Decision for dispute CAC-UDRP-103491

Case number	CAC-UDRP-103491
Time of filing	2021-01-05 12:38:49
Domain names	APPRENDOINTESASANPAOLO.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

Organization	leed johnny ()

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 owner of several trademark registrations, such as:
- International trademark registration n. 793367 “INTESA”, granted on September 04, 2002 and duly renewed, in class 36;
- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 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 05, 2014, in classes 9, 16, 35, 36, 38, 41 and 42;
- 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.
The Complainant adds that it is the owner of domain names composed with the INTESA PAOLO and INTESA trademarks. These domain names are redirected to its official website <intesasanpaolo.com>.
The disputed domain name is:
- <apprendointesasanpaolo.com> created on February 3, 2020.
The Complainant contends that the disputed domain name is connected to a website sponsoring, among others, banking and financial services, for which the Complainant’s trademarks are registered and used.

FACTUAL BACKGROUND

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

INTESA SANPAOLO is the undisputed leading Italian banking group and is among the top banking groups in the euro zone. INTESA SANPAOLO is the company resulting from the merger (effective January 01, 2007) between Banca Intesa S.p.A. and Sanpaolo S.p.A., two of the top Italian banking groups.

With market shares of more than 21% in most Italian regions, the Complainant offers its services to approximately 14.6 million Italian customers and also over 7.2 million to European customers, due to its strong presence in Central-Eastern Europe.

The international network specialized in supporting corporate customers is present in 26 countries, in particular in the Mediterranean area and those arears where Italian companies are most active, such as the United States, Russia, China and India.

The Complainant provides documentation advertising on its online training offer.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Preliminary issue on the language of the proceeding

The Complainant is an Italian company, while the Respondent is a Chinese citizen and the language of the registration agreement is Chinese.

Given the above, the present Complaint was written in English, a third international language comprehensible to a wide range of Internet users worldwide, including the ones living in Italy and in China.
Paragraph 11 of the Rules aims at ensuring fairness in the selection of language by giving full considerations to the parties' level of comfort with each language, English seemed to be the fair language in the present proceeding.

Furthermore, it is true that there are no evidences of an agreement between the Complainant and the Respondent to the effect that the proceedings should be in English. However, it is not possible to ignore that the present dispute has been started because the Respondent deliberately registered a domain name which is identical to a well-known registered trademark legitimately owned and used in Italy and in English speaking countries around the world. Since it is inconceivable that the Respondent was not aware of such circumstance when it registered the disputed domain name, the Complainant believes that a fair solution shall be – at least – to accept the Complaint as filed in English, accept a Response in either English, or Chinese (or the preferable language of the Respondent, if any) and appoint a Panel familiar with such languages.

So, in accordance with the instructions submitted by the CAC, for the reasons described above, the Complainant requests the Panel to maintain English the proceeding language or, at least, one of the languages accepted by the Panel.

Identical or confusing similarity
The Complainant submits that the disputed domain name <APPRENDOINTESASANPAOLO.COM> is identical, or – at least – confusingly similar to its INTESA SANPAOLO and INTESA trademarks.

The Complainant contends that the disputed domain name exactly reproduces its well-known trademark INTESA SANPAOLO, with the mere addition of the Italian term “apprendo” even though the domain name at stake does not correspond to the name of the Respondent, who is not commonly known as APPRENDOINTESASANPAOLO.

Absence of rights or legitimate interest
The Respondent has no rights on the disputed domain name, and no use of the INTESA SANPAOLO and INTESA trademarks has been authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue.
The Complainant did not find any fair or non-commercial uses of the disputed domain name.

Bad faith registration and use

The INTESA SANPAOLO and INTENSA trademarks are distinctive and well known all around the world.
The fact that the Respondent has registered a domain name that is confusingly similar to the INTESA SANPAOLO and INTESA trademarks 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 SANPAOLO” and “INTESA”, it would have identified the Complainant,
The disputed domain name is connected to a website sponsoring, among others, banking and financial services, for which the Complainant’s trademarks are registered and used.

Consequently, Internet users, while searching for information on the Complainant’s services, are confusingly led to the websites of the Complainant’s competitors, sponsored on the websites connected to the domain name at issue.

Therefore, the Complainant deems that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant’s web site.

The Complainant also claims that the Respondent’s commercial gain is evident, since it is obvious that its sponsoring activity is being remunerated.
The Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of his web site.
It deemed that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant’s web site.

RIGHTS

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has submitted evidence of its prior registered INTESA SANPAOLO and INTESA trademarks which are protected in several countries worldwide.
The disputed domain name entirely incorporates the Complainant’s INTESA SANPAOLO trademark.

The addition of the Italian generic term “Apprendo” does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademarks.

The Complainant has, to the satisfaction of the Panel, shown that 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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:
(i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) the Respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
(iii) the Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

The Respondent did not respond to the Complaint. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the disputed domain name.

The Respondent is not related in any way with the Complainant. There is no indication that the Respondent is commonly known by the term "INTESA SANPAOLO", or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

The Respondent used the disputed domain name to resolve to a parking website providing links to websites dedicated to finance and competing with the Complainant.

Such a use does not constitute a bona fide offering of goods and services or a legitimate non-commercial fair use.

In the circumstances of this case, the Panel finds that the Complainant has established a prima facie case of the Respondent's lack of rights or legitimate interests in relation to the disputed domain names, which the Respondent has not rebutted.
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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of a domain name. It provides that:
"For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
(i) circumstances indicating that the Respondent has registered or the respondent has 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
(ii) the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location."

Given the notoriety of the Complainant's in finance and its presence on the internet through its own website www.intensasanpaolo.com and the use of the disputed domain name, the Panel finds that the Respondent was well aware of the Complainant's rights in the INTESA SANPAOLO and INTESA trademarks when it registered the disputed domain name. It constitutes bad faith registration.

The disputed domain name is used to attract and divert internet users to a parking website generating pay-per-click revenues. It constitutes bad faith use.

The Panel finds that, according to Par. 4(b) (iv) of the Policy “by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on the respondent’s website or location.”

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

Language of the proceeding.
The Respondent did not submit any answer and did not react after receiving the Complaint.
The disputed domain name is composed with the Italian term “Apprendo”, which is added to the INTESA SANPAOLO and INTESA trademarks.
The parking website is in Italian, including an official mention drafted in English.
Given the international aspect of the case and the absence of any opposition on the language issue, the Panel agrees that English shall be the language of the proceeding.

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 comprises the INTESA SANPAOLO and INTESA trademarks. The additional generic italian term "Apprendo" does not avoid the likelihood of confusion.

The Respondent used the disputed domain name to resolve to a parking website providing links to websites dedicated to finance and competing with the Complainant.

Such a use does not constitute a bona fide offering of goods and services or a legitimate non-commercial fair use.

Given the notoriety of the Complainant’s in finance and its presence on the internet through its own website www.intensasanpaolo.com and the use of the disputed domain name, the Panel finds that the Respondent was well aware of the Complainant’s rights in the INTESA SANPAOLO and INTESA trademarks when it registered the disputed domain name. It constitutes bad faith registration.

The disputed domain name is used to attract and divert internet users to a parking website generating pay-per-click revenues. It constitutes bad faith use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **APPRENDOINTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	**Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2021-02-09

Publish the Decision