

Decision for dispute CAC-UDRP-103907

Case number	CAC-UDRP-103907
Time of filing	2021-07-02 09:36:57
Domain names	INTESA-SAN-PAOLO-PRIVATE.NET

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	giulia baccanelli
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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 of a number of trade marks for INTESA SANPAULO including, by way of example only, European Union trade mark registration number 530199 for INTESA SANPAULO in classes 35, 36 and 38, applied for on September 8, 2006 and registered on June 18, 2007.

FACTUAL BACKGROUND

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

The Complainant is an Italian banking group which was formed in 2007 following the merger of Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. It has a market capitalisation exceeding EUR 29.9 billion and approximately 4,700 branches in Italy as well as many branches in other countries. The Complainant trades as INTESA SANPAULO and owns many trade marks to protect this trading style including the mark in respect of which full details are given above. It also owns a large number of domain names which comprise or include its trade marks, including <intesasanpaolo.com>, which resolves to its principal website.

The disputed domain name was registered on June 25, 2020. As at June 29, 2021 it resolved to a directory page containing a number of Italian language pay-per-click ("PPC") links including "Prestiti Online Esito Immediato" (that is, "Online Loans Immediate Result") and "Apri Conto Aziendale Online" (that is "Open Business Account Online").

The disputed domain name is identical or at least confusingly similar to the Complainant's INTESA SANPAULO trade mark as it exactly reproduces it and simply adds the word "Private".

The Respondent has no rights or legitimate interests in respect of the disputed domain name. Any use of the Complainant's INTESA SANPAULO mark has to be authorised by it and it has not authorised or licensed the Respondent to register or use the disputed domain name. The Respondent is not known as "Intesa-San-Paulo-Private", nor is it making any fair or non-commercial uses of the disputed domain name.

The Respondent has registered and is using the disputed domain name in bad faith. The Complainant's INTESA and INTESA SANPAULO trade marks are distinctive and well-known. The fact that the disputed domain name is confusingly similar to the Complainant's INTESA SANPAULO trade mark suggests that the Respondent was aware of the Complainant's mark as at the date it registered it and would not have been registered were it not for the Complainant's trade mark.

The disputed domain name is not being used for any bona fide offering. Moreover, the circumstances indicate that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its website. The links on the Respondent's website are associated with the services for which the Complainant's trade marks are registered. Accordingly, Internet users searching for information on the Complainant will be confusingly led to the Respondent's website and to sponsored links for services provided by the Complainant's competitors.

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

Paragraph 4(a) of the Policy requires that the Complainant prove each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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.

Identical or confusingly similar

So far as the first element is concerned, the Complainant's trade mark registrations for INTESA SANPAULO, including the trade mark in respect of which full details are provided above, establish its rights in this mark.

For the purpose of comparing the disputed domain name with the Complainant's mark, it is established practice to disregard the generic Top-Level Domain, that is ".net" in the case of the disputed domain name, as this is a technical requirement of registration. The remaining element of the disputed domain name comprises the Complainant's trade mark, in full and without alteration, save for the inclusion of hyphens between the individual elements, followed by the word "private". The hyphens are of no significance in this context and the word "private", which can be associated with personal banking services, does not serve to differentiate the disputed domain name from the Complainant's trade mark.

Where a domain name wholly incorporates a complainant's registered trade mark that is sufficient to establish confusing similarity for purposes of first element of the Policy; see, for example, CAC Case No. 102382, MAJE v enchong lin. The Panel accordingly finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

Rights and legitimate interests

Paragraph 4(c) of the Policy sets out circumstances, without limitation, by which a respondent might demonstrate that it has rights or a legitimate interest in a domain name. These are, summarised briefly: (i) if the respondent has been using the domain name in connection with a bona fide offering of goods and services; (ii) if the respondent has been commonly known by the domain name; or (iii) if the respondent has been making a legitimate non-commercial or fair use of the domain name.

As to whether the use to which the disputed domain name is being put might amount to a bona fide offering of goods and services, the use of a domain name to host a parked page comprising PPC links will not be considered to comprise a bona fide offering if such links capitalize on the reputation and goodwill of the complainant's mark; see, for example, CAC Case No. 102384, Avast Software s. r. o. v Milen Radumilo.

There is no evidence that the Respondent has been commonly known by the disputed domain name, nor does the Respondent's use of the domain name to point to a directory page amount to making a legitimate non-commercial or fair use of it. The second and third circumstances set out at paragraph 4(c) of the Policy are therefore also inapplicable. The Complainant having made out a prima facie case in relation to the second element, the burden of proof shifts to the Respondent to rebut it; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. In the absence of any response by it to the Complaint, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Bad faith

The Panel accepts the Complainant's submission that the distinctive nature of the Complainant's mark and its repute means that it is highly improbable that the Respondent registered the disputed domain name without an awareness of the Complainant and its trade mark rights. This is particularly the case when the only known use to which the disputed domain name has been put is to point to a page hosting PPC links associated with the Complainant's services, which suggests that the Respondent did not have any other use in mind for the disputed domain name as at the date of registration. In these circumstances, the registration by the Respondent of the disputed domain name, which is confusingly similar to the Complainant's mark, leads to a presumption of bad faith; see for example CAC Case No 102157, FEDERATION FRANCAISE DE TENNIS (FFT) v Biswas, Jyotirmoy. The Panel therefore finds that the disputed domain name was registered in bad faith.

Whilst the use of a domain name to point to parking pages hosting PPC sponsored links is not inherently objectionable, previous decisions under the Policy have found that such conduct can constitute bad faith use if the combination of the characteristics of a domain name and the nature of the links on the website to which it resolves are intended to mislead Internet users. The Respondent is seeking to gain income from Internet users who visit its website under the impression that

the disputed domain name is owned and operated by, or with the authority of the Complainant. The fact that those Internet users will appreciate, on arriving at the Respondent's website, that it has no connection with the Complainant is immaterial because the Respondent will, by then, have had the opportunity to earn PCC income from Internet users who may click on one or more of the sponsored links on its website particularly as some of those links ostensibly relate to services similar to those provided by the Complainant. See, for example, Yahoo! Inc. v. Hildegard Gruener, WIPO Case No. D2016-2491. The Respondent is deriving income from the confusion being caused to Internet users and such conduct falls within the example of bad faith registration and use set out at paragraph 4(b)(iv) of the Policy namely that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website.

For these reasons, the Panel therefore finds that the disputed domain name was both registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-SAN-PAOLO-PRIVATE.NET**: Transferred

PANELLISTS

Name	Antony Gold
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DATE OF PANEL DECISION	2021-08-09
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Publish the Decision