

Decision for dispute CAC-UDRP-104324

Case number	CAC-UDRP-104324
Time of filing	2022-02-02 09:14:58
Domain names	SECURITY-HOMEBANKING-ISP.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	saad ali
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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 a relevant Italian banking group with strong presence 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.

The Complainant owns the following trademark rights:

- International trademark registration n. 920896 "INTESA SANPAOLO", granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 41 and 42;
- International trademark registration n. 793367 "INTESA", granted on September 4, 2002 and duly renewed, in connection with class 36;
- EU trademark registration n. 5301999 "INTESA SANPAOLO", filed on September 8, 2006 granted on June 18, 2007 and duly renewed, in connection with the classes 35, 36 and 38;
- EU trademark registration n. 12247979 "INTESA", filed on October 23, 2013 and granted on March 5, 2014 in connection with classes 9, 16, 35, 36, 38, 41 and 42; and
- EU trademark registration n. 7310337 "ISP", filed on October 13, 2008, granted on February 12, 2010 and duly renewed, in

connection with the class 36.

The disputed domain name <security-homebanking-isp.com> was registered on February 3, 2021 and currently resolves to an inactive website.

FACTUAL BACKGROUND

The Complainant is a relevant Italian banking group with strong presence 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 has a market capitalization exceeding 44,2 billion euro, with presence in different business areas as retail, corporate and wealth management. The Complainant has a network of approximately 4,200 branches capillary, distributed throughout Italy, with market shares of more than 17% 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 with a network of approximately 1.000 branches and over 7,1 million customers. The Complainant supports international corporate customers in 25 countries, including in the United States, Russia, China and India.

The Complainant owns European's trademark rights over the term, "INTESA SANPAOLO", since September 8, 2006, and over the initials, "ISP" (which stands for "INTESA SANPAOLO") since October 13, 2008.

The Complainant also owns a domain names portfolio, 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>, which are connected to the official website <http://www.intesasanpaolo.com>, registered on August 24, 2006.

According to the evidence presented before the Panel, the disputed domain name <security-homebanking-isp.com> was registered on February 3, 2021 and resolves to an inactive website.

By the time of this Decision, the disputed domain name and the website remains inactive.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has sufficiently proved before the Panel, that owns European's trademark rights over the term "INTESA SANPAOLO", since September 8, 2006 (application date), June 18, 2007 (registration date), and over "ISP", which represents the abbreviation of the well-known trademark "INTESA SANPAOLO", since October 13, 2008 (application date), February 12, 2010 (registration date).

The disputed domain name <security-homebanking-isp.com>, is the result of the combination of the words "security" plus a hyphen, and "homebanking" plus a hyphen, which describe the services for which the Complainant's trademarks have been registered and are used, plus the trademark ISP.

It is well established by the Domain Name Jurisprudence that for the purposes of the analysis of the First UDRP Element, in this case, the gTLD ".com", is viewed "as a standard registration requirement and as such is disregarded" (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0, point 1.7).

This Panel is ready to find that the disputed domain name <security-homebanking-isp.com> is confusingly similar to

Complainant's ISP trademark.

Therefore, the Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is confusingly similar to a service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Regarding the Second UDRP Element, to this Panel it is clear that:

- (1) the Respondent is not associated or affiliated or hasn't been authorized or licensed by the Complainant to register the disputed domain name;
- (2) there is no evidence of the reason why the Respondent did such selection of the disputed domain name, in which adds the descriptive words "security" and "homebanking" which are intrinsically related to Complainant's business area plus the Complainant's ISP trademark;
- (3) there is no evidence that the Respondent has become commonly known by the term "SECURITY-HOMEBANKING-IPS.COM";
- (4) the Respondent registered the disputed domain name on February 3, 2021 meaning at least 13 years after the Complainant's acquired its trademark rights over the EU Trademark ISP on October 13, 2008 (application date), February 12, 2021 (registration date); and
- (5) the Respondent is not making a bona fide offering of goods or services, or a legitimate non-commercial or fair use of the disputed domain name, since it resolves to an inactive website, where such lack of use represents strong evidence of its lacks of rights or legitimate interests in the disputed domain name.

Therefore, 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

Paragraph 4(b) of the Policy describes several non-exclusive and merely illustrative circumstances to demonstrate a respondent's bad faith registration and use.

The Complainant acquired its European trademark rights at least since October 13, 2008, meaning at least 13 years BEFORE the Respondent registered the disputed domain name on February 3, 2021, therefore it is very difficult to this Panel, especially due to the absolute absence of any Response, including to the Cease and Desist Letter sent by the Complainant on March 25, 2021, to consider that at the time of registration the Respondent did such combination and selection of words for the disputed domain name, without previous knowledge of Complainant's trademarks value.

As the Complainant argues in its Complaint:

"The Complainant's trademarks "INTESA SANPAOLO" and "INTESA" 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. In addition, if the Respondent had carried even a basic Google search in respect of the wordings "INTESA SANPAOLO" and "INTESA", the same would have yielded obvious references to the Complainant."

This Panel coincides with Complainant's argument and finds its emphasis at point 3.2.2. of the WIPO Overview 3.0. which states:

"Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level

domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark."

Furthermore, the Respondent has been already incurred in cybersquatting acts with Complainant's trademarks on mind, adding less to the Respondent (see *Intesa Sanpaolo S.p.A. v. saad ali*, CAC Case No. 104322).

The Domain Name Jurisprudence, has established in relation to the Passive Holding Doctrine, that:

"(...) While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include:

- (i) the degree of distinctiveness or reputation of the complainant's mark,
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use,
- (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and
- (iv) the implausibility of any good faith use to which the domain name may be put." (see point 3.3 of the WIPO Overview 3.0").

In the present Case, the Complainant is a recognized Italian bank Institution, with well-known trademarks, incorporated in the disputed domain name, and the Respondent has not submitted any kind of Response, or any evidence of good-faith use, facts that are sufficient to this Panel, to conclude the presence of bad faith use of the disputed domain name as well.

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

In summary and in accordance with Paragraph 4(a) of the Policy, the Complainant has proved that:

- (i) the disputed domain name <security-homebanking-isp.com> is confusingly similar to Complainant's service trademarks: "ISP" which represents the abbreviation of the well-known trademark "INTESA SANPAOLO";
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name, due to there is no proof of affiliation and/or authorization by Complainant (plus the reasons described above); and
- (iii) the disputed domain name has been registered and is being used in bad faith, due to the incorporation of a well-known trademark in the disputed domain name, and the inactivity of the website.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. SECURITY-HOMEBANKING-ISP.COM: Transferred

PANELLISTS

Name	Ms. MARÍA ALEJANDRA LÓPEZ GARCÍA
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DATE OF PANEL DECISION 2022-03-02

