

Decision for dispute CAC-UDRP-103543

Case number	CAC-UDRP-103543
Time of filing	2021-03-02 09:23:54
Domain names	BANCA-INTESA-SAN-PAOLO.COM

Case administrator

Organization	Denisa Bilík (CAC) (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

Organization	Milen Radumilo
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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, inter alia, of the following registrations for the trademarks “INTESA SANPAOLO” and “BANCA INTESA SANPAOLO”:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, filed on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38;
- EU trademark registration n. 5302377 “BANCA INTESA SANPAOLO”, filed on September 8, 2006, granted on July 6, 2007 and duly renewed, in classes 35, 36 and 38.

Moreover, the Complainant is also the owner, inter alia, of the following domain names bearing the signs “INTESA SANPAOLO” and “BANCA INTESA SANPAOLO”: <INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ and BANCAINTESASANPAOLO.COM, .EU, .INFO, .BIZ, .ORG, .NET>.

All of them are connected to the official website <http://www.intesasanpaolo.com>.

FACTUAL BACKGROUND

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

The Complainant is the leading Italian banking group and a major player 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 32,1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 5,300 branches well distributed throughout Italy, with market shares of more than 21% in most Italian regions, the Group offers its services to approximately 14,7 million Italian customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,1 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.

On March 31, 2020, the Respondent registered the disputed domain name <BANCA-INTESA-SAN-PAOLO.COM>.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant's contentions can be summarised as follows:

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

The disputed domain name is confusingly similar, to the Complainant's trademarks "INTESA SANPAOLO" and "BANCA INTESA SANPAOLO" and virtually identical to the Complainant's well-known trademark "BANCA INTESA SANPAOLO" adding only hyphens as punctuation and the gTLD .com which do not prevent said confusing similarity.

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

The Respondent has no rights to the disputed domain name and is not authorized by the Complainant to use the Complainant's trade marks or the disputed domain name.

The disputed domain name does not correspond to the name of the Respondent and the Respondent is not commonly known as "BANCA-INTESA-SAN-PAOLO".

There are no fair or non-commercial uses of the disputed domain name.

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 disputed domain name which is not a bona fide offering of services.

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

The Complainant's trademarks "INTESA SANPAOLO" and "BANCA 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 their complicated elements 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 "INTESA

SANPAOLO” and “BANCA INTESA SANPAOLO”, the same would have yielded obvious references to the Complainant. 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 disputed domain name would not have been registered if it were not for the Complainant’s trademarks. This is a clear evidence of registration of the disputed domain name in bad faith.

By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of his web site (par. 4(b)(iv) of the Policy).

Several WIPO decisions stated that the registration and use of a domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy. See, e.g., Encyclopaedia Britannica Inc. v. Shedon.com, WIPO Case No. D2000-0753 (“Respondent’s Ownership of a site which is a mis-spelling of Complainant’s britannica.com site and which Respondent used to hyperlink to a gambling site demonstrates Respondent’s bad faith registration and use of the britannica.com domain name”); YAHOO! INC. v. David Murray, Case No. D2000-1013 (finding bad faith where respondent chooses a domain name similar to the complainant’s mark for a site which offers services similar to the complainant); Edmunds.com v. Ultimate Search, Inc., WIPO Case No. D2001-1319 (“Registration and use of a domain name to redirect Internet users to websites of competing organizations constitutes bad faith registration and use under the Policy”); Netwizards, Inc. v. Spectrum Enterprises, WIPO Case No. D2000-1768 (“Registration and continued use of the contested domain name for re-directing Internet users, i.e. particularly customers and potential customers of the Complainant, from the Complainant’s website to the website of...a company which directly competes with the Complainant, constitutes bad faith registration and use”); Oly Holigan, L.P. v. Private, Case No. FA0011000095940 (finding bad faith where respondent used the disputed domain name to “redirect the Complainant’s consumers and potential consumers to commercial websites which are not affiliated with Complainant”); Marriott International, Inc. v. Kyznetsov, Case No. FA0009000095648 (finding bad faith where respondent registered the domain name <marriottrewards.com> and used it to route internet traffic to another website that “promotes travel and hotel services . . . identical to the services offered by the Complainant”); Zwack Unicom Ltd v. Duna, WIPO Case No. D2000-0037 (respondent’s linking to complainant’s competitor held to constitute bad faith); Schneider Electric SA v. Ningbo Wecans Network Technology Co., Ltd, Ningbo Eurosin International Trade Co., Ltd., Case No. D2004-0554; Microsoft Corporation v. StepWeb, Case No. D2000-1500; Baudville, Inc. v. Henry Chan, Case No. D2004-0059; National City Corporation v. MH Networks LLC, Case No. D2004-0128.

The Respondent’s commercial gain is evident, since it is obvious that the Respondent’s sponsoring activity is being remunerated.

RESPONDENT:

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

The disputed domain name is confusingly similar to the Complainant's "BANCA INTESA SANPAOLO" mark (registered, inter alia, in the EU for financial services since 2007) containing that mark in its entirety and adding only hyphens as punctuation and the gTLD ".com" neither of which prevent said confusing similarity.

The Respondent is not commonly known by the disputed domain name or authorised by the Complainant. The disputed domain name has been pointed to competing commercial pay per click links which is not a bona fide offering of goods or services or a legitimate non-commercial or fair use.

The registration of a domain name containing a combination of the three elements of the Complainant's mark and the pointing of that domain name to competing financial services makes it more likely than not that the Respondent knew of the Complainant and its business, rights and services at the time of registration of the disputed domain name.

The Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or services on it and thereby disrupting the Complainant's business.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **BANCA-INTESA-SAN-PAOLO.COM**: Transferred

PANELLISTS

Name	Dawn Osborne
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DATE OF PANEL DECISION 2021-03-23

Publish the Decision