Decision for dispute CAC-UDRP-103297

Case number	CAC-UDRP-103297
Time of filing	2020-09-23 09:45:40
Domain names	INTESAWALLET.COM, INTESAGLOBALPAYMENTS.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	Organo Gold Holdings, Limited

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings related to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant owns a portfolio of trademark registrations including the following:

- 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, granted on March 5, 2014, in classes 9, 16, 35, 36, 38, 41 and 42; and

- EU trademark registration n. 5301999, INTESA SANPAOLO, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

FACTUAL BACKGROUND

The Complainant carries on an international banking business providing services under the INTESA and INTESA SANPAOLO marks for which it owns the above trademark registrations.

Moreover, the Complainant is also the owner of the following portfolio of Internet domain names incorporating the signs “INTESA” and “INTESA SANPAOLO”: <intesasanpaolo.com>, <intesasanpaolo.org>, <intesasanpaolo.eu>, <intesasanpaolo.info>, <intesasanpaolo.net>, <intesasanpaolo.biz>, <intesa-sanpaolo.com>, .org, <intesa-sanpaolo.com>, <intesa-sanpaolo.eu>, <intesa-sanpaolo.info>, <intesa-sanpaolo.net>, <intesa-sanpaolo.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> and <intesasanpaolowallet.com> all of them are now connected to the official website www.intesasanpaolo.com.

The disputed domain names were registered by the Respondent on March 20, 2020 and each resolve to parked web pages containing only onward links to other web locations.

The Respondent asserts that it is a corporation established in 2008 selling coffee, tea and food supplements in more than 30 countries worldwide.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant, referring to evidence of registrations annexed to the Complaint, claims rights in the INTESA and INTESA SANPAOLO marks acquired through its portfolio of registered trademarks described above and its extensive use of the marks in its international banking business.

The Complainant submits that it is among the top banking groups in the Euro zone, with a market capitalisation exceeding €34,8 billion, and is the undisputed leader in Italy, in all areas of banking including retail, corporate and wealth management. It has a network of approximately 3,700 branches well distributed throughout Italy, with market shares of more than 15% in most Italian regions. The Complainant’s group provides its services to approximately 11,8 million customers with a network of approximately 1.000 branches and over 7,2 million customers. It is established in 25 countries, in particular in the Mediterranean area, with a strong presence in Central-Eastern Europe and those areas where Italian companies are most active, such as the United States, Russia, China and India.

The Complainant submits that the disputed domain names are identical, or at least confusingly similar, to the Complainant’s trademarks INTESA and INTESA SANPAOLO. They exactly reproduce the Complainant’s INTESA mark with merely adding the terms “wallet” and of the expression “global payments”, each of which refer to financial products and services, for which the above-mentioned trademarks have been registered and are used.

The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain names, submitting that the disputed domain names do not correspond to the name of the Respondent; that to the best of the Complainant’s knowledge, the Respondent is not commonly known as <intesawallet.com> or <intesaglobalpayments.com>; that the Complainant has not authorized or licensed anyone to use the disputed domain names; that the Respondent is not putting the disputed domain names to any fair or non-commercial use; that the screenshots of the websites to which the disputed domain names resolve illustrate that they each resolve to web pages containing only onward links to other web locations which is not a bona fide offering of goods or services such as to create rights or legitimate interest in the disputed domain names.

The Complainant submits that the disputed domain names were registered and are being used in bad faith, arguing that the disputed domain names are intentionally confusingly similar to the Complainant’s distinctive and well known registered trademarks INTESA and INTESA SANPAOLO with a reputation all around the world. The Complainant argues that the fact that the disputed domain names are confusingly similar to the Complainant’s marks indicates that the Respondent had knowledge of the Complainant’s trademarks at the time of registration of the disputed domain names. In addition, Complainant asserts that 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, in an annex to the Complaint, an extract of a Google search in support of these allegations and argues that this raises a clear inference of knowledge of the Complainant's trademark on the part of the Respondent.

In addition, the Complainant alleges that the disputed domain names are not used for any bona fide offerings but more particularly, there are present circumstances indicating that, by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 refers to screenshots of the web pages to which the disputed domain names resolve which illustrates that they are each connected to a website sponsoring, among others, banking and financial services. These are classes of services for which the Complainant's trademarks are registered and used. The Complainant submits that 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 domain names at issue.

The Complainant identifies several UDRP decisions that have found that the registration and use of a domain name to re-direct Internet users to websites of competing organizations constitute bad faith registration and use under the Policy. Citing for example Encyclopaedia Britannica Inc. v. Shedon.com, WIPO Case No. D2000-0753 ("Respondent's Ownership of a site which is a mis-spelling of Complainant's britannica.com site and which Respondent used to hyperlink to a gambling site demonstrates Respondent's bad faith registration and use of the britannnica.com domain name").

The Complainant argues that the Respondent's commercial gain is evident, since it is obvious that the Respondent's activity is being remunerated.

The Complainant adds that it is no coincidence that this speculation has involved a big financial institution such as the Complainant. In fact, the practice of creating diversion in the 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 previously successfully brought other UDRP cases, listed in an annex to the Complaint, where the panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations.

Lastly, referring to a copy of a letter in the annex to the Complaint, the Complainant states that on May 6, 2020 the Complainant's representatives sent to the Respondent a cease and desist letter asking for the voluntary transfer of the disputed domain names. The Complainant states that despite such communication, the Respondent did not comply with the above request.

RESPONDENT:

The Respondent asserts that it was established in 2008 in Richmond in Canada as a small coffee shop and it has grown into a large multinational corporation selling coffee, tea and food supplements in more than 30 countries worldwide. The products of Organo Gold are sold through an international network of cooperating independent distributors.

On March 20, 2020, the Respondent registered the disputed domain names <intesawallet.com> and <intesaglobalpayments.com> which it states were intended to be used for the purpose of processing payments between the Respondent and its cooperating distributors using an IT payment processing system presently being developed. The Respondent explains that word "Intesa" which in the Italian language means "agreement" was chosen intentionally as a reference to Italy being the country with the best coffee culture in the world to describe perfectly the cooperation between the Respondent and its cooperating distributors.

The Respondent denies that the respective disputed domain names <intesawallet.com> and <intesaglobalpayments.com> are conflicting or confusing with the Respondent's Intesa Sanpaolo S.p.A company name or its INTESA and "INTESA

SANPAOLO trademarks.

The Respondent firstly argues that the Complainant's company name is not "INTESA" but "INTESA SANPAOLO". The bank named Banca Intesa was established in 1998 and ceased to exist in 2007 due to merger with bank SANPAOLO IMI S.P.A. Since 2007, i.e. for 13 years, the company name and the advertised brand has been "INTESA SANPAOLO" not "INTESA".

Secondly, while the Respondent admits that the disputed domain names <intesawallet.com> and <intesaglobalpayments.com> each contain the word "intesa" which is identical to the Complainant's registered trademark it is necessary to say that the protection for the element "INTESA" by such trademarks is quite weak because the word "INTESA" is a common Italian word meaning an agreement.

The Respondent adds that the Complainant has not been using the brand INTESA and since 2007 has used it only as a part of the new company name as INTESA SANPAOLO.

The Respondent further argues that since the protection for the "intesa" elements in the disputed domain name is weak and the domain names contain also other elements, i.e. "wallet" and "globalpayments" which are more connected with payments than with the banking industry, the respective disputed domain names should not cause any confusion among the public.

The Respondent names an affiliated company which it states provides a pay wallet service at a named website for which the respective domains are intended to be used.

The Response states that due to obstacles created by the Complainant the Respondent's affiliated company has decided to file an application for word "FINTESA" which is similar to the word "INTESA". The Respondent adds that it is a goal of the Complainant and its affiliate company to defend their right to use the Italian word "intesa" and the domain names <intesawallet.com> and <intesaglobalpayments.com> for use within the payment system.

In Annexes attached to the Response, the Respondent provides evidence of United States Trademark Application FINTESA, serial number 90104465, filed on August 10, 2020 by the Respondent's affiliate company for services in international class 36, together with a document described as an "advertisement for FINTESA" which consists of a graphic banner with the wording "OGPay by ORGANO" and "FINTESA – Servicing your Global Payments needs to a finely brimmed margin where elegant simplicity reigns". The banner is of a type that might appear as a website header, but the Respondent provides no information as to where it claims that it has been published.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

Complainant's Rights and Confusing Similarity

The Complainant has adduced clear and convincing and uncontested evidence of its rights in the INTESA and INTESA SANPAOLO marks acquired through its portfolio of registered trademarks described above and its extensive use of the marks in its international banking business.

The disputed domain names consist of the word “Intesa” which is the Complainant’s INTESA registered trade mark with the addition of the terms “wallet” and of the expression “global payments” in combination with the Top Level Domain extension (“gTLD”) <.com>.

The Respondent denies that the respective disputed domain names <intesawallet.com> and <intesaglobalpayments.com> are conflicting or confusing with the Respondent’s Intesa Sanpaolo S.p.A company name or its INTESA and “INTESA SANPAOLO trademarks.

The Respondent firstly argues that the Complainant’s company name is not “INTESA” but “INTESA SANPAOLO”. The bank named Banca Intesa was established in 1998 and ceased to exist in 2007 due to merger with bank SANPAOLO IMI S.P.A. Since 2007, i.e. for 13 years, the company name and the advertised brand has been “INTESA SANPAOLO” not “INTESA”.

While the Respondent admits that the disputed domain names <intesawallet.com> and <intesaglobalpayments.com> each contain the word “intesa” that is identical to the Complainant’s registered trademark it argues that the protection for the element “INTESA” by such trademarks is quite weak as the word “INTESA” is a common Italian word meaning an agreement.

It is well accepted that there is a low threshold for a complainant to cross in the first element of the test in paragraph 4(a)(i) of the Policy. Issues such as the strength of weakness of the mark are addressed when considering the Respondent’s rights and legitimate interests or bad faith registration.

In the present case, the word “Intesa”, which is Complainant’s trademark, is the initial, dominant and only distinctive element in either of the disputed domain names.

The gTLD extension may be ignored for the purpose of comparison as in the context of this case it would be perceived as a necessary technical element. This Panel finds therefore that the disputed domain names are confusingly similar to the INTESA mark in which the Complainant has rights.

The Complainant has therefore succeeded in the first element of the test in paragraph 4(a)(i) of the Policy.

Respondents Rights or Legitimate interest

The Complainant has made out a prima face case that the Respondent has no rights or legitimate interests in the disputed domain names, alleging that:

- the disputed domain names do not correspond to the name of the Respondent;

- that to the best of the Complainant’s knowledge, the Respondent is not commonly known as <intesawallet.com> or <intesaglobalpayments.com>;

- that the Complainant has not authorized or licensed anyone to use the disputed domain names;

- that the Respondent is not putting the disputed domain names to any fair or non-commercial use; and

- that the screenshots of the websites to which the disputed domain names resolve illustrate that they each resolve to web pages containing only onward links to other web locations which is not a bona fide offering of goods or services such as to create rights or legitimate interest in the disputed domain names.

In such circumstances the burden of production shifts to the Respondent to prove its right or legitimate interests.

The Respondent has adduced in evidence a document which is presented as an advertisement but without any context or explanation as to where it claims to have been published. It also offers as evidence a print-out of a United States trademark application filed by a third party on 10 August 2020 for FINTESA. It states that the third parry is an affiliate company which is developing an IT payments programme for use in the Respondent's coffee distributorship.

There is no evidence whatsoever of the Respondent's business or of the efforts claimed to be made by the affiliate company developing the IT system. Furthermore the Respondent moves between claims to right in INTESA and FINTESA as trademarks while not producing any evidence of use of either.

A mere application for a trademark does not establish rights or legitimate interests in a domain name sufficient to discharge the burden of production that rests on the Respondent.

Furthermore the Respondent's submissions lack weight, consistency and credibility in that it claims to have an international business but has adduced no supporting evidence.

In these circumstances this Panel finds that the Respondent has failed to discharge the burden of production and that the Complainant has succeeded in the second element of the test in paragraph 4(a)(ii) of the Policy.

Registration and Use in Bad Faith

The Complainant has convincingly argued that the registrant of each of the disputed domain names was aware of the Complainant and it banking business when the disputed domain names were registered. This Panel accepts this reasoning which is supported by the fact that each of the disputed domain names contain Complainant's mark in its entirety in combination with elements "wallet" and "global payments", that refer to financial services. There is nothing on the record that shows that the registrant of the disputed domain name might have had any bona fide reason for registering these domain names.

The Respondent's arguments that it wanted to use the Italian word for "agreement" is too coincidental and even if it were true any such use of the word INTESA would conflict with the Complainant's extensive and strong rights in the INTESA mark. The argument that there is a difference between the Complainant's banking business and a payments service does not withstand any consideration.

This Panel rejects the Respondent's arguments that the Complainant's rights are weak. Quite the contrary. On the balance of probabilities, the disputed domain names where chosen and registered because of the strength and distinctiveness of the Complainant's rights. This Panel finds that on the balance of probabilities the disputed domain names were chosen and registered in bad faith in order to take predatory advantage of the Complaint and its rights and goodwill in the INTESA name and mark.
This Panel finds, having considered the evidence and submissions of the Parties, that on the balance of probabilities the disputed domain names are being used in bad faith in an intentional attempt to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Complainant's web site.

In making this finding this Panel rejects the Respondent's submissions that it is entitled to use the commonplace Italian word "Intesa" meaning "agreement". The difficulty for the Respondent is that it is not using this word on its own it is being used with other elements that specifically refer to the Complainant's financial services business. The Respondent has not shown that it has any reason to use these terms in a domain name that contains Complainant's trademark. The Respondent's assertion that it has a bona fide food and food supplements business and that its affiliate company is developing an IT system for use in the Respondent's business lacks credibility because the Respondent has not adduced any

evidence that it has any business and even the trademark to which it refers is for the term FINTESA.

The Complainant has therefore succeeded in the third and final element of the test in paragraph 4(a)(iii) of the Policy and is entitled to succeed in this application.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESAWALLET.COM**: Transferred
2. **INTESAGLOBALPAYMENTS.COM**: Transferred

PANELLISTS

Name	**Mr James Jude Bridgeman**

DATE OF PANEL DECISION 2020-11-13

Publish the Decision