

Decision for dispute CAC-UDRP-103702

Case number	CAC-UDRP-103702
Time of filing	2021-04-06 11:34:51
Domain names	sanpaolointesa-group.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

Name	Nanci Nette
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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, among others, of the following registrations for the trademarks "INTESA SANPAOLO" and "GRUPPO INTESA SANPAOLO":

- International trademark registration n. 920896 "INTESA SANPAOLO", granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration n. 5301999 "INTESA SANPAOLO", granted on June 18, 2007 and duly renewed, in connection with the classes 35, 36 and 38;
- EU trademark registration n. 5344544 "GRUPPO INTESA SANPAOLO", granted on July 06, 2007 and duly renewed, in classes 35, 36 and 38.

Moreover, the Complainant is also the owner, among others, of the following domain names bearing the signs "INTESA SANPAOLO" and "GRUPPO INTESA SANPAOLO": <INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ and GRUPPOINTESASANPAOLO.COM, .INFO, .BIZ, .ORG, .NET, .EU>.

FACTUAL BACKGROUND

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.

The Complainant is among the top banking groups in the euro zone, with a market capitalisation exceeding 41,5 billion euro, and the leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 5,300 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 14,7 million 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 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 of several trademarks with the term "INTESA SANPAOLO" and "GRUPPO INTESA SANPAOLO" and also several domain names bearing the signs "INTESA SANPAOLO" and "GRUPPO INTESA SANPAOLO". All of them are now connected to the official website <http://www.intesasanpaolo.com>.

On July 16, 2019, the Respondent registered the domain name <SANPAOLOINTESA-GROUP.COM>.

The Complainant has the view that 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 "GRUPPO INTESA SANPAOLO". As a matter of fact, <SANPAOLOINTESA-GROUP.COM> is almost identical to the trademark "INTESA SANPAOLO", with the mere inversion of the terms "INTESA" and "SANPAOLO", and the addition of the word "group".

The Complainant contents, that the Respondent has no rights on the disputed domain name, and any use of the trademarks "INTESA SANPAOLO" and "GRUPPO INTESA SANPAOLO" has to be authorized by the Complainant. Nobody has been authorized or licensed by Complainant to use the domain name at issue.

The disputed domain name does not correspond to the name of the Respondent and, to the best of Complainant knowledge, the Respondent is not commonly known as "SANPAOLOINTESA-GROUP".

The Complainant contents that it's trademarks "INTESA SANPAOLO" and "GRUPPO 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 SANPAOLO" and "GRUPPO 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 in the view of Complainant that the disputed domain name would not have been registered if it were not for Complainant's trademark. This, the Complainant points out, is a clear evidence of registration of the disputed domain name in bad faith.

In addition, the disputed domain name is not used for any bona fide offerings. More particularly, the Complainant states, that there are present circumstances indicating that, 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).

First of all, several services can be detected, but not in good faith: in fact, the 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.

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 states, that 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, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones. So, the Respondent's conduct is even worse. The Respondent's commercial gain is in the view of Complainant evident, since it is obvious that the Respondent's sponsoring activity is being remunerated.

In the view of the Complainant, it is no coincidence that a big financial institution such as Intesa Sanpaolo is involved in this case. In fact, the diversion practice in banking realm is very frequent due to the high number of online banking users. In fact, it has also to be pointed out that the Complainant has already been part of other WIPO Cases where the panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations.

Lastly, the Complainant points out that on January 25, 2021 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

A. Identical or confusingly similar with Complainant's trademark

The Complainant owns "Intesa Sanpaolo" trademark registrations effective in various jurisdictions. As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain name incorporates the entire Complainant's trademark "Intesa Sanpaolo" but in the wrong order with adding the word "group" divided by the sign "-" at the end of the disputed domain name.

As stated in WIPO Overview 3.0 “where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element” (see par. 1.8).

In the present case, the Complainant’s trademark is clearly recognizable, even in the wrong order, in the disputed domain name and the addition of the generic word “group” divided by a minus sign from the trademark “Intesa Sanpaolo” of Complainant does not lead to a different conclusion.

The .com domain zone shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The Respondent did not respond.

When a respondent remains completely silent in the face of a prima facie case that it lacks any rights or legitimate interests in respect of a domain name, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. Here the Complainant has presented an abundance of evidence to show that the Respondent has no plausible right or legitimate interest in respect of the disputed domain name and the Panel so finds.

The disputed domain name redirects to a parking page with commercial links and previous panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use (see e.g. CAC Case No. 102862 and WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe).

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

The Panel believes that Respondent registered the disputed domain name with full knowledge of Complainant's rights. The disputed domain name was registered more than ten years after the registration of the trademarks and the domain names of the Complainant and Complainant used it widely since then.

Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. If the Respondent had carried even a basic Google search in respect of the wording “INTESA SANPAOLO”, the same would have yielded obvious references to the Complainant.

Besides, the evidence on record shows that the disputed domain name redirects to a parking page with commercial links. Respondent’s use of the disputed domain name for a parking page is in itself sufficient to support a finding of bad faith use as Respondent is intentionally attempting to attract Internet users to its website for commercial gain, and is thus creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent’s website, in accordance with paragraph 4(b)(iv) of the Policy.

All the circumstances of this dispute demonstrate that the Respondent targeted the Complainant by incorporating Complainant’s trademark in the wrong order with adding the word “group” at the end of the disputed domain name. Besides, the Complainant contends that the Respondent choose to register the domain names to create a confusion with domain name used by the Complainant. The Panel agrees with the Complainant.

Furthermore, the Complainant’s attorneys send on January 25, 2021 to the Respondent a cease and desist letter, asking for

the voluntary transfer of the disputed domain name. Despite such communication, the Respondent did not comply with the above request.

Based on the above, the Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. SANPAOLOINTESA-GROUP.COM: Transferred

PANELLISTS

Name	Jan Christian Schnedler, LL.M.
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DATE OF PANEL DECISION 2021-04-28

Publish the Decision