

Decision for dispute CAC-UDRP-104118

Case number	CAC-UDRP-104118
Time of filing	2021-11-01 09:33:36
Domain names	INTESAFX.COM, INTESAFXTR.COM, INTESAFX21.COM, INTESAFXTR21.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	Intesa Trade LTD
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks:

- INTESA SANPAOLO, international registration No. 920896, of 7 March 2007, duly renewed, for goods and services in classes 9, 16, 35, 36, 41 and 42;
- INTESA, international registration No. 79336, of 4 December 2002, duly renewed, for services in class 36;
- INTESA SANPAOLO, EUTM registration No. 530199, filed on 8 September 2006 and registered on 18 June 2007, duly renewed, for services in classes 35, 36 and 38; and
- INTESA, EUTM registration No. 12247979, filed on 23 October 2013 and registered on 5 March 2014 for goods and services in classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

The Complainant originates from the merger, in 2007, of Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the most important Italian banking groups. As a result, the Complainant is the undisputed leader in Italy in the retail, corporate and wealth management fields and is among the top banking groups in the Euro zone, with a market capitalisation exceeding 47,7 billion

Euro. The Complainant operates throughout the Italian territory with a network of around 4,300 branches and a market share above 19% in most Italian regions. The Complainant offers its services to approximately 13,5 million customers in Italy, and has a strong presence also in Central-Eastern Europe, with a network of approximately 1000 branches and over 7,2 million customers.

The disputed domain names were registered in July 2021, well after the Complainant's trademarks, and lead to parking pages containing sponsored links to banking and financial services, among others.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant maintains that the disputed domain names are identical or at least confusingly similar to the Complainant's trademarks listed above. More specifically, the disputed domain names include the Complainant's trademarks followed by "fx", "fxtr", "fx21" and "fxtr21", as the case may be. These wordings refer to "forex", "forex trading", "forex 2021" and "forex trading 2021". The word "forex" stands for "foreign exchange market", which is descriptive of the financial services for which the Complainant's trademarks are registered and used.

The Complainant also maintains that the Respondent has no rights on the disputed domain names, and that any use of the trademarks INTESA and INTESA SANPAOLO should be authorised by the Complainant. The Complainant did not authorise the Respondent to use the dispute domain names and the Respondent is not making a non-commercial or fair use of these domain names.

Lastly, the Complainant contends that the disputed domain names were registered and are being used in bad faith. The Complainant's trademarks INTESA and INTESA SANPAOLO are distinctive and well-known. The fact that the Respondent registered four domain names all confusingly similar to the Complainant's trademarks shows that the Respondent was well aware of these trademarks at the time of the registration of the disputed domain names. A simple Google search on the trademarks INTESA and INTESA SANPAOLO would have revealed that they all belong to the Complainant. Therefore, it is more than likely that the Respondent would not have registered the disputed domain names if it were not for the Complainant's trademarks.

The Complainant also finds that disputed domain names are not used in connection with a bona fide offering of goods or services. The disputed domain names lead to parking pages containing sponsored links, including, for banking and financial services. Consequently, the disputed domain names and corresponding web pages are likely to mislead potential customers of the Complainant as to their origin. Therefore, the Complainant believes that the Respondent registered and uses the disputed domain names to divert traffic from the Complainant and thus in bad faith. The Respondent is also likely to derive an income from the sponsored links associated to the disputed domain names, which is a further indication of bad faith.

For all these reasons, the Complainant requests that the disputed domain names be transferred to the Complainant.

The Respondent did not reply to the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

1. Confusing similarity of the disputed domain name to the Complainant's trademark

The Panel agrees with the Complainant that the disputed domain names are confusingly similar to the Complainant's trademark INTESA as they include it entirely and the wordings "fx" and "fxtr" are commonly used in the financial field. Indeed, "fx" stands for "forex" and "fxtr" stands for "forex trading". As far as the number "21" in the disputed domain names <intesafx21.com> and <intesafxtr21.com> is concerned, it is likely to refer to the year 2021. The term "forex" is itself the abbreviation of "foreign exchange" and indicates the trading of one currency to another. Therefore, the acronyms "fx" and "fxtr" are descriptive of specific financial activities that are part of the Complainant's business. In light of the foregoing, the disputed domain names consist of the Complainant's trademark followed by descriptive words referring to the Complainant's activity and by the number 21, indicating the year 2021. The addition of these wordings and of the number "21" to the Complainant's trademark INTESA in the disputed domain names is therefore likely to enhance rather than to diminish the confusing similarity of the disputed domain names with this trademark.

For the reasons mentioned above, the Panel is satisfied that the first condition under the Policy is met.

2. No rights or legitimate Interests

As also confirmed in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Complainant states that it never authorised the Respondent to register domain names including its trademarks and that the Respondent is not one of its licensees. Furthermore, the Complainant points out that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain names.

The Panel agrees with the Complainant that the use of a third party's trademark, renown in the banking and financial fields, to access websites containing sponsored links relating to the same field in which the Complainant's operates is likely to divert consumers looking for the Complainant and to generate undue profit for the Respondent.

In view of this, said use cannot amount to a bona fide offering of goods and services, or to a legitimate non-commercial or fair use of the disputed domain names, as required by paragraph 4(c)(i) and (iii) of the Policy.

Lastly, the Panel notes that the Respondent's name as listed in the Whois of the disputed domain names is "Intesa Trade Ltd.". The Complainant did not comment this circumstance, likewise the Respondent who, as said, did not file a Response. However, in deciding the UDRP, the Panel is under the duty to ensure that the Parties are treated with equality (para. 10 of the Rules). Hence, even if none of the Parties, and the Respondent in particular, has raised this issue, the Panel believes that it must evaluate whether the fact that the Respondent's name is "Intesa Trade Ltd." provides the Respondent with a legitimate right or interest in the disputed domain names under para. 4(c)(ii) of the Policy.

In the Panel's view, the mere fact that the Respondent's name, as listed in the relevant Whois, contains the term "Intesa", which coincides with the Complainant's trademark, cannot automatically lead to the conclusion that the Respondent has been commonly known by the disputed domain names and therefore owns rights or legitimate interests over them. As also confirmed by para. 2.8 of the WIPO Jurisprudential Overview 3.0, in order to enjoy rights or legitimate interests, the Respondent must prove to be "commonly known by" the disputed domain name. Hence, the mere fact that the disputed domain names are held by a company allegedly named "Intesa Trade Ltd." is insufficient, absent any other evidence in support, to conclude that the Respondent owns legitimate rights or interests over them. The Respondent could have replied to the Complainant's contentions

in order to affirm and prove its rights over the disputed domain names, but chose not to do so by avoiding to file a Response.

In consideration of the above, the Panel concludes that the Complainant has proved the Respondent's lack of rights or legitimate interests in the disputed domain names. Thus, also the second condition under the Policy is met.

3. Bad faith

In relation to bad faith, the Panel agrees with the Complainant that the Respondent was well aware of the Complainant's mark and activity at the time of the registration of the disputed domain names. Indeed, the Complainant's trademark is highly distinctive and enjoys reputation, as also confirmed in several other UDRP decisions. Moreover, the fact that the disputed domain names include the Complainant's trademark INTESA followed by acronyms commonly used in the financial field, is a further indication of the Respondent's knowledge of the type of activity that the Complainant's performs under its well-known trademarks internationally.

With respect to use in bad faith, the Panel notes that at the time of the filing of the Complaint, the disputed domain names led to websites containing sponsored links to competitors of the Complainant. Most probably the Respondent earned some kind of remuneration from each click on the sponsored links. Although the relevant webpages displayed the following statement: "The Sponsored Listings displayed above are served automatically by a third party. Neither Parkingcrew nor the domain owner maintain any relationship with the advertisers", prior UDRP Panels have established that "[p]articularly with respect to "automatically" generated pay-per-click links, (...) a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests). Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith" (see in this respect, para. 3.5 of the WIPO Jurisprudential Overview 3.0).

As the Respondent did not make any effort to avoid links, which target the Complainant's trademark, the fact that the sponsored links appearing on the web pages related to the disputed domain names were automatically generated by third parties cannot prevent a finding of bad faith.

The Panel would also like to spend a few words on the fact that the disputed domain names appear to be registered in the name of a company allegedly called "Intesa Trade Ltd.". In the absence of any evidence in support of this circumstance, the Panel has reasons to believe that the registrant's name listed in the Whois does not correspond to the true name of the Respondent. Indeed, as mentioned previously, the word "intesa" is an Italian word and it is a striking coincidence, that a company having its registered office in the Seychelles bears an Italian name, coinciding with the Complainant's well-known trademark INTESA. Instead, it seems much more realistic, to the Panel's eye, that such a name has been used to increase the confusion of the Internet user when coming into contact with disputed domain names. The provision of false contact information at the time of the registration of the disputed domain names is, in all respects, a clear indication of bad faith.

Lastly, the Panel has noted that, at the time of the drafting of this decision, all the disputed domain names are no longer accessible. In light of the overall circumstances of the matter, the Panel believes that it is more likely than not, that once receiving a copy of the Complaint, the Respondent has tried to conceal the unlawful use of the domain names it was making up to that moment, in a vain attempt to prevent a decision that could lead to their reassignment to the Complainant.

For all the reasons set forth above, the Panel concludes that the Respondent has registered and used the disputed domain names to intentionally attempt to attract, for commercial gain, Internet users to its web sites, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web sites or as to a service accessible through the sponsored links appearing on said web sites.

Thus, the Panel is satisfied that also the third and last condition under the Policy is met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESAFX.COM:** Transferred
2. **INTESAFXTR.COM:** Transferred
3. **INTESAFX21.COM:** Transferred
4. **INTESAFXTR21.COM:** Transferred

PANELLISTS

Name	Angelica Lodigiani
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DATE OF PANEL DECISION	2021-12-12
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Publish the Decision	
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