

Decision for dispute CAC-UDRP-103820

Case number	CAC-UDRP-103820
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Time of filing	2021-05-24 09:36:01
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Domain names	INTESACASH.COM
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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	Whitehall World Wide
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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 proved to be the owner of the following “INTESA” and “INTESA SANPAOLO” trademarks:

- 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; and
- 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.

The Complainant supports to be the owner of numerous domain names composed by INTESA or INTESA SAN PAOLO.

FACTUAL BACKGROUND

FACTUAL BACKGROUND

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

The Complainant is an Italian based company active in the banking field.

The Complainant owns numerous trademarks composed by "INTESA" or "INTESA SAN PAOLO" and operates the domain name <intesasanpaolo.com>.

According to the information provided by the Registrar, the Respondent is Whitehall World Wide. The disputed domain name currently resolves to a webpage hosting sponsored links.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

As regards the first element of the Policy, the Complainant supports that the disputed domain name is confusingly similar to the "INTESA" and "INTESA SAN PAOLO" trademarks. The addition of the element "CASH" does not impact on the confusing similarity assessment in view of its dictionary/generic meaning.

As regards the second element of the Policy, the Complainant denies that the Respondent has been authorized to use the trademarks "INTESA" and "INTESA SAN PAOLO" in the disputed domain name. Moreover, the Respondent is not making a non-commercial / fair use of the disputed domain name.

As regards the third element of the Policy, the Complainant claims that the Respondent registered the disputed domain name primarily for the purpose of economically exploiting the Complainant's INTESA and INTESA SAN PAOLO trademarks through the sponsored links.

RESPONDENT:

The Respondent did not submit any reply.

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

1. The disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

The disputed domain name is confusingly similar to the Complainant's registered trademark as it wholly incorporates the sign INTESA (see *Six Continent Hotels, Inc. v. The Omnicorp*, WIPO Case No. 2005-1249 and *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903).

The addition of the element "CASH" increases rather than excludes the risk of confusion for the public. In the Panel's view "cash" could be easily associated to the banking and financial field which is the core business of the Complainant.

Furthermore, the addition of ".com" is generally disregarded in view of its technical function.

As a consequence, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark INTESA, for the purposes of the First Element of the Policy.

2. The Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a response to the Complaint. Therefore, it has notified the Panel about possible rights or legitimate interests it might hold on the disputed domain name. On its part, the Complainant has submitted information and arguments which, according to the Panel, are sufficient to conclude that the Respondent has no rights or legitimate interest in the disputed domain name.

According to the information provided by the Complainant, and not contested, the Respondent is not commonly known by the disputed domain name nor he has been authorized to use the Complainant's trademark.

Additionally, the disputed domain name leads to a webpage containing several sponsored links related to the financial field. The Panel takes the view that such use is not a non-commercial or fair use for the purposes of the Policy. It is probable that the domain name owner obtains revenues from the sponsored links each time an internet users clicks on the link. Moreover, the word "Intesa" has no "dictionary" meaning which could justify the nature of the PPC links involved in this case. Therefore, the Respondent's revenues derive from a non-authorized use of the "INTESA" trademark.

For these reasons, the Panel takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name for the purposes of the Policy.

3. The disputed domain name has been registered and is being used in bad faith.

The Panel finds the following circumstances as material in order to establish the Respondent's bad faith in the registration of the disputed domain name:

(i) the disputed domain name was registered well after the Complainant acquired rights on the trademarks "INTESA" and "INTESA SAN PAOLO";

(ii) the Complainant's trademark is known in the banking/financial field at least in Europe. The reputation of the INTESA and INTESA SAN PAOLO trademarks makes it very improbable that the Respondent was not aware of the Complainant's exclusive rights at the time of the registration of the disputed domain name. Under this regard a quick google search could have easily showed that INTESA is a trademark used by the Complainant;

(iii) the use of the word "CASH" combined with "INTESA" is, without any reasonable explication by the Respondent, an index that the Respondent knew about the INTESA trademark and the Complainant's business at the time of the registration of the disputed domain name.

As regards use in bad faith, the Panel is convinced that the Respondent intention was to use the disputed domain name to exploit the Complainant's trademarks for economical purposes. The PPC links are all related to the Complainant's business and they are not justified by a "dictionary" meaning of the word "INTESA". Therefore, internet users are attracted to the disputed

domain name only because the "INTESA" trademark is well known in its field of business. As a consequence also the Respondent's PPC revenues are caused by a non-authorized use of the Complainant's trademark, INTESA, in the disputed domain name.

Such use is considered by the Panel in bad faith.

Moreover, the Respondent had the chance to explain the reason of the registration/use of the disputed domain name both in and outside this administrative proceeding but failed to do so.

All above considered the Panel finds the evidence submitted as sufficient to prove use and registration in bad faith of the disputed domain name for the purposes of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **INTESACASH.COM**: Transferred

PANELLISTS

Name	Andrea Mascetti
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DATE OF PANEL DECISION	2021-06-25
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Publish the Decision