

Decision for dispute CAC-UDRP-104000

Case number	CAC-UDRP-104000
Time of filing	2021-09-02 09:55:22
Domain names	MYINTESASANPAOLO.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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	CHENG LIN
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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 claims rights in the INTESA and INTESA SANPAOLO trademarks and service marks and has adduced evidence of its ownership of the following registrations:

- International trademark INTESA SANPAOLO, registration number 920896, registered on March 7, 2007, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark INTESA SANPAOLO, registration number 5301999, registered on June 18, 2007, for services in classes 35, 36 and 38;
- International trademark INTESA, registration number 793367 registered on September 4, 2002 for services in class 36; and
- EU trademark INTESA, registration number 12247979, registered on March 5, 2014, for goods and services in classes 9, 16, 35, 36 38, 41 and 42.

FACTUAL BACKGROUND

The Complainant has an established Internet presence and is also the owner of a large portfolio of Internet domain names including <intesanpaolo.com>, <intesanpaolo.org>, <intesanpaolo.eu>, <intesanpaolo.info>, <intesanpaolo.net>, <intesanpaolo.biz>, <intesa-sanpaolo.com>, <intesa-sanpaolo.org>, <intesa-sanpaolo.eu>, <intesa-sanpaolo.info>, <intesa-sanpaolo.net>, <intesa-sanpaolo.biz> and <intesa.com>, <intesa.info>, <intesa.biz>, <intesa.org>, <intesa.us>, <intesa.eu>, <intesa.cn>, <intesa.in>, <intesa.co.uk>, <intesa.tel>, <intesa.name>, <intesa.xxx>, <intesa.me>, all of which are now connected to the official website at <<http://www.intesanpaolo.com>>.

The disputed domain name was registered on February 21, 2021.

In the absence of a response to the Complaint, the only information available about the Respondent is that provided in the Complaint, the Registrar's Whois and the information provided by the Registrar in response to the request by the Center for verification of the registration details of the disputed domain name.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims rights in the INTESA and INTESA SANPAOLO trademarks established by its ownership of the portfolio of trademark and service mark registrations described herein and its extensive use of the marks in its banking business since January 1, 2007 following a merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups.

The Complainant asserts that it is among the top banking groups in the Euro zone, with a market capitalisation exceeding €45,3 billion, It has a presence in 25 countries, including Eastern Europe, the Mediterranean area, the United States, Russia, China, and India.

It has a network of approximately 4,300 branches capillary and well distributed throughout Italy where it is an undisputed leader in all business areas including retail, corporate and wealth management. With market shares of more than 19% in most Italian regions. The Complainant's banking group offers its services to approximately 13,5 million customers. In Central-Eastern Europe it has a network of approximately 1.000 branches and over 7,2 million customers.

The Complainant submits that the disputed domain name is identical, or at least confusingly similar, to the Complainant's trademarks INTESA and INTESA SANPAOLO because it exactly reproduces the INTESA SANPAOLO mark with the mere addition of the word "my".

The Complainant further argues that the Respondent has no rights or legitimate interests in the disputed domain name, because to the best of the Complainant's knowledge the Respondent is not known by the disputed domain name and the Complainant, as owner of the INTESA and INTESA SANPAOLO marks, has not licensed the Respondent or anybody to use the disputed domain name.

The Complainant refers to a screen capture of the homepage of the website to which the disputed domain name resolves which has been annexed as an exhibit to the Complaint, and argues that the Respondent is not making any fair, non-commercial, or bona fide use of the disputed domain name. The Complainant argues that the screen capture shows that the Respondent's website contains content sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used. This Panel notes however, that this statement is not correct because the screen capture merely shows a page with no content except for the words "home", "MY BANK" and the url <<https://www.myintesanpaolo.com>>.

The Complainant further alleges that the disputed domain name was registered and is being used in bad faith arguing that

the Complainant's trademarks INTESA and INTESA SANPAOLO are distinctive and well known all around the world. The fact that the Respondent has registered the disputed domain name that is confusingly similar to them indicates that the registrant had knowledge of the Complainant's trademarks at the time of registration.

In addition, the Complainant contends that if the Respondent had carried out even a basic Google search in respect of the words INTESA SANPAOLO and INTESA, the same would have yielded obvious references to the Complainant. In support of this argument, in an annex to the Complaint, the Complainant has submitted the results of a Google search that it carried out. It contends that 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 which is clear evidence of registration of the domain name in bad faith.

The Complainant adds that because of the similarity between the disputed domain name and the Complainant's trademarks, Internet users, while searching for information on the Complainant's services, are confusingly led to the websites of Complainant's competitors, sponsored on the websites connected to the domain name at issue. Therefore, the Complainant deems that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant's web site.

Furthermore, the contested domain name is not used for any bona fide offerings, but instead, 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. Several WIPO decisions stated that the registration and use of a domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy. See, e.g., Encyclopaedia Britannica Inc. v. Shedon.com, WIPO Case No. D2000-0753 ("Respondent's Ownership of a site which is a misspelling of Complainant's britannica.com site and which Respondent used to hyperlink to a gambling site demonstrates Respondent's bad faith registration and use of the britannica.com domain name").

It is further contended that the current use of the disputed domain name is misleading to the Complainant's clients and is likely to result in the loss of potential new ones, adding that the Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated.

Furthermore, the Complainant alleges that it is no coincidence that the Respondent has targeted the Complainant which is a big financial institution, and such diversionary practice is commonplace in the banking realm due to the high number of online banking users. The Complainant has previously brought a number of successful cases under the Policy where the Panellists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations. A list of the cases is provided in an annex to the Complaint.

Lastly, it shall be noted that on March 30, 2021 the Complainant's attorneys sent to the Respondent a cease-and-desist letter, asking for the voluntary transfer of the domain name at issue. Despite such communication, the Respondent did not comply with the above request.

RESPONDENT:

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

Language of Proceeding

Although the language of the registration agreement is Italian, the Complainant requests this Panel to accept the Complaint in the English language and direct that English is the language of the proceeding,

This Complainant submits that, while the Complainant is an Italian entity, the Respondent appears to be based in the U.S.A. and that the English language is comprehensible to a wide range of Internet users worldwide.

Additionally, the Complainant argues that the spirit of Paragraph 11 of the Rules requires fairness in the selection of language by giving full considerations to the parties' level of comfort with each language, therefore use of the English language is both fair and appropriate in the present proceeding.

Furthermore, as the Respondent, who has provided an address in in the U.S.A, is likely to be an English-speaking subject and the Complainant bases its claim on its registered trademark legitimately owned and used in Italy and at an international level by the Complainant from several years all around the world.

As an alternative the Complainant requests that the Complaint is accepted as filed in English and a Response may be filed in either English, or Italian or the preferable language of the Respondent, if any. In such circumstances a Panel familiar with such languages should be appointed.

Rule 11 of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") Language of Proceedings confers on the Panel authority to determine the language of the language of this administrative proceeding having regard to the relevant circumstances

(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Having considered the application of the Complainant, which is an Italian company, based in Italy, and considering that the registration agreement is in the Italian language, and therefore Italian would be the default language, and noting that the Respondent has registered the disputed domain name providing an address in the State of New Hampshire, U.S.A., he is likely to be familiar with the English language, and that the evidence adduced is in the English language, requiring no translations and the physical address of the Registrar chosen by the Respondent is in the State of California, U.S.A., this Panel is satisfied that there would be no prejudice to the Respondent if the Complainant's application is granted. Having regard to the circumstances of this administrative proceedings, this Panel allows the Complainant's application and directs that the language of this proceeding shall be English.

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

The Complainant has adduced convincing and uncontested evidence that it has rights in the INTESA and INTESA SANPAOLO trademarks established by its ownership of the portfolio of trademark and service mark registrations described and listed above and its extensive use of the marks in its banking business since January 1, 2007 following a merger

between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups, having grown to have a market capitalization exceeding €45,3 billion, a presence in 25 countries, with a network of approximately 4,300 branches and an established Internet presence.

The disputed domain name consists of the Complainant's INTESA and INTESA SANPAOLO registered marks with the mere addition of the prefix "my" and the generic Top-Level Domain ("gTLD") <.com> extension.

The Complainant's marks are the dominant and only distinctive elements of the disputed domain name. Neither the element "my" which is descriptive, nor the gTLD <.com> extension add any distinctive character to the disputed domain name.

This Panel finds therefore that the disputed domain name is confusingly similar to the INTESA and INTESA SANPAOLO marks in which the Complainant has rights and the Complainant has therefore succeeded in the first element of the test in paragraph 4(a)(i) of the Policy.

The Complainant has submitted that the Respondent has no rights or legitimate interests in the disputed domain name arguing that

- to the best of the Complainant's knowledge the Respondent is not known by the disputed domain name;
- the Complainant, as owner of the INTESA and INTESA SANPAOLO marks, has not licensed the Respondent or anybody to use the disputed domain name; and
- the screen capture of the homepage of the website to which the disputed domain name resolves which has been annexed as an exhibit to the Complaint shows that the Respondent is not making any fair, non-commercial, or bona fide use of the disputed domain name.

It is noteworthy that in notwithstanding the Complainant's submission that the screen capture of the Respondent's home page, shows content sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used. this Panel notes however, that this statement is not correct because the screen capture merely shows an almost blank webpage with no content except for the words "home", "MY BANK" and the url <<https://www.myintesasanpaolo.com>>.

Nonetheless, because of the strength of the Complainant's marks and because the Whois shows that the Respondent uses a name that is in no way similar to the disputed domain name or either of the Complainant's marks and because the disputed domain name is almost identical to the marks, this Panel accepts that the Respondent has a case to answer.

It is well established that once the Complainant makes out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name the burden of production falls on the Respondent to prove his rights or legitimate interest in the disputed domain name.

The Respondent has failed to discharge this burden and therefore this Panel must find that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has therefore succeeded in the second element of the test in paragraph 4(a)(ii) of the Policy.

This Panel finds that because of the distinctive character of the INTESA and INTESA SANPAOLO marks, and the long and extensive use of those marks by the Complainant, including on the Internet, resulting in a substantial international goodwill and reputation, it is implausible that the registrant of the disputed domain name was unaware of the Complainant, its name, subject trade marks, websites at the time of registration of the disputed domain name.

This Panel finds therefore that, on that balance of probabilities, the disputed domain name was chosen and registered in bad faith with the Complainant's marks in mind, to take predatory advantage of the Complainant, its marks and reputation. While the Complainant has not adduced evidence that the disputed domain name resolves to a website with links to the

Complainant's competitors, as it claims, it is nonetheless clear that the Respondent is using the disputed domain name, incorporating the Complainant's trademarks as the address of a website has no bona fide content and such use of the Complainant's trademarks is without license or permission.

Furthermore because of the similarity of the disputed domain name and the Complainant's marks, on the balance of probabilities Internet users seeking the Complainant who come across the Respondent's URL and website, would be misled and misdirected away from the Complainant's website therefore damaging the Complainant, its trademarks and the goodwill associated with the marks. In reaching this decision this Panel is conscious that the unauthorized adoption of the trademarks of a banking business in this manner is particularly likely to damage consumer confidence in the Complainant's other online activity.

This Panel finds therefore that on the balance of probabilities the disputed domain name is being used in bad faith. As this Panel has found that the disputed domain name has been both registered and is being used in bad faith, the Complainant has succeeded in the third and final element of the test in paragraph 4(a)(iii) of the Policy and is entitled to the remedy requested.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. MYINTESASANPAOLO.COM: Transferred

PANELLISTS

Name	Mr James Jude Bridgeman
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DATE OF PANEL DECISION 2021-10-01

Publish the Decision
