

Decision for dispute CAC-UDRP-104466

Case number CAC-UDRP-104466

Time of filing 2022-04-01 09:41:27

Domain names GRUPPO-INTESA.ORG

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Intesa Sanpaolo S.p.A.

Complainant representative

Organization Intesa Sanpaolo S.p.A.

Respondent

Name Gabriella Campora

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 owns various trade mark registrations, including:

- (1) International trademark registration n. 793367 for "INTESA", registered on September 4, 2002;
- (2) EU trademark registration n. 12247979 for "INTESA", registered on March 5, 2014; and
- (3) -EU trademark registration n. 5344544 for "GRUPPO INTESA SANPAOLO", registered on July 6, 2007.

The Complainant submits that it owns EU trademark registration n. 779827 for "GRUPPO INTESA", registered on November 15, 1999, although it appears that this mark is in fact owned by a company in the Complainant's group and not by the Complainant itself.

FACTUAL BACKGROUND

The Complainant is a leading Italian banking group with a market capitalisation exceeding 44,6 billion euro with a network of approximately 3,700 branches and market share of more than 17% in most Italian regions and approximately 13,5 million customers. It 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 Complainant is also the owner, among the others, of the following domain names bearing the signs "INTESA" and "GRUPPO INTESA": <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, GRUPPO-INTESA.COM, GRUPPOINTESA.COM, GRUPPOINTESA.IT, GRUPPOINTESA.EU, GRUPPOINTESA.US, GRUPPOINTESA.ORG> and <GRUPPOINTESA.NET>. All of them divert to the official website <intesasanpaolo.com>.

On July 19, 2021 the Respondent registered the domain name <GRUPPO-INTESA.ORG> which does not resolve to an active website.

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).

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

The Complainant has demonstrated that it owns registered trade mark rights in its INTESA trade mark as set out above. The disputed domain name wholly incorporates the INTESA mark and is therefore confusingly similar to it. The addition of the common Italian word "GRUPPO" meaning "group" in English and of a hyphen does not prevent a finding of confusing similarity. As a result, the Panel finds that the disputed domain name is confusingly similar to either of the Complainant's registered trade marks for INTESA.

The Complainant has submitted that the Respondent has no rights in the disputed domain name, and that it has not authorised or licensed the Complainant's use of the "INTESA", or "GRUPPO INTESA SANPAOLO" trade marks in the disputed domain name. It has further submitted that the disputed domain name does not correspond to the name of the Respondent and, that the Respondent is not commonly known as "GRUPPO-INTESA" or by the disputed domain name. The Complainant has also submitted that the Respondent has not made a fair or non-commercial use of the disputed domain name.

The Panel notes that the disputed domain name does not resolve to an active website and that there is no evidence on the record that it has ever been used by the Respondent. However, the Complainant's banking and financial services business is extremely well established both in Italy and in the numerous countries internationally and as a result it enjoys a very well-established reputation and goodwill attaching to its distinctive INTESA and GRUPPO INTESA SANPAOLO trade marks and it also appears to trade under the GRUPPO INTESA mark. The Complainant has submitted evidence that even a basic Google search in respect of the names "INTESA", "GRUPPO INTESA" and "GRUPPO INTESA SANPAOLO" would have yielded obvious references to the Complainant and that the Complainant owns numerous domain names incorporating its marks which divert to the Complainant's main website. In these circumstances there is a strong inference that the Respondent has registered the disputed domain name for its own likely illegitimate purposes.

Accordingly, the Panel finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has provided no explanation for its registration and has not rebutted the case made out by the Respondent and therefore the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name under the Policy.

By the time that the Respondent registered the disputed domain name in July 2021, the Complainant already had very well established international businesses under its distinctive GRUPPO INTESA or GRUPPO INTESA SANPAOLO trade marks and it is apparent that it had a strong Internet presence also by that time. As noted above, there is no evidence that the Respondent has actively used the disputed domain name and in these circumstances the Panel finds that there is a very strong inference that the Respondent was well aware of the Complainant's business and of its distinctive GRUPPO INTESA or GRUPPO INTESA SANPAOLO trade marks when it registered the disputed domain name.

It is clear that the Respondent has not used the disputed domain name to date. Previous panels have found that the passive use of a disputed domain name may amount to evidence of bad faith based on a consideration of factors such as (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 of 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 WIPO Overview 3.0, section 3.3)

In this case the Complainant's INTESA , GRUPPO INTESA or GRUPPO INTESA SANPAOLO marks enjoy a high level of distinctiveness and of repute as a result of use in relation to the Complainant's very well-established international business. The Respondent has failed to submit a response or to provide any evidence of actual or contemplated good faith use. Further, the Respondent did not reveal her real identity when registering the disputed domain name and this could only be identified during the registrar's verification process.

Finally, the GRUPPO INTESA mark is so distinctive that any good faith use by the Respondent seems implausible, other than in relation to a bona fide criticism site and there is no evidence that the Respondent has or intends to use the disputed domain name for that purpose. On balance it seems more likely than not that the Respondent registered the disputed domain name in bad faith for its own purposes, namely for re-sale or possibly in order to embark on a phishing scheme in relation to a very well reputed Complainant bank's name and mark. As a result, the Panel finds that the disputed domain name has been both registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GRUPPO-INTESA.ORG**: Transferred

PANELLISTS

Name	Alistair Payne
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DATE OF PANEL DECISION 2022-04-30

Publish the Decision
