Decision for dispute CAC-UDRP-103130

Case number	CAC-UDRP-103130
Time of filing	2020-06-26 09:19:20
Domain names	02intesasanpaolo.top

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	IntesaSanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	Tye Dye Eye - Leland Hillman

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings of which the Panel is aware that are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following registrations, among others, for the trademark “INTESA SANPAOLO”:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 2007 and duly renewed, in classes 9, 16, 35, 36, 41, 42;

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

FACTUAL BACKGROUND

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

The Complainant is among the top banking groups in the euro zone, with a market capitalisation exceeding 27,2 billion euro, and the undisputed leader in Italy in all business areas (retail, corporate and wealth management). Its international network is present in 25 countries, in particular in the Mediterranean area and in the United States, Russia, China and India. The

Complainant’s “INTESA SANPAOLO” trademark is distinctive and well known all around the world.

The Respondent registered the domain name 02INTESASANPAOLO.TOP on February 15, 2020. It does not resolve to an active website.

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

The disputed domain name 02INTESASANPAOLO.TOP is virtually identical and hence confusingly similar to the Complainant’s “INTESA SANPAOLO” trademark since it comprises the entirety of the Complainant’s well-known trademark “INTESA SANPAOLO”, with the mere addition of the number “02”, together with the inconsequential gTLD ".top", which may be ignored.

In the absence of any Response, the Panel accepts the Complainant's submission that the Respondent has no rights in respect of the disputed domain name because: (i) any use of the trademark “INTESA SANPAOLO” has to be authorized by the Complainant and nobody has been authorized or licensed by the Complainant to use the disputed domain name; (ii) the disputed domain name does not correspond to the name of the Respondent and, to the best of the Complainant's knowledge, the Respondent is not commonly known as “02INTESASANPAOLO”; and (iii) the Complainant has not found any fair or non-commercial uses of the disputed domain name, which does not resolve to an active website.

As to bad faith, the Panel finds that the Complainant’s “INTESA SANPAOLO” trademark is distinctive and well known around the world so the Respondent’s registration of a confusingly similar domain name indicates that the Respondent was well aware of the Complainant’s trademark at that time and registered the domain name in bad faith.

The Panel does not accept the Complainant’s submission that there are present circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy). Although this is a possibility, there is no evidence from which such a conclusion can be drawn.

However, the Panel does accept the Complainant's submission that because the Respondent must have known of the Complainant's well-known mark at the time of registration of the disputed domain name and because there is no conceivable use that could be made of the disputed domain name that would not amount to an infringement of the Complainant's trade mark rights, this is a case in which the Respondent's passive holding of the disputed domain name with knowledge of the Complainant's trademark rights is evidence of both bad faith registration and use. See, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 and also the "WIPO Overview of WIPO Views on Selected UDRP Questions" at paragraph 3.2.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **02INTESASANPAOLO.TOP**: Transferred

PANELLISTS

Name	**Alan Limbury**

DATE OF PANEL DECISION 2020-08-10

Publish the Decision