Decision for dispute CAC-UDRP-106194

Case number	CAC-UDRP-106194
Time of filing	2024-02-01 11:45:36
Domain names	INTESASANPAOLOMOBILEAPP.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

Name	Milen Radumilo

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

Complainant is the owner, among others, of the following registrations for the trademarks “INTESA SANPAOLO” and “INTESA”:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42;

- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in connection with class 36;

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, filed on September 8, 2006, granted on June 18, 2007 and duly renewed, in connection with the classes 35, 36 and 38;

- EU trademark registration n. 12247979 “INTESA”, filed on October 23, 2013 and granted on March 5, 2014, in connection with classes 9, 16, 35, 36, 38, 41 and 42.

Complainant has submitted evidence of the above mentioned registrations.

Moreover, Complainant also possesses, among the others, 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 website http://www.intesasanpaolo.com.

Respondent registered the domain name <intesasanpaolomobileapp.com> on June 26, 2022.

FACTUAL BACKGROUND

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 capitalisation exceeding 50,88 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,300 branches capillary and well distributed throughout the Country, with market shares of more than 15% in most Italian regions, the Group offers its services to approximately 13,6 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 900 branches and over 7,2 million customers. Moreover, the international network specialised 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.

On September 29, 2022 Complainant’s attorneys sent to Respondent a cease-and-desist letter asking for the voluntary transfer of the disputed domain name. Despite such communication, Respondent did not comply with the request. Consequently, Complainant filed a Complaint.

PARTIES CONTENTIONS

The Complainant´s contentions are summarised below.

No administratively compliant Response has been filed.

RIGHTS

Complainant asserts that it is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”. As a matter of fact, the disputed domain name <intesasanpaolomobileapp.com> exactly reproduces the well-known trademark INTESA SANPAOLO with the mere addition of the expression MOBILE APP, referring to the services offered by the Complainant to its customers through the use of an application to be installed on mobile devices.

According to the Policy paragraph 4(a)(i) it needs first to be established that:

(i)The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

The disputed domain name consists of the distinctive element INTESA and the descriptive elements SANPAOLO and MOBILE APP of which the first also belongs to some of the trademark registrations of Complainant. Therefore, the disputed domain name is similar to the invoked trademarks.

Further, the trademark registrations predate the registration of the disputed domain name and thus the trademark rights prevail.

Thus, the Panel agrees with this assertion of Complainant.

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 Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

According to the Policy paragraph 4(a)(ii) it needs further to be established that:

(ii) Respondent has no rights or legitimate interests in respect of the domain name.

Paragraph 4 (c) of the Policy provides circumstances that could demonstrate that Respondent has no rights to and legitimate interests in the Domain Name. These circumstances are not exclusive. Circumstance that are providing rights or legitimate interests to the domain name are:

(i) before any notice to the Respondent of the dispute, the use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if though it has acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to Complainant Respondent has no rights on the disputed domain name, and any use of the trademarks 'INTESA SANPAOLO' and 'INTESA' has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue.

Further, the disputed domain name does not correspond to the name of Respondent and, to the best of Complainant's knowledge, Respondent is not commonly known as 'Intesasanpaolomobileapp'.

Lastly, Respondent did not find any fair or non-commercial uses of the domain name at stake (see the contested domain name's home-page).

Only the second assertion of Complainant can be checked by the Panel as true. However, as Respondent did not defend itself by asserting the contrary, the Panel accepts the assertions of Complainant as true.

Complainant has, to the satisfaction of the Panel, shown 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

According to the Policy paragraph 4(a)(iii) it finally needs to be established that:

(iii) the domain name has been registered and is being used in bad faith.

Paragraph 4 (b) of the Policy provides circumstances on that demonstrate that Respondent has registered and used the domain name in bad faith. These circumstances are not exclusive. Those circumstance are for example:

(i) circumstances indicating that Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Complainant asserts that its trademarks 'INTESA SANPAOLO' and 'INTESA' are distinctive and well known all around the world.

Complainant continues with the allegation that Respondent had knowledge of Complainant's trademark at the time of registration of the disputed domain name because if Respondent had carried out, even, a basic Google search on Complainant's trademark, the same would have yielded obvious references to the Complainant. An extract of a Google search is submitted by Complainant,

Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant's trademark. This is clear evidence of registration of the domain name in bad faith.

In addition, Complainant asserts that the contested domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the domain name, 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. In fact, the domain name is connected to a website with sponsoring, banking and financial services, which are the services that Complainant is rendering.

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 domain name at issue.

According to Complainant Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated. Further, it is no coincidence that this speculation has 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, Complainant submits evidence that Respondent has already been part of many other WIPO Cases where the Panel ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations.

Further Complainant cites several WIPO decisions in which the registration and use of a domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy.

Based on the above the Panel has the following findings.

Bad faith circumstances occur mainly when a Respondent sees financial gain on riding on the coat tails of Complainant's success. This is mostly profitable when Complainant has a reputation. Therefore, first it needs to be established whether Complainant has such a reputation.

To substantiate its reputation Complainant submits pages on its website on which, in graphics, its leading position in Italy is depicted. Further, inter alia, its place at the Eurozone ranking with respect to bank's market capitalisation is demonstrated where Intesa Sanpaolo stands on the 3rd pace after BNP Paribas and Banco Santander.

Further, in order to substantiate its reputation Complainant submits a list of other WIPO cases in which Complainant has filed a Complaint. The list is extensive and this is no coincidence according to Complainant: the diversion practice in banking realm by bad faith parties is very frequent due to the high number of online banking users.

On the reputation the Panel finds that, although all the graphics cannot be considered objective information of its reputation as it is on Complainant's own website and it does not refer or shows that the information is cited from an objective source, considering the amount and extensiveness of the graphics and the fact that Respondent did not counterargue, the Panel considers it as plausible evidence of its reputation.

Further, Complainant submits evidence showing the layout of the website behind the disputed domain name: it has a basic layout consisting of a black background and blue frames with links to other websites. Where the links lead to is not clear as there is no evidence submitted of the webpages that follow from clicking on the links. It can therefore not be established that the links lead to websites of competitors as asserted by Complainant. Nevertheless, the Panel is aware of these so-called pay-per-click websites. They are a current trend in any kind of business. These websites use well known trademarks in the domain names, and once typing the domain name in a browser, they provide websites with links that lead the visitors to other websites that may or may not comprise competitive information but in any event not to information that originates from the trademark owner. The domain names of -the black with blue frames containing links- websites clearly use the reputed trademarks to attract visitors and earn money through the links that are clicked on. These domain names and its underlying websites never respect the interests of the trademark owner whose trademark is used in the domain name, either correctly or with an additional term or with a typo.

The website format thus already shows that the use and registration of the disputed domain name is in bad faith.

Further, the bad faith use and registration of the disputed domain name is enhanced by showing other activities of Respondent, as substituted by Complainant, namely a list of WIPO cases in which Respondent is defendant and of which Complainant has asserted that they are comprising decisions against Respondent in the same type of cases. Now that Respondent did not counterargue, the Panel has considered this as a true assertion substantiated with evidence.

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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLOMOBILEAPP.COM**: Transferred

PANELLISTS

Name	**Marieke Westgeest**

DATE OF PANEL DECISION 2024-03-05

Publish the Decision