Decision for dispute CAC-UDRP-103475

Case number	CAC-UDRP-103475
Time of filing	2020-12-23 11:52:52
Domain names	INTESASANPAOLO.NETWORK

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	emanuel barzaban

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

Complainant holds the following international and European trademark registrations for the sign “INTESA” and ”INTESA SANPAOLO”:

- International trademark registration n. 793367 “INTESA”, dated of September 4, 2002 and duly renewed, in class 36. However, the provided evidences do not allow the Panel to know in which countries the said trademark has been accepted;

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41, 42. However, the provided evidences do not allow the Panel to know in which countries the said trademark has been accepted;

- EU trademark registration n. 12247979 “INTESA”, applied on October 23, 2013 and granted on March 5, 2014, in classes 9, 16, 35, 36, 38, 41 and 42;

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006, granted on June 18, 2007 and

duly renewed, in classes 35, 36 and 38.

Complainant also alleges that it owned domain names bearing the signs “INTESA SANPAOLO” and “INTESA”, namely intesasanpaolo.com, .org, .eu, .info, .net, .biz, intesa-sanpaolo.com, .org, .eu, .info, .net, .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.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

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 January 1, 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 37,4 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 5,360 branches capillary and well distributed throughout the Country, with market shares of more than 21% in most Italian regions, the Group offers its services to approximately 14.6 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 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, among others, of the following registrations for the trademarks “INTESA” and “INTESA SANPAOLO”:

- 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”, applied on October 23, 2013 and granted on March 5, 2014, in classes 9, 16, 35, 36, 38, 41 and 42;

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”: INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .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. All of them are now connected to the official website http://www.intesasanpaolo.com.

On July 21, 2020 the Respondent registered the domain name <INTESASANPAOLO.NETWORK>.

It is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”. As a matter of fact, <INTESASANPAOLO.NETWORK> exactly reproduces my Client’s well-known trademark “INTESA SANPAOLO”.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Respondent has no rights on the disputed domain name, and any use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue.

The domain name at stake does not correspond to the name of the Respondent and, to the best of Compalinant´s knowledge, the Respondent is not commonly known as “INTESASANPAOLO”.

Lastly, the Complainant does not find any fair or non-commercial uses of the domain name at stake.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The disputed domain name <INTESASANPAOLO.NETWORK> was registered and is used in bad faith.

The Complainant’s trademarks “INTESA” and “INTESA SANPAOLO” are distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wordings “INTESA” and “INTESA SANPAOLO”, the same would have yielded obvious references to the Complainant. The Complainant submits an extract of a Google search in support of its allegation. This raises a clear inference of knowledge of the Complainant’s trademark on the part of the Respondent. Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant’s trademark. This is a clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bona fide offerings. More particularly, there are present circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 (par. 4(b)(i) of the Policy).

The disputed domain name is not used for any bona fide offerings, even if it is not connected to any web site, by now. In fact, countless UDRP decisions confirmed that the passive holding of a domain name with knowledge that the domain name infringes another party’s trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 and also the panels’ consensus view on this point, as reflected in the “WIPO Overview of WIPO Views on Selected UDRP Questions” at paragraph 3.2.).

In particular, the consensus view of WIPO UDRP panellists is that passive holding of a domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, panels have tended to make such findings in circumstances in which, for example, a complainant’s mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the complainant’s trade mark rights.

As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademarks. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant’s trademarks and that results so similar to the Complainant’s domain names currently used by the latter to provide online banking services for enterprises.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain name has to be considered a use in bad faith: «The very act of having acquired [the domain name] raises

the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests» (Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., concerning just the case of a bank).

The risk of a wrongful use of the domain name at issue is even higher in the present case, since the Complainant has already been targeted by some cases of phishing in the past few years. Such a practice consists of attracting the customers of a bank to a web page which imitates the real page of the bank, with a view to having customers disclose confidential information like a credit card or bank account number, for the purpose of unlawfully charging such bank accounts or withdrawing money out of them. It happened that some clients of the Complainant have received e-mail messages asking, by the means of web pages which were very similar to the Complainant's ones, the sensitive data of the Clients, like user ID, password etc. Then, some of the Clients have been cheated of their savings.

Even excluding any "phishing" purposes or other illicit use of the disputed domain name in the present case, anyway we could find no other possible legitimate use of <INTESASANPAOLO.NETWORK>. The sole further aim of the owner of the domain name under consideration might be to resell it to the Complainant, which represents, in any case, an evidence of the registration and use in bad faith, according to par. 4(b)(i) («circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name»).

Lastly, it shall be noted that on July 28, 2020 the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the domain name at issue. Despite such communication, the Respondent did not comply with the above request.

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Complainant alleges that it holds international and European Union trademark registrations for the sign 'INTESA' since 2002 and 2014, as well as for the sign 'INTESA SANPAOLO' since 2007.

Complainant also alleges that it owned domain names bearing the signs NTESA SANPAOLO" and "INTESA": INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .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 that they point to the official website of Complainant's company : http://www.intesasanpaolo.com.

Complainant states that the disputed domain name is identical or at least confusingly similar to Complainant's marks. It incorporates Complainant's well-know trademark 'INTESA SANPAOLO' in its entirety.

Complainant further argues that Respondent has no rights nor legitimate interests in using the disputed domain name. The use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by Complainant. In the present case, Respondent has never been authorized by Complainant to register the disputed domain name. The domain name use does not use Respondent’s name and Respondent is not commonly known under the name ‘INTESASANPAOLO’. No fair or non-commercial use may justify the use of the disputed domain name by Respondent.

Complainant finally comes down to the conclusion that, under the specific circumstances of the case, Respondent’s registration and use of the disputed domain name amounts to bad faith.

First, Complainant emphasises the well-known and highly distinctive character of the trademark to show that Respondent was aware of Complainant’s right when registering the disputed domain name. To support its claim, Complainant refers to an extract of Google search for the search entries “INTESA” and “INTESA SANPAOLO” which revealed obvious references to the Complainant.

Besides, Respondent did not use the disputed domain name for any bona fide offering of goods or services but instead registered it with the sole purpose of selling, renting, or otherwise transferring the 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 domain name.

Complainant states that Respondent’s passive holding of the disputed domain name with knowledge that the disputed domain name infringed its rights amounts to bad faith registration and use because Complainant’s mark is well-known, and because there is no conceivable use of the disputed domain name that would not amount to an infringement of Complainant’s trademark rights. The risk of wrongful use is particularly high considering the numerous phishing attempts targeting Complainant over the past few years.

Finally, Complainant’s representative sent to Respondent a cease and desist letter asking for the voluntary transfer of the domain name at issue, to which Respondent did not comply.

RESPONDENT:

Respondent did not provide any response to the complaint and is therefore in default.

RIGHTS

Paragraph 4(a) of the Policy requires the Complainant to prove three elements in order to the transfer of the disputed domain name:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

Rights

Complainant claims rights in the INTESA SANPAOLO mark through international and European Union registrations since 2007. Even if Complainant does not show in which countries and for which classes the international trademarks have been

registered, in details, the European Union trademarks are sufficient to establish rights in a mark under Policy 4(a)(i).

Continuous case law on Policy 4(4)(i) has established that trademark registration in a single jurisdiction is sufficient to show that Complainant has rights in the sign reproduced by the disputed domain name. For recent case law, see ACINDAR INDUSTRIA ARGENTINA DE ACEROS S.A. v. Sandeep Rangu, Case n°102400 (CAC March 19, 2019), " 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 trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark ACINDAR".

The Panel considers that Complainant has trademark rights for the sign "INTESA" and "INTESA SANPAOLO".

Complainant alleges the disputed domain name <intesasanpaolo.network> is identical or confusingly similar to Complainant's INTESA SANPAOLO mark. Under Policy 4(a)(i), incorporating a mark in its entirety and adding the ".network" top-level domain at the end generally makes the disputed domain name identical to the registered mark it contains. For recent case law, See ACINDAR INDUSTRIA ARGENTINA DE ACEROS S.A. v. Sandeep Rangu, Case n° 102400 (CAC March 19, 2020) "The Panel disregards the gTLD suffix ".online" for the purpose of this comparison. It is no more distinctive than the common gTLDs ".com" or ".net" and as to any brand significance it is likely to be totally ignored by web users. Such web users are likely to focus entirely on the only distinctive element in the disputed domain name, being the ACINDAR element". The Panel agrees that disputed domain name is confusingly similar to Complainant's mark.

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

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii), the burden then shifts to Respondent to show it has rights or legitimate interests. Recent case law has confirmed this standard, see BOURSORAMA SA v. Technology Vavalle, Case n° 102331 (CAC January 31, 2019), "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 trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Panel is satisfied of such".

Complainant asserts that it has not authorized the use of its trademarks by Respondent. Complainant further alleges that Respondent has no legitimate rights or interests in the disputed domain name because Respondent is not using his family name and is not known by the disputed domain name. This reasoning is found is recent case law, see ACINDAR INDUSTRIA ARGENTINA DE ACEROS S.A. v. Sandeep Rangu, Case n° 102400 (CAC March 19, 2020) "The Respondent's name according to information provided by the registrar for the disputed domain name is "Sandeep Rangu", which is known as a male name of Indian origin. This name bears no resemblance to "ACINDAR". (…) The Respondent has no rights or interests in the disputed domain name".

The Panel agrees on this aspect and considers that the use by Respondent of the INTESA SANPAOLO mark was unauthorized and that the latter was not known under such name.

Complainant further argues that Respondent did not register the disputed domain name for any bona fide offering of goods or services, nor any legitimate noncommercial or fair use. Instead, Complainant holds that Respondent uses the disputed domain name with the sole purpose of reselling it to Complainant or one of its competitors. Complainant further argues that Respondent was passively holding the disputed domain name while knowing that it infringed Complainant's trademark since the trademark was well-known trademark and that there was no plausible circumstance under which the registration could lead a legitimate use of the domain name.

Such circumstances normally meet the standards of Policy 4(a)(ii) according to case law. For recent case law, see Intesa Sanpaolo S.p.A. v. Albert Rae, Case n° 102152 (September 17, 2018) “In this regard, the Panel is of the view that given Complainant’s goodwill and renown in relation to banking and the nature of the disputed domain names, it is not possible to conceive a plausible circumstance in which Respondent could legitimately use the disputed domain names, as such use would invariably result in misleading diversion and taking unfair advantage of Complainant’s rights”.

The Panel agrees that such passive holding of the disputed domain name by Respondent might cause confusion for internet users as to the commercial origin of the goods and services offered by Complainant. Finally, Respondent did not respond neither to the cease and desist letter sent by Complainant and nor to this Complaint. Panel finds that Respondent is therefore in fault and that Complainant has made a prime facie case.

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

Complainant argues that Respondent was aware of Complainant’s rights in the well-known INTESA SANPAOLO trademark and thus registered the disputed domain name in bad faith. Registration in bad faith might indeed be demonstrated by very well-known character of the mark, as shown in recent case law, see Pepsico, Inc. v. Allen Othman, Case n° 102380 (CAC March 8, 2019) “The Complainant's mark is very well-known. The company has been operating under various brands and marks for over a century, and its core brand ‘PEPSI’ is found to be one of the leading global brands; the Complainant has provided ample evidence of this in a series of Annexes. The Panel cannot imagine a situation where a registrant would identify text such as that in the disputed domain name, and register such a domain name, without knowledge of the Complainant's fame, name, and activities. (…) This Respondent must have been aware of the Complainant's rights when it registered the disputed domain name, in light of its very well-known and famous nature. In the present case, the combination of the passive holding with the very close similarity between the disputed domain name and the Complainant's mark makes a finding of bad faith a real possibility”. The Panel agrees that given the strong presence of Complainant in the financial field, in Central-Eastern Europe and in the United States, Russia, China and India, it is unlikely that Respondent was not aware of Complainant’s rights when registering the disputed domain name.

As demonstrated by Complainant, a quick Google search on the sign “INTESA” or “INTESA SANPAOLO” would have directly refer to its business. Panel therefore finds that Respondent registered the disputed domain name in bad faith.

Complainant further argues that Respondent used the disputed domain name in bad faith because it was registered it with the sole purpose of reselling it to Complainant or one of its competitors; and was passively holding the disputed domain name while knowing that it infringed Complainant’s well-known trademark. There was no plausible circumstance under which the registration could lead a legitimate use of the sign.

The strength of Complainant’s mark as well as the failure of Respondent to comply with the cease and desist letter has been held to be evidence of bad faith in previous case law, see Intesa Sanpaolo S.p.A. v. Albert Rae, Case n° 102152 (September 17, 2018). The Panel also finds that Respondent’s passive holding of the disputed domain names constitutes in the circumstances of this case use in bad faith. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. In this regard, the Panel has taken into account the strength of Complainant’s trademark in connection with banking and related services, the nature of the disputed domain names which also refer to Complainant’s activities and the fact that Respondent failed not only to respond Complainant’s cease and desist letter but also to take part in these proceedings. The Panel acknowledges the strength of Complainant’s mark in the banking and financial field and the failure of Respondent to comply with the cease and desist letter. Moreover, having received the cease and desist letter, Respondent could not be considered as using the disputed domain name in good faith since it has obviously knowledge of Complainant’s rights.

Panel finds that Respondent is using the disputed domain name in 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

The Panel ultimately considers that Complainant holds trademark rights for the “INTESA SANPAOLO” sign. Respondent’s domain name is confusingly similar to the latter trademark. Complainant has established that Respondent registered and uses the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO.NETWORK**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2021-02-03

Publish the Decision