

Decision for dispute CAC-UDRP-105691

Case number	CAC-UDRP-105691
Time of filing	2023-08-09 09:20:16
Domain names	GRUPPOINTESASANPALOBANCA.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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	Livia Dor
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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 registered owner of the following trademark and service mark registrations INTESA SANPAOLO, GRUPPO INTESA SANPAOLO and BANCA INTESA SANPAOLO:

- International trademark and service mark registration n. 920896 INTESA SANPAOLO, registered on March 7, 2007, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration n. 5301999 INTESA SANPAOLO registered on June 18, 2007 for services in classes 35, 36 and 38;
- EU trademark registration n. 5344544 GRUPPO INTESA SANPAOLO registered on July 6, 2007 for services in classes 35, 36 and 38;
- EU trademark registration n. 5302377 "BANCA INTESA SANPAOLO, registered on July 6, 2007 for services in classes 35, 36 and 38.

FACTUAL BACKGROUND

The Complainant is a banking group established in Italy with an international presence, and in addition to its registered trademark rights described above, it has an established internet presence and is the owner of a large portfolio of Internet domain names including <bancaintesasampaolo-group.com> and <gruppobancaintesasampaolo.com>, all of which are connected to the Complainant's official website www.intesasampaolo.com.

The disputed domain name was registered on June 14, 2023, and resolves to a webpage with pay-per-click links to third party sites, including websites offering services competing with the Complainant.

There is no information available about the Respondent, except for that provided in the Complaint, the Registrar's Whois and the information provided by the Registrar to the Centre in response to the request by the Centre for details of the registration of the disputed domain name.

PARTIES CONTENTIONS

Complainant

The Complainant claims rights in the INTESA SANPAOLO, GRUPPO INTESA SANPAOLO and BANCA INTESA SANPAOLO trademarks and service marks established by its ownership of the portfolio of registrations described above and its extensive use of the marks in its banking business.

The Complainant submits that it is a leading Italian banking group and is among the top banking groups in the euro zone, with a market capitalisation exceeding €46,51 billion, having 3,400 branches in Italy, with approximately 13.6 million customers.

It also has a strong presence in Central and Eastern Europe with a network of approximately 950 branches and over 7,2 million customers.

It is represented 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.

Moreover, the Complainant has provided evidence in the form of a screen capture of its official website at www.intesasanpaolo.com to show that it has an established internet presence. It also submits that it is the owner of a large portfolio of Internet domain names including <bancaintesasnanpaolo-group.com> and <gruppobancaintesasnanpaolo.com> all of which resolve to its official website.

The Complainant alleges that the disputed domain name <gruppointesasnanpaolobanca.com> is identical or confusingly similar to its "INTESA SANPAOLO", "GRUPPO INTESA SANPAOLO" and "BANCA INTESA SANPAOLO" trademarks and service marks.

The Complainant particularly argues that the disputed domain name exactly reproduces its well-known trademark GRUPPO INTESA SANPAOLO, with the mere addition of the Italian term "BANCA" (meaning "bank"), which is an obvious reference to the Complainant's business and is in fact an element in Complainant's BANCA INTESA SANPAOLO registered trademark.

It is next alleged that the Respondent has no rights in the disputed domain name, arguing that any use of the trademarks INTESA SANPAOLO, GRUPPO INTESA SANPAOLO and BANCA INTESA SANPAOLO must be authorized by the Complainant, because of its pre-existing registered trademark rights.

The Complainant adds that it has not authorized or licensed anyone to use the disputed domain name.

The Complainant furthermore submits that the disputed domain name does not correspond to the name of the Respondent, and, to the best of the Complainant's knowledge, the Respondent is not commonly known as "GRUPPOINTESANPAOLOBANCA".

Referring to a screen capture of the website to which the disputed domain name resolves, which is exhibited in an annex to the Complaint, the Complainant submits that the web pages do not show that the Respondent is putting the website and the disputed domain name to any fair or non-commercial use.

Next the Complainant alleges that the disputed domain name was registered and is used in bad faith.

The Complainant argues that its trademarks "INTESA SANPAOLO", "GRUPPO INTESA SANPAOLO" and "BANCA INTESA SANPAOLO" are distinctive and well known all around the world. The fact that the Respondent has registered the disputed domain name that is confusingly similar to the Complainant's marks indicates that the Respondent had knowledge of the Complainant's marks at the time of registration of the disputed domain name.

In addition, it is argued that if the Respondent had carried out even a basic search on an Internet search engine in respect of the wordings "INTESA SANPAOLO", "GRUPPO INTESA SANPAOLO" and "BANCA INTESA SANPAOLO", the same would have yielded obvious references to the Complainant. In support of this argument, the Complainant has exhibited a screen capture of the results of such a search in an annex to the Complaint.

The Complainant argues that this raises a clear inference of knowledge of the Complainant's trademarks on the part of the Respondent. Therefore, it is probable that the disputed domain name would not have been registered if it were not for Complainant's trademark. The Complainant submits that this is clear evidence that the disputed domain name was registered in bad faith.

The Complainant contends that the screen capture shows that the disputed domain name resolves to a website sponsoring banking and financial services, for whom the Complainant's trademarks are registered and used. Consequently, 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 disputed domain name.

The Complainant contends that therefore the disputed contested domain name is not used for any *bona fide* offerings, but the evidence shows that 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 in order to gain through pay-per-click income from the links on the exhibited website.

Therefore, the Complainant argues that the Respondent has registered and is using the disputed domain name to intentionally divert traffic away from the Complainant's web site.

The Complainant argues that such use of the disputed domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy. See, e.g., *Encyclopaedia Britannica Inc. v. Shedon.com*, WIPO Case No. D2000-0753 ("Respondent's Ownership of a site which is a mis-spelling of Complainant's britannica.com site and which Respondent used to hyperlink to a gambling site demonstrates Respondent's bad faith registration and use of the britannica.com domain name").

The Complainant furthermore submits that the current use of the disputed domain name, facilitates access to the web sites of the Complainant's competitors, which damages the Complainant's business by the misleading the Complainant's existing, and potential new clients. See *Microsoft Corporation v. StepWeb*, WIPO Case No. D2000-1500.

The Complainant contends that Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated.

The Complainant adds that it is no coincidence that the Respondent has targeted a big financial institution such as the Complainant, as the practice of diversion of Internet traffic is very frequent in the banking realm due to the high number of online banking users.

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

Complainant's Rights

Complainant has provided convincing, uncontested evidence that it has rights in the INTESA SANPAOLO, GRUPPO INTESA SANPAOLO and BANCA INTESA SANPAOLO marks, established by the ownership of the portfolio of the service mark registrations described above and the reputation and goodwill that it has established in the marks by extensive and long use in the banking industry in Europe.

Confusing Similarity

The disputed domain name < gruppointesasanpaolobanca.com> consists of Complainant's service marks INTESA SANPAOLO and GRUPPO INTESA SANPAOLO in their entirety and each of the three elements in Complainant's BANCA INTESA SANPAOLO registered service mark.

Complainant's eponymous INTESA SANPAOLO mark is the dominant and only distinctive element in the disputed domain name. The additional words "gruppo" and "banca" are non-distinctive elements in both Complainant's marks and in the disputed domain name and their presence in the disputed domain name does not prevent a finding of confusing similarity with each of Complainant's INTESA SANPAOLO, GRUPPO INTESA SANPAOLO and BANCA INTESA SANPAOLO marks.

Similarly, the gTLD extension <.com> does not prevent a finding of confusing similarity as the circumstances of this proceeding, it would be considered to be a necessary technical requirement for a domain name registration,

This Panel finds therefore that the disputed domain name is confusingly similar to each of Complainant's INTESA SANPAOLO, GRUPPO INTESA SANPAOLO and BANCA INTESA SANPAOLO marks, and Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

Rights and Legitimate Interests

The Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the disputed domain name arguing that:

- any use of the trademarks "INTESA SANPAOLO", "GRUPPO INTESA SANPAOLO" and "BANCA INTESA SANPAOLO" must be authorized by the Complainant, because of its pre-existing rights INTESA SANPAOLO mark;
- Complainant has not authorized or licensed anyone to use the disputed domain name;
- the disputed domain name does not correspond to the name of the Respondent;
- to the best of the Complainant's knowledge, the Respondent is not commonly known as "GRUPPOINTESASANPALOBANCA";
- the exhibited screen capture of the website to which the disputed domain name resolves, does not show that the Respondent is putting the website and the disputed domain name to any fair or non-commercial use.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondent has failed to discharge that burden and therefore this Panel must find that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

Registration and Use in Bad Faith

The Complainant has adduced clear and convincing, uncontested evidence that it has trademark and service mark rights in the INTESA SANPAOLO, GRUPPO INTESA SANPAOLO and BANCA INTESA SANPAOLO which predate the registration of the disputed domain name on June 14, 2023.

The Complainant has also shown that it has an established reputation in the use of its eponymous trademark and domain name; that it has establishments across the frontiers of Western and Eastern Europe, and has a large portfolio of Internet domain names with an established web presence on its website at www.g.com.

The disputed domain name is a clear combination of the elements of the name of the Complainant's banking group. The combination of the INTESA SANPAOLO name with the descriptive terms "Gruppo" and "banca" cannot be a mere coincidence and it is most improbable that the registrant of the disputed domain name was unaware of the Complainant, its name, its trademarks and its goodwill and reputation when the disputed domain name was chosen and registered.

This Panel finds therefore that on the balance of probabilities the disputed domain name was registered in bad faith with the Complainant in mind to take predatory advantage of the Complainant's goodwill and reputation in the mark.

The screen capture of the website to which the disputed domain name resolves which has been exhibited in evidence in an annex to the Complaint, shows that Respondent is using the disputed domain name as the address of a webpage that displays links to third party websites.

On the balance of probabilities, the Respondent is receiving pay per click from such links and the Respondent has averred that they resolve to the websites of competing entities. Even if they did not resolve to competing websites, such use of the disputed domain name within the address of the webpage that links to third parties would constitute use in bad faith for the purposes of the Policy.

On the balance of probabilities, the Respondent is using the disputed domain name in bad faith in this manner to attract and confuse Internet users, and to misdirect Internet traffic to the Respondent's website causing harm to the Complainant's business and goodwill.

As this Panel has found that the disputed domain name was registered and is being used in bad faith, the Complainant has succeeded

in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **GRUPPOINTESASANPAOLOBANCA.COM**: Transferred

PANELLISTS

Name	James Bridgeman
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DATE OF PANEL DECISION	2023-09-01
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Publish the Decision