

Decision for dispute CAC-UDRP-103909

Case number	CAC-UDRP-103909
Time of filing	2021-07-02 09:38:25
Domain names	INTESA-DISANPAOLOSMS.COM, SICUREZZA-INTESASANPAOLO-IT.COM, PERSONE-E-FAMIGLIE-INTESASANPAOLO.COM, LOGIN-PAGE-INTESADISANPAOLO.COM, INTESASAN-PAOLO-ENTRA.COM, SICUREZZA-INTESASANPAOLO-IT.NET, SMS-INTESA-DISANPAOLO.COM, INTESA-SANMOBILE.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	Maurizio Fabio Milani
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of several trademark registrations consisting of the terms "ISP", "GRUPPO INTESA" and "GRUPPO INTESA SANPAOLO":

- EU trademark registration n. 12247979 "INTESA", filed 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", filed on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

FACTUAL BACKGROUND

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

The Complainant claims to be among the top banking groups in the euro zone, with a market capitalisation exceeding 47,0

billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

It further contends its marks "INTESA SANPAOLO" and "INTESA" are distinctive and well known all around the world.

The Respondent registered the disputed domain names on August 3, 2020. The disputed domain names lead to a construction website without any true content.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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 Panel finds that all eight disputed domain names are confusingly similar to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA":

Many panels have found that a domain name is confusingly similar to a complainant's trademark where it incorporates the complainant's trademark in its entirety. This is the case here, where all of the disputed domain names contain one or both registered trademarks. The combination of these trademark(s) with the term "DI" or further terms, such as "SMS", "SICUREZZA" (meaning "safety"), "PERSONE-E-FAMIGLIE" (meaning "persons and families"), "LOGIN-PAGE", "ENTRA" (meaning "enter") or MOBILE does not avoid the finding of confusing similarity. These terms will either not be noted by the public ("DI") or are descriptive and will therefore lead to users' confusing expectations that corresponding websites run by the Complainant are accessible under the respective domain names.

2.

In the absence of any response, or any other information from the Respondent indicating the contrary, the Panel further holds that the Complainant successfully presented its prima facie case and that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

In particular, the Respondent is not affiliated with nor authorized by the Complainant in any way, and it is not related in any way to the Complainant's business. In addition, the Respondent is not commonly known by any of the disputed domain names. Finally, the websites available under the disputed domain names only show construction websites with can neither be considered as bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

3.

Finally, the Panel finds that the disputed domain names have also been registered and are being used in bad faith.

First, it is to be noted that the non-use of a disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding.

It is the view of this Panel that the Respondent has intentionally registered the series of disputed domain names, which fully include the Complainant's trademarks "INTESA SANPAOLO" and/or "INTESA". In addition, the Panel notes that Complainant's trademarks "INTESA SANPAOLO" and "INTESA" are deemed well-known at least in Italy, where the respondent is located. Therefore, it is the view of this Panel that the Respondent knew or should have known that the disputed domain names are almost identical to the Complainant's trademark(s) when it registered these domain names. Registration of a domain name in awareness of a reputed trademark and in the absence of rights or legitimate interests amounts to registration in bad faith.

Considering the high similarity between the trademark "INTESA SANPAOLO" and/or "INTESA" and the disputed domain names, which suggests the Respondent's awareness of the trademark, the Panel finds that the Respondent registered and is using the disputed domain names for bad faith purposes. Relevant additional factors supporting these findings are (i) the high degree of distinctiveness and the worldwide reputation of the Complainant's marks, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, (iii) the implausibility of any good faith use to which the disputed domain names may be put and, (iv) the Respondent hiding his identity behind a privacy shield.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. INTESA-DISANPAOLOSMS.COM: Transferred
2. SICUREZZA-INTESASANPAOLO-IT.COM: Transferred
3. PERSONE-E-FAMIGLIE-INTESASANPAOLO.COM: Transferred
4. LOGIN-PAGE-INTESADISANPAOLO.COM: Transferred
5. INTESASAN-PAOLO-ENTRA.COM: Transferred
6. SICUREZZA-INTESASANPAOLO-IT.NET: Transferred
7. SMS-INTESA-DISANPAOLO.COM: Transferred
8. INTESA-SANMOBILE.COM: Transferred

PANELLISTS

Name	Dr. Tobias Malte Müller
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DATE OF PANEL DECISION 2021-08-16

Publish the Decision
