the Complainant's official website at "www.intesasanpaolo.com".

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 field. The Complainant 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.

The Complainant is also 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 Complainant offers its services to approximately 11,8 million customers.

Abroad, the Complainant 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 disputed domain name was registered on October 31, 2018.

At the time of the filing of the Complaint, the disputed domain name led to a webpage containing links also referring to the Complainant.

Before filing its Complaint, the Complainant sent a cease and desist letter to the contact e-mail address for the owner of the disputed domain name, asking for its voluntary transfer, but failed to receive any reply.

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

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

I. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (paragraph 4(a)(i) of the Policy)

The Panel is of the opinion that the disputed domain name is confusingly similar to the Complainant's earlier trademark INTESA SANPAOLO. As a matter of fact, this trademark is reproduced in the disputed domain name with a small typo contained in the last portion of the trademark. In particular, the word "paolo" is spelt "palo" in the disputed domain name. However, this minor difference is hardly noticeable, considering that it is placed at the end of a long wording, that it consists of the omission of a single letter and that the words "paolo" and "palo" are very similar one another.
Concerning the addition of the term "convalida", this is an Italian term meaning "validation". The addition of this generic term to a wording clearly referring to the Complainant and to its well-known trademark INTESA SAN PAOLO enhances the confusing similarity. As a matter of fact, the Internet users can perceive the term "convalida" as related to the online banking services offered by the Complainant; for instance, they can perceive that the disputed domain name leads to a website where the Complainant's customers can validate their requests. Moreover, the fact that the word "convalida" is in Italian also adds confusion as the Complainant is a well-known Italian banking group.

For all these reasons, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of rights or legitimate interests in respect of the disputed domain name (paragraph 4(a)(ii) of the Policy)

It is generally recognised that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

In the instant case, the Complainant maintains that the Respondent is not known to the Complainant and that the Complainant never licensed its trademarks to the Respondent, nor authorised the Respondent to include its trademarks in a domain name.

Moreover, the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, nor appears to be known by the disputed domain name.

As the Respondent failed to object to the Complainant's allegations, the Panel takes the view that the Complainant's statements are sufficient to establish a prima facie lack of rights or legitimate interests of the Respondent in the disputed domain name.

Thus, the Panel is satisfied that also the second condition under the Policy is met.

III. Bad faith (paragraph 4(a)(iii) of the Policy)

The Policy requires that in order to meet the third and last requirement under the Policy, the Complainant must successfully prove that both the registration and use of the disputed domain name have been made in bad faith.

Regarding bad faith registration, the Complainant states that its trademarks “INTESA SANPAOLO” and “INTESA” are distinctive and internationally well known. The fact that the Respondent registered a domain name that is confusingly similar to them indicates that the Respondent was aware of the Complainant’s trademark at the time of registration of the disputed domain name. Had the Respondent carried out a basic Google search in respect of the wordings “INTESA SANPAOLO” and

“INTESA”, the same would have yielded obvious references to the Complainant.

The Panel agrees with the Complainant that the Respondent was aware of the Complainant's trademark at the time of the registration of the disputed domain name. The trademark INTESA SANPAOLO is highly distinctive and enjoys reputation at least in Italy. The disputed domain name includes the Complainant's trademark entirely but for a small typo and it includes the generic Italian word "convalida" that fits perfectly well in the context of online banking services, which is one of the fields where the Complainant operate.

Furthermore, the Panel has noticed that the Respondent registered other domain names containing the Complainant's trademarks, such as <bancaintesasanpaolo.com>, <intbancasasanpaolo.com> and <intesabancasapaolo.com>. All these domain names were recently transferred to the Complainant following three UDRP proceedings (see CAC's decisions Nos. 102546, 102547 and 102232).

It follows from the above that the Respondent has clearly targeted the Complainant's trademarks, being well aware of their reputation and value. Thus, the Panel concludes that the Complainant has successfully proved that the disputed domain name was registered in bad faith.

With respect to the use of the disputed domain name in bad faith, the Complainant has provided evidence of the fact that at the time of the filing of the Complaint the disputed domain name led to a web page containing several links, some of which apparently related to the Complainant and others to other entities or activities. Moreover, the same web page includes a banner stating that the disputed domain name is offered for sale.

Whether the links appearing on the Respondent's website are automatically generated, originate by third parties, or are the result of the Respondent's activity is irrelevant as previous UDRP panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests). Likewise it is irrelevant whether or not the Respondent generates revenues from the links appearing on his website. The fact is that the Respondent is using a third party's renowned trademark either to lead the Complainant's customers or potential customers to its website without any authorisation, probably with the aim of receiving some economic advantage to this diversion, or to sell the domain name for an appropriate value. Such use of the disputed domain name cannot amount to a use of the disputed domain name in good faith. This is even more so considering that prior to initiating this dispute, the Complainant sent a cease and desist letter to the Respondent, offering to settle the dispute by transferring the disputed domain name to the Complainant. However, the Respondent failed to answer to the Complainant's letter, as such reiterating its bad faith in the use of the domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPALO-CONVALIDA.COM**: Transferred

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2020-06-19

Publish the Decision