Decision for dispute CAC-UDRP-103240

Case number	CAC-UDRP-103240
Time of filing	2020-09-02 09:24:42
Domain names	AGGIORNAINTESAONLINE.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	gianluca (gianluca nisi)

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

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

- International trademark registration number 793367 “INTESA”, granted on September 4, 2002 in class 36;

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

- EU trademark registration number 12247979 “INTESA”, granted on March 5, 2014 in classes 9, 16, 35, 36, 38, 41 and 42;

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

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 now connected to the official website http://www.intesasanpaolo.com.

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 capitalization exceeding 29.9 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. 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 Complainant is the owner, among others, of the trademarks mentioned above.

The disputed domain name <AGGIORNAINTESAONLINE.COM> was registered on March 31, 2020. The disputed domain name remains inactive.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

i) The Complainant has rights in the marks “INTESA” and “INTESA SANPAOLO” based on International and EUIPO trademark registrations. The disputed domain name exactly reproduces its well-known trademark “INTESA”, with the mere addition of the terms “AGGIORNA” (meaning “update”) and “ONLINE.”

ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name; the use of the trademarks “INTESA SANPAOLO” and “INTESA” has not been authorized by the Complainant; nobody has been authorized or licensed by the above-mentioned banking group to use the disputed domain name; the disputed domain name does not correspond to the name of the Respondent, and thus the Respondent is not commonly known as “AGGIORNAINTESAONLINE”; and it does not find any fair or non-commercial uses of the disputed domain name.

iii) The Respondent has registered and is using the disputed domain name in bad faith. The Complainant contends that its trademarks “INTESA” and “INTESA SANPAOLO” are distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to the Complainant’s well known trademarks indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name. 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 domain name (the Policy paragraph 4(b)(i)). The disputed domain name is not used for any bona fide offerings, even if it is not connected to any website. UDRP decisions confirmed that the passive holding of a domain name is evidence of bad faith registration and use.

RESPONDENT:

The Respondent did not submit a Response.

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

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

(3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (Forum July 31, 2000) (holding that the respondent’s failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO February 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Rights

The Complainant contends that it has rights in the marks “INTESA” and “INTESA SANPAOLO” based on International trademark registration number 793367 “INTESA”, granted on September 4, 2002; International trademark registration number 920896 “INTESA SANPAOLO”, granted on March 7, 2007; EU trademark registration number 12247979 “INTESA”, granted on March 5, 2014; EU trademark registration number 5301999 “INTESA SANPAOLO”, granted on June 18, 2007.

The Complainant has provided the Panel with each copy of the trademark registrations at issue. Registration of a mark with regional and international trademark authorities sufficiently establishes the required rights in the mark for purposes of the Policy. As such, the Panel finds that the Complainant has established its rights in the marks “INTESA” and “INTESA SANPAOLO.”

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant’s trademarks “INTESA” and “INTESA SANPAOLO.” The Complainant asserts that the disputed domain name exactly reproduces its well-known trademark “INTESA”, with the mere addition of the terms “AGGIORNA” (meaning “update”) and “ONLINE.”

The Panel agrees with the Complainant and notes that the addition of '.com' gTLD and a descriptive term is generally disregarded in the assessment under paragraph 4(a)(i) of the Policy when comparing disputed domain name and trademarks. Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks “INTESA” and “INTESA SANPAOLO.”

No rights or legitimate interests

The Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (the complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy). See also Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (Forum November 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii)).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name on the grounds that the use of the trademarks “INTESA SANPAOLO” and “INTESA” has not been authorized by the Complainant; nobody has been authorized or licensed by the above-mentioned banking group to use the disputed domain name; the disputed domain name does not correspond to the name of the Respondent, and thus the Respondent is not commonly known as “AGGIORNAINTESAONLINE”; and it does not find any fair or non-commercial uses of the disputed domain name.

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) 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 that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith. The Complainant contends that its trademarks "INTESA" and "INTESA SANPAOLO" 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.

The Panel observes that while constructive knowledge is insufficient to support a finding of bad faith, actual knowledge can be used to demonstrate a respondent's bad faith registration and use. See Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (Forum February 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding bad faith per paragraph 4(a)(iii) of the Policy, the Panel here finds actual knowledge through the name used for the domain and the use made of it."). The Panel infers, due to the notoriety of the Complainant's marks that the Respondent had actual knowledge of the Complainant's rights in "INTESA" and "INTESA SANPAOLO" marks before the registration of the disputed domain name, which constitutes bad faith registration and use per paragraph 4(a)(iii) of the Policy.

The Complainant further contends that the disputed domain name is not used for any bona fide offerings, even if it is not connected to any web site. UDRP decisions confirmed that the passive holding of a domain name is evidence of bad faith registration and use.

The Panel agrees that the passive holding of a domain name does not necessarily circumvent a finding that the domain name is being used in bad faith within the requirements of paragraph 4(a)(iii) of the Policy. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the panel must give close attention to all the circumstances of the respondent's behavior, and a remedy can be obtained under the Policy only if those circumstances show that the respondent's passive holding amounts to acting in bad faith.).

The particular circumstances of this case that the Panel has considered are:

i) The Complainant's trademarks "INTESA" and "INTESA SANPAOLO" are distinctive and well known all around the world; and

ii) The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name.

Taking into account all of the above, the Panel concludes that the Respondent's passive holding of the disputed domain name constitutes bad faith under Policy paragraph 4(a)(iii) and that the Respondent is using 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. **AGGIORNAINTESAONLINE.COM**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2020-10-05

Publish the Decision