Decision for dispute CAC-UDRP-103106

Case number	CAC-UDRP-103106
Time of filing	2020-06-16 08:52:29
Domain names	AGGIORNAMENTOINTESASANPAOLO.COM, AGGIORNAMENTOISPWEB.ONLINE

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	armando gara

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks, including the following trademark registrations:

- International trademark n° 793367 for the word mark “INTESA”, registered on September 4, 2002 for services in class 36;

- International trademark n° 920896 for the word mark “INTESA SANPAOLO”, registered on March 7, 2007 for goods and services in classes 9, 16, 35, 36, 41 and 42;

- European Union trademark n° 012247979 for the word mark “INTESA”, registered on March 5, 2014 for goods and service in classes 9, 16, 35, 36, 38, 41 and 42;

- European Union trademark n° 005301999 for the word mark “INTESA SANPAOLO”, registered on June 18, 2007, for services in classes 35, 36 and 38.

Such trademarks are hereinafter individually and jointly referred to as the "INTESA SANPAOLO trademarks".

FACTUAL BACKGROUND

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

The Complainant is a leading Italian banking group. It 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.

The Complainant has a market capitalisation exceeding 27,2 billion euro and has a network of approximately 3,700 branches distributed throughout Italy, with market shares of more than 15% in most Italian regions to provide its services to approximately 11,8 million customers. The Complainant also has a network of approximately 1.000 branches and over 7.2 million customers in Central and Eastern Europe and an international network specialised in supporting corporate customers in 25 countries, in particular in the Mediterranean area and those areas where Italian companies are most active, such as the United States of America, the Russian Federation, the People's Republic of China and India.

On December 19, 2019, the Respondent registered the disputed domain names, which are presently passively held.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the that disputed domain name <aggiornamentointesasanpaolo.com> 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).

However, the Panel did not find the disputed domain name <aggiornamentoispweb.online> to be identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

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 <aggiornamentointesasanpaolo.com> (within the meaning of paragraph 4(a)(ii) of the Policy).

In view of the Panel's decision with respect to paragraph 4(a)(i) of the Policy, the Panel did not have to decide if the Respondent has rights or legitimate interests in respect of the disputed domain name <aggiornamentoispweb.online>.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name <aggiornamentointesasanpaolo.com> has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

In view of the Panel's decision with respect to paragraph 4(a)(i) of the Policy, the Panel did not have to decide if the disputed domain name <aggiornamentoispweb.online> has been registered and is being used in bad faith.

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

1. According to standard case law, the top level domain, in this case ".com" and ".online," should be ignored when comparing

the disputed domain names and the INTESA SANPAOLO trademarks.

2. The Panel finds that the disputed domain name <aggiornamentointesasanpaolo.com> is confusingly similar to the "INTESA SANPAOLO" trademarks as the disputed domain name includes the INTESA SANPAOLO trademarks in its entirety, with the sole difference that the disputed domain name also includes the term "aggionamento", which means "update". The addition of such generic term does not take away the similarity between the disputed domain name and the INTESA SANPAOLO trademarks.

3. The Panel finds that Complainant did not shown that the disputed domain name <aggiornamentoispweb.online> is identical or confusingly similar to the INTESA SANPAOLO trademarks. The Complainant failed to show that it has rights as meant in paragraph 4(a)(i) of the Policy in the letters "ISP". The Complainant only mentioned that the letters "ISP" as part of the disputed domain name "reproduce the abbreviation of the INTESA SANPAOLO trademarks," but failed to show how the Complainant can claim trademark rights in such abbreviation, and why the addition of the words "aggiornamento" and "web" would not take away a possible similarity with the letters "ISP". As the Complaint did not meet the first requirement of paragraph 4(a) of the Policy, the Panel shall not have to decide if the disputed domain name <aggiornamentoispweb.online> meets the other requirements of paragraph 4(a) of the Policy.

4. The Panel finds that the Complainant successfully made a prima facie case that the Respondent has made no use of, or demonstrable preparations to use the disputed domain name <aggiornamentointesasanpaolo.com> in connection with a bona fide offering of goods or services, neither is Respondent making a legitimate non-commercial or fair use of this disputed domain name, nor is Respondent commonly known under the disputed domain name. The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name <aggiornamentointesasanpaolo.com>. The Complainant's allegations were not challenged by the Respondent.

5. In the absence of a Response, the Panel infers that the Respondent had the Complainant's "INTESA SANPAOLO" trademarks in mind when registering the disputed domain name <aggiornamentointesasanpaolo.com>, as it copied the entire "INTESA SANPAOLO" trademarks, while the trademarks are sufficiently distinctive that is it likely that the Respondent was familiar with the trademarks when it registered that disputed domain name. For these reasons the Panel finds that the disputed domain name <aggiornamentointesasanpaolo.com> was registered and is being (passively) used in bad faith.

Therefore, the Panel finds that all three elements under the paragraph 4(a) of the Policy have been proved by the Complainant with respect to the disputed domain name <aggiornamentointesasanpaolo.com>.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **AGGIORNAMENTOINTESASANPAOLO.COM**: Transferred
2. **AGGIORNAMENTOISPWEB.ONLINE**: Remaining with the Respondent

PANELLISTS

Name	**Alfred Meijboom**

DATE OF PANEL DECISION 2020-07-21

Publish the Decision