Decision for dispute CAC-UDRP-103285

Case number	CAC-UDRP-103285
Time of filing	2020-09-16 09:51:35
Domain names	GRUPOINTESA.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

Name	lan fei

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided 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”, “INTESA SANPAOLO” and “GRUPO INTESA”:

- Chilean trademark registration n. 912344 “GRUPO INTESA”, granted on February 19, 2001 and duly renewed, in class 36;

- 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;

- 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 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 capitalisation exceeding 34,8 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.

On March 16, 2020 the Respondent registered the domain name <GRUPOINTESA.COM>.

It is more than obvious that the domain name at issue is identical, to the Complainant’s trademarks “GRUPO INTESA”, while it is also very similar to “INTESA” and “INTESA SANPAOLO”, as it shares with them the most distinctive portion “Intesa”.

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 “GRUPO INTESA”, “INTESA” and “INTESA SANPAOLO” 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 “GRUPOINTESA”.

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 <GRUPOINTESA.COM> was registered and is used in bad faith.

The Complainant’s trademarks “GRUPO INTESA” “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. In addition, if the Respondent had carried even a basic Google search in respect of the wordings "INTESA" and "INTESA SANPAOLO", the same would have yielded obvious references to the Complainant. The Complainant submits 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 disputed 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, 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 (paragraph 4(b)(iv) of the Policy).

First of all, several services can be detected, but not in good faith: in fact, the disputed domain name is now connected to a web site containing pornographic images, videos and links.

As it can be easily noted, the website contains several sponsored links offering pornographic items. Therefore, there is a clear commercial gain for the owner of the domain name, who is trading on the reputation of Intesa Sanpaolo. In fact, Internet users, while looking for Intesa Sanpaolo's website in order to get some information on its banking services, may chance upon the Respondent's website. Moreover, the Respondent's conduct is evidently causing dilution and tarnishments to the Complainant's marks and image.

The fact that the disputed domain name is connected to a pornographic website is a clear indication that the domain name has been registered and used in bad faith. As concluded in several WIPO cases (see, among others, Ty, Inc. v. O.Z. Names, WIPO Case No. D2000-0370; Oxygen Media, LLC v. Primary Source, WIPO Case No. D2000-0362; Dell Computer Corporation v. RaveClub Berlin, WIPO Case No. D2002-0601; Six Continents Hotels, Inc. v. Seweryn Nowak, WIPO Case No. D2003-0022), the redirection to pornographic sites from a domain name incorporating a well-known trademark is evidence of bad faith. In WIPO Case No. D2003-0022, for example, the Panel stated that «it is commonly understood, under WIPO case law, that, whatever the motivation of Respondent, the diversion of the domain names to a pornographic site is itself certainly consistent with the finding that the domain name was registered and is being used in bad faith».

In addition, it must be underlined that – according to the "WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3rd Edition ("WIPO Overview 3.0")", par. 3.12 – "using a domain name to tarnish a complainant's mark (e.g., by posting false or defamatory content, including for commercial purposes) may constitute evidence of a respondent's bad faith" and this surely includes adult contents, considering that the previous "WIPO Overview 2.0" (at par. 3.11) stated that "Intentional tarnishment of a complainant's trademark may in certain specific circumstances constitute evidence of registration and/or use of a domain name in bad faith. […] Tarnishment in this context normally refers to such conduct as linking pornographic images or wholly inappropriate information to an unrelated trademark".

As clearly underlined in WIPO Case No. D2003-0557; Miroglio S.p.A. v. Mr. Alexander Albert W. Gore, the consequences for Complainant "are potentially catastrophic, should even a minority of Internet users come to believe that Complainant is actually associated with pornography". As the Panel stated in WIPO Case No. D2000-0079; Motorola, Inc. v. NewGate Internet, Inc., "while many adult sex sites are perfectly legal and constitute bona fide offerings of goods or services, the use of somebody else's trademark as a domain name (or even as a meta-tag) clearly does not constitute a bona fide offering of goods or services when the website owner has no registered or common law rights to the mark, since the only reason to use the trademark as a domain name or meta-tag is to attract customers who were not looking for an adult sex site, but were instead looking for the products or services associated with the trademark. Such use of a trademark can create customer confusion or dilution of the mark, which is precisely what trademark laws are meant to prevent. And actions that create, or tend to create, violations of the law can hardly be considered to be bona fide".

It is no coincidence that this speculation has involved a big financial institution such as Intesa Sanpaolo. In fact, the diversion practice in banking realm is very frequent due to the high number of online banking users. In fact, it has also to be

pointed out that the Complainant has already been part of other WIPO Cases where the Panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations.

Lastly, it shall be noted that on September 3, 2020 the Complainant's attorneys sent to the to the Respondent's Registrar a cease and desist letter asking to forward the document to the domain name owner in order to require the voluntary transfer of the domain name at issue. Despite such communication, the Respondent did not comply with the above 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.

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).

This is a case of "typosquatting", i.e. the disputed domain name contains the Complainant's trademark GRUPO INTESA in it's entirety. It is well established that the specific top level of a domain name such as ".com", ".org" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

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).

The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use his trademarks in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent.

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).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant's trademark INTESA and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name with prior knowledge of the Complainant and the Complainant's mark. The Panel therefore finds that the disputed domain name was registered in bad faith.

The disputed domain name currently resolves to a website flagged as insecure containing pornographic content. Furthermore the disputed domain name enables the Respondent to send e-mails using an e-mail address that contains the disputed domain name.

It is inconceivable that the Respondent can use the e-mails connected to the disputed domain name for good faith use of the disputed domain name as part of an e-mail address.

The Panel agrees with the Complainant that as the website of the disputed domain name contains several sponsored links offering pornographic items there is a clear commercial gain for the owner of the domain name, who is trading on the reputation of the INTESA trademarks. Moreover, the Respondent's conduct is evidently causing dilution and tarnishments to the Complainant's marks and image.

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

1. The three essential issues under the paragraph 4(a) of the Policy are whether:

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

ii. the Respondent has no rights or legitimate interests with respect to the disputed domain name; and

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

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain name, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant states and proves that the disputed domain name is confusingly similar even identical to its trademarks and its domain names. Indeed, the trademark is fully incorporated in the disputed domain name.

The disputed domain name is therefore deemed identical or confusingly similar.

b) The Respondent is not generally known by the disputed domain name and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain name.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain name was registered. The present use of the disputed domain name is evidently causing dilution and tarnishments to the Complainant’s marks and image. Furthermore there are indications that the disputed domain name is likely used as part of e-mail addresses for fraudulent purposes. It is concluded that the Respondent makes bad faith use of the disputed domain name.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GRUPOINTESA.COM**: Transferred

PANELLISTS

Name	**Lars Karnoe**

DATE OF PANEL DECISION 2020-10-23

Publish the Decision