Decision for dispute CAC-UDRP-103492

Case number	CAC-UDRP-103492
Time of filing	2021-01-05 12:46:23
Domain names	INTESASANPAOLOSMSATTIVA.COM

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	andalrico lucchesi

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 owns several trademarks consisting either of the word element “INTESA” alone or “INTESA SANPAOLO”.

Some of the most relevant trademarks are as follows:

• International Registration of a word trademark “INTESA”, No. 793367 in Class 36;
• International Registration of a word trademark “INTESA SANPAOLO”, No. 920896 in Classes 9, 16, 35, 36, 41, 42;
• Word EU trademark “INTESA”, No. 12247979, registered in Classes 9, 16, 35, 36, 38, 41 and 42; and
• Word EU trademark “INTESA SANPAOLO”, No. 5301999, registered in Classes 35, 36 and 38.

Moreover, the Complainant owns an important domain names portfolio containing the expressions “INTESA” alone or “INTESA SANPAOLO”.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is an Italian banking group based in Torino. With its 3,700 branches distributed throughout Italy, the Complainant offers its services to more than 11 million customers and its market share amount to more than 15% in most Italian regions.

No information is known about the Respondent who registered the disputed domain name <INTESASANPAOLOSMSATTIVA.COM> on 10 May 2020. The disputed domain name is not currently used in connection with any goods or services and resolves in blank page.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Identical or confusingly similar

The Complainant argues that the disputed domain name <INTESASANPAOLOSMSATTIVA.COM> and the Complainant's registered trademarks are confusingly similar.

The Complainant states, in particular, that the registered trademarks are fully contained in the disputed domain name and points out that the elements in which the names vary, are generics, and thus do not alter the overall confusion between the them.

No rights or legitimate interests

The Complainant argues that there is no evidence at all that the Respondent is commonly known by the disputed domain name or a name corresponding to the disputed domain name, nor that the Respondent is using it for offering goods or services in the market. Moreover, the Complainant states that the Respondent has not been licensed or otherwise authorized to use any of the Complainant’s trademarks nor to apply for or use any domain name incorporating such trademarks.

Registered and used in bad faith

As far as bad faith registration is concerned, the Complainant states that the trademarks owned by him are well known marks and consequently the Respondent could not be unaware of the Complainant rights over the name “INTESA” and/or “INTESA SANPAOLO” at the time of the disputed domain name registration.

Finally, the website at the disputed domain name is currently inactive and there is no evidence of it having ever been associated with any goods or services. The Complainant underlines that, although the domain name is not being actively used by the Respondent, passive holding may amount to bad faith use under certain circumstances, as in this case.

RESPONDENT:

The Respondent did not respond to the Complaint.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to trademarks 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 has been registered 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 states that the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel shall draw such inferences therefrom as appropriate.

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant.

The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidences provided in support of them.

1. The Complainant owns a several trademarks that are comprised of two distinctive elements "INTESA" and "SANPAOLO". Besides the EU protection, the trademarks are protected in various non-EU countries and thus their protection could be considered as almost worldwide.

The disputed domain name <INTESANPAOLO-ONLINE.COM> comprises of the distinctive element "<INTESANPAOLO-" followed by the word elements "SMS" and "-ATTIVA>" and the Top-Level domain ".com". It is evident, that the particles "SMS" and "ATTIVA" refer to "Active short message service" (commonly known as sms messages) and as such are of lower distinctive nature compared to the core elements "INTESANPAOLO". Indeed, banking services often employ the use of sms messages for notification purposes. In this regard, the particles "SMS" and "ATTIVA" needs to be perceived as descriptive or at least allusive of on-line banking services.

Additionally, the Top-Level domain ".com" represents a technical requirement of registration and as such must be disregarded under the confusing similarity test.

The Panel finds that Complainant's trademarks "INTESA SANPAOLO" are both visually and phonetically reproduced by the root of the disputed domain name <INTESANPAOLO->.
Furthermore, the additional elements "SMS" and "ATTIVA" have a very low degree of distinctive character in relation to the banking services provided under the name of the Complainant's trademarks "INTESA SANPAOLO", and as such do not alter the overall similarity of the registered trademarks and the disputed domain name.

Consequently, the Panel considers that the disputed domain name partially reproduces the Complainant's previously registered trademarks to the extent that they are confusingly similar.

The Panel accordingly concludes that paragraph 4(a)(i) of the Policy is satisfied.

3. The Respondent is not in any way related to the Complainant's business, and is not the agents of the Complainant. The Respondent is not currently known and has never been known as "INTESA SANPAOLO", or any combination of this

trademark.

The domain name <INTESASANPAOLOSMSATTIVA.COM> is not associated with any webpage. Therefore, the Respondent does not appear to have a legitimate interest in the disputed domain name.

Consequently, and in the absence of a Response, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, so that the requirements of paragraph 4(a)(ii) of the Policy are met.

4. As to the bad faith at the time of the registration, the Panel finds that, in light of the distinctiveness of the Complainant's trademark with which the disputed domain name is confusingly similar, and due to the worldwide presence of the Complainant's business known under the name "INTESA SANPAOLO", the Respondent was more likely be aware of the Complainant's trademark at the time of the registration of the disputed domain name.

Furthermore, the Complainant notes that the disputed domain name does not resolve to any web site or other on-line presence, nor appears to have been used so far. In this regard, prior Panels have discussed the passive holding of a domain names (e.g. in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003) and found that the passive holding itself can constitute bad faith use.

The Panel recalls that „the relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith" (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

The particular circumstances of this case, allow the Panel to infer that this is the case when the inactivity of the domain name holder could be considered as a bad faith use, given that:

(i) The Complainant's business name and trademark "INTESA SANPAOLO" has a wide online presence and is widely known, as evidenced by its substantial use in several countries;

(ii) The principal word element <INTESASANPAOLO" in the disputed domain name represents the Complainant's registered trademarks "INTESA SANPAOLO";

(iii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name.

Bearing in mind these circumstances, the Respondent can be deemed to have registered the disputed domain name for blocking purposes.

Under such circumstances, the Panel finds that the disputed domain name was registered in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLOSMSATTIVA.COM**: Transferred

PANELLISTS

Name	**JUDr. Hana Císlerová, LL.M.**

DATE OF PANEL DECISION 2021-01-31