Decision for dispute CAC-UDRP-103214

Case number	CAC-UDRP-103214
Time of filing	2020-08-06 10:32:55
Domain names	aggiornamentoispweb.online

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	Armando Gara

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has evidenced to be the owner, inter alia, of the following trademark registration which enjoys protection e.g. in Italy where both Parties are domiciled:

Word mark ISP, European Union Intellectual Property Office (EUIPO), registration no.: 7310337, registration date: February 12, 2010, status: active.

Furthermore, the Complainant has evidenced to own various domain names relating to its ISP trademark, including the domain names <ispbank.net>, <ispbank.org> and <ispbank.eu>.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is the leading Italian banking group and also one of the protagonists in the European financial arena. 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.

Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 29,8 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,700 branches capillary and well distributed throughout the Country, with market shares of more than 15% in most Italian regions, the Group offers its services to approximately 11,8 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,2 million customers. Moreover, the international network specialised 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. Intesa Sanpaolo is also known among consumers as "ISP" (its acronym).

The Complainant is the owner, among others, of the following registrations for the trademarks "ISP", "INTESA" and "INTESA SANPAOLO":

- EU trademark registration n. 7310337 "ISP", applied on October 18, 2008 and granted on February 12, 2010 and duly renewed, in class 36;

- EU trademark registration n. 6399802 "ISP SERVIZI TRANSAZIONALI", applied on October 29, 2007 and granted on September 17, 2008 and duly renewed, in classes 9, 16, 35, 36, 41 and 42;

- 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; and

- 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.

Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the signs "ISP", "INTESA SANPAOLO" and "INTESA": ISPBANK.NET, ISPBANK.ORG, ISPBANK.BIZ, ISPBANK.EU, ISPBANK.IT, ISP-INTESASANPAOLO.COM, 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 now connected to the official website http://www.intesasanpaolo.com.

On December 12, 2019 the Respondent registered the domain name <AGGIORNAMENTOISPWEB.ONLINE>.

It is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant's trademarks "ISP", "INTESA SANPAOLO" and "INTESA". As a matter of fact, <AGGIORNAMENTOISPWEB.ONLINE> exactly reproduces my Client's well-known trademark "ISP", with the mere addition of the descriptive terms "AGGIORNAMENTO" (meaning "update") and "WEB", clear references to the online banking activities carried out by the Complainant for its customers.

It is also clear that "ISP" in this context is an abbreviation for "INTESA SANPAOLO", the other trademark registered by the Complainant. Again, "ISP" is also one of the name for which the Complainant is known among public.

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

The Respondent has no rights on the disputed domain name, and any use of the trademarks “ISP”, “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue.

The domain name at stake does not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as “AGGIORNAMENTOISPWEB”.

Lastly, we do not find any fair or non-commercial uses of the domain name at stake.

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

The disputed domain name <AGGIORNAMENTOISPWEB.ONLINE> was registered and is used in bad faith.

The Complainant’s trademarks “ISP”, “INTESA SANPAOLO” and “INTESA” are distinctive and well known all around the world. The fact that the Respondent has registered a 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 “AGGIORNAMENTO ISP WEB”, “INTESA SANPAOLO” and “INTESA”, the same would have yielded obvious references to the Complainant. The Complainant submitted an extract of a Google search in support of its allegation. This raises a clear inference of knowledge of the Complainant’s trademark on the part of the Respondent. Therefore, it is more than likely that the domain name at issue 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. More particularly, 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 Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the disputed domain name (par. 4(b)(i) of the Policy).

The disputed domain name is not used for any bone fide offerings, even if it is not connected to any web site, by now. In fact, countless UDRP decisions confirmed that the passive holding of a domain name with knowledge that the domain name infringes another party’s trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, enclosed as Annex E, and also the panels’ consensus view on this point, as reflected in the “WIPO Overview of WIPO Views on Selected UDRP Questions” at paragraph 3.2.).

In particular, the consensus view of WIPO UDRP panellists is that passive holding of a domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, 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.

As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademarks. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant’s trademarks and that results so similar to the Complainant’s domain names currently used by the latter to provide online banking services for enterprises.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the

disputed domain name has to be considered a use in bad faith: «The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests» (Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., concerning just the case of a bank).

The risk of a wrongful use of the domain name at issue is even higher in the present case, since the Complainant has already been targeted by some cases of phishing in the past few years. Such a practice consists of attracting the customers of a bank to a web page which imitates the real page of the bank, with a view to having customers disclose confidential information like a credit card or bank account number, for the purpose of unlawfully charging such bank accounts or withdrawing money out of them. It happened that some clients of the Complainant have received e-mail messages asking, by the means of web pages which were very similar to the Complainant's ones, the sensitive data of the Clients, like user ID, password etc. Then, some of the Clients have been cheated of their savings.

Even excluding any "phishing" purposes or other illicit use of the disputed domain name in the present case, anyway we could find no other possible legitimate use of <AGGIORNAMENTOISPWEB.ONLINE>. The sole further aim of the owner of the domain name under consideration might be to resell it to the Complainant, which represents, in any case, an evidence of the registration and use in bad faith, according to par. 4(b)(i) («circumstances indicating that you have registered or you have 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 that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name»).

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.

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 Panel finds that the disputed domain name <aggiornamentoispweb.online> is confusingly similar to the Complainant's ISP trademark, since the disputed domain name incorporates the latter in its entirety and the mere addition of the descriptive terms "aggiornamento" (the Italian word for "update") as well as "web" is not capable to dispel the confusing similarity arising from such incorporation of the Complainant's ISP trademark in the disputed domain name. Also, the applicable new generic Top Level Domain (TLD) ".online" is a standard registration requirement and as such may be disregarded under the first element confusing similarity test.

Moreover, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent so far has neither made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate non-commercial or fair use of the disputed domain name, nor is the Respondent commonly known thereunder. The disputed domain name apparently has not yet been actively used by the Respondent, either on the Internet or in any other way (so-called "passive holding"). Many UDRP panels have recognized, however, that the mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase, may not of itself confer rights or legitimate interests in a domain name. Accordingly, the Panel has no difficulty in finding that the Respondent in fact lacks rights or legitimate interests in respect of the disputed domain name.

Finally, the Complainant points to the fact, and the Panel agrees with this line of argumentation, that given the reputation of the Complainant's trademark "ISP" all around the world and given the fact that the Respondent has created a domain name that actually is somehow framing the Complainant's ISP trademark by two descriptive terms, indicates that the Respondent had knowledge of the Complainant's trademarks at the time of the registration of the disputed domain name. Also, there is a consensus view among UDRP panels that a passive holding of a domain name may, in appropriate circumstances, be consistent with the finding of bad faith, in particular in circumstances in which, for example, a complainant's trademark is well-known, and there is no conceivable use that could be made of the domain name and would not amount to an infringement of the complainant's trademark's rights. In the case at hand, given the undisputed reputation of Complainant's ISP trademark, in the absence of any other reasonable explanation as to why the Respondent should rely on the disputed domain name and in light of the fact that the Respondent has brought forward nothing in substance relating to the intended use of the disputed domain name that would have allowed the Panel to hold for Respondent, the Panel finds that the Respondent has registered and is making use of the disputed domain name in a manner which at least takes unjustified and unfair advantage of the Complainant's ISP trademark's fame and must, therefore, be considered as registered and being used in bad faith within the larger meaning of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AGGIORNAMENTOISPWEB.ONLINE**: Transferred

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2020-09-04

Publish the Decision