Decision for dispute CAC-UDRP-103087

Case number	CAC-UDRP-103087
Time of filing	2020-05-29 09:05:10
Domain names	CLIENTE-INTESASANPAOLO.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	Reinhard Krauß

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns a series of trade marks consisting of the names INTESA and INTESA SANPAOLO, including the International trade mark INTESA, registration number 793367, first granted on 4 September 2002, in international class 36; the International trade mark INTESA SANPAOLO, registration number 920896, first granted on 7 March 2007, in international classes 9, 16, 35, 36, 41 and 42; the EU trade mark INTESA, registration number 12247979, first granted on 5 March 2014, in international classes 9, 16, 35, 36, 38, 41 and 42; and the EU trade mark INTESA SANPAOLO, registration number 5301999, first granted on 18 June 2007, in international classes 35, 36 and 38.

In addition, the Complainant owns multiple domain names consisting of the names INTESA and INTESA SANPAOLO, including: <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>; 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>, and <intesa.me>, which are all connected to the Complainant’s official website <intesasanpaolo.com>.

FACTUAL BACKGROUND

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

The Complainant is a leading Italian and Euro-zone banking group and resulted from the merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. in 2007. Intesa Sanpaolo has a market capitalisation exceeding 24,9 billion Euros, and provides retail, corporate and wealth management services through a network of approximately 3,700 branches located throughout Italy. The Complainant's group offers its services to approximately 11,8 million customers. 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, which specialises 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 Respondent registered the disputed domain name <cliente-intesasanpaolo.com> on 26 January 2020. As at the date of this decision, the disputed domain name resolves to a "403 error" page with the sole message "Forbidden" and "You don't have permission to access/on this server" and is inactive. There is no evidence before the Panel that the disputed domain name has ever been linked to an active website since it was registered.

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

With regard to the first UDRP element, the Panel finds that the disputed domain name <cliente-intesasanpaolo.com> is, if not identical with, then at least confusingly similar to the Complainant's trade marks INTESA and INTESA SANPAOLO. Indeed, the disputed domain name incorporates the Complainant's trade marks in their entirety. The addition of the generic and descriptive term "cliente" (or "client") is not sufficient to alter the overall impression of the designation as being connected to the Complainant's trade marks. The Panel notes in this connection that the term "cliente" is closely related to the Complainant's business activities as a financial services provider. The addition of the generic and descriptive term "cliente" does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trade marks, and its associated domain names; rather to the contrary, it increases the likelihood of confusion by suggesting that the disputed domain name provides access to a client portal for service users of the Complainant's business. The Panel follows in this respect the view established by numerous other decisions that a domain name that wholly incorporates a Complainant's trade mark may be sufficient to establish confusing similarity for the purposes of the UDRP (see, for example, WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy <porsche-autopartes.com>).

With regard to the second UDRP element, there is no evidence before the Panel to suggest that the Respondent has made

any use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Neither is there any indication that the Respondent is making legitimate non-commercial or fair use of the disputed domain name. As at the time of this decision, the disputed domain name is not being used for any active website but resolves to a "403 Forbidden" error page. A lack of content at the disputed domain has in itself been regarded by other panels as supporting a finding that the Respondent lacked a bona fide offering of goods or services and did not make legitimate non-commercial or fair use of the disputed domain name (see, for example, Forum Case No. FA 1773444, Ashley Furniture Industries, Inc v. Joannet Macket/JM Consultants). The Panel further finds that the Respondent is not affiliated with or related to the Complainant in any way and is neither licensed nor otherwise authorised by the Complainant to make any use of the Complainant's trade marks or to apply for or use the disputed domain name. Finally, the Whois information also does not suggest that the Respondent is commonly known by the disputed domain name <cliente-intesasanpaolo.com>. Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

With regard to the third UDRP element, the Complainant asserts that its trade marks INTESA and INTESA SANPAOLO are famous and well-known around the world. The Panel considers that it does not have sufficient evidence to support a finding that the Complainant's trade marks are indeed well-known and the Complainant has not pointed the Panel to any other decisions that would have contained such a finding. However, the name INTESA SANPAOLO is certainly distinctive and the Complainant adduced evidence to show that, if the Respondent had carried out Google search for the names INTESA and INTESA SANPAOLO, the search results would have yielded immediate and obvious references to the Complainant. It is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical with or confusingly similar to the Complainant's trade marks and that he registered the disputed domain name in full knowledge of the Complainant's trade marks.

Furthermore, the website related to the disputed domain name is currently inactive and resolves to an error page. The Respondent has not demonstrated any activity in respect of the disputed domain name. First, it is difficult to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate on the grounds that it would constitute passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trade mark law under circumstances where that disputed domain name corresponds to the Complainant’s trade marks and is similar to the Complainant’s domain names currently used by the latter to provide online banking services. Indeed, in its submissions, the Complainant expresses concerns that the disputed domain name may be used for "phishing", i.e., for attracting the customers of the Complainant's banking business to a web page which imitates the real page of the bank with a view to enticing customers to disclose confidential information and sensitive data, such as credit card or bank account numbers, user IDs, and passwords, for fraudulent purposes. Secondly, numerous other UDRP decisions have taken the view, which this Panel shares, that the passive holding of a domain name with knowledge that the domain name infringes another party’s trademark rights may in itself be regarded as evidence of bad faith registration and use (see, for example, WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; and WIPO Case No. D2004-0615, Comerica Inc. v. Horoshiy, Inc.).

Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Gregor Kleinknecht**

DATE OF PANEL DECISION 2020-07-08