Decision for dispute CAC-UDRP-103476

Case number	CAC-UDRP-103476
Time of filing	2020-12-23 11:49:21
Domain names	GRUPPOINTESA-ID.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.

Respondent

Name	Sara Fortunas

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 holder of various trademarks including the following:

- INTESA, International trademark registration No. 793367, registered on September 4, 2002 in class 36;

- INTESA, EU trademark registration No. 12247979, registered on March 5, 2014 in classes 9, 16, 35, 36, 38, 41 and 42;

- GRUPPO INTESA, EU trademark registration No. 000779827, registered on November 15, 1999 in classes 9, 16, 36, 38, 41 and 42.

FACTUAL BACKGROUND

The Complainant, Intesa Sanpaolo S.p.A., is an Italian banking group resulting from the merger (effective as of January 1, 2007) between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. The Complainant has a market capitalisation exceeding 37,4 billion euro and a network of approximately 5,360 branches in Italy. The Complainant also has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,2 million customers. Moreover, the

Complainant's international network specialised in supporting corporate customers is present in 26 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 of the word marks INTESA and GRUPPO INTESA, registered in several classes and covering various countries, including in Italia where the Respondent is located. The Complainant also claims to be the owner of various domain names including <gruppointesa.com>, which redirects to the Complainant's official website http://www.intesasanpaolo.com/.

The disputed domain name <gruppointesa-id.com> has been registered on April 17, 2020 by the Respondent. According to evidence provided by the Complainant, the disputed domain name does not refer to any active website.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant considers the disputed domain name to be confusingly similar to trademarks in which it has rights. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent does not use the disputed domain name in connection with any legitimate use. Also, according to the Complainant, the Respondent has not been authorized to register or use the disputed domain name. Finally, the Complainant considers that the disputed domain name was registered and is being used in bad faith. The Complainant contends that the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks. According to the Complainant, there are present circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name. The Complainant further contends that there is no conceivable legitimate use that could be made of the disputed domain name by the Respondent.

RESPONDENT:

The Respondent did not reply to the Complainant's contentions.

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 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed, it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities, that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

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 has therefore dealt with each of these requirements in turn.

1. Identity or confusing similarity

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant is the holder of the registered INTESA and GRUPPO INTESA word marks which are used in connection with its banking business, it is established that there are trademarks in which the Complainant has rights.

The disputed domain name <gruppointesa-id.com> incorporates the Complainant's INTESA and GRUPPO INTESA trademarks in their entirety, merely adding a hyphen and the term "id", which is a common abbreviation for "identification". In these circumstances, the Panel finds that the confusing similarity is obvious.

It is well established that the Top-Level Domains ("TLDs") such as ".com" may be disregarded when considering whether the disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see section 1.11 WIPO Overview 3.0).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks. Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No rights or legitimate interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of proof to the Respondent (see section 2.1 WIPO Overview 3.0 and Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455; Belupo d.d. v. WACHEM d.o.o., WIPO case No.

2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is "Sara Fortunas". The Respondent's use and registration of the disputed domain name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Generally speaking, UDRP panels have found that where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 WIPO Overview 3.0). In this case, the disputed domain name incorporates the Complainant's INTESA and GRUPPO INTESA trademarks in their entirety, merely adding a hyphen and the term "id", which is a common abbreviation for "identification". This short additional term does not prevent potential confusion with the Complainant, and could even refer to some identification tool linked to the Complainant's banking services.

Therefore, the Panel finds that the disputed domain name carries in a high risk of implied affiliation with the Complainant and cannot constitute fair use.

Moreover, the Panel is of the opinion that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. In fact, the Respondent is not making any use of the disputed domain name in connection with an active website.

The Respondent had the opportunity to demonstrate his rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name. In light of the above, the Complainant succeeds on the second element of the Policy.

3. Bad faith

Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (see section 4.2 WIPO Overview 3.0 and e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070). In the instant case, the Panel finds it inconceivable that the Respondent was not aware of the Complainant's rights at the moment it registered the disputed domain name. The disputed domain name incorporates both INTESA and GRUPPO INTESA trademarks of the Complainant in their entirety with the mere addition of a hyphen and the short descriptive term "id". Given the Complainant's presence in Italy, where the Respondent is located, the Respondent was or should at the very least be aware of the Complainant and its rights. A simple internet search for INTESA and GRUPPO INTESA reveals obvious references to the Complainant.

The Complainant adds that there are present circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant or to a competitor of Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name. However, the Complainant fails to identify the concrete circumstances it refers to. The Panel can thus not accept this specific argument.

Regarding bad faith use, UDRP panels have found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion

with a complainant's mark:

- seeking to cause confusion for the respondent's commercial benefit, even if unsuccessful;

- the lack of a respondent's own rights to or legitimate interests in a domain name;

- absence of any conceivable good faith use (see section 3.1.4 WIPO Overview 3.0).

In the present case, the Panel finds that the very nature of the disputed domain name suggests an intention to cause confusion. The disputed domain name incorporates both INTESA and GRUPPO INTESA trademarks of the Complainant in their entirety and combines this with the term "id", a common abbreviation for "identification". Given the importance of the (secure) identification of clients, especially in the context of banking services, the combination of "id" with the Complainant's marks may even increase confusion amongst Internet users.

The uncontested lack of the Respondent's own rights to or legitimate interests in the disputed domain name has already been mentioned above.

Finally, given the distinctive character of the Complainant's marks, the Panel finds it difficult to conceive any plausible good faith use of the disputed domain name by the Respondent in the future. Moreover, in the circumstances of this case, the Panel finds that the use of the disputed domain name for fraudulent activity cannot be excluded, e.g., by profiting of the likelihood of confusion with the Complainant's trademarks for phishing activities through the sending of e-mails. This is especially relevant in the banking sector.

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was 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. **GRUPPOINTESA-ID.COM**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2021-01-27

Publish the Decision