Decision for dispute CAC-UDRP-103313

Case number	CAC-UDRP-103313
Time of filing	2020-09-30 12:09:36
Domain names	intesa-sanpaolo-antifrode.info

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Roberta Esposito

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceeding which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

EU trademark registration number 12247979 “INTESA”, applied on October 23, 2013 and granted on March 05, 2014, in classes 9,16, 35, 36, 38, 41 and 42;

EU trademark registration number 53001999 “INTESA SANPAOLO”, applied on September 08, 2006, granted on June 18, 2007 and duly renewed, in 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 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 34,8 billion euro, and the leader in Italy, in many 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 16% 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 1.100 branches and over 7,2 million customers. Moreover, 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 following registrations for the trademarks “INTESA’ and ‘INTESA SANPAOLO”.

The Complainant is also the owner of the domain names consisting of the prefix <INTESASANPAOLO> followed by the following gTLDs and ccTLDs: .COM, .ORG, .EU, .INFO, .NET, .BIZ.

The Complainant is also the owner of the domain names consisting of the prefix <INTESA> followed by the following gTLDs and ccTLDs: .COM, .INFO, .BIZ, .ORG, .US, .EU, .CN, .IN, .CO.UK, .TEL, .NAME, .XXX, .ME.

On April 24, 2020, the Respondent registered the disputed domain name <INTESA-SANPAOLO-ANTIFRODE.INFO>.

The Respondent listed its address as being in Italy.

The disputed domain name consists of the Respondent's trademark followed by the Italian word "ANTIFRODE" which translates into English as "ANTI-FRAUD".

At the time of the Complaint the disputed domain name did not resolve to a website.

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

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent shall be transferred to the Complainant:

1) the disputed domain name is identical or confusingly similar to a trademark or service mark (“mark”) in which the Complainant has rights; and

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

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

The Panel is satisfied that the Complainant has proved all three elements for the principal reasons set out below.

A. RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant asserts it has a number of trademark registrations consisting of the words INTESA and INTESA SANPAOLO. At least one of these registrations predates the registration date of the disputed domain name by over a decade.

To satisfy paragraph 4(a)(i) of the Police it is enough that the Panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V v. Telepathy, Inc D2001-0217 (WIPO may 7, 2001); see also WIPO Case Nos D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark INTESA SANPAOLO.

The next question is whether the disputed domain name is confusingly similar to the INTESA SANPAOLO trademark.

The Panel disregards the gTLD suffix ".info". It is of no brand significance and it is likely to be totally ignored by web users. Such web users are likely to focus entirely on the only distinctive element in the disputed domain name, being the INTESA-SANPAOLO-ANTIFRODE element.

The INTESA-SANPAOLO-ANTIFRODE element differs only from the INTESA SANPAOLO trademark by way of the last word "ANTIFRODE". The word translates to mean 'antifraud' which does not materially change the trademark by introducing a new word. It is well established that domain names consisting merely of variations to a trademark that are "insufficient to prevent threshold Internet user confusion" will be held to be confusingly similar to the said trademark (See Apple Inc. v. Contact Privacy Inc. / Grand Slam Co. WIPO Case No D2012-0844 citing WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 2nd Ed ("WIPO Overview 2.0") which is now superseded by "WIPO Overview 3.0" that contains the same principle). The addition of a word which is essentially meaningless falls under this principle. An internet user will observe nothing of any meaning when viewing the disputed domain name and will focus on the first two words.

B. NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Respondent's name according to information provided by the registrar is "Roberta Esposito". This name bears no resemblance to "INTESA SANPAOLO". Further, the disputed domain name does not resolve to an active website which would indicate any right or legitimate interest in the disputed domain name.

The Respondent has no rights or interests in the disputed domain name.

C. BAD FAITH

The Panel accepts that the Complainant has an international reputation in the INTESA SANPAOLO trade mark in relation to financial services, especially in the European Union. The Panel refers in particular to the detailed business information contained in one of the annexures attached to the Complainant which clearly demonstrates the Complainant's extensive use of INTESA as a house brand of one of Europe's largest financial institutions.

The Panel notes that the disputed domain name does not resolve to an active website. The Panel also notes that the disputes domain name has been registered for a short period. Such facts alone do not indicate bad faith. This is not a case of prolonged passive holding. It is not, in the Panel's opinion, indicative of bad faith for a domain name registrant to fail to immediately direct the disputed domain name to an active page within a few months of registration. Website development can take time and it is foreseeable that some traders may direct a domain name to a parking page whilst they legitimately pursue such development.

However the apparent passive holding of the disputed domain name is not what is of central concern to the Panel on the issue of bad faith. What is of concern is that:

(a). According to the Complainant's uncontested contentions INTESA SANPAOLO is distinctive and well known; and

(b). The only distinctive element in the disputed domain name is INTESA-SANPAOLO-ANTIFRODE; and

(c). The Complainant has evidenced long standing registered rights in trade marks consisting of INTESA SANPAOLO coupled with uncontested contentions of the size of the Complainant's business under its INTESA SANPAOLO trade mark and its prominence in a Google search.

These combined facts have led the Panel to the conclusion that in such circumstances it is highly unlikely that the Respondent was unaware of this reputation at the time of registering the disputed domain name.

As the Panel has found the Respondent had such prior knowledge of the INTESA SANPAOLO trade mark at the time of registering the disputed domain name it can only follow that the purpose in registering the disputed domain name was to opportunistically profit from such confusing similarity. The Respondent targeted the Complainant's well known name for this purpose. Such opportunism has been recognized by numerous panels, the Panel refers to the commentary of the learned Gerald M Levine, Domain Name Arbitration, Legal Corner Press, 1st ed. 2015, pp 258 to 259.

Therefore in consideration of all the circumstances the disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-SANPAOLO-ANTIFRODE.INFO**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2020-11-06

Publish the Decision