Decision for dispute CAC-UDRP-101434

Case number	CAC-UDRP-101434
Time of filing	2017-03-02 09:49:38
Domain names	intesasanpaolo.group

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Nicholas Taylor

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending and/or decided legal proceedings between the parties to this dispute or relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following registrations for the trademark “INTESA SANPAOLO”

-International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 2007, in classes 9, 16, 35, 36, 38, 41 and 42, covering also Australia, China, United States of America, Japan, Russian Federation and many others;
-EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 08, 2006 and granted on June 18, 2007, in classes 35, 36 and 38;
-EU trademark registration n. 5421177 “INTESA SANPAOLO & device”, applied on October 27, 2006 and granted on November 5, 2007, in classes 9, 16, 35, 36, 38, 41 and 42.

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 36,3 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,000 branches capillary and well distributed throughout the Country, with market shares of more than 13% in most Italian regions, the Group offers its services to approximately 11.1 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.200 branches and over 7,8 million customers. Moreover, the international network specialised in supporting corporate customers is present in 29 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.

On January 12, 2017, the Respondent registered the domain name INTESASANPAOLO.GROUP and uses the domain for a parking website.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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). It is more than obvious that the domain name at issue is identical to the Complainant's trademarks. As a matter of fact, the new gTLD extension ".group" even increase the likelihood of confusion with the Complainant's trademark, given the popularity of the "Intesa Sanpaolo Group".

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 Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

The Respondent has no rights on the disputed domain name, since Nicholas Taylor has nothing to do with Intesa Sanpaolo. In fact, any use of the trademark "INTESA SANPAOLO" has to be authorized by the Complainant. Nobody has been authorized or licensed by the above mentioned banking group to use the domain name at issue.

The domain name at stake does not correspond to the name of the Respondent and Nicholas Taylor is definitely not commonly known as "INTESASANPAOLO".

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy). The domain name "INTESASANPAOLO.GROUP" was registered and is being used in bad faith.

The Complainant's trademark "INTESA SANPAOLO" is distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to it 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 wording "INTESA SANPAOLO", the same would have yielded obvious references to the Complainant.

In addition, the contested domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the 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).

First of all, several services can be detected, but not in good faith: in fact, the domain name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used (see also the Complainant's official site http://www.intesasanpaolo.com home page). Internet users, while searching for information on the Complainant's services, are confusingly led to the websites of the Complainant's competitors, sponsored on the websites connected to the domain name at issue.

Therefore, 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. The Respondent uses the domain for a parking website which offers via Godaddy references to other competitors of the Complainant . This use of the disputed domain name, which allows accessing to the web sites of the Complainant's competitors, also through the Complainant's trademark, causes, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones (see WIPO Decisions n. D2000-1500, Microsoft Corporation v. StepWeb, and D2001-1335, The Vanguard Group, Inc v. Venta).

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

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

The Respondent has registered and is using a doman which is identical with the trademarks owned by the Complainant. This behaviour is not based on a legitimate interest, but in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO.GROUP**: Transferred

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2017-03-29

Publish the Decision