Decision for dispute CAC-UDRP-103389

Case number	CAC-UDRP-103389
Time of filing	2020-11-12 10:48:17
Domain names	INTESAESANPAOLO.CLOUD, INTESAGROUP.CLOUD

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.

Respondent

Organization	CARLO CORTESE

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 names.

IDENTIFICATION OF RIGHTS

EU TM Registration No. 12247979 INTESA registered on 5 March 2014 for various goods and services in classes 9, 16, 35, 36, 41 and 42.

EU TM Registration No. 5301999 INTESA SANPAOLO registered on 8 September 2007 for various services 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 1 January 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 31.1 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 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 owns a number of trademark registrations in a number of jurisdictions for the trademarks INTESA SANPAOLO and INTESA. These include the EU trademark registrations referred to above.

Moreover, the Complainant is also the owner of numerous domain names containing INTESA SANPAOLO and INTESA which redirect to its official website located at www.intesasanpaolo.com.

On 12 April 2020 and 15 April 2020 the Respondent registered the domain names INTESAESANPAOLO.CLOUD and INTESAGROUP.CLOUD.

Neither of the disputed domain names resolve to active websites.

On 22 May 2020 the Complainant's attorneys sent to the Respondent's Registrar a cease and desist letter, asking for the voluntary transfer of the disputed domain names to their client. The Respondent never replied to such communication.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

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

1) the disputed domain names are 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 names; and
3) the disputed domain names have been registered and are being used in bad faith.

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

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant claims registered rights over a number of trade marks. However the Panel has focused on two trade mark registrations in particular, EU TM Registration No. 12247979 INTESA registered on 5 March 2014 for various goods and services in classes 9, 16, 35, 36, 41 and 42 and EU TM Registration No. 5301999 INTESA SANPAOLO registered on 8 September 2007 for various services in classes 35, 36 and 38.

Both these registrations pre-date the registration of the disputed domain names by many years.

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

Hence here registered rights in both INTESA and INTESA SANPAULO are established.

The next question is whether the disputed domain names are confusingly similar to either of these trademarks.

The Panel will first address <INTESAESANPAOLO.CLOUD>.

INTESA SANPAULO is a distinctive sign in both Italian and English. The SANPAULO element translates from Italian into English as "Saint Paul", which has no obvious meaning in relation to financial services.

The addition of "E" in the middle of <INTESAESANPAOLO.CLOUD> and the addition of the .CLOUD gTLD suffix does nothing to distinguish <INTESAESANPAOLO.CLOUD> from the distinctive INTESA SANPAULO trademark. If anything, the addition of .CLOUD only adds to confusion as it indicates that the domain name may be used to direct a web-user to a cloud storage service operated by, or for, the Complainant.

The Panel is therefore satisfied that INTESAESANPAOLO.CLOUD is confusingly similar to a trademark in which the Complainant has rights.

Turning to <INTESAGROUP.CLOUD>.

Again, the addition of the .CLOUD gTLD suffix does not assist the Respondent for the reasons set out above in relation to INTESAESANPAOLO.CLOUD. Further, the GROUP element merely indicates the domain name refers to a group of companies. It is completely non-distinctive.

The Panel is therefore satisfied that <INTESAGROUP.CLOUD> is confusingly similar to a trademark in which the Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS
The Respondent's name bears no resemblance to the disputed domain names. Further, the disputed domain names do not resolve to a website.

There is simply no basis to conclude that the Respondent has rights or interests in the disputed domain names.

BAD FAITH

The Complainant correctly asserted that the passive holding of a domain name may, in appropriate circumstances, be indicative of bad faith. It will be so indicative when all the circumstances of the Respondent's behaviour indicates he or she

is acting in bad faith (Telstra Corporation Ltd v. Nuclear Marshmallows D2000-0003 (WIPO February 18, 2000)).

In this sense the fact of passive holding is not often of central concern in a case such as the present where the domain names were not registered years ago, but approximately 8 months ago. What is of concern is that:

(a). INTESA SANPAULO and INTESA are well known and distinctive trademarks;
(b). As discussed above, there is almost no distinction to be drawn between these marks and the disputed domain names; and
(c). the use of the gTLD suffix .CLOUD is likely to indicate to web-users that the disputed domain names are likely to be used to direct the web-user to a cloud storage service operated by, or for, the Complainant. This is of particular concern given the Complainant is well known in the financial services industry which is an obvious target market for unscrupulous individuals engaging in phishing for fraudulent purposes.

These facts indicate that the Respondent knew of the said trade marks before seeking to register the disputed domain names and its passiveness only further confirms its lack of bona fide. Further, there is no response from the Respondent to contradict this inference that the Panel draws under Rule 14(b) and (5)(a) of the UDRP Rules.

As the Panel has found the Respondent had such prior knowledge of the INTESA SANPAULO and INTESA trade marks at the time of registering the disputed domain names it can only follow that its purpose in registering the disputed domain names was to opportunistically profit from such confusing similarity. The Respondent targeted the Complainant's well-known name for this purpose and the use of .CLOUD gTLD only heightens concern as for how the Respondent was going to opportunistically profit. Such opportunism has been recognised as bad faith 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 names have been registered and are 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. **INTESAESANPAOLO.CLOUD**: Transferred
2. **INTESAGROUP.CLOUD**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2020-12-14

Publish the Decision