Decision for dispute CAC-UDRP-103122

Case number	CAC-UDRP-103122
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Domain names	INTESASANPAOLO-BANCA.COM, INTESASANPAOLO-IT.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	Repossessed by Go Daddy

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings, pending or decided, which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant owns EU word trade mark for INTESA SANPAOLO under number 5301999 in classes 35, 36, 38. This trade mark was registered on 18 June 2007.

FACTUAL BACKGROUND

The Complainant, Intesa Sanpaolo S.P.A. is an Italian multinational bank with a business address at Piazza San Carlo 156, Turin, Italy. Intesa Sanpaolo was established on 1 January 2007 following a merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. The Complainant provides retail, corporate and wealth management services. It is the registered owner of a number of international and EU trade marks for INTESA SANPAOLO and INTESA including the following trade mark:

-EU word trade mark for INTESA SANPAOLO under number 5301999 in classes 35, 36, 38. This trade mark was registered on 18 June 2007.

The Complainant has used the INTESA SANPAOLO mark in global business since in or around 2007. It operates its main company website at www.intesasanpaolo.com.

The Respondent is Repossessed by Go Daddy with a business address at 14455 N Hayden Rd, 85260 Scottsdale AZ, United States. It is the registered owner of the disputed domain names <intesasanpaolo-banca.com> and <intesasanpaolo-IT.com>. The disputed domain names were registered on 23 December and 26 December 2019, respectively.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant asserts it has registered rights in the EU word mark for INTESA SANPAOLO described above. It explains that it first used INTESA SANPAOLO in 2007 following a merger between Banca Intessa and Grupo Sanpaolo IMI. It submits that its brand has gained substantial renown worldwide through global use of the INTESA SANPAOLO brand. It submits that it is considered one of the leading banks in Italy and in the Eurozone, in addition it asserts that it carries out substantial business supporting corporate customers in over 25 countries including in Central Eastern Europe, the United States, Russia, China and India.

The Complainant submits that the disputed domain names are identical or confusingly similar to its trade mark. It says that the disputed domain name <intesasanpaolo-banca.com> reproduces its trade mark but for the inclusion of “banca”. It asserts that “banca” is the Italian for bank and descriptive of the services provided by the Complainant. The disputed domain name <intesasanpaolo-IT.com> again reproduces the Complainant’s trade mark but for the inclusion of “IT”. The Complainant notes that “IT” is most likely a reference to Italy, the location of the Complainant’s headquarters.

The Complainant claims that the Respondent has no rights or legitimate interest in the disputed domain names. It confirms that its banking group has not licensed or authorised the use of its trade mark in the disputed domain names.

The Complainant submits that the disputed domain names have no connection to the Respondent’s business name and it submits that to the best of its knowledge the Respondent is not commonly known by the names “INTESASANPAOLO-BANCA” and “INTESASANPAOLO-IT”.

The Complainant refers to the screenshots of <intesasanpaolo-banca.com> and <intesasanpaolo-IT.com> which the Complainant submits as evidence that the Respondent is not using the disputed domains name for any fair or non-commercial use.

The Complainant asserts that the disputed domain names were registered and are used in bad faith.

The Complainant submits that its trade mark “INTESA SANPAOLO” is distinctive and well-known worldwide. It follows, the Complainant says that the Respondent has registered domain names that are confusingly similar to its trade mark which it says indicates that the Respondent was aware of the Complainant’s registered trade mark rights at the time of registration of the disputed domain names.

The Complainant argues that if the Respondent had carried out a basic Google search it would have discovered evidence of the Complainant’s mark. The Complainant provides an extract from a Google search of INTESA SANPAOLO. Considering this evidence, the Complainant notes that there is a clear inference of knowledge of the Complainant’s trade mark by the Respondent. Accordingly, the Complainant explains that this is clear evidence that the disputed domain names were registered in bad faith.

The Complainant asserts that the disputed domain names are not used in connection with a bona fide offering of services. The Complainant refers to 4(b)(i) of the Policy, the Complainant submits that by using the disputed domain names the Respondent has registered or acquired the domain names primarily for the purpose of selling, renting, or otherwise transferring the domain name registrations to the Complainant who is the owner of the trade mark or service mark or to a

competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs.

Referring to the screenshots of the disputed domain names, the Complainant submits that the disputed domain names are not being used for a bona fide offering of services, even though they are not connected to any websites. The Complainant submits that the practise of passive holding of a domain name with knowledge that the domain name infringes another party's trade mark rights is evidence of bad faith registration and use. In support of this point, the Complainant relies on WIPO decision Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, and also previous panels' consensus views on this point as set out in paragraph 3.3 in the "WIPO Overview of WIPO Views on Selected UDRP Questions".

The Complainant notes that the consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may be consistent with a finding of bad faith. It further 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 domain name that would not amount to an infringement of the complainant's trade mark rights. In relation to the first point, the Complainant notes that it has established the renown of its trade mark. In regard to the second point, the Complainant asserts that there is no explanation as to what use the Respondent could put the disputed domain names to, in circumstances that the disputed domain names resemble the Complainant's trade mark and the domain name from which it offers its own banking services.

The Complainant argues that the present case matches the panels' requirements and should be considered passive holding. Referring to a previous finding by the panel, the Complainant notes that there is no need to await some future use of the disputed domain names to occur in order to demonstrate the Respondent's bad faith use.

The Complainant also raises concerns that the Respondent may have registered the disputed domain names for "phishing" purposes. In the past, its customers have been targeted, they have been diverted to a fake website, induced to provide personal information and have been cheated of savings as a result of this practise.

In the alternative, in circumstances where there could be no possible legitimate use of the disputed domain names, the Complainant submits that the Respondent may plan to sell the disputed domain names to the Complainant which is evidence of registration and use in bad faith according to paragraph 4(b)(i) of the Policy.

In addition, on 14 February 2020 the Complainant submits that its attorneys sent a cease and desist letter to the Respondent requesting voluntary transfer of the disputed domain names. The Respondent did not comply with this request.

Therefore, the Complainant submits that the Respondent has engaged in abusive domain name registrations and bad faith use has been established in accordance with the third element of the Policy.

RIGHTS

The Complainant has established that it owns EU word trade mark registration INTESA SANPAOLO number 5301999 in classes 35, 36 and 38 registered on 18 June 2007.

The Complainant's registered INTESA SANPAOLO trade mark is wholly contained in both of the disputed domain names. In fact, each of the disputed domain names are identical to the Complainant's trade mark apart from the addition of "banca" in one case and "IT" in the other. The Panel finds that these additional elements are not material in these circumstances and do not function as distinguishers.

Accordingly, the Panel finds that the disputed domain names are identical or confusingly similar to the Complainant's registered trade mark rights and the Complaint succeeds under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

There is no evidence to suggest that the Complainant has licensed or authorised the Respondent to use its INTESA

SANPAOLO trade mark or that the Respondent is commonly known by either of the disputed domain names, or is using the disputed domain names for any fair or legitimate non-commercial purpose.

According to the Complainant the disputed domain names are being used without authorisation and the Respondent has failed to reply to the Complainant's counsel's cease and desist letter or to offer any explanation for its use of the disputed domain names.

The Panel finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in either of the disputed domain names. In circumstances that the Respondent has failed to respond or to rebut this case and in the absence of any explanation to the contrary and for the reasons set out under "bad faith" below, the Panel finds that the Complainant succeeds under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainant has demonstrated that it owns registered trade mark rights in the INTESA SANPAOLO trade mark as described above. The disputed domain names were registered respectively on 23 December and 26 December 2019 more than a decade after the Complainant's word mark INTESA SANPAOLO was first used in Italy and after it was registered as a European trade mark in 2007. Considering the degree of distinctiveness of the INTESA SANPAOLO mark and also the degree of renown of the Complainant's mark internationally, it seems to the Panel more likely than not that the Respondent was well aware of the Complainant's trade mark when it registered each of the disputed domain names.

The disputed domain names do not resolve to websites and the Respondent is passively holding the disputed domain names. There is no evidence that the Respondent has tried to sell or use the disputed domain names for any commercial purpose. In spite of this, panels have found that such inactivity or inaction does not necessarily prevent a finding of bad faith under the doctrine of passive holding (see paragraph 3.3 "WIPO Overview of WIPO Views on Selected UDRP Questions").

Paragraph 3.3 of "WIPO Overview of WIPO Views on Selected UDRP Questions" provides that in applying the passive holding doctrine panels have found the following factors to be relevant: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

As discussed in the first paragraph above and as this Panel has found previously (see CAC Case No. 103031), the Complainant's trade mark is distinctive and is very well reputed. The Respondent has failed to respond to this Complaint and to the Complainant's cease and desist letter. The Panel also finds it inconceivable that the disputed domain names could be put to any bona fide use in circumstances that each of the disputed domain names wholly incorporate the Complainant's trade mark and the Respondent has no apparent justification for use of the Complainant's mark or of the registration of domain names that incorporate it.

Accordingly, the Panel finds that the Complainant has demonstrated that each of the disputed domain names were registered and used in bad faith and the Complainant succeeds under 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

The Complainant owns registered trade mark rights for its INTESA SANPAOLO mark. The disputed domain names wholly incorporate this trade mark and as a result the disputed domain names are identical or confusingly similar to the Complainant's trade mark.

There is no evidence that the Respondent was permitted to use the Complainant's INTESA SANPAOLO trade mark and no

evidence that it has made a bona fide or non-commercial use of the disputed domain names.

The disputed domain names were registered at least a decade after the Complainant's trade mark was registered. The INTESA SANPAOLO mark has an established reputation and is distinctive. As a result, it is likely that the disputed domain names were registered with prior knowledge of the Complainant's mark. The Respondent has made a passive holding of the disputed domain names and overall this supports a finding that each of the disputed domain names were registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO-BANCA.COM**: Transferred
2. **INTESASANPAOLO-IT.COM**: Transferred

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2020-07-24

Publish the Decision