Decision for dispute CAC-UDRP-103473

Case number	CAC-UDRP-103473
Time of filing	2020-12-23 11:05:24
Domain names	GRUPPOSANPAOLO.ONLINE

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.

Respondent

Name	omar nasr

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

In these proceedings, the Complainant relies on its following trademarks:

- 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, also covering Italy (basic registration);
- 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; and
- EU trademark registration n. 5344544 “GRUPPO INTESA SANPAOLO”, filed on September 28, 2006, granted on July 6, 2007 and duly renewed, in classes 35, 36 and 38.

It is worth noting that, the Complainant also owns multiple registrations for the same trademark in many countries around the world, which have not been cited in these proceedings.

Further, the Complainant is also the owner, among others, of the following domain names bearing the sign “INTESA SANPAOLO” and “GRUPPO INTESA SAN PAOLO”: <INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ>; <INTESA-

SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ>; and, <GRUPPOINTESASANPAOLO.COM, .INFO, .BIZ, .ORG, .NET, .EU>. All of them are now connected to the official website <intesasanpaolo.com>.

FACTUAL BACKGROUND

The Complainant is a large Italian banking group of companies, which emerged in 2007 from two other large Italian banking groups, Banca Intesa S.p.A. and Sanpaolo IMI S.p.A.
According to the evidence filed by the Complainant and not disputed by the Respondent, the Complainant has thousands of branches and millions of customers in Europe, where it figures in the top banking groups. It is especially well active in Italy, where the Respondent is based.

The Complainant owns a significant portfolio of trademarks including the wording "GRUPPO INTESA SANPAOLO", among which notably an international registration dating back to 2007 and a couple of EU trademark registrations from 2006. It also owns a multitude of related domain names, like <gruppointesasanpaolo.com>, since September 29, 2006.

The disputed domain name <GRUPPOSANPAOLO.ONLINE> was registered on May 25, 2020 by the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its GRUPPO INTESA SANPAOLO trademark; that the Respondent lacks rights or legitimate interests in the disputed domain name, and; that the Respondent registered and used the disputed domain name in bad faith.

RESPONDENT:

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).

More precisely, the disputed domain name <GRUPPOSANPAOLO.ONLINE> is highly similar to the Complainant’s International and EU Trademark Registrations for INTESA SANPAOLO and GRUPPO INTESA SANPAOLO, as well as to its domain name <gruppointesasanpaolo.com>. Indeed, the omission of the word “INTESA” in the middle of the disputed domain name is not sufficient to escape the finding of confusing similarity, when following the well-established trademark theory of imperfect recollection, as the rest of the word elements – the first and the last – have been kept by the Respondent (GRUPPO and SANPAOLO).

Further, the Complainant has presented a Google search on the expression GRUPPO INTESA SANPAOLO that provides several results, all of them being linked with the Complainant. What’s even more interesting is that the same results appeared, when the Panel carried out an ex officio Google search for GRUPPO SANPAOLO (without INTESA).

As far as the gTLD ".online" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the GRUPPO INTESA SANPAOLO trademark in a domain name, and that it had never licensed its trademark to the Respondent, who is not affiliated or doing any business with the Complainant.

Furthermore and finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark, especially at its home country –Italy– where the Respondent is also based (see Google search, previously mentioned) and the fact that the disputed domain name fully incorporates this trademark, it is rather clear to this Panel that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name resolves to an inactive website. Passive use of a domain name clearly amounts to use in bad faith, especially when the Complainant’s trademark has such a strong reputation that it is widely known, and when it is impossible to conceive any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate. These are exactly the circumstances that apply in the case at issue. The trademarks INTESA SANPAOLO and GRUPPO INTESA SANPAOLO enjoy wide and extensive reputation. Thus, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate.
Therefore, the Panel finds it clear that the disputed domain name was used in bad faith.

Given what precedes, the Panel does not consider necessary to further analyze the Complainant’s submissions regarding an eventual “phishing” activity of the Respondent.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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 disputed domain name wholly incorporates the Complainant's trademark, except for the middle part. The disputed

domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorized to include the Complainant's trademark in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's well-known trademark. His use of the disputed domain name is in bad faith, as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GRUPPOSANPAOLO.ONLINE**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2021-01-25

Publish the Decision