

Decision for dispute CAC-UDRP-104690

Case number	CAC-UDRP-104690
Time of filing	2022-07-04 10:10:23
Domain names	MODULO-AGGIORNAMENTO-INTESA.COM

Case administrator

Organization	Denisa Bilík (CAC) (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

Organization	marano tu si, antonio di bartolomeo
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OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the domain name <modulo-aggiornamento-intesa.com> ("the disputed domain name").

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks, amongst others:

- International trade mark registration no. 920896, registered on 7 March 2007, for the word mark INTESA SANPAOLO, in classes 9, 16, 35, 36, 38, 41 and 42 of the Nice Classification;
- International trade mark registration no. 793367, registered on 4 September 2002, for the word mark INTESA, in class 36 of the Nice Classification;
- EU trade mark registration no. 005301999, registered on 18 June 2007, for the word mark INTESA SANPAOLO, in classes 35, 36 and 38 of the Nice Classification; and
- EU trade mark registration no. 012247979, registered on 5 March 2014, for the word mark INTESA, in classes 9, 16, 35, 36, 38, 41 and 42 of the Nice Classification.

(hereinafter, collectively or individually, “the Complainant’s trade mark”; “the Complainant’s trade mark INTESA”; or “the trade mark INTESA” interchangeably).

At the time of writing, the disputed domain name resolves to a parked page comprising pay-per-click (“PPC”) links (“the Respondent’s website”).

FACTUAL BACKGROUND

The Complainant’s contentions can be summarised as follows:

A. Background history

The Complainant is the leading Italian banking group and a major player in the European financial arena, whose company name resulted from the merger in 2007 of two Italian banking groups, namely, Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups. The Complainant presently offers its services to approximately 13.5 million customers worldwide, with an international network present in 25 countries.

In addition to the trade marks mentioned in the above section “Identification of rights”, and numerous other trade marks, the Complainant informs that it is also the owner of various domain names which contain the marks INTESA and INTESA SANPAOLO, most notably <intesasanpaolo.com>, which was registered in 2006.

The disputed domain name <modulo-aggiornamento-intesa.com> was registered on 2 October 2020.

By way of relief, the Complainant seeks the transfer of the disputed domain name <modulo-aggiornamento-intesa.com> to the Complainant on the grounds advanced in section B below.

B. Legal grounds

I. The disputed domain name is confusingly similar to trade marks in which the Complainant has rights

The Complainant claims that the disputed domain name is identical, or at least confusingly similar, to the Complainant’s trade marks INTESA and INTESA SANPAOLO. The disputed domain name reproduces the Complainant’s well known trade marks, with the mere addition of the Italian terms “modulo” and “aggiornamento”, which are merely descriptive of the Complainant’s services.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant states that the Respondent has no rights in the disputed domain name, and any use of the trade marks INTESA SANPAOLO and INTESA has to be authorised by the Complainant. The Respondent is not authorised or licensed by the Complainant in any way, nor is the Respondent commonly known by the disputed domain name.

III. The Respondent registered and is using the disputed domain name in bad faith

Registration

The Complainant states that the trade marks INTESA SANPAOLO and INTESA are well-known and distinctive. The Complainant further states that, given the distinctiveness and reputation of the trade marks INTESA SANPAOLO and INTESA, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant’s trade marks.

Use

The Complainant avers that the disputed domain name is connected to a website sponsoring, amongst others, banking and

financial services, and that the Respondent has intentionally used the disputed domain name to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant as to the source, sponsorship, affiliation, or endorsement of that website (paragraph 4(b)(iv) of the UDRP Policy).

The Complainant claims that the disputed domain name is not used for any bona fide offerings in so far as it resolves to a website which contains links to the Complainant's competitors.

As additional indicia giving rise to a presumption of bad faith, the Complainant refers to the Respondent's failure to respond to the Complainant's cease-and-desist letter.

The Complainant therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to trade marks in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP 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 UDRP 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 UDRP 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

A. General

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy sets out the following threshold for the Complainant to meet for the granting of the relief sought (transfer of the disputed domain name):

- 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.

It is incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three UDRP

Policy elements in turn.

B. Identical or Confusingly Similar

The Panel is satisfied that the Complainant owns trade mark rights in “INTESA” since 2002.

The disputed domain name is <modulo-aggiornamento-intesa.com>, and the Complainant’s trade mark is INTESA.

The Panel notes that the Complainant’s trade mark INTESA is wholly incorporated into the disputed domain name. The additional Italian words “modulo” and “aggiornamento”, which taken together have the meaning of “updated module” in the English language, are immaterial to the confusing similarity test, in the Panel’s view. This is because the Complainant’s trade mark INTESA retains its distinctive character in the disputed domain name string, which clearly evokes the Complainant’s trade mark.

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

C. Rights or Legitimate Interests

The Respondent has defaulted in these UDRP proceedings. Nevertheless, the Panel is empowered to draw adverse inferences from the Respondent’s silence (Rule 14 (b) of the UDRP Rules).

The Panel notes that the Complainant firmly denies any affiliation and/or association with, or authorisation for, the Respondent of any nature. Moreover, the Complainant argues that the Respondent is not known by the disputed domain name; and that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name.

The Complainant has provided evidence to support its contentions, which remained unchallenged by the Respondent.

In addition, in the Panel’s view, the choice of a domain name which incorporates a complainant’s trade mark wholly (as in this case) or virtually wholly, and is unaccompanied or unsupported by any credible explanation as to the reason for this coincidence, could further evidence a lack of rights or legitimate interests.

The Panel has also taken stock of paragraph 2.9 of the WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”), according to which UDRP panels have found that the use of a domain name to host a parked page containing PPC links does not represent a bona fide offering where such links compete with, or capitalise on, the reputation and goodwill of the complainant’s trade mark or otherwise mislead Internet users.

The Panel considers that substantial evidence sways in favour of the Complainant in this case. Therefore, the Complainant has succeeded under paragraph 4(a)(ii) of the UDRP Policy.

D. Registered and Used in Bad Faith

D.1 Registration in bad faith

The following facts are compelling evidence to this Panel that the disputed domain name was registered in bad faith:

- The Complainant has been in operation since at least 2007, with a major presence in Italy, where the Respondent appears to be based;
- The Complainant operates its activities through the domain name <intesianpaolo.com>, which was registered in 2006;
- The disputed domain name <modulo-aggiornamento-intesa.com> was registered on 2 October 2020;

- The lack of any credible evidence-backed rationale for the Respondent's choice of the disputed domain name; and
- UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trade mark can by itself create a presumption of bad faith (paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0), and the Panel accepts that the Complainant's trade mark is widely known in its field of business.

D.2 Use in bad faith

The Complainant alleges that the Respondent has engaged in the conduct described in paragraph 4(b)(iv) of the UDRP Policy, which provides as follows:

"(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the respondent's website or location or of a product or service on the respondent's website or location."

Furthermore, the Complainant alludes to the Respondent's failure to respond to the Complainant's cease-and-desist letter as additional evidence of bad faith use.

The Panel has consulted the WIPO Jurisprudential Overview 3.0, in particular paragraph 3.3 and paragraph 3.5, to determine whether or not there has been bad faith use of the disputed domain name.

Of particular note, UDRP panels have found that a respondent cannot disclaim responsibility for content appearing on the website to which the domain name resolves nor would such PPC links per se vest the respondent with rights or legitimate interest (paragraph 3.5 of the WIPO Jurisprudential Overview 3.0).

In the present matter, the Panel considers the most conducive factors to a finding in favour of the Complainant under this Policy ground to be (i) the degree of distinctiveness or reputation of the Complainant's trade mark; (ii) the Respondent's overall disinterest in defending the Complainant's claim (Respondent's default position pre- and in the course of the UDRP proceedings); and (iii) the implausibility of any good faith use to which the disputed domain name may be put.

In view of the above, the Panel finds that the Complainant has succeeded under paragraph 4(a)(iii) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MODULO-AGGIORNAMENTO-INTESA.COM**: Transferred

PANELLISTS

Name	Dr Gustavo Moser
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DATE OF PANEL DECISION	2022-08-08
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Publish the Decision