Decision for dispute CAC-UDRP-103209

Case number	CAC-UDRP-103209
Time of filing	2020-07-31 09:11:24
Domain names	INTESASANPAOLO-SECURE.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	J Smith

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademark registrations for the sign “INTESA SANPAOLO” (the “INTESA SANPAOLO trademark”):

- the International trademark INTESA SANPAOLO with registration No.920896, registered on 7 March 2007 for goods and services in International Classes 9, 16, 35, 36, 38, 41 and 42; and

- the European Union trademark INTESA SANPAOLO with registration No.5301999, registered on 18 June 2007 for goods and services in International Classes 35, 36 and 38.

FACTUAL BACKGROUND

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

The Complainant is the leading Italian banking group, formed as a result of the merger in 2007 between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups. The market capitalisation of the Complainant exceeds 29.8

billion Euro, and it has a network of 3700 branches and 11.8 million customers in Italy. The Complainant has a strong presence in Central and Eastern Europe with a network of approximately 1000 branches and over 7.2 million customers. The international network of the Complainant specialised in supporting corporate customers is present in 25 countries in the Mediterranean area, the United States, Russia, China and India.

The Complainant's official website is located at the domain name <intesasanpaolo.com>.

The Respondent registered the disputed domain name on 1 March 2020. It resolves to a website containing pay per click links offering third-party banking and financial services.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that the disputed domain name is confusingly similar to the INTESA SANPAOLO trademark in which the Complainant has rights, because the disputed domain name exactly reproduces the trademark with the addition of the descriptive term "secure".

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has not been authorized by the Complainant to use the INTESA SANPAOLO trademark, and the disputed domain name does not correspond to the name of the Respondent. The Complainant adds that the Respondent does not carry out a fair or non-commercial use of the disputed domain name.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, the INTESA SANPAOLO trademark is distinctive and well-known around the world, and the Respondent registered the disputed domain name with knowledge of the INTESA SANPAOLO trademark and in view of it. By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's INTESA SANPAOLO trademark as to the source, sponsorship, affiliation, or endorsement of his website. The disputed domain name is not used for any bona fide purpose, but is connected to a website that contains commercial links to banking and financial services offered by competitors of the Complainant.

The Complainant notes that on 20 March 2020 it sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the disputed domain name, but the Respondent did not comply with the request.

RESPONDENT:

The Respondent did not reply to the Complainant's contentions and did not submit any arguments or evidence in its defence.

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

(ii) the respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name …"

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the INTESA SANPAOLO trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain ("gTLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the sequence "intesasanpaolo-secure". It consists of the elements "intesasanpaolo" and "secure", divided by a hyphen. The element "intesasanpaolo" is identical to the INTESA SANPAOLO trademark, while "secure" is a descriptive word which has a low effect on the overall impression made by the disputed domain name, in which the "intesasanpaolo" sequence dominates. As discussed in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "WIPO Overview 3.0"), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

Taking all the above into account, the Panel finds that the disputed domain name is confusingly similar to the INTESA SANPAOLO trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because the Respondent has no permission to use the INTESA SANPAOLO trademark and is not commonly known under the disputed domain name. The Complainant also points out that the disputed domain name is connected to a website that contains commercial links to banking and financial services offered by competitors to the Complainant. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not alleged that is has rights and legitimate interests in the disputed domain name and has not disputed the Complainant's allegations and evidence in this proceeding.

The disputed domain name is confusingly similar to the INTESA SANPAOLO trademark and incorporates it with the addition of the element "secure", the combination of which may lead Internet users to believe that the Respondent's website is an official secure website of the Complainant for its online banking services. The evidence submitted by the Complainant and not disputed by the Respondent shows that the disputed domain name is indeed associated to a website that contains pay per click links to banking and financial services offered by competitors to the Complainant.

All the above leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant's INTESA SANPAOLO trademark, has registered and used the disputed domain name in an attempt to exploit this trademark's goodwill to mislead and attract Internet users and then expose them to sponsored commercial links of the Complainant's competitors for financial gain. In the Panel's view, such activity is not legitimate and does not give rise to rights and legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(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; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

As discussed above, the disputed domain name is confusingly similar to the INTESA SANPAOLO trademark and incorporates the element “secure” that may lead Internet users to believe that the associated website is an official secure website of the Complainant for its online banking services. As submitted by the Complainant and not denied by the Respondent, the disputed domain name resolves to a website featuring commercial links offering services that compete with the Complainant’s.

Taking all this into account, the Panel accepts that as more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainant and targeting the INTESA SANPAOLO trademark in an attempt for commercial gain to attract traffic to the disputed domain name by creating a false impression in Internet users that the Respondent’s website is an online location offering the banking services of the Complainant, and exposing them to commercial pay-per-click links to the Complainant’s competitors.

This satisfies the Panel that the Complainant has established that the Respondent has registered and used the disputed domain name 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-SECURE.COM**: Transferred

PANELLISTS

Name	**Assen Alexiev**

DATE OF PANEL DECISION 2020-09-05

Publish the Decision