Decision for dispute CAC-UDRP-104051

Case number	**CAC-UDRP-104051**
Time of filing	**2021-10-04 09:58:01**
Domain names	**INTESAINVESTMENTBANK.COM**

Case administrator

Organization	**Iveta Špiclová (Czech Arbitration Court) (Case admin)**

Complainant

Organization	**Intesa Sanpaolo S.p.A.**

Complainant representative

Organization	**Intesa Sanpaolo S.p.A.**

Respondent

Name	**Elizabeth Omoregie**

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 owner of the following trademarks:
- International trademark registration n. 920896 “INTESA SANPAOLO”, registered on 7 March 2007, in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, filed on 8 September 2006 and registered on 18 June 2007, in classes 35, 36 and 38;
- International trademark registration n. 793367 “INTESA”, registered on 4 September 2002 and duly renewed, in class 36;
- EU trademark registration n. 12247979 “INTESA”, filed on 23 October 2013 and registered on 5 March 2014, in classes 9, 16, 35, 36 38, 41 and 42; and
- EU trademark registration n. 6661672 “INTESA SANPAOLO BANK & device”, filed on 12 February 2008 and registered on 23 January 2009, in classes 9, 16, 35, 36, 41 and 42.

The Complainant is also owner of numerous domain names registered in several TLDs and including the terms “INTESA SANPAOLO”, “INTESA” and “INTESA SANPAOLO BANK” (e.g., INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA.COM, .INFO, .BIZ, .ORG, .US, .EU, .CN, .IN, .CO.UK,

.TEL, .NAME, .XXX, .ME, and INTESASANPAOLOBANK.IT, .EU, .COM, .NET, .MOBI, .PL, etc.). All of them resolves to the official website of the Complainant (https://www.intesasanpaolo.com).

The above-mentioned trademarks and domain names are hereinafter collectively referred to as the INTESA SANPAOLO Trademark.

FACTUAL BACKGROUND

The Complainant is a leading Italian banking group, born from the merger of Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., effective as of 1 January 2007.

The Complainant is among the largest financial institutions in the Euro zone, with a market capitalisation exceeding 46,6 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,300 branches capillary and well distributed throughout Italy, with market shares of more than 19% in most Italian regions, the Complainant offers its services to approximately 13,5 million customers.

The Complainant has a strong presence in Central-Eastern Europe as well, with a network of approximately 1,000 branches and over 7,2 million customers.

Moreover, the Complainant's 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 in the United States, Russia, China and India.

The Complainant owns several trademarks and domain names, all of them characterised by the presence of the distinctive terms "INTESA SANPAOLO", “INTESA”, and “INTESA SANPAOLO BANK”.

The disputed domain name was registered on 27 August 2020, well after the registration of the Complainant's INTESA SANPAOLO Trademark, by Elizabeth Omoregie, an individual located in Nigeria.

The disputed domain name resolves to a parking page with PPC links to third parties' websites and related to products and services competing with the Complainant's products and services.

The Complainant sent a cease and desist letter to the Respondent without obtaining any response.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is identical or at least confusingly similar to the Complainant’s trademark, because it reproduces the term “INTESA” with the mere addition of the terms “INVESTMENT” and "BANK". According to the Complainant, considered the banking and financial context in which the Complainant operates, it is undeniable that the disputed domain name will result even more confusingly similar to the business carried out by the Complainant under the INTESA SANPAOLO Trademark.

The Complainant contends that the Respondent has nothing to do with the Complainant, nor has been authorised or licensed to use the INTESA SANPAOLO Trademark or to register or use the disputed domain name. The disputed domain name does not correspond to the Respondent's name, nor is this latter commonly known by the disputed domain name. Since the disputed domain name is parked, there is no fair or non-commercial use of the disputed domain name.

Finally, the Complainant contends that, given the distinctiveness and reputation of the INTESA SANPAOLO Trademark, it is unlikely that the Respondent had no knowledge of the Complainant's trademark when he had registered the disputed domain name. The Complainant has submitted the results of a Google search and alleges that had the Respondent performed a basic search on Google, he should have yielded obvious references to the Complainant. Hence, according to the Complainant, it is most likely that the Respondent registered and has used the disputed domain name having in mind the Complainant and the INTESA SANPAOLO Trademark and with the clear intention to take advantage of the reputation of the same by creating a likelihood of confusion between such mark and the disputed domain name. The Complainant also contends that the use of the disputed domain name which resolves to a parking page containing links that redirect to websites related to products and services competing with the Complainant's products and services is not to be considered a good faith use under the Policy and the UDRP case law.

The Complainant, therefore, requests the transfer of the disputed domain name.

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

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

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:
(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 by the Respondent in bad faith.

I. THE COMPLAINANT’S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S TRADEMARK

The Complainant has established that it has rights in the INTESA SANPAOLO Trademark since 2002.

In assessing identity or confusing similarity the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, because it incorporates the entirety or at least the distinctive part of the INTESA SANPAOLO Trademark, and differs from such mark by merely adding the generic and descriptive terms "INVESTMENT", "BANK", and the TLD .COM.

In UDRP cases where the relevant trademark is recognisable within the disputed domain name, Panels agree that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element (see paragraph 1.7 WIPO Overview 3.0).

In this specific case, the addition of terms related to the Complainant's business (banking and financial services) even increases the likeliness of confusion between the disputed domain name and the Complainant's trademark.

UDRP panels also agree that the TLD is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant’s trademark as it is a technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

2. THE RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent (see paragraph 2.1 of the WIPO Overview 3.0: "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 Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain name, nor is affiliated to the Complainant in any form.

The disputed domain name was registered on 27 August 2020 by Elizabeth Omoregie, an individual located in Nigeria. There is no evidence that the Respondent has been commonly known by the disputed domain name.

Moreover, the disputed domain name resolves to a parking page with PPC links to third parties' sites and to products or services competing with the Complainant's products or services. Such use of the domain name is clearly not a legitimate non-commercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s mark.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response and, thus, has failed to invoke any of the circumstances that could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

3. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Respondent registered the disputed domain name to be considered confusingly similar to the Complainant's trademark, since it incorporates the INTESA SANPAOLO Trademark or at least its distinctive part. The addition of the generic and descriptive terms “INVESTMENT” "BANK" and the TLD “.COM” (technical requirement of the registration) are not sufficient elements to escape the finding of confusing similarity between the disputed domain name and the Complainant’s trademark.

Considering that the Complainant provides banking and financial services, the Respondent's choice to add generic and descriptive terms concerning such activities to the trademark of the Complainant shows the Respondent's clear intention to enhance such likeliness of confusion for the Internet users who are seeking or expecting the Complainant.

Given the distinctiveness and reputation of the Complainant's prior mark (the Complainant has demonstrated that the INTESA SANPAOLO Trademark is frequently subject of cybersquatting), it is inconceivable that the Respondent could have registered

the disputed domain name for a mere chance without actual knowledge of the Complainant's rights in such well-known mark and the intention to exploit such reputation by diverting traffic away from the Complainant’s website.

Even assuming that the Respondent had no knowledge of the Complainant’s prior mark at the time of registration of the disputed domain name (which is quite unlikely), it omitted to verify that the disputed domain name would have infringed the Complainant's earlier rights or, even worse, it verified it and deliberately proceeded with the infringing registration and use.

The Complainant has submitted the results of a Google search carried out regarding the terms “INTESA SANPAOLO”, all of them related to the Complainant. Should the Respondent have performed a similar search on the Internet before registering the disputed domain name, he would have easily learnt about the Complainant’s activities and trademark registered and used worldwide.

This Panel highlights that, according to paragraph 2 of the Policy, it is the Respondent’s responsibility to determine whether the domain name registration infringes or violates third party's rights. By registering the disputed domain name confusingly similar with the Complainant’s well-known mark, the Respondent has violated, inter alia, the cited provision of the Policy.

The disputed domain name resolves to a parking page. While the sale of traffic (i.e., connecting domain names to parking pages and earning click-per-view revenue) does not in and of itself constitute bad faith, in the present case, considering that the website associated to the disputed domain name contains PPC links related to products and services competing with the Complainant's products and services, the Panel finds that, by registering and using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of his website or a product or service on his website (paragraph 4(b)(iv) of the Policy).

The Respondent has neither replied to the Complainant's cease and desist letter, nor submitted a Response in this administrative proceeding to provide any evidence of actual or contemplated good faith use.

Taken into account all circumstances of this case, the Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESAINVESTMENTBANK.COM**: Transferred

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2021-10-29

Publish the Decision