

Decision for dispute CAC-UDRP-103701

Case number	CAC-UDRP-103701
-------------	------------------------

Time of filing	2021-04-06 11:08:59
----------------	----------------------------

Domain names	INTESASANPAOLO.FINANCE
--------------	-------------------------------

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
--------------	--

Complainant

Organization	Intesa Sanpaolo S.p.A.
--------------	-------------------------------

Complainant representative

Organization	Intesa Sanpaolo S.p.A.
--------------	-------------------------------

Respondent

Name	Amir Mt
------	----------------

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.

FACTUAL BACKGROUND

The Complainant is the leading Italian banking group (among the top banking groups in the euro zone), and also one of the protagonists in the European financial arena. 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.

The Complainant is the owner, among others, of the following registrations for the international and EU trademarks "INTESA SANPAOLO" and "INTESA" in classes 9, 16, 35, 36, 38, 41 and 42. Moreover, the Complainant is also the owner, among the others, of multiple domain names bearing the signs "INTESA SANPAOLO" and "INTESA" (e.g. <INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ>), all of which are now connected to the official website <http://www.intesasanpaolo.com>.

On September 27, 2020, the Respondent registered the disputed domain name <INTESASANPAOLO.FINANCE>.

The Complainant asserts that their "INTESA SANPAOLO" and "INTESA" trademarks are well-known, that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, that the Respondent

has no permission from the Complainant to use the Complainant's trademarks nor does it have any rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

The Complainant also states that, the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the domain name at issue. Despite such communication, the Respondent did not comply with the above request.

PARTIES CONTENTIONS

The Respondent did not reply to Complainant's contentions in this proceeding.

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

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the UDRP Policy have been satisfied, namely: (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) the disputed domain name has been registered and is being used in bad faith.

Reasons for Decision

I. Identical or Confusingly Similar

The disputed domain name <intesianpaolo.finance> incorporates the Complainant's trademark "INTESA SANPAOLO" in its entirety, with no additional terms. Where a domain name incorporates the entirety of a trademark, it will normally be considered identical or confusingly similar to the trademark (see Fendi Adele Srl. v. Ashot Rostomian, WIPO Case No. D2000-1247; Austrian Airlines AG. v. Stanley Varanian, WIPO Case No. D2008-1027).

The Panel considers the disputed domain name to be identical to the Complainant's well-known registered trademark and that 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), and hence, successfully proving the first element of the Policy.

II. Rights or Legitimate Interests

The Panel considers that the Complainant has made a prima facie case showing that the Respondent lacks rights or legitimate interests. In the present circumstances, the Panel finds - in agreement with the Complainant contentions - that i) the disputed

domain name does not correspond to the name of the Respondent, ii) that the Respondent is not commonly known as "INTESASANPAOLO", and has decided not to file a Response in order to show the contrary to this Panel, and iii) the Respondent has not used or presented any evidence to this Panel that it has made demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services. In addition, the Panel also notes that the Complainant has never authorised or licensed the Respondent to register or use any of its trademarks "INTESA SANPAOLO" and/or "INTESA".

In light of the above, 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).

III. Registered and Used in Bad Faith

As mentioned before, the disputed domain name <intesasanpaolo.finance> incorporates the Complainant's trademark in its entirety. The domain name extension ".finance" should usually be ignored for the purposes of assessing the confusing similarity. However, in this occasion, the Respondent has not only chosen a domain name identical to the Complainant's trademarks, but also chosen a gTLD extension directly describing the business and "finance" services offered by the Complainant.

With all of this in mind, the Panel considers that the Respondent was well aware of the reputation of the Complainant at the time the disputed domain name was registered (i.e. September 2020, many years after the Complainant became popular and well-known). The Panel concludes that the disputed domain name was registered with the intention to target the Complainant and its trademark, which constitutes registration in bad faith.

The Panel notes that the disputed domain name redirects currently to an inactive website. The Complainant sent a Cease & Desist Letter via the Privacy Service being used by the Respondent, and the Panel notes that the website under the disputed domain name, at that time (from the evidence provided by the Complainant), was linked to parking website with sponsored links to financial service offerings (i.e. in the same sector as the Complainant). This initial use by the Respondent shows it was capitalising on the initial confusion of users who are looking for information about the Complainant, and who instead are directed to other websites, as determined by the Respondent's parking service (which complies with circumstances listed in the paragraph 4(b)(ii) as registration and sue in bad faith).

Sometime after February 2021, this is after the cease & desist letter was sent by the Complainant, the content of the disputed domain name changed from the parking site to its current inactive website.

Panels have found that the non-use of a domain name could constitute registration and use of bad faith under the doctrine called as "passive holding". Factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. See as examples: Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, Merryvale Ltd. v. Vlad Kordov, WIPO Case No. D2020-0934.

The Panel confirms that in the present case, all the above circumstances apply: i) Complainant's trademark has a strong reputation and is widely known as international banking group, recognised as "well-known" by previous UDRP Panels; ii) the Respondent has not filed any Response or evidence to rebut the contentions of the Complainant, and has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name; iii) the Respondent has taken active steps to conceal its true identity, by operating under a name "Amir Mt" that is not a registered business name, and has provided false contact details, in breach of its registration agreement (i.e. the Respondent used a non-existent physical address in Germany. The Panel could not find any "Amir Mt" located in Germany, nor any such address in Germany. Additionally, the city of Köln is located in the state of Nordrhein-Westfalen, and not in any state called "Zaksen" (nor is it located in the real state of Sachsen (in case there could be a typo in the state name)).

Taking into account all of the above, as well as the change in the content of the website to which the disputed domain name

resolves, it is not possible to conceive any good faith use of the disputed domain name by the Respondent.

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).

For the foregoing reasons, the Panel orders that the disputed domain name be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **INTESASANPAOLO.FINANCE:** Transferred

PANELLISTS

Name	Laura Martin-Gamero Schmidt
------	-----------------------------

DATE OF PANEL DECISION	2021-05-14
------------------------	------------

Publish the Decision	
----------------------	--