

Decision for dispute CAC-UDRP-103536

Case number	CAC-UDRP-103536
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Time of filing	2021-02-01 10:04:16
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Domain names	INTESAGRUPPO.NET
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Case administrator

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

Organization	Intesa Sanpaolo S.p.A.
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Complainant representative

Organization	Intesa Sanpaolo S.p.A.
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Respondent

Name	Lo Blue Giuseppe
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OTHER LEGAL PROCEEDINGS

The Panel is unaware 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, inter alia, the following registrations for the trademarks “INTESA” and “GRUPPO INTESA SANPAOLO”:

- International trademark registration n. 793367 “INTESA”, granted on September 04, 2002 and duly renewed, in class 36;
- EUTM 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;
- EUTM registration n. 5344544 “GRUPPO INTESA SANPAOLO”, filed on September 28, 2006, granted on July 6, 2007 and duly renewed, in connection with classes 35, 36 and 38.

The Complainant is also the owner of, inter alia, the following domain names “INTESA” and “GRUPPO INTESA SANPAOLO” registered as: <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, GRUPPOINTESASANPAOLO.COM, .INFO, .BIZ, .ORG, .NET, .EU and INTESAGROUP.COM>.

All of these domain name registrations are connected to the Complainant's official website <http://www.intesasanpaolo.com>.

FACTUAL BACKGROUND

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

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 leader in Italy in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 5,360 branches 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 of the group, 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 numerous trademark and domain registrations.

On May 17, 2020 the Respondent registered the disputed domain name <INTESAGRUPPO.NET>. However, 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 the Respondent is not commonly known as "INTESAGRUPPO". The disputed domain name is connected to a website sponsoring, among others, banking and financial services, for whom 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.

The current use of the disputed domain name, which allows accessing to the web sites of the Complainant's competitors, also through the Complainant's trademark, causes, damage to the Complainant due to the redirection of their present clients and to the loss of potential new ones.

The Respondent's commercial gain is a result of the Respondent's sponsoring activity being remunerated. The diversion practice in banking realm is very frequent due to the high number of online banking users. On June 19, 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.

PARTIES CONTENTIONS

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).

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

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According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(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.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Disputed domain name is confusingly similar to the Complainant's trademarks, company name and domains. This finding is based on the well-established practice of disregarding the top-level suffix in the domain name (i.e. ".NET") in evaluating the existence of a likelihood of confusion, and holding that the mere addition of a generic term such as "GRUPPO" to a famous name, which is the case here, is not sufficient to prevent the existence of a likelihood of confusion.

Additionally, in the case at hand, the Complainant is also the proprietor of a mark featuring both elements "GRUPPO" and "INTESA" even if in reverse order. Due to the similarity of the names INTESA, GRUPPO INTESA SANPAOLO and the disputed domain name <INTESAGRUPPO.NET>, the Panel finds that the disputed domain name and the earlier rights are confusingly similar.

The Panel therefore comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP which has been concluded e.g. in WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

The Complainant has put forward that the Respondent is not commonly known by the disputed domain name. Neither is the Respondent in any way related to the Complainant. Nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent failed to provide any information or evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

The Panel therefore also concludes that the Respondent did not establish any right or legitimate interest to the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use of the disputed domain name, either in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name. On the contrary, the evidence provided by the Complainant shows that the disputed domain name is used to direct traffic to websites advertising banking services of competitors of the Complainant.

None of the prima facie evidence was challenged by the Respondent. On the contrary, there was no response to the Complainant's cease-and-desist letter of June 19, 2020 at all.

In the absence of a Response and given the reputation of the Complainant and its trademarks, company name and domains as supported by the Complainant's evidence, the Panel must conclude that the Respondent was fully aware of the Complainant's trademarks, domains and company name such as e.g. "INTESA" and "GRUPPO INTESA SANPAOLO" at the time of registering the disputed domain name <INTESAGRUPPO.NET>.

Therefore, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under 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. **INTESAGRUPPO.NET**: Transferred

PANELLISTS

Name	Udo Pfléggar
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DATE OF PANEL DECISION	2021-03-10
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Publish the Decision
