Decision for dispute CAC-UDRP-105475

Case number	**CAC-UDRP-105475**
Time of filing	**2023-05-26 10:29:34**
Domain names	**INTESA-MARKETS.COM**

Case administrator

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

Complainant

Organization	**Intesa Sanpaolo S.p.A.**

Complainant representative

Organization	**Intesa Sanpaolo S.p.A.**

Respondent

Organization	**1337 Services LLC**

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

Identification of rights

The Complainant submitted evidence that it is the owner of the following trademarks:

- International trademark "**INTESA SANPAOLO**" (wordmark), registration n. 920896, registered on March 7, 2007, in classes 9, 16, 35, 36, 41 and 42;
- International trademark "**INTESA**", registration n. 793367, registered on September 4, 2002, in class 36;
- International trademark "**BANCA INTESA**" (combined trademark), registration n. 831572, registered on June 24, 2004, in class 36;
- EU trademark "**INTESA SANPAOLO**" (wordmark), registration n. 5301999, registered on June 18, 2007, in classes 35, 36 and 38;
- EU trademark "**INTESA**" (wordmark), registration n. 12247979, registered on March 5, 2014, in classes 9, 16, 35, 36 38, 41 and 42; and
- EU trademark "**BANCA INTESA**" (combined trademark), registration n. 2987220, registered on January 26, 2004, in classes 9, 16, 35, 36, 38, 41 and 42.

These international trademarks and EU-trademarks are hereafter referred to as the "**Trademarks**".

PARTIES CONTENTIONS

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant claims to be the leading Italian banking group and a major player in the European financial area. The Complainant claims to have a strong presence in Central-Eastern Europe, and to have an international network that supports corporate customers in 25 countries including the United States, Russia, China and India.

The Complainant claims to be the owner of several trademarks comprising the term “INTESA”. The Complainant submitted evidence that it is the owner of the various international and EU-trademarks that are listed above and referred to in this decision as the “Trademarks”.

The Complainant also states that it is the owner of multiple domain names which include the word “INTESA”. However, the Complainant failed to submit evidence that it is indeed the registered owner of such domain names. The Complainant provided screenshots of the website available via the domain name <intesasanpaolo.com>, without a clear indication of the identity of the operator of this website or domain and without the whois data of this domain name.

The Complainant states that the disputed domain name <Intesa-markets.com> was registered on April 20, 2023. However, the Complainant did not submit evidence thereof.

According to the Complainant, the disputed domain name resolves to a website sponsoring banking and financial services, i.e., identical services as those for which the Complainant’s Trademarks are registered and used.

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

1. **Confusing similarity**

The disputed domain name consists of the Complainant's Trademark “INTESA” with the addition of a hyphen and the term “MARKETS”.

The Panel remarks that Section 1.7 of WIPO Overview 3.0, states that, "*in cases where a domain name contains the whole of a trademark, or where at least one dominant feature of the relevant trademark is recognisable in the domain name, the domain name shall normally be considered confusingly similar to that trademark for the purposes of UDRP status*".

The Panel is of the opinion that the sole addition of the descriptive term “MARKETS” and a hyphen does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. This is supported by section 1.8 of WIPO Overview 3.0, which states: "*Where the relevant mark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not preclude a finding of confusing similarity under the first element*".

The gTLD ".com" may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. **Rights or legitimate interests**

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant argues that:

- The Respondent is not authorized or licensed by the Complainant;
- The disputed domain name does not correspond to the name of the Respondent. The Respondent is not commonly known as “INTESA-MARKETS”;
- There is no fair or non-commercial use of the disputed domain name.

The Respondent did not file an administratively compliant (or any) response. The Respondent did not provide evidence that it has rights or legitimate interests in the disputed domain name (the Respondent could, inter alia, have provided evidence of the factors mentioned in paragraph 4(c) of the Policy, but failed to do so).

The Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name from the following facts:

- There is no evidence at all that the Respondent is or has been commonly known by the disputed domain name or by the term(s) “INTESA” or “INTESA-MARKETS”;

- There is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers. On the contrary, it appears that the Respondent is taking advantage (or at least intends to take advantage) of the Complainant's registered Trademarks to attract internet users to its own website;

- The Respondent did not show to have any trademark rights or other rights in the term(s) “INTESA” or “INTESA-MARKETS”;

- The Respondent does not seem to have any consent or authorisation to use the Trademark(s) or variations thereof and does not seem to be related in any way to the Complainant.

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name.

3. **Bad faith**

The Complainant argues the following:

- The Respondent registered the disputed domain name with actual knowledge of the Trademarks. The Trademarks are well known all around the world. A Google search with the words “INTESA” and “INTESA SANPAOLO” clearly leads to the Complainant.
- The Respondent does not use the disputed domain name for a bone fide offering of goods or services. The disputed domain name is connected to a website sponsoring banking and financial services. The Complainant asserts that the Respondent uses the Trademarks for these purposes. The Complainant claims that the Respondent has registered and is using the disputed domain name to confuse consumers and intentionally divert traffic away from the website of the Complainant.
- The disputed domain name refers to the websites of the competitors of the Complainant.
- Several panellists have ordered the transfer or the cancellation of disputed domain names in similar WIPO cases where Intesa

Sanpaolo was the complainant.

The Panel weighs these arguments and facts as follows:

The Panel accepts that the evidence submitted by the Complainant proves that the Respondent uses the disputed domain name for offering “trading” services. The Panel furthermore accepts that these “trading” services are to be considered competing services to the services covered by the Complainant’s Trademarks. At the very least, offering “trading” services via the disputed domain name is to be considered as a way of intentionally confusing consumers and intentionally trying to divert traffic away from the website of the Complainant.

The Panel finds that, on the balance of probabilities, it may be expected that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence of the Complainant's Trademark(s) and the scope of these Trademarks. The Panel points to the fact that the Complainant has trademark rights to the terms “INTESA” for banking and financial services in various countries. The term selected by the Respondent (“INTESA”) seems to have no meaning in any language and seems only selected for its similarity to the Complainant’s registered Trademark(s). Moreover, the registration of the Complainant’s Trademarks predates the registration of the disputed domain name. The disputed domain name is almost identical to the Complainant's Trademark(s) "INTESA", with the addition of a hyphen and the descriptive word “MARKETS”. A Google search of the term "INTESA" clearly points to the Complainant. In light of this, it seems unlikely that the Respondent would not have been aware of the unlawful character of the disputed domain name at the time of its registration and use. The Panel concludes that the Respondent knew or at the very least should have known of the existence of the Complainant and its Trademarks.

In the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel believes from the facts in this case that the Respondent had the Trademark(s) of the Complainant in mind when registering and subsequently using the disputed domain name.

From these facts, the Panel concludes that the Respondent had actual knowledge of the Trademarks of the Complainant. The Respondent must have had the Trademark of the Complainant in mind when registering and using the disputed domain name. It appears that the Respondent tried to profit from the name and success of the Complainant with the disputed domain name.

For all the reasons stated above, the Panel concludes that the Complainant did prove that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(1)(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. **INTESA-MARKETS.COM**: Transferred

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2023-06-29

Publish the Decision