Decision for dispute CAC-UDRP-103289

Case number	CAC-UDRP-103289
Time of filing	2020-09-23 11:27:20
Domain names	INTESASANPAOLO.PRO

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	david latter

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, among others, of the following registrations for the trademark “INTESA SANPAOLO”:
- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42, covering also Australia, China, United States of America, Japan, Russian Federation;
- 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;
- EU trademark registration n. 5421177 “INTESA SANPAOLO & deviceargues applied on October 27, 2006, granted on November 5, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42.
Moreover, the Complainant is also the owner of the following domain names bearing the sign “INTESA SANPAOLO”: “INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ” and INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ”. 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 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 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.

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

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.

On May 8, 2020 the Respondent registered the domain name INTESASANPAOLO.PRO.

In the view of Complainant it is more than obvious that the disputed domain name at issue is identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”. As a matter of fact, INTESASANPAOLO.PRO exactly reproduces the well-known trademark “INTESA SANPAOLO”.

The Respondent has no rights on the disputed domain name, and any use of the trademarks “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.

Complianant states that the disputed domain name does not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as “INTESASANPAOLO”.

The disputed domain name was in the view of Complainant registered and is used in bad faith:

The Complainant’s trademarks “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 “INTESA SANPAOLO” and “INTESA”, the same would have yielded obvious references to the Complainant. The Complainant submits, as Annex D, 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, 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 (par. 4(b)(iv) of the Policy).

The Complainant contests that first of all, several services can be detected, but not in good faith: in fact, the disputed domain name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used.

Consequently, Internet users, while searching for information on the Complainant's services, are confusingly led to the websites of the Complainant's competitors, sponsored on the websites connected to the disputed domain name.

Therefore, the Complainant deems that the Respondent has registered and is using the disputed domain name in order to intentionally divert traffic away from the Complainant's web site.

Several WIPO decisions stated that the registration and use of a domain name to re-direct internet users to web sites of competing organizations constitute bad faith registration and use under the Policy.

The current use of the disputed domain name, which allows accessing to the web sites of the Complainant's competitors, also through the Complainant's trademark, causes, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones. So, the Respondent's conduct is in the view of Complainant even worse.

The Respondent's commercial gain is in the view of Complainant evident, since it is obvious that the Respondent's sponsoring activity is being remunerated.

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.

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 Complainant has rights in the mark by virtue of its registered trademark INTESA SANPAOLO.

In line with decisions of many other UDRP panels, a disputed domain is found to be confusingly similar to a complainant´s

trademark, when the disputed name incorporates the complainant´s trademark in its entirety (e.g. Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack, WIPO Case No. D2015-0070 ; Chloé S.A.S. v. DVLPMNT Marketing, Inc., WIPO Case No. 2014-0039). The Panel shares this view in the present case. In this case the Complainant´s registered trademark INTESA SANPAOLO is fully included in the disputed domain name. The only difference to the Complainant´s registered trademark is the gTLD suffix ".pro". This is not sufficient. Therefore the Panel decides that the disputed domain name is confusingly similar to the Complainant´s trademark INTESASANPAOLO.

The Complainant contends that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, is not making a legitimate non-commercial or fair use of the disputed domain name, and is not commonly known under the disputed domain name. The Complainant furthermore contends that the Respondent is not affiliated with nor authorized by Complainant in any way. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks INTESASANPAOLO, or apply for registration of the disputed domain name by the Complainant.

The Respondent is identified as "david latter".

The Panel notes that the disputed domain name holder´s name or contact details do not contain any reference to INTESASANPAOLO or similar word or name. In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no right or legitimate interests in respect of the disputed domain name.

The disputed domain name is connected to a webpage offering services (e.g. banking, deal in credits), which are similar to services provided by banks and therefore similar to the services offered by the Complainant. The offers of the webpage are not linked to the Complainant´s website, but to other companies. By using the entire long trademark of Complainant only with the addition of a different gTLD (".PRO") the Respondent causes a similarity to the Complainant´s website. This creates confusion for the visitors of the website. Also, the Respondent can gain commercial advantages by the redirection of its visitors.

A web site using the Complainant´s trademark and redirecting its visitors to other than the Complainant´s websites providing similar services cannot be a bona fide offering of goods or services.

The Panel believes that the Respondent registered the disputed domain name with knowledge of the complainant´s rights. First, the Complainant obtained its first trademark registration more than a decade before the disputed domain name was registered and used it widely since then. A simple and quick search for the disputed domain name would have revealed the latter. Secondly, the Respondent has used the disputed domain name providing access to services (e.g. banking), which are similar to services provided by the Complainant. This is a clear indication that the Respondent was aware of the Complainant and the Complainant´s trademarks. The Respondent´s behavior demonstrates knowledge and targeting of the Complainant and its trademark.

The Panel regards the Respondent´s behavior as an attempt to attract Internet users to other than the Complainant´s website for commercial gain. This behavior is a clear use of the disputed domain name in bad faith with regards to paragraph 4 (b) (iv) of the Policy.

Accordingly the Panel concludes that the Respondent has registered and 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. **INTESASANPAOLO.PRO**: Transferred

PANELLISTS

Name	**Jan Christian Schnedler, LL.M.**

DATE OF PANEL DECISION 2020-10-20

Publish the Decision