Decision for dispute CAC-UDRP-102911

Case number	CAC-UDRP-102911
Time of filing	2020-02-13 09:21:45
Domain names	INTESASANPAOLO-RBMSALUTE.COM, INTESASANPAOLORBM.COM, INTESASANPAOLORBMSALUTE.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	shenchaoyong

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 multiple registrations for the word mark INTESA SANPAOLO including International Trademark No. 920896 registered on March 7, 2007, and European Trademark No. 005301999 registered on June 18, 2007.

The Complainant is also the owner of Italian Trademark No. 302018000010352 registered on December 13, 2018 for the word mark XME SALUTE.

FACTUAL BACKGROUND

The Complainant is a leading Italian banking group with a presence in Europe. The Complainant was the company which resulted from the merger between two Italian banking groups: Banca Intesa S.p.A. and Sanpaolo IMI S.p.A.

The Complainant is also the registrant for multiple domain names that include the words INTESA SANAOLO, including <intesasanpaolo.com>, <intesasanpaolo.org> and <intesasanpaolo.eu>.

There are three disputed domain names in the present case:

- <intesasanpaolo-rbmsalute.com>;
- <intesasanpaolorbm.com>; and
- <intesasanpaolorbmsalute.com>.

All three disputed domain names were created on December 21, 2019 and were registered in the name of the Respondent.

COMPLAINANT:

The Complainant requests that the proceedings be held in English.

The Complainant contends that the disputed domain names are confusingly similar to the INTESA SANPAOLO mark on the basis that the disputed domain names wholly incorporate the Complainant's INTESA SANPAOLO mark in its entirety, and that the addition of the terms "rbm" and "salute", and the generic top-level domain ("gTLD") ".com" are insufficient to avoid the likelihood of confusion with the INTESA SANPAOLO mark.

The Complainant also argues that the Respondent does not have any rights or legitimate interests in the disputed domain names. The Respondent is not affiliated with the Complainant nor did the Complainant license or authorize the Respondent to use the INTESA SANPAOLO mark.

The Complainant further asserts that the disputed domain names have been registered and are being used in bad faith as the Respondent should have known of the INTESA SANPAOLO mark at the time of registration of the disputed domain names. The Complainant also asserts that the Respondent has registered the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring the domain names to the Complainant who is the owner of the trademark, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain names.

RESPONDENT:

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

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

Procedural Issue: Language of Proceedings

Paragraph 11 of the Rules provides that:

"(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

The language of the Registration Agreements for disputed domain names is Chinese. The Complainant requested that the language of the proceeding be English. The Respondent did not respond to the Complainant's language request.

The Panel cites the following with approval: "Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel's discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case." (Groupe Auchan v. xmxzl, WIPO Case No. DCC2006-0004).

The Panel finds that in the present case, the following should be taken into consideration upon deciding on the language of the proceeding:

(i) All three disputed domain names consist of Latin letters, rather than Chinese letters;
(ii) When the Panel accessed the disputed domain names, the pages that the disputed domain names resolved to offer their respective domain names for sale in the English language;
(iii) The Complainant may be unduly disadvantaged by having to conduct the proceeding in the Chinese language; and
(iv) The Respondent did not object to the Complainant's request that English be the language of the proceeding

Upon considering the above, the Panel determines that English be the language of the proceeding.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the trademark INTESA SANPAOLO.

All three disputed domain names wholly incorporate the Complainant's INTESA SANPAOLO mark.

The disputed domain name <intesasanpaolo-rbmsalute.com> differs from the Complainant's INTESA SANPAOLO trademark by the omission of the space interspersing the words INTESA and SANPAOLO, and the addition of a hyphen, the terms "rbm" and "salute", and the generic Top-Level Domain ("gTLD") suffix ".com".

The disputed domain name <intesasanpaolorbm.com> differs from the Complainant's INTESA SANPAOLO trademark by the omission of the space interspersing the words INTESA and SANPAOLO, and the addition of the term "rbm" and the gTLD suffix ".com".

The disputed domain name <intesasanpaolorbmsalute.com> differs from the Complainant's INTESA SANPAOLO trademark by the omission of the space interspersing the words INTESA and SANPAOLO, and the addition of the terms "rbm" and "salute", and the generic Top-Level Domain ("gTLD") suffix ".com".

The Complainant alleges that the term "rbm" is an intentional misspelling of the term "xme" and, taken together with the term "salute", refers to the Complainant's registered XME SALUTE mark and the Complainant's online booking management system for medical services named "XME SALUTE". The Panel is of the opinion that the term "rbm" is not an intentional misspelling of "xme" as the letters do not look or sound similar, nor are the corresponding letters close to each other on a QWERTY or AZERTY keyboard. Furthermore, the word "salute" exists in both the English and Italian language and thus the term "rbm salute" is not necessarily an intentional misspelling of the Complainant's XME SALUTE mark.

Regardless, it is well-established where a complainant's trademark is well recognizable within a domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity (see WIPO Overview 3.0, section 1.8; Novartis AG v. Radu Luca, WIPO Case No. D2016-2582). Thus, the addition of the hyphen and the terms "rbm" and "salute" do not avoid confusing similarity with the Complainant's INTESA SANPAOLO mark.

It is also established that the addition of a gTLD to a domain name does not avoid confusing similarity as the use of a TLD is technically required to operate a domain name (see Accor v. Noldc Inc., WIPO Case No. D2005-0016; F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451; WIPO Overview 3.0, section 1.11). Thus, the addition of the gTLD ".com" is without significance and does not prevent a finding of confusing similarity in the present case.

In the particular circumstances of the present case, the Panel is of the view that the disputed domain names are identical or confusingly similar to the Complainant's trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name (see WIPO Overview 3.0, paragraph 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain names and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant has provided evidence that it owns multiple registrations for the INTESA SANPAOLO mark before the disputed domain names were registered and that it has not licensed or otherwise permitted the Respondent to use the Complainant's INTESA SANPAOLO mark (see LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master, WIPO Case No. D2010-0138).

In addition, the registrant name "shenchaoyong" bears no resemblance to the disputed domain names in any way (see Sportswear Company S.P.A. v. Tang Hong, WIPO Case No. D2014-1875; WIPO Overview 3.0, section 2.3). Thus, there is no evidence that the Respondent is commonly known by the disputed domain names.

In the present case, the Respondent did not submit a response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain names which is sufficient to rebut the Complainant's prima facie case.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain names and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence that the disputed domain names were created after the INTESA SANPAOLO mark was registered. Therefore, the prior registration of the INTESA SANPAOLO mark is suggestive of the Respondent's bad faith when he registered the disputed domain names (see Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735).

The Complainant has further submitted evidence that an Internet search of the term INTESSA SANPAOLO would lead to results exclusively relating to the Complainant. This is suggestive that the Respondent knew or should have known that its registration would be identical or confusingly similar to the Complainant's INTESA SANPAOLO mark (see WIPO Overview 3.0, paragraph 3.2.2).

Given the distinctive nature of the INTESA SANPAOLO mark and the evidence provided by the Complainant, the Panel finds that the Respondent knew or should have known about the INTESA SANPAOLO mark and finds it inconceivable that the Respondent could have acquired the disputed domain names without knowledge of the INTESA SANPAOLO mark. (See Leite's Culinaria, Inc. v. Gary Cieara, WIPO Case No. D2014-0041; WIPO Overview 3.0, paragraph 3.2.2).

The disputed domain names currently resolve to pages that offer the corresponding domain name for sale. Past panels have held that "offers to sell to the public at large, domain names that are identical or confusingly similar to marks of others, may constitute bad faith within the meaning of paragraph 4(a)(iii) of the Policy. 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 E. Remy Martin & C° v. Zouxinyue, WIPO Case No. D2013-2219; Alloy Rods Global, Inc. v. Nancy Williams, WIPO Case No. D2000-1392).
Under the particular circumstances of this case, the Panel finds that the Respondent registered the disputed domain names primarily for the purpose of selling it to anyone prepared to pay a price exceeding the direct costs related to the disputed domain names. The Panel finds this is an indication of bad faith registration and use.
The Respondent did not submit a Response in this proceeding which is a further indications of the Respondent's bad faith, which was considered by the Panel.

Based on the evidence presented to the Panel, including the confusing similarity between the disputed domain names and the Complainant's mark, the distinctive nature of the Complainant's mark, the fact that the only use that the disputed domain names were put to was to direct to webpages offering their corresponding domain name for sale, and the fact that no Response was submitted by the Respondent, the Panel draws the inference that the disputed domain names were registered and are being 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. **INTESASANPAOLO-RBMSALUTE.COM**: Transferred
2. **INTESASANPAOLORBM.COM**: Transferred
3. **INTESASANPAOLORBMSALUTE.COM**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2020-04-07

Publish the Decision