Decision for dispute CAC-UDRP-103227

Case number	CAC-UDRP-103227
Time of filing	2020-09-02 09:15:13
Domain names	intesasanpaolo-it.app

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	marin cristoiu

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of a number of trade marks for INTESA SANPAULO including, by way of example only, European Union trade mark registration number 530199 for INTESA SANPAULO in classes 35, 36 and 38, applied for on September 8, 2006 and registered on June 18, 2007.

FACTUAL BACKGROUND

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

The Complainant is an Italian banking group which was formed in 2007 following the merger of Banca Intesa S.p.A. and Sanpaulo IMI S.p.A. It has a market capitalisation exceeding EUR 29.9 billion and approximately 3,700 branches in Italy as well as many branches in other countries. The Complainant trades as INTESA SANPAULO and owns many trade marks to protect this trading style including the mark in respect of which full details are given above. It also owns a large number of domain names which comprise or include its trade marks, including <intesasanpaulo.com> which resolves to its principal website.

The disputed domain name was registered on November 16, 2019. As at August 15, 2020 it did not resolve to an active

website.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The disputed domain name is identical or at least confusingly similar to the Complainant's INTESA SANPAULO trade mark as it exactly reproduces it and couples it with the acronym IT, which is an abbreviation for the geographical term "Italy" where the Complainant has its headquarters.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. Any use of the Complainant's INTESA SANPAULO mark has to be authorised by it and it has not authorised or licensed the Respondent to register or use the disputed domain name. The Respondent is not known as INTESA SANPAULO-IT, nor is it making any fair or non-commercial uses of the disputed domain name.

The Respondent has registered and is using the disputed domain name in bad faith. The fact that the disputed domain name is confusingly similar to the Complaint's INTESA SANPAULO trade mark suggests that the Respondent was aware of the Complainant's trade mark as at the date it registered it. The disputed domain name is not being used for any bona fide offering. Passive holding of a domain name can in appropriate circumstances amount to registration and use in bad faith. 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 mark. Moreover, the Respondent may have registered the disputed domain name either for the purpose of phishing or other illicit uses or for the purpose of selling it to the Complainant, which would amount to bad faith registration and use under paragraph 4(b)(i) of the Policy.

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 4(a) of the Policy requires that the Complainant prove each of the following three elements in order to succeed in its Complaint:

(i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

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

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

Identical or confusingly similar

So far as the first element is concerned, the Complainant's trade mark registrations for INTESA SANPAULO, including the trade mark in respect of which full details are provided above, establish its rights in the this mark.

For the purpose of comparing the disputed domain name with the Complainant's mark, it is established practice to disregard the generic Top Level Domain, that is ".app" in the case of the disputed domain name, as this is a technical requirement of registration. The remaining element of the disputed domain name comprises the Complainant's trade mark, in full and without alteration, coupled with a hyphen and the letters "IT". The hyphen is of no significance in this context and the letters "IT" will be understood by Internet users to comprise the widely recognized acronym for "Italy", this being the country where the Complainant's head office is based. Accordingly, they do not serve to differentiate the disputed domain name from the Complainant's trade mark.

Where a domain name wholly incorporates a complainant's registered trade mark that is sufficient to establish confusing similarity for purposes of first element of the Policy; see, for example, CAC Case No. 102382, MAJE v enchong lin, and section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition. The Panel accordingly finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

Rights and legitimate interests

Paragraph 4(c) of the Policy sets out circumstances, without limitation, by which a respondent might demonstrate that it has rights or a legitimate interest in a domain name. These are, summarised briefly: (i) if the respondent has been using the domain name in connection with a bona fide offering of goods and services; (ii) if the respondent has been commonly known by the domain name; or (iii) if the respondent has been making a legitimate noncommercial or fair use of the domain name.

The fact that the disputed domain name does not resolve to an active website means that it is not being used in connection with a bona fide offering of goods and services. Nor is there any evidence that the Respondent has been commonly known by the disputed domain name, nor does the Respondent's passive holding of the domain name amount to making a legitimate noncommercial or fair use of it.

The Complainant having made out a prima facie case in relation to the second element, the burden of proof shifts to the Respondent to rebut it; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. In the absence of any response by it to the Complaint, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Bad faith

The Panel accepts the Complainant's submission that the distinctive nature of the Complaint's INTESA SANPAULO trade mark means that it is highly improbable that the Respondent registered the disputed domain name without an awareness of the Complainant and its trade mark rights. The fact that the disputed domain name does not resolve to an active website comprises passive holding which panels in many earlier decisions under the Policy have found capable of amounting to bad faith registration and use. The material factors in this respect were first set out in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 and are fulfilled in the circumstances of these proceedings. In particular, the Panel takes into account that (i) the Complainant has established that its rights in its INTESA SANPAULO mark are both

extensive and established , (ii) the Respondent has not provided any evidence of actual or contemplated good faith use by it of the disputed domain name, (iii) the Respondent has taken active steps to conceal its true identity, by use of a privacy service and (iv) it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate or infringe the Complainant's trade mark rights.

For these reasons the Panel finds that the disputed domain name was both registered and used in bad faith. It is not therefore necessary to consider the Complainant's additional submissions.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO-IT.APP**: Transferred

PANELLISTS

Name	**Antony Gold**

DATE OF PANEL DECISION 2020-10-06

Publish the Decision