Decision for dispute CAC-UDRP-103059

Case number	CAC-UDRP-103059
Time of filing	2020-05-14 11:40:07
Domain names	clienti-intesasanpaolo.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Zikow Maks

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns the following “INTESA SANPAOLO” trademark registrations:

-- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42; and
-- EU trademark registration n. 5301999 “INTESA SANPAOLO”, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

The disputed domain name was registered on February 16, 2020, i.e. the Complainant’s trademark registrations cited above predate the registration of the disputed domain name.

FACTUAL BACKGROUND

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

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 leading banking groups in the Euro zone, with a market capitalisation exceeding 26.1 billion euro. With market shares of more than 15% in most Italian regions, the Intesa Sanpaolo offers its services to approximately 11,8 million customers in Italy. Intesa Sanpaolo also has a strong presence in Central-Eastern Europe with a network of approximately 1,000 branches and over 7.2 million customers. Moreover, its international network specialised in supporting corporate customers is present in 25 countries, including the United States, Russia, China and India.

Complainant contends that Respondent is not affiliated with Complainant nor authorized by Complainant in any way to use the trademark “INTESA SANPAOLO”. Complainant does not carry out any activity for, nor has any business with Respondent. Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that Respondent is not related in any way to Complainant’s business. The disputed domain name does not correspond to the name of the Respondent, and the Respondent is not commonly known as “CLIENTI-INTESASANPAOLO”. According to Complainant, there is no fair or non-commercial use of the disputed domain name because it does not resolve to an active website.

Complainant further contends that Respondent has registered the disputed domain name in bad faith. Its trademark “INTESA SANPAOLO” is distinctive and well known around the world. The fact that Respondent has registered a domain name that is confusingly similar to this distinctive brand name indicates that Respondent had positive knowledge of Complainant’s trademark at the time of registration of the disputed domain name. In addition, if Respondent had performed even a basic Google search in respect of the phrase “INTESASANPAOLO”, the search results would have shown obvious references to Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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 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.

According to Article 11(a) of the Rules, “unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”.

The language of the Registration Agreement is Dutch. The Complainant, however, has requested that the language of the proceeding be English instead of Dutch.

The Panel uses its discretionary authority to decide that the language of the proceedings shall be English for the following reasons:

(a) Both the Complainant and the Respondent are located in Italy. While it would be understandable to conduct proceedings between two Italian Parties in Italian language, it is unclear why it would make any sense to conduct the proceedings in Dutch, which is usually not considered to be a “lingua franca”. It seems much more reasonable to conduct the proceedings in English, which is the most common foreign language in Italy (and more generally in Europe).

(b) The disputed domain name features the gTLD <.com>, which has a global connotation and stands for the English word “commerce”. English being the main language of international business, it seems that the disputed domain name was intended to reach not only a Dutch (or Italian) speaking public (for which a domain name under the corresponding ccTLDs <.nl> (or <.it>) would have been more appropriate).

(c) The Complainant has submitted its Complaint and supporting evidence in English. If the Complainant were required to submit all documents in Dutch, the administrative proceeding would be unduly delayed and the Complainant would have to incur substantial expenses for translation.

(d) The Respondent has neither submitted any objection to the use of English language, nor reacted in any other way which would indicate that the Respondent is unable to communicate in English.

PRINCIPAL REASONS FOR THE DECISION

Except for the space between “INTESA” and “SANPAOLO” (which for technical reasons cannot be represented in an internet domain name) and the suffix ".com" (which is also owed to the technical requirements of the domain name system), the only difference between Complainant’s trademark “INTESA SANPAOLO” and the disputed domain name is the is the descriptive prefix “CLIENTI-", which is insignificant to the overall impression. The Panel therefore finds the disputed domain name to be confusingly similar to the “INTESA SANPAOLO” mark in which Complainant has rights.

The Panel further finds that Complainant successfully submitted prima facie evidence that Respondent has neither made any use of, or demonstrable preparations to use, 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 Respondent.

The Panel also finds that the Complainant successfully submitted prima facie evidence that Respondent was aware of the Complainant's rights in the well-known designation “INTESA SANPAOLO” when registering the disputed domain name. Again, this prima facie evidence was not challenged by the Respondent, which supports the conclusion that the disputed domain name was REGISTERED in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Given the fact that the disputed domain name only resolves to the registrar’s standard template website, the primary question of this proceeding is whether or not the Respondent has also USED the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant's case regarding such bad faith use is that the Respondent is effectively engaged in “passive holding” of the disputed domain name within the terms originally established by Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. The panel in Telstra noted that the question as to which circumstances of “passive holding” may constitute use in bad faith cannot be answered in the abstract. This question may only be determined on the basis of the particular facts of each case. A panel should give close attention to all the circumstances of the Respondent's behaviour, and a remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith (cf. Sanofi-aventis v. Gerard Scarretta, WIPO Case No. D2009-0229; Mount Gay Distilleries Limited v. shan gai gong zuo shi, CAC Case No. 100707; RueDuCommerce v. TOPNET, CAC Case No. 100617; INFRONT MOTOR SPORTS LICENCE S.r.l. v. VICTOR LEE, CAC Case No. 100385).

With this approach in mind, the Panel has identified the following circumstances as material to the issue in the present case:

(i) The Complainant's trademark has a history of more than 10 year (with an even longer history of its two predecessors Banca Intesa S.p.A. and Sanpaolo IMI S.p.A.), a strong reputation, is highly distinctive and is widely known (particularly in

Italy where the Respondent is located);

(ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name, nor can the Panel conceive of any such good faith use;

(iii) taking into account the nature of the disputed domain name the Panel cannot conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law; and

(iv) finally, special care should be taken with regard to bank websites, as there is a continuous realistic risk that domain names comprising a bank's name will be abused for phishing attacks to illegally obtain customer's user credentials for online banking. In particular the prefix "CLIENTI" (which means "customers" in Italian) combined with the bank's name "INTESA SANPAOLO" could mislead customers to (wrongly) believe that the disputed domain name is used to operate an online banking website for the Complainant's customers.

Given all of these circumstances the Panel finds that the manner in which the disputed domain name is being used constitutes use in bad faith. The requirements of paragraph 4(a)(iii) of the Policy have therefore been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2020-06-25

Publish the Decision