Panel Decision for dispute CAC-ADREU-006212

Case number	CAC-ADREU-006212
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Domain names	INTESACOMMERCIALE.EU

Case administrator

Tereza Bartošková (Case admin)

Complainant

Organization

Respondent

Name	Simon Lundgren - Domain Park

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

None that the Panel is aware of.

FACTUAL BACKGROUND

The Complainant is Intesa Sanpaolo S.p.A, a company registered under the laws of Italy. The Complainant is a company which resulted from a merger in 2007 between two large Italian banks, Banca Intesa S.p.A. and Sanpaolo IMI S.p.A..

The Respondent, “Simon Lundgren - Domain Park”, has an address listed in Berlin, Germany on the WHOIS database.

The Respondent registered the domain name ‘INTESACOMMERCIALE.EU’ (the ‘Domain Name’) on 25 July 2011.

On 11 November 2011 the Complainant’s lawyer wrote to the Respondent (by registered mail and by e-mail) setting out the Complainant’s rights in relation to the INTESA trade mark, and requested the transfer of the Domain Name. In addition they requested transfer of the domain name ‘INTENSASANPAOLO.IT’, which was also registered by the Respondent on 4 July 2011 (prior to the registration of the Domain Name in issue here). Following this, the letter was returned to the Complainant's lawyer by the postal system with an indication that the address (taken from the WHOIS) was incorrect.

On 25 January 2012, the Complainant filed its complaint against the Respondent with the Czech Arbitration Court, seeking transfer of the Domain Name to the Complainant.

On 6 February 2012 the ADR proceedings were formally commenced and a notification of such was sent to the Respondent, explaining that it had 30 days within which to submit a Response - in accordance with the ADR Rules. The notification also explained the potential consequences of a failure to provide a response within this set time frame.

The Respondent failed to submit a Response within the time frame required, or at all, and a Notification of Respondent’s Default was therefore issued by the Czech Arbitration Court on 12 April 2012.

On 30 April 2012, having received a Statement of Acceptance and Declaration of Impartiality, the Czech Arbitration Court appointed Steve Palmer of Palmer Biggs Legal as the Panel in these ADR proceedings.

A. COMPLAINANT

The Complainant states:

It is the leading banking group in Italy, resulting from the merger in 2007 between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups. The Complainant is amongst the top banking groups in the eurozone, with a market capitalisation exceeding 30.9 billion euro, and the leader in Italy in all business areas (retail, corporate and wealth management).

The Complainant has a network of approximately 5,800 branches in Italy with approximately 11.4 million customers. It has a strong presence in Central-Eastern Europe, with a network of approximately 1,700 branches and over 8.4 million customers.

The Complainant's international presence specialises more in corporate customers in 29 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 a number of trade mark registrations for INTESA, including some registered European Community Trade marks in relevant classes. It is also the owner of a number of actively used domain names (in that they direct to the Complainant's main website) which feature INTESACOMMERCIALE as the prefix, and which were registered by the Complainant prior to the registration of the Domain Name in issue.

The Respondent registered the Domain Name in issue on 25 July 2011.

The Domain Name contains the exact word INTESA, a trade mark which is owned by the Complainant and has the mere addition of the generic and descriptive term "COMMERCIALE" (Italian for 'commercial'). Further, the Domain Name is identical to the above mentioned domain names "INTESACOMMERCIALE" owned by the Complainant and registered prior to the registration of the Domain Name in issue.

On 11 November 2011 the Complainant's lawyer wrote to the Respondent (by registered mail and by e-mail) setting out the Complainant's rights in relation to the INTESA trade mark and requested the transfer of the Domain Name. However, the letter was retuned by the postal system with an indication that the address (taken from the WHOIS) was incorrect.

****The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law (Paragraph B11(d)(1)(i) of the ADR Rules)****

The Domain Name is very similar to the trade mark INTESA which is owned by the Complainant.

Further the Domain Name is identical to a number of domain names with the prefix INTESACOMMERCIALE which are owned and by the Complainant.

****The domain name has been registered by the Respondent without rights or legitimate interest in the name (Paragraph B11(d)(1)(ii) of the ADR Rules)****

The Respondent has no rights in the Domain Name, as it does not correspond to a trade mark registered in the name of the Respondent, nor does it correspond to the name of the Respondent itself.

Also, the Respondent is not commonly known as "INTESACOMMERCIALE".

Finally, there is no fair or non-commercial use of the Domain Name.

****The domain name has been registered or is being used in bad faith (Paragraph B11(d)(1)(iii) of the ADR Rules)****

Under Paragraph B11(f)(4) of the ADR Rules), bad faith may be found to be present by the existence of the fact that "…the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law, or it is a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent".

The Domain Name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trade marks are registered and used. Therefore, there is a likelihood of confusion as Internet users, while searching for information on the Complainant's services, will be led to the websites of the Complainant's competitors, via the links found at the websites connected to

the Domain Name.

The Complainant contends that the Respondent has registered and is using the Domain Name in order to intentionally divert traffic away from the Complainant's web site. This diversion of web traffic through the use of the Complainant's trade mark causes great damage to the Complainant due to it misleading existing customers, and to the potential loss of new customers.

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

In conclusion, the requirements established by the Regulation and Article B.11 of the ADR Rules are satisfied in the present case.

B. RESPONDENT

No Response or other communication has been received on the online ADR Platform from the Respondent in respect of the Complaint.

DISCUSSION AND FINDINGS

As the Respondent failed to submit a Response to the Complaint, this decision has made in accordance with Paragraph B10 of the ADR Rules.

*** Identical or confusingly similar Domain Name ***

The first requirement of Art 21(1) Public Policy Rules has been satisfied in the Panel's view. The Domain Name is confusingly similar to the Complainant's prior CTM registration for INTESA, in that it contains that exact word INTESA plus the additional the non distinctive element 'commerciale', together with a '.eu' suffix (which serves no relevant distinguishing purpose).

*** No rights or legitimate interest ***

Art 21(1)(a) Public Policy Rules provides that the Domain Name shall be subject to revocation if it has been registered by the Respondent without rights or legitimate interest in the name.

On the evidence made available to the Panel, and in the absence of any formal Response from the Respondent, it appears to the Panel's satisfaction that the Respondent does not have any rights or legitimate interest in the name.

Art 21(2) Public Policy Rules sets out a list of factors which may demonstrate a legitimate interest (the mirror provisions at B.11(e) of the ADR Rules). This list includes, inter alia, situations where the domain name holder is commonly known by the name corresponding to the Domain Name. This does not apply in this case. The list also includes a situation where the domain name holder is making legitimate non-commercial fair use of the domain name without intending to mislead the consumers. In the absence of anything to the contrary, the Panel finds this not to apply here.

In the circumstances, the Panel finds that, on the balance of probabilities, the Respondent registered the Domain Name without legitimate interest in the name and the Domain Name .

Bad Faith

The Panel has also considered whether or not the Domain Name should be subject to revocation under Art 21(b) Public Policy Rules - whereby the Domain Name shall be subject to revocation if it has been registered or is being used in bad faith.

Relevant to a finding of bad faith is the issue of whether or not the Respondent had knowledge of the Complainant and its INTESA trade mark when it registered the Domain Name on 25 July 2011. The Panel finds that, on the balance of probabilities, the Respondent did register (and has since used as a directory site diverting visitors to, inter alia, competitors of the Complainant) the Domain Name in full knowledge of the Complainant and its INTESA trade mark. The Panel finds this to be the case not least due to the Respondent's prior registration on 4 July 2011 of an Italian domain name INTENSASANPAOLO.IT which is virtually an exact match (save for a typographical error/additional letter 'N') to the Complainant's full corporate name.

Art 21(3) (the equivalent provisions are found in B.11(f) ADR Rules) sets out a non-exhaustive list of circumstances, which if found to be

present shall be evidence of ‘bad faith’ within the meaning of Art21(1)(b). The Panel notes that the Complainant need only prove one of these grounds in order to succeed in demonstrating that the Respondent had registered or used the Domain Name in bad faith.

In the Panel’s view, there are circumstances which indicate that, on the balance of probabilities, the bad faith factor set out in Article 21(3)(d) of the Public Policy Rules / B11(f)(4) ADR Rules to be present. In this regard, it is the Panel’s view that on the balance of probabilities any intentional use of the Domain Name by the Respondent has been to attract Internet users for commercial gain to the Respondent’s website or other on-line location (the Domain Name attaches to a directory website with links to, inter alia, competitors of the Complainant, which may well generate 'click through' income for the Respondent), by creating a likelihood of confusion with the Complainant's INTESA trade mark, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent.

In addition, looking at the bad faith factor in Article 21(3)(a) of the Public Policy Rules / B11(f)(1) ADR Rules, the Panel finds it very likely that the Respondent has an overarching aim behind its registration of the Domain Name, namely to sell it to the Complainant at some point. The Panel infers this from the fact that the Respondent also registered INTENSASANPAOLO.IT prior to the Domain Name in issue was registered.

In conclusion, and in addition to the finding that the Respondent has no legitimate interest in the name, the Panel also finds that the Domain Name was registered and has been used by the Respondent in bad faith.

Finally, under B10 of the ADR Rules, it must be noted that the Panel shall draw such inferences as it considers appropriate in circumstances where a Respondent is in default of filing a response. The Panel infers from the Respondent's silence in this case that it accepts the Complainant's position as set out in the Complaint and that the Respondent has no points to raise in reply that would materially affect the Panel's decision.

The Panel finds the registration of the Domain Name by the Respondent to be speculative or abusive within the meaning of Art 21 Public Policy Rules, and the Complainant is entitled to succeed. The Domain Name should therefore be transferred to the Complainant.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name INTESACOMMERCIALE.EU be transferred to the Complainant

PANELISTS

Name	**Steve Palmer**

DATE OF PANEL DECISION 2012-05-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: INTESACOMMERCIALE.EU

II. Country of the Complainant: Italy, country of the Respondent: Germany

III. Date of registration of the domain name: 25 July 2011

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:

- INTESA trade mark (word) registered by the Complainant in various countries including as a European Comunity Trade Mark under reg. No. 3105277, filed on 21 March 2003 and registered on 13 February 2009.

- Other: The Complainant is the owner of a number of actively used domain names (in that they direct to the Complainant’s main website) which feature INTESACOMMERCIALE as the prefix, and which were registered by the Complainant prior to the registration of the Domain Name in issue.

V. Response submitted: No

VI. Domain Name is confusingly similar to the protected right of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
- Why the Complainant considers the Respondent to lack the rights and legitimate interests: Respondent has no rights in that the Domain Name does not correspond to a trade mark registered in the name of the Respondent, nor does it correspond to the name of the Respondent.

- Rights or legitimate interests the Respondent claims to have: None

- Does the Panel consider the Respondent to have no rights or legitimate interests: No rights / no legitimate interest

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):

- Why the Complainant considers the Respondent to have registered or use the domain name/s in bad faith:

The Domain Name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trade marks are registered and used. Therefore, there is a likelihood of confusion - as Internet users, while searching for information on the Complainant's services, will be led to the websites of the Complainant's competitors, via the links found at the websites connected to the Domain Name.

The Complainant contends that the Respondent has registered and is using the Domain Name in order to intentionally divert traffic away from the Complainant's web site. This diversion of web traffic through the use of the Complainant's trade mark causes great damage to the Complainant due it misleading existing customers, and to the potential loss of new customers.

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

2. How the Respondent rebuts the statements of the Complainant: No response filed.

3. Does the Panel consider the Respondent to have registered or use the domain name in bad faith: Yes

IX. Other substantial facts the Panel considers relevant:

The Panel finds that the Respondent did register (and has since used as a directory site diverting visitors to, inter alia, competitors of the Complainant) the Domain Name in full knowledge of the Complainant and its INTESA trade mark. The Panel finds this to be the case not least due to the Respondent's prior registration on 4 July 2011 of an Italian domain name INTENSASANPAOLO.IT which is virtually an exact match (save for a typographical error/additional letter 'N') to the Complainant's full corporate name. Following this, the Panel finds it very likely that the Respondent has an overarching aim behind its registration of the Domain Name, namely to sell it to the Complainant.

X. Dispute Result: Transfer of the disputed Domain Name

XI. Procedural factors the Panel considers relevant:

Under B10 of the ADR Rules the Panel shall draw such inferences as it considers appropriate in circumstances where a Respondent is in default of filing a response. The Panel infers from the Respondent's silence in this case that it accepts the Complainant's position and that the Respondent has no points to raise in reply that would materially affect the Panel's decision.