Decision for dispute CAC-UDRP-103219

Case number	CAC-UDRP-103219
Time of filing	2020-08-06 10:25:49
Domain names	INTESAVERIFICAZION.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	fedor kalie

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the registrations for the trademarks “INTESA” and “INTESA SANPAOLO” as follows:

- International trademark registration n. 793367 “INTESA”, granted on September 04, 2002 and duly renewed, in class 36;
- 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. 12247979 “INTESA”, applied on October 23, 2013 and granted on March 05, 2014, in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 08, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”: INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .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, INTESA.ME. All of them are connected with the official website

http://www.intesasanpaolo.com.

FACTUAL BACKGROUND

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

Intesa Sanpaolo 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., two of the top Italian banking groups.

The Complainant is one of the leading protagonists in the European financial arena. Therefore, Intesa Sanpaolo is a leading Italian banking group among the top banking groups in the euro zone, with a market capitalization exceeding 46,1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). It has a network of approximately 4,500 branches capillary and well distributed throughout the Country, with market shares of more than 18% in most Italian regions, the Group offers its services to approximately 12 million customers.

Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,5 million customers. Moreover, the international network specialized 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 on 14 January 2020.

The Complainant's attorneys sent a cease and desist letter to the Respondent on 24 February 2020 requesting the Respondent the voluntary transfer of the disputed domain name but the Respondent did not reply nor transferred voluntarily the disputed domain name.

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 confusingly similar to a trademarks 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 DOMAIN NAME IS CONFUSINGLY SIMILAR TO A TRADEMARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Panel finds that the disputed domain name is obviously confusingly similar and almost identical to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA". As a matter of fact, INTESAVERIFICAZION.COM exactly reproduces the well-known trademark "INTESA" of the Complainant, with the mere addition of the term "VERIFICAZION", which is found by

the Panel as a reference to the term “VERIFICATION”, an expression obvious widely used by the Complainant for the security of its clients’ bank accounts. The addition of a term by the Respondent cannot avoid the misuse of the trademarks quoted above.

The Panel therefore finds that the disputed domain name is 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).

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME

The Respondent has no rights on the disputed domain name, and any use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant. The use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant. The Respondent has not evidenced any such authorization or license accorded by the Complainant.

The disputed domain name does not correspond to the name of the Respondent and in the finding of the Panel the Respondent is not commonly known as “INTESAVERIFICAZION”. The Panel can follow the allegations of the Complainant to that extent. The Whois information is quite different from the disputed domain name. The Respondent is not related in any way with the Complainant as the disputed domain name concerns and does not carry out any activity nor any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark or apply for registration of the disputed domain name by the Complainant.

The Panel examined the disputed domain name’s homepage and does not find any fair or non-commercial uses of the disputed domain name.

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant’s trademarks “INTESA SANPAOLO” and “INTESA” are distinctive and well known all around the world. The fact that the Respondent has registered a disputed domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wordings “INTESA SANPAOLO” and “INTESA”, the same would have yielded obvious references to the Complainant. The Panel reviewed the submitted extract of a Google search and finds that it raises a clear inference of knowledge of the Complainant’s trademark on the side of the Respondent. Therefore, it is likely that the disputed domain name would not have been registered if it were not for Complainant’s trademark. This is a clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bone fide offerings. The Panel follows the allegation that there are present circumstances indicating that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site in accordance with par. 4(b)(iv) of the Policy.

The Panel finds that several services cannot be detected as being made in good faith. The disputed domain name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant’s trademarks are registered and used (see also the Complainant’s official site http://www.intesasanpaolo.com home page).

Consequently, Internet users, while searching for information on the Complainant’s services, are confusingly led to the websites of the Complainant’s competitors, sponsored on the websites connected to the disputed domain name.

Thus in the Panel´s finding the Respondent has registered and is using the disputed domain name in order to intentionally

divert traffic away from the Complainant's web site.

The registration and use of the disputed domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy.

The current use of the disputed domain name, which allows accessing to the web sites of the Complainant's competitors, also through the Complainant's trademark, causes in the view of the Panel also great damages to the Complainant due to the misleading of their present clients and to the loss of potential new ones. (see WIPO Decisions No. D2000-1500, Microsoft Corporation v. StepWeb, and D2001-1335, The Vanguard Group, Inc v. Venta).

Since the Panel knows that the Respondent's sponsoring activity is being remunerated it is obvious that the Respondent's commercial gain is evident. Moreover, it is no coincidence that this speculation has involved the Complainant as a big financial institution. In fact, the diversion practice in banking realm is very frequent due to the high number of online banking users.

The Panel is aware that the Complainant has already been part not of only one other case. See for instance the CAC´s Cases where the Panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations (see for instance CAC Nr. 103130 Intesa Sanpaolo S.p.A. vs Tye Dye Eye - Leland Hillman, CAC Nr. 103140 Intesa Sanpaolo S.p.A. vs Artem Pavlov, CAC Nr. 103178 Intesa Sanpaolo S.p.A. vs Alan Envy , CAC Nr. 103114, Intesa Sanpaolo S.p.A. vs Roman Bogdanov, CAC Nr. 103087 Intesa Sanpaolo S.p.A. vs Reinhard Kraus, CAC Nr. 103138 Intesa Sanpaolo S.p.A. vs marco caslone, CAC Nr. 103138 Intesa Sanpaolo S.p.A. vs Andrea Enna etc.) as well many of and WIPO Cases.

In addition the Respondent was noted by the Complainant's attorneys who sent to the Respondent a cease and desist letter dated 24 February 2020 asking for the voluntary transfer of the disputed domain name. Despite such communication, the Respondent did not comply with this request.

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

The Complainant's trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and based on the registered trademark well-known all around the world. The Respondent should have had knowledge of the Complainant's trademark at the time of registration of the disputed domain name because it has registered a disputed domain name that is confusingly similar to them. Moreover, if the Respondent should had carried only a basic Google search in respect of the wordings "INTESA SANPAOLO" and "INTESA", the same would had led the Respondent to all obvious references to the Complainant. This is a clear evidence of registration of the disputed domain name in bad faith.

The disputed domain name is not used for any bona fide offerings, even if it is not connected to any web site. The passive holding of a disputed domain name with knowledge that this domain name infringes another party's trademark rights is the evidence of bad faith registration and use.

The Respondent has registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant as the owner of the trademark and service mark or to a competitor of Complainant. Thus the disputed domain name is not used for any bona fide offerings but for a valuable covering of the Respondent's out-of-pocket costs which are directly and obviously related to the disputed domain name.

The Panel is therefore convinced that the overall circumstances of this case suggest that the disputed domain name was registered and is being used in bad faith and the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESAVERIFICAZION.COM**: Transferred

PANELLISTS

Name	**JUDr. Vojtěch Trapl**

DATE OF PANEL DECISION 2020-09-01

Publish the Decision