

Decision for dispute CAC-UDRP-103941

Case number	CAC-UDRP-103941
Time of filing	2021-07-30 09:59:24
Domain names	banca-intesasanpaolo.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	David Czinczenheim
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that 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 “BANCA INTESA SANPAOLO”:

- International trademark registration No. 920896 “INTESA SANPAOLO”, granted on 7 March 2007 and duly renewed in Classes 9, 16, 35, 36, 41 and 42 under the Nice Classification (NCL);
- EU trademark registration No. 5301999 “INTESA SANPAOLO”, granted on 18 June 2007 and duly renewed in NCL classes 35, 36 and 38; and
- EU trademark registration No. 5302377 “BANCA INTESA SANPAOLO”, granted on 6 July 2007 and duly renewed in NCL classes 35, 36 and 38.

The Complainant is also the owner of the following domain names, among others, incorporating the marks “INTESA SANPAOLO” and “BANCA INTESA SANPAOLO”: <INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, BANCAINTESASANPAOLO.COM, BIZ, INFO, NET, ORG, EU, IT>. All of these domain names connect to the main website <www.intesasanpaolo.com>.

The Respondent registered the domain name <BANCA-INTESASANPAOLO.COM> on 7 December 2020.

FACTUAL BACKGROUND

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

The Complainant, Intesa Sanpaolo, is Italy's leading banking group. It has an extensive coverage there geographically and in terms of offerings and is among the eurozone's top banking groups with a market capitalisation of over €45 billion. The group also has a strong presence in central and eastern Europe, with a network of some 1,000 branches and over 7.2 million customers. The Complainant's international network specialized in supporting corporate customers comprises 25 countries, in particular in the Mediterranean area and in areas where Italian companies are most active such as in the United States, Russia, China and India.

The Complainant provides internet banking among its extensive offerings.

The Complainant's representatives on 21 January 2021 sent the Respondent a cease and desist letter, asking for the voluntary transfer of the disputed domain name to their client. The letter remains unanswered.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

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

It is more than obvious that the disputed domain name is identical or – at least – confusingly similar to the Complainant's trademarks "INTESA SANPAOLO" and "BANCA INTESA SANPAOLO". As a matter of fact, the disputed domain name <BANCA-INTESASANPAOLO.COM> exactly reproduces the well-known trademark "BANCA INTESA SANPAOLO".

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

The Respondent has no rights in the disputed domain name, whereas any use of the trademarks "INTESA SANPAOLO" and "BANCA INTESA SANPAOLO" must be authorized by the Complainant. The Complainant has authorized no one to use the disputed domain name.

Nor does the disputed domain name correspond to the Respondent's own name and, to the best of the Complainant's knowledge, the Respondent is not commonly known as "BANCA-INTESASANPAOLO".

There is no fair or non-commercial use being made of the disputed domain name, as is shown by the home page associated with it that is adduced in evidence in this proceeding. The home page redirects to a parking page offering the disputed domain name for sale.

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The domain name <BANCA-INTESASANPAOLO.COM> was both registered and is being used in bad faith.

The Complainant's trademarks "INTESA SANPAOLO" and "BANCA 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.

If the Respondent had carried out even a basic Google search in respect of the strings “INTESA SANPAOLO” and “BANCA INTESA SANPAOLO”, this would have yielded obvious references to the Complainant, as shown by an extract of a Google search performed by the Complainant and which it submits in evidence in support of this 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 disputed domain name would not have been registered if it were not for Complainant’s trademark. This is clear evidence of registration of the disputed domain name in bad faith.

The disputed domain name is not used in connection with any bona fide offerings. More particularly, the circumstances indicate that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the Complainant or a competitor for a consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name (this being an instance demonstrating bad faith contained in para. 4(b)(i) of the Policy). The evidence of the disputed domain name’s use referred to above redirects to a parking page where it is offered for sale.

The Complainant refers to decisions of several previous panels in support of the above contentions, and remarks that, absent bad faith, it is not possible to understand what kind of use the Respondent could make of a domain name which exactly corresponds to the Complainant’s trademarks. These are moreover these trademarks employed by a major financial institution for providing online banking services over its domain names. In fact, the practice of diverting clients is a frequent practice in the realm of banking due to the high number of online banking users, as shown by several earlier ADR claims made by the Complainant itself (a list of which was submitted in evidence).

Lastly, the Complainant draws attention to the fact that a cease and desist letter sent to the Respondent and asking him to transfer the disputed domain name to the Complainant voluntarily remains unanswered.

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.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to a trademark 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 that 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

This is an uncontested case of cybersquatting for potential financial gain.

With respect to the cumulative three-part UDRP test, the Panel finds that:

(1) it is plain that the disputed domain name <BANCA-INTESASANPAOLO.COM> is confusingly similar to the Complainant's trademark "BANCA INTESA SANPAOLO", the Complainant's ownership of this mark having been duly substantiated in this proceeding;

(2) there is no indication whatsoever in this proceeding that the Respondent has any right or legitimate interest in the disputed domain name. To the contrary, the use being made of it (display of an offer to sell the disputed domain name on a parking page) indicates that employment of the Complainant's trademark serves to trade on that trademark in violation of the Complainant's rights;

(3) such trading on the Complainant's trademark in turn indicates bad faith use of the name, whereas any purpose at the point of registering the disputed domain name other than one in violation of the Complainant's rights can be discounted in the circumstances of this case.

In reaching these findings, the Panel has based itself on evidence submitted by the Complainant that substantiates each one. The Panel does not, however, accept the Complainant's contentions in their entirety and makes the following remarks:

- it attaches no weight to the Complainant's "cease and desist letter" and notes that this was sent to the registrar of the disputed domain name and not to the Respondent;

- it takes note of the susceptibility to misuse of banks' trademarks in an environment of prevalent online banking, and specifically of the 7-page list of ADR proceedings that the Complainant initiated, but draws no inference in this proceeding as concerns any particular behaviour relative to online banking as such;

- on technical grounds, it accords only limited significance to the evidence of a Google search that the Complainant adduced and was apparently performed by the Complainant. The Complainant in particular provided no details as to the method used to ensure that the search was conducted under conditions which could assure that a person unconnected with the Complainant and its affairs would also obtain such results. The Panel by contrast takes due note of the other evidence the Complainant offered as to its widespread presence and operations;

- it makes no determination as to the Respondent's actual identity. The Complainant has provided no substantiation in this regard, while the CAC Case Administrator received no confirmation of the delivery in this proceeding of CAC notifications to the registrant's email address that was provided by the disputed domain name's registrar when disclosing the Respondent's contact details.

None of the remarks just made, alone or combined, invalidates the above findings. The Panel therefore accepts the Complaint and orders the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	Kevin J. Madders
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DATE OF PANEL DECISION 2021-09-08

Publish the Decision
