

Decision for dispute CAC-UDRP-104119

Case number	CAC-UDRP-104119
Time of filing	2021-11-01 09:34:09
Domain names	INTESAFXONLINE.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

Organization	SOFTWARE DEVELOPER
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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 is the owner of the following registrations for the trademarks INTESA and INTESA SANPAOLO:

- International trademark registration n. 793367 "INTESA", granted on September 4, 2002 and duly renewed, in class 36;
- International trademark registration n. 920896 "INTESA SANPAOLO", granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 41, 42;
- EU trademark registration n. 12247979 "INTESA", applied 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", applied on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

The Complainant is also the owner of the following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”: <INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .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 them are now connected to the official website <http://www.intesasanpaolo.com>.

FACTUAL BACKGROUND

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

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 47,7 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 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 7,2 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.

The disputed domain name <INTESAFXONLINE.COM> was registered on August 18, 2021.

PARTIES CONTENTIONS

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).

First, the Complainant claims rights in the INTESA and INTESA SANPAOLO mark through its trademark registrations with the EUIPO and WIPO. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See *Avast Software s. r. o. v Milen Radumilo*, 102384, (CAC 2019-03-12).

Second, the Complaint claims that the prominent part of the disputed domain name is confusingly similar to its trademark registrations. In particular, the Complainant points out that the disputed domain name reproduces its trademark INTESA with an additional financial keyword “fx online” which could mean FOrEign EXchange ONLINE.

The Panel accepts that additional financial term does not alter the overall impression of the designation as being connected to the Complainant, instead the additional term may further enhance the similarity between the disputed domain and the Complainant. Furthermore, the “.com” generic top-level domain (“gTLD”) is irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of paragraph 4(a)(i) of the Policy. See *Belron International Limited v Andrea Paul*, 103381, (CAC 2020-12-09) and *LESAFFRE ET COMPAGNIE v Tims Dozman*, 102430, (CAC 2019-04-02).

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the

burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name and the Respondent is not authorized or licensed to use of the trademarks INTESA and INTESA SANPAOLO as well as the disputed domain name. The Complainant could not find any fair or non-commercial use of the disputed domain name.

Having reviewed the screenshot of the website, the Panel notes that the website does not resolve to any active content which the Respondent has not demonstrated any relevant rights or legitimate interests on the disputed domain name, see JCDECAUX SA v. fer abregao, 104072 (CAC 2021-11-18) ("Furthermore, the material published at the disputed domain name - consisting of what the Complainant terms links to unrelated information, and what appears to the Panel to be default configuration information - does not point towards any relevant rights or legitimate interests that the Panel could consider further. ") The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name and the Respondent has not rebutted the assertion.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

First, the Complainant argues that its trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and well known all around the world and the Respondent had actual knowledge of the trademarks as it has registered a domain name that is confusingly similar to Complainant's trademarks. Basic Google search in respect of the wordings "INTESA SANPAOLO" and "INTESA" would also yield obvious references to the Complainant. The Panel agrees that Complainant's INTESA SANPAOLO and INTESA are well-known and notes that the trademarks were registered well before the registration date of the disputed domain name. The Panel also considers that the Respondent is named as "SOFTWARE DEVELOPER" which should have basic IT knowledge to perform Google search and the results would be highly linked to the Complainant as mentioned by the Complainant. Registering a domain name similar to a well-known brand with actual knowledge clearly constitutes to registration in bad faith, see ARCELORMITTAL (SA) v acero, 102399, (CAC 2019-04-22). On this basis, the Panel accepts that the disputed domain name was registered in bad faith.

Second, the Complainant asserts that the disputed domain name is not used for any bona fide offerings and passively holding constitutes bad faith. The Respondent has had 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). The Panel is of the view that passively holding a domain name may not lead to bad faith as long as it does not infringe any 3rd party right. However, the Respondent is passively holding the disputed domain name that is confusingly similar to Complainant's trademark without proper explanation. It is commonly agreed that passive holding like this does not constitute a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain names, see Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico, 103516 (CAC 2021-02-18) and section 3.3 of the WIPO Overview 3.0. In this circumstance, the Panel finds that Respondent's use of the disputed domain name is in bad faith.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

PRINCIPAL REASONS FOR THE DECISION

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESAFXONLINE.COM**: Transferred

PANELLISTS

Name	Mr Paddy TAM
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DATE OF PANEL DECISION	2021-11-29
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Publish the Decision