Decision for dispute CAC-UDRP-103123

Case number	CAC-UDRP-103123
Time of filing	2020-06-24 08:57:50
Domain names	INTESA-SICUREZZA.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

Organization	Kenny Rogers Roasters

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant proved to be the owner of the following “INTESA” and “INTESA SANPAOLO” trademarks:

- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in class 36;

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

- EU trademark registration n. 12247979 “INTESA”, applied on October 23, 2013 and granted on March 5, 2014, in classes 9, 16, 35, 36, 38, 41 and 42;

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

FACTUAL BACKGROUND

The Complainant is an italian based company active in the banking field.

The Complainant owns numerous trademarks composed by "INTESA" or "INTESA SAN PAOLO" and operates the domain name <intesasanpaolo.com>.

According to the information provided by the Registrar, the Respondent is Kenny Rogers based in the italian town of Cosseria. The disputed domain name currently resolves to an inactive page.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

As regards the first element of the Policy, the Complainant supports that the disputed domain name is confusingly similar to the "INTESA" and "INTESA SAN PAOLO" trademarks. The addition of the element "SICUREZZA" does not impact on the confusingly similarity assessment in view of its dictionary meaning.

As regards the second element of the Policy, the Complainant denies that the Respondent has been authorized to use the trademarks "INTESA" and "INTESA SAN PAOLO" in the disputed domain name.

As regards the third element of the Policy, the Complainant claims that the Respondent registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant.

RESPONDENT:

The Respondent did not submit any reply.

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

1. The disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

The disputed domain name is confusingly similar to the Complainant's registered trademark as it wholly incorporates the sign INTESA (see Six Continent Hotels, Inc. v. The Omnicorp, WIPO Case No. 2005–1249 and Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903).

The addition of the element "SICUREZZA" increases rather than excludes the risk of confusion for the public. In the Panel's view "SICUREZZA" (which means safety for the Italian public) could be easily associated with the Complainant's field of business: the concept of safety is strictly related to banking and financial services.

Furthermore, the addition of ".com" is generally disregarded in view of its technical function.

As a consequence, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, for the purposes of the First Element of the Policy.

2. The Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a response to the Complaint. Therefore, it has filed no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which, according to the Panelist, are sufficient to conclude that the Respondent has no rights or legitimate interest in the disputed domain name.

According to the information provided by the Complainant, and not contested, the Respondent is not commonly known by the disputed domain name nor he has been authorized to use the Complainant's trademark.

Additionally, the disputed domain name leads to an inactive page. The Panels finds that the lack of contents at the disputed domain name shows the absence of a bona fide offering of goods or services and of a legitimate noncommercial/ fair use of the disputed domain name.

For these reasons, the Panel takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name for the purposes of the Policy.

3. The disputed domain name has been registered and is being used in bad faith.

The Panel finds the following circumstances as material in order to establish the Respondent's bad faith in the registration of the disputed domain name:

(i) the disputed domain name was registered well after the Complainant acquired rights on the trademarks "INTESA" and "INTESA SAN PAOLO";

(ii) the Complainant's trademark is known in the banking/financial field at least in Italy where the Respondent is allegedly based. The reputation of the INTESA and INTESA SAN PAOLO trademarks makes it very improbable that the Respondent was not aware of the Complainant's exclusive rights at the time of the registration of the disputed domain name;

(iii) the use of the word "SICUREZZA" combined with "INTESA" is, without any reasonable explication by the Respondent, an index that the Respondent knew about the INTESA trademark and the Complainant's business at the time of the registration of the disputed domain name.

Currently, the disputed domain name is not used. It is consensus view among the UDRP panels, that non-use of a domain name does not prevent a finding of use in bad faith (WIPO Case No. 2000-0003). In this case, the Panel considers the following circumstances as material to conclude that the disputed domain name is used in bad faith:

(i) the high degree of distinctiveness and reputation of the Complainant's trademark which makes it very improbable that the

disputed domain name could be used in good faith;

(ii) the Respondent had the chance to explain the reason of the registration/use of the disputed domain name both in and outside this administrative proceeding but failed to do so;

(iii) the Respondent shielded its contact details using a privacy protection service which combined with the other elements is a further index of use in bad faith.

All above considered the Panel finds the evidence submitted as sufficient to prove use and registration in bad faith of the disputed domain name for the purposes of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-SICUREZZA.COM**: Transferred

PANELLISTS

Name	**Andrea Mascetti**

DATE OF PANEL DECISION 2020-07-27

Publish the Decision