

Decision for dispute CAC-UDRP-103958

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| Case number | CAC-UDRP-103958 |
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| Time of filing | 2021-08-04 09:59:59 |
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| Domain names | ubi-banca.com |
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Case administrator

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| Organization | Denisa Bilík (CAC) (Case admin) |
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Complainant

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| Organization | Intesa Sanpaolo S.p.A. |
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Complainant representative

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| Organization | Intesa Sanpaolo S.p.A. |
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Respondent

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| Organization | linhai bo |
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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 has provided evidence of ownership of the following trademarks:

- International trademark registration n. 914379 "UBI BANCA", granted on January 15, 2007 and duly renewed, covering services in international classes 35, 36 and 41;

- International trademark registration n. 1489309 "UBI BANCA", granted on February 15, 2019, covering services in international classes 9, 16, 35, 36 and 41.

FACTUAL BACKGROUND

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

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

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.

Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 45,3 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,700 branches capillary and well distributed throughout the Country, with market shares of more than 19 % in most Italian regions, the Group offers its services to approximately 13,5 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 25 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.

UBI Banca (Unione di Banche Italiane) was established on April 1, 2007 from the merger between Banche Popolari Unite and Banca Lombarda e Piemontese. As from August 5, 2020 UBI Banca is part of the Intesa Sanpaolo Group and involves a multiregional coverage with 1,565 branches in Italy and an international presence aimed at customer needs. UBI Banca is the fifth largest banking company in Italy by number of branches.

The Complainant is also the owner, among the others, of the following domain names bearing the sign “UBI BANCA”: <UBIBANCA.COM>, <UBIBANCA.INFO>, <UBIBANCA.BIZ>, <UBIBANCA.ORG> (all of them are now connected to the official website <https://www.ubibanca.com/> and <UBIBANCA.EU>).

On May 29, 2021 the Respondent registered the domain name <UBI-BANCA.COM>.

The domain name at issue is identical, or – at least – confusingly similar, to the Complainant’s trademark “UBI BANCA”. <UBI-BANCA.COM> exactly reproduces the well-known trademark “UBI BANCA”.

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

The Respondent has no rights on the disputed domain name, and any use of the trademark “UBI BANCA” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue.

The domain name at stake does not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as “UBI-BANCA”.

Lastly, the Complainant did not find any fair or non-commercial uses of the domain name at stake.

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

The disputed domain name <UBI-BANCA.COM> was registered and is used in bad faith.

The Complainant’s trademark “UBI BANCA” is distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to “UBI BANCA” 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 wording “UBI BANCA”, the same would have yielded obvious references to the Complainant. The Complainant submits an extract of a Google search in support of its allegation. 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 domain name at issue would not have been registered if it were not for Complainant’s trademark. This is a clear evidence of registration of the domain name in bad faith.

In addition, the contested domain name is not used for any bona fide offerings. More particularly, 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 disputed domain name is now connected to a web site containing pornographic images, videos and links.

As it can be easily noted, the website contains several sponsored links offering pornographic items. Therefore, there is a clear commercial gain for the owner of the domain name, who is trading on the reputation of Intesa Sanpaolo. In fact, Internet users, while looking for Intesa Sanpaolo's website in order to get some information on its banking services, may chance upon the Respondent's website. Moreover, the Respondent's conduct is evidently causing dilution and tarnishment to the Complainant's marks and image.

The fact that the disputed domain name is connected to a pornographic website is a clear indication that the domain name has been registered and used in bad faith. As concluded in several WIPO cases (see, among others, Ty, Inc. v. O.Z. Names, WIPO Case No. D2000-0370; Oxygen Media, LLC v. Primary Source, WIPO Case No. D2000-0362; Dell Computer Corporation v. RaveClub Berlin, WIPO Case No. D2002-0601; Six Continents Hotels, Inc. v. Seweryn Nowak, WIPO Case No. D2003-0022), the redirection to pornographic sites from a domain name incorporating a well-known trademark is evidence of bad faith. In WIPO Case No. D2003-0022, for example, the Panel stated that «it is commonly understood, under WIPO case law, that, whatever the motivation of Respondent, the diversion of the domain names to a pornographic site is itself certainly consistent with the finding that the domain name was registered and is being used in bad faith».

In addition, it must be underlined that – according to the “WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3rd Edition (“WIPO Overview 3.0”)”, par. 3.12 – “using a domain name to tarnish a complainant's mark (e.g., by posting false or defamatory content, including for commercial purposes) may constitute evidence of a respondent's bad faith” and this surely includes adult contents, considering that the previous “WIPO Overview 2.0” (at par. 3.11) stated that “Intentional tarnishment of a complainant's trademark may in certain specific circumstances constitute evidence of registration and/or use of a domain name in bad faith. [...] Tarnishment in this context normally refers to such conduct as linking pornographic images or wholly inappropriate information to an unrelated trademark”.

As clearly underlined in WIPO Case No. D2003-0557; Miroglio S.p.A. v. Mr. Alexander Albert W. Gore, the consequences for Complainant “are potentially catastrophic, should even a minority of Internet users come to believe that Complainant is actually associated with pornography”. As the Panel stated in WIPO Case No. D2000-0079; Motorola, Inc. v. NewGate Internet, Inc., “while many adult sex sites are perfectly legal and constitute bona fide offerings of goods or services, the use of somebody else's trademark as a domain name (or even as a meta-tag) clearly does not constitute a bona fide offering of goods or services when the website owner has no registered or common law rights to the mark, since the only reason to use the trademark as a domain name or meta-tag is to attract customers who were not looking for an adult sex site, but were instead looking for the products or services associated with the trademark. Such use of a trademark can create customer confusion or dilution of the mark, which is precisely what trademark laws are meant to prevent. And actions that create, or tend to create, violations of the law can hardly be considered to be bona fide”.

It is no coincidence that this speculation has involved a big financial institution such as Intesa Sanpaolo. 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.

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

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

Notwithstanding the fact that no Response has been filed, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant must establish that it has a trademark or service mark and that the disputed domain name is identical or confusingly similar to that trademark or service mark for the Complainant to succeed.

The Complainant, Intesa Sanpaolo S.p.A., is an Italian banking group founded in 2007 and with branches in a large number of countries worldwide. The Complainant has provided evidence of ownership of the following registrations for the marks "UBI BANCA":

- International trademark registration n. 914379 "UBI BANCA", granted on January 15, 2007 and duly renewed, covering services in international classes 35, 36 and 41;
- International trademark registration n. 1489309 "UBI BANCA", granted on February 15, 2019, covering services in international classes 9, 16, 35, 36 and 41.

As regards the question of identity or confusing similarity for the purpose of the Policy, it requires a comparison of the disputed domain name with the trademarks in which the Complainant holds rights. According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), "this test typically involves a side-by-

side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name”.

Also, according to section 1.7 of the WIPO Overview 3.0, “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing”.

The disputed domain name wholly incorporates the Complainant’s trademarks “UBI BANCA” in addition to a hyphen. This addition does not prevent a finding of confusing similarity with the Complainant’s trademarks. The fact that a domain name wholly incorporates a complainant’s trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such marks.

It is well accepted by UDRP panels that a generic Top-Level Domain (“gTLD”), such as “.com”, is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark.

This Panel concludes that the disputed domain name is identical to the Complainant’s trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate the respondent’s rights or legitimate interests in the disputed domain name:

- (i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview 3.0, which states: “[...] where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

The evidence on record does not show that the Respondent was commonly known, as an individual or an organization, by the disputed domain name.

The Panel also accepts, in the absence of a rebuttal from the Respondent, that the Respondent uses the Complainant’s trademarks in the disputed domain name without authorization from the Complainant.

Equally, the Panel finds that the Respondent has not made a legitimate noncommercial or fair use of the disputed domain name.

Therefore, the Panel concludes that the Respondent has no right or legitimate interests in the disputed domain name and therefore finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registration and Use in Bad faith

For the purpose of Paragraph 4(a) (iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the domain names in bad faith:

(i) circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the holders documented out-of-pocket costs directly related to the domain name; or

(ii) the holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or

(iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on the holder's website or location.

The Panel finds the third and fourth elements of Paragraph 4(b) of the Policy applicable in the present case.

The Panel sides with the Complainant and agrees that the Complainant's UBI BANCA trademarks are well known worldwide in relation to banking services.

The evidence on the record shows that the Respondent was certainly aware of the existence of the Complainant and of the rights of the Complainant, and that the Respondent, by registering and using the disputed domain name has intentionally attracted internet users by creating a likelihood of confusion with the Complainant's trademark.

In addition, the website associated with the domain name displays adult content and pay-per-click commercial links which allow the Respondent to profit off the Complainant's well-known trademark.

The Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith, and therefore finds that the requirement of paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UBI-BANCA.COM**: Transferred

PANELLISTS

| | |
|------|---------------------|
| Name | Arthur Fouré |
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| DATE OF PANEL DECISION | 2021-08-28 |
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Publish the Decision
