

Decision for dispute CAC-UDRP-104622

Case number	CAC-UDRP-104622
Time of filing	2022-06-02 09:14:30
Domain names	INTESASANPAOLO.CREDIT

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	Alexander Alberht
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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 numerous trademark registrations, such as:

- International trademark registration No. 920896 "INTESA SANPAOLO", registered on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 41 and 42;
- International trademark registration No. 793367 "INTESA", registered on September 4, 2002 and duly renewed, in connection with class 36;
- EU trademark registration No. 5301999 "INTESA SANPAOLO", registered on June 18, 2007 and duly renewed, in connection with the classes 35, 36 and 38;
- EU trademark registration No. 12247979 "INTESA", registered on March 5, 2014, in connection with classes 9, 16, 35, 36 38, 41 and 42.

The Complainant proved its ownership of listed trademark registrations by the submitted extract from the Registers.

FACTUAL BACKGROUND

The Complainant is the leading Italian banking group and also one of the protagonists in the European financial area. 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 capitalization exceeding 38,0 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,700 branches capillary and well distributed throughout the Country, with market shares of more than 16% 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 7,0 million customers.

Moreover, the international network specialized 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 (provided in the Annex to the complaint).

Moreover, the Complainant is also the owner, among the others, 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 connected to the official Complainant's website <http://www.intesasanpaolo.com>.

The disputed domain name <intesasanpaolo.credit> (hereinafter referred to as "disputed domain name") was registered on June 2, 2021 and redirect to the parking page.

According to the Registrar verification, the Respondent is 'Porkbun LLC'. The Respondent's provided address as being at Sherwood, United States.

PARTIES CONTENTIONS

COMPLAINANT:

A. The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademarks.

The Complainant contends that the disputed domain name is identical or at least confusingly similar to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA" because the disputed domain name reproduces the well-known trademark "INTESA SANPAOLO".

B. The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant asserts that the Respondent has no rights on the disputed domain name and any use of the Complainant's trademarks has to be authorized by the Complainant. The Complainant adds that anyone has been authorized or licensed by the Complainant to the disputed domain name.

The Complainant contends that the Respondent is not known as the disputed domain name. In addition, there is no any fair or non-commercial use of the disputed domain which redirects to the parking page.

C. The Complainant contends that the domain name has been registered and is being used in bad faith.

The Complainant asserts that the disputed domain was registered and used in bad faith. First, the Complainant contends that its trademarks are distinctive and well-known all around the world and so the Respondent must have been aware of the Complainant's trademarks at the time of registration of the disputed domain name. In accordance with this contention, the Complainant submitted Annex which reflects the internet search of the terms "INTESA SANPAOLO".

The Complainant adds that the disputed domain is not used for any bona fide purposes and there are present circumstances indicating that the Respondent has registered the disputed domain primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name (Paragraph 4(b)(i) of the Policy).

Moreover, the disputed domain redirects to a parking page in which the same domain name is offered for sale (provided in the Annex to the complaint).

The Complainant adds that several WIPO Panel decisions stated that "[a]lthough Respondent's offer of the disputed Domain Name for sale was not made specifically to Complainant or its competitor, offers for sale to the public may nevertheless constitute evidence of bad faith under the Policy" (see the WIPO Case No. D2002-0005, United Artists Theatre Circuit Inc. v. Domains for Sale Inc.).

In this regard, the Complainant contends that "[o]ffers to sell to the public at large domain names that are identical or confusingly similar to marks of others may constitute bad faith [...] This is based on the non-exhaustive character of the express list of bad faith factors in paragraph 4(b) of the Policy, and the lack of a justification for awarding financial gain to persons for the mere act of registration of the marks of others": [see United Feature Syndicate, Inc. v. All Business Matters,

Inc. (aka All Business Matters.com) and Dave Evans (WIPO Case No. D2000-1199); Alloy Rods Global, Inc. v. Nancy Williams (WIPO Case No. D2000-1392); Dell Computer Corporation v. Alex and Birgitta Ewaldsson (WIPO Case No. D2000-1087); eBay Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd. (WIPO Case No. D2000-1463)].

Moreover, “[t]he sole fact that the disputed domain names have been registered by a person that does not use them but publicly offers them for rent or sale is the most perfect evidence of a bad faith activity in prejudice of Internet community and of the owner of the trademarks used as domain names” (the WIPO Case No. D2000-0245, TV Globo Ltda. v. Radio Morena).

In addition, the Complainant points out the Paragraph 4(b) of the Policy which provides a non-exhaustive list of circumstances that can constitute evidence of a Respondent’s bad faith in registering and using a domain name. In particular, the consensus view of WIPO UDRP panelists is that bad faith may in, some cases, be found in other conducts carried out by a domain name holder. Panels have tended to make such findings in circumstances in which, for example, a complainant’s mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the Complainant’s trademark rights.

The Complainant asserts that the present case completely matches to the above requirements: “[t]he Panel accepts the Complainant’s submissions that [...] it is not possible for the Respondent to have been unaware of the Complainant’s [...] brand and associated trademarks prior to registering the Domain Name. As a consequence, the Panelist finds that in registering the Domain Name, the Respondent was aware of the Complainant’s [...] brand and associated trademarks. Given the above information [...] the Panelist can find no plausible circumstances in which the Respondent could legitimately use the Domain Name” (see the WIPO Case No. D2004-0071, Microsoft Corporation v. Superkey Worldwide, Inc.).

The Complainant contends that it is not possible for the Panelist to “conceive a plausible situation in which the Respondent would have been unaware of this fact at the time of registration” (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). On the contrary, the contested domain name “is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith” (see the WIPO Case No. D2000-0163, Veuve Clicquot Pnsardin, Maison Fondée en 1772 v. The Polygenix Group Co.). Besides, “It is not likely that any trader would choose a name including the trademark [...] if not to create an impression of association with the Complainant” (the WIPO Case No. D2002-0810, Benetton Group S.p.A. v. Azra Khan).

Lastly, the Complainant contends that it is no coincidence that this Respondent’s speculation involved a big financial institution such as Intesa Sanpaolo. In fact, the diversion practice in banking realm is very frequent due to the high number of online banking users. In fact, it has also to be pointed out that the Complainant has already been part of other WIPO Cases where the Panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations. A list of the WIPO Cases in which Intesa Sanpaolo has been part as the Complainant is enclosed as Annex.

RESPONDENT:

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

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them (Paragraph 5(f) of The Rules).

I. CONFUSING SIMILARITY

The Panel finds that the disputed domain is confusingly similar to the Complainant's trademarks consisting of terms "INTESA" or "INTESA SANPAOLO".

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter referred to as "The WIPO Overview 3.0") in Paragraph 1.7 states: "[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

In the WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasilij Terkin, the Panel stated that: "In numerous cases, it has been held that a domain name that wholly incorporates a Complainant's registered mark may be sufficient to establish confusing similarity for purposes of the UDRP."

The Complainant has established that owns numerous trademark registrations consisting of the terms "INTESA" and "INTESA SANPAOLO", protected for the goods and services in connection with financial business activities (evidenced by the Annex).

The Complainant's trademark is incorporated in its entirety and clearly recognizable in the disputed domain <intesasanpaolo.credit>. The addition of the new generic Top-Level Domain <.credit> does not change the overall impression of the disputed domain. Just the opposite, the term "credit" is generally connected with financial issues, which is the main business area of the Complainant (evidenced by the Annex). By that the disputed domain in its entirety creates confusion with the Complainant's trademarks.

As stated in the WIPO Overview 3.0 in Paragraphs 1.7 and 1.8, where a domain name incorporates the entirety of a trademark, the domain will normally be considered confusingly similar.

Therefore, the disputed domain name <intesasanpaolo.credit> as it reproduces "INTESA SANPAOLO" trademark in its entirety, with the addition of the new gTLD <.credit> is considered to be confusingly similar to the relevant trademarks.

As a result, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain.

According to Paragraph 4(a)(ii) of the Policy, the Complainant shall make case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfils this demand the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the Policy (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman).

Moreover, past Panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, past Panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the Policy, once the complainant has made something credible (prima facie evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing concrete evidence.

In the CAC Case No. 102279, FileHippo s.r.o. v. whois agent, the Panel stated that "[i]n the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant's trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under Paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of Paragraph 4(a)(ii) of the Policy."

In the present case the Complainant contends that the Respondent is not related in any way with the Complainant and the Complainant had never granted any license nor authorization to the Respondent to use the Complainant's trademark or apply for registration of the disputed domain names.

Furthermore, the disputed domain name redirects to the parking page (evidenced by the Annex). Therefore, this Panel agrees with the Complainant's contention that the Respondent aims to the commercial use of the disputed domain without any authorization by the Complainant.

The Respondent did not reply to the Complaint and so failed to demonstrate Its rights or legitimate interests in the disputed

domain.

Therefore, the Panel finds that the Complainant has satisfied Paragraph 4(a)(ii) of the Policy.

III. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel finds that the Respondent registered and used the disputed domain name in bad faith.

The WIPO Overview 3.0 in Paragraph 3.1.4 states: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

The WIPO Overview 3.0 in Paragraph 3.3 states: "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding."

In the WIPO Case No. D2006-1440, National Football League v. Thomas Trainer, the Panel stated: "when a registrant, such as the Respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted."

In the WIPO Case No. D2015-1167, Valero Energy Corporation and Valero Marketing and Supply Company v. Sharad Bhat, the Panel stated that: "In accordance with previous UDRP decisions, inactive or passive holding of a domain name, under the circumstances does not prevent a finding of bad faith use."

In the WIPO Case No. D2002-0005, United Artists Theatre Circuit Inc. v. Domains for Sale Inc, the Panel stated that: "Although Respondent's offer of the disputed Domain Name for sale was not made specifically to Complainant or its competitor, offers for sale to the public may nevertheless constitute evidence of bad faith under the Policy".

In the present case, the Complainant owns numerous trademark registrations consisting of the terms "INTESA" and "INTESA SANPAOLO" (evidence by the Annex). Past Panels decided that "INTESA" and "INTESA SANPAOLO" trademarks are well-known (see the WIPO Case No. D2016-0372, Intesa Sanpaolo S.p.A. v. Francesc Valls Martinez; the WIPO Case No. D2014-1862, Intesa Sanpaolo S.p.A. v. Rika Doi Apple /Whois privacy protection service by onemae.com; the WIPO Case No. D2015-0623, Intesa Sanpaolo S.p.A. v. Huang You Bao / Huang You Bao).

Moreover, the Complainant has certain reputation in the area of financial services in Italy and in the European Union (evidenced by the Annex).

Furthermore, in the WIPO Case No. D2014-1862, Intesa Sanpaolo S.p.A. v. Rika Doi Apple /Whois privacy protection service by onemae.com, the Panel found that "the Complainant's mark is a well-known trademark internationally in the field of financing. In light of the well-known status of the Complainant's mark established well before the registration date of the disputed domain name, it is inferred that the Respondent registered the disputed domain name with the knowledge of the Complainant's rights in the Complainant's mark".

Therefore, this Panel assumes that the Respondent must have been aware of the Complainant's trademarks and their reputation before the registration of the disputed domain on June 2, 2021.

Moreover, the disputed domain redirects to an inactive parking website (evidenced by the Annex). By that, the Respondent is passively holding the disputed domain and is offering the domain for sale. Past Panels found that offering the disputed domain for sale to the public may constitute evidence of bad faith [see the WIPO Case No. D2002-0005, United Artists Theatre Circuit Inc. v. Domains for Sale Inc.; the WIPO Case No. D2000-1199, United Feature Syndicate, Inc. v. All Business Matters, Inc. (aka All Business Matters.com) and Dave Evans; or the WIPO Case No. D2000-1392, Alloy Rods Global, Inc. v. Nancy Williams].

To sum up, according to this Panel, the Respondent must have been aware of the Complainant's trademark in the time of registration of the disputed domain. This Panel asserts that the Respondent was using the disputed domain in bad faith by registration of the domain and offering it for sale without any authorization or consent from the Complainant.

Following the above mentioned, the Panel finds that the Complainant has satisfied Paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. INTESASANPAOLO.CREDIT: Transferred

PANELLISTS

Name JUDr. Radim Charvát, Ph.D., LL.M.

DATE OF PANEL DECISION 2022-07-04

Publish the Decision
