

Decision for dispute CAC-UDRP-104253

Case number	CAC-UDRP-104253
Time of filing	2022-01-03 09:41:26
Domain names	INTESANPAOLOASSICURA.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

Organization	Above.com Domain Privacy
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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

EU trademark registration n. 5301999 "INTESA SANPAOLO", applied on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

FACTUAL BACKGROUND

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

The Complainant is the leading Italian banking group 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.

Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 33,0 billion euro, and the leader in Italy, in many business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,100 branches capillary and well distributed throughout the country, with market shares of more than 16 % in most Italian regions, the Group offers its services to approximately 11,8 million customers. Intesa Sanpaolo has a strong presence in

Central-Eastern Europe with a network of approximately 1.100 branches and over 7,3 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.

The Complainant is the owner of numerous trademarks containing or consisting of the words “INTESA SANPAOLO” and “INTESA”, including the EU trade mark registration referred to above.

Moreover, the Complainant is also the owner of the following domain names containing the words “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 these domain names are now connected to the Complainant's official website <http://www.intesasanpaolo.com>.

It has been put to the Respondent that it registered the domain name <INTESANPAOLOASSICURA.COM> on December 1, 2021. As the Respondent has not filed a Response, the Panel takes this assertion of fact as uncontested.

The disputed domain name diverts users to website that contains pornographic material.

PARTIES CONTENTIONS

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

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

- 1) the disputed domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and
- 2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- 3) the disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied that the Complainant has satisfied all three elements for the principal reasons set out below.

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant asserts it has a number of trademark registrations consisting of the words "INTESA SANPAOLO". At least one of these registrations predates the registration date of the disputed domain name by over a decade.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark "INTESA SANPAOLO".

The next question is whether the disputed domain name is confusingly similar to the "INTESA SANPAOLO" trademark.

The Panel disregards the gTLD suffix ".com" for the purpose of this comparison. It is of no brand significance and it is likely to be totally ignored by web users. Such web users are likely to focus entirely on the only distinctive element in the disputed domain name, being the INTESANPAOLOASSICURA element.

This INTESANPAOLOASSICURA element is strikingly similar to only from the "INTESA SANPAOLO" trademark. There is the absence of the letters "SA" in the middle of the former element, however that makes little difference to the look or sound of this element when compared with the "INTESA SANPAOLO" trademark. Essentially, the disputed domain name looks and sounds like the "INTESA SANPAOLO" trademark with the word ASSICURA at the end. ASSICURA is simply the Italian word for "ensures" and therefore does very little to relieve the confusion caused by the remaining striking similarities.

The disputed domain name is therefore confusingly similar to the "INTESA SANPAOLO" trademark.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name according to information provided by the registrar for the disputed domain name is "Above.com Domain Privacy". This name bears no resemblance to "INTESANPAOLOASSICURA". Further, the website to which the disputed domain name resolves has no content which would indicate any right or legitimate interest in the disputed domain name.

The Respondent has no rights or interests in the disputed domain name.

BAD FAITH

The Complainant has evidence for a long standing international reputation in its well known "INTESA SANPAOLO" trademark. Further, given the unique nature of that trademark it is highly unlikely that a registrant registering a domain name consisting of the words "INTESANPAOLOASSICURA" would not have known of the Complainant. It is particularly noted that ASSICURA is an ordinary Italian word. The Panel finds it is no coincidence that this ordinary Italian word proceeds a clear misspelling of the internationally known Italian based trademark "INTESA SANPAOLO". That clear misspelling being "INTESANPAOLO".

Hence there is already a strong indication of bad faith before one even looks at the use of the domain name.

However turning to the use of the domain name this only further indicates an existence of bad faith.

The position on the use of domain names to direct to pornographic material and bad faith is well stated in Motorola, Inc. v. NewGate Internet, Inc. WIPO Case No. D2000-0079 where the panelist stated:

“[W]hile many adult sex sites are perfectly legal and constitute bona fide offerings of goods or services, the use of somebody else’s trademark as a domain name (or even as a meta-tag) clearly does not constitute a bona fide offering of goods or services when the website owner has no registered or common law rights to the mark, since the only reason to use the trademark as a domain name or meta-tag is to attract customers who were not looking for an adult sex site, but were instead looking for the products or services associated with the trademark. Such use of a trademark can create customer confusion or dilution of the mark, which is precisely what trademark laws are meant to prevent. And actions that create, or tend to create, violations of the law can hardly be considered to be bona fide”.

In agreement with this position, it is the present Panel's view that provided the pornographic content is not of an unlawful nature then the mere fact that a domain name redirects users to a pornographic website is not, by itself, indicative of bad faith which the Policy is designed to address. However what is of concern to the Policy is when a registrant both registers a domain name similar to another trader's trademark and also redirects that domain name to a pornographic site knowing that is likely to damage the other trader's reputation.

That is clearly the scenario that has happened in the present dispute. The Complainant is a well-known financial institution and, as it clearly submits in the Complaint, it has no interest in being associated with pornographic material, which it states causes "dilution and tarnishments" to its "marks and image".

Therefore in consideration of all the circumstances the disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **INTESANPAOLOASSICURA.COM**: Transferred

PANELLISTS

Name	Mr Andrew Norman Sykes
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DATE OF PANEL DECISION	2022-02-07
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Publish the Decision