Panel Decision for dispute CAC-ADREU-004089

Case number	**CAC-ADREU-004089**
Time of filing	**2006-12-29 11:18:48**
Domain names	**bancointesa.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Banca Intesa S.p.A.**

Respondent

Organization / Name	**Dave Davies**

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

The Panel is not aware of any legal proceeding concerning the disputed domain name.

FACTUAL BACKGROUND

The Complainant is Banca Intesa S.p.a., among the greatest Italian banks, holder of several registered trademarks including: Italian trademark registration n. 818814 granted on june 2000 “Banca Intesa” for products/services in classes 9, 16; 36, 38, 41 and 42; Community trademark registration n. 779793 granted on November 15, 1999 “Banca Intesa” for products/services 9, 16; 36, 38, 41 and 42.
On 9 april 2006 Respondent registered the disputed domain name.
On 20 december 2006 Complainant filed a complaint before the Czech Arbitration Court (CAC);
After positive formal requirements compliance review, on 4 january 2007 CAC notified parties of commencement of ADR proceeding, allowing respondent to file a response within the 30 days deadline from the performed complaint delivery;
On 5 january 2007 respondent timely filed a response;
On 31 january 2007 the appointed panelist Mr. Roberto MANNO filed his statement of acceptance and declaration of impartiality and independence;
Projected decision-date was set on 5 march 2007.

A. COMPLAINANT

Complainant contends that the domain name registered by respondent is confusingly similar with names in respect of which he has exclusive rights under community and national laws, and that such domain names have been registered without legitime interest and in bad faith.
Detailed evidences, including national/community trademark (CTM) registrations and changes of CTM applicant’s name, shows the ownership of said exclusive rights.
Complainant’s ownership on “Banca Intesa” trademarks have also been confirmed by more than ten decisions by WIPO panellists under URDP cases.
It is complainant’s submission that registered “bancointesa.eu” domain name, is confusingly similar with “banca intesa” trademark and complainant’s websites (bancaintesa.it; bancaintesa.eu), have been registered without any legitime interest pursuant to par. B.11(d)(1)(ii) of ADR rules: respondent neither have a right on the name applied for nor it is possible to find any fair and non-commercial use of said domain name.
On the contrary, evidence of bad faith registration and use as set fort by par B (11)(f)/4) is provided by alleged pornographic use of disputed domain name, hosting links to porn sites and other pornographic material.
Complainant stresses how it is consistent with cited WIPO URDP case-law – which, in complainant’s view, may give relevant guidelines also for the resolution of .eu adr proceedings- to consider connections with pornographic websites as a clear bad-faith in indication in

domain name registration and use. Further evidence in bad-faith registration is argued from registrant's contact details: respondent name (i.e. Dave Davies) and fax number (i.e. + 1.111111111) are clearly fakes and should be regarded as a temptative to hide registrant's real identity.

B. RESPONDENT

Respondent contends that complainant's rights do not cover "bancointesa" word, but only "banca intesa" words. Further, respondent is surprised of complainant's concerns. In respondent's view, complainant had to apply for disputed domain name during the Sunrise period; or at least had to enter in contact with respondent before commencing the ADR proceeding.
It is respondent's submission that domain name was registered for legitime business pursposes; that he is an UK-citizen having legitime business in Canada; that there is no evidence of pornographic use of the disputed domain name; that fax number was not an attempt to hide his identity but the consequence of the registrar (GoDaddy Inc.) application platform.
Response is attached with an annexed evidence, which is a .jpg file representing an HTML webpage, with the following text: "This is Alessandro Bancointesa personal home page! I am a second year law student at McGill University. Leave me email by clicking here Alessandro Bancointesa. Special thanks to my friend Dave for providing the webspace for me. Under construction, new website is coming soon, I am learning more html/css!!!"

DISCUSSION AND FINDINGS

It results from the attached documentary evidence filed by the complainant, a well known Italian bank and among the largest European banking groups, the use since 1998 of the brand "BANCA INTESA" on the ground of several Italian and community trademark registrations, including:
i) Italian trademark registration n. 818814 granted on june 2000 "Banca Intesa" for products/services in classes 9, 16; 36, 38, 41 and 42;
ii) Community trademark registration n. 779793 granted on November 15, 1999 "Banca Intesa" for products/services 9, 16; 36, 38, 41 and 42.

The complainant alleges that registration and use of the disputed domain name are abusive and speculative under art. 21 of Public Policy Rules and par. B11 of ADR Rules, as:
i) Domain name is confusingly similar with complainant's trademark: the sole difference consisting in the use of the word "banco" in place of "banca" in the disputed domain name bancointesa.eu is irrelevant;
ii) Respondent registered the domain name without any right or legitime interest in the name: online searches and other kind of investigations as trademark watching services in order to detect any identical or similar trademark gave no results of possible respondent's rights/legitime interest in the use of "Intesa" or "bancointesa" names;
iii) Domain name has been registered / used in bad faith: complainant alleges in particular that domain name have been intentionally used in order 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 rights are recognized to complainant. It is complainant's submission that alleged use of disputed domain name for pornographic purposes is clear indication of registration and use in bad faith, as confirmed by a number of cases decided by WIPO Panelists under UDRP Rules;
iv) Respondent's contact information (the name Dave Davies; the fax number +1.111111111111) should constitute another pattern of conduct revealing the intention to hide respondent's identity, and therefore respondent's bad faith in the registration of disputed domain name.

The Panel wishes to stress the following remarks:
a) In abusive and speculative registration proceedings under art. 21 PPR revocation of disputed domain name (hereinafter, DDN) may be the consequence of proved: identicality/confusing similarity of DDN and registrant's lack of right/legitime interest in the name; or identicality/confusing similarity of DDN and bad faith in DDN registrant or user;
b) As far as URDP decisions may be helpful in ascertaining the single subjective elements of bad faith use or registration, or lack of right/legitime interest, the Panel outlines that for a revocation order under .eu PPR complainant have to prove either one of abovementioned requirements.

The Panel is satisfied that DDN is confusing similar to complainant's rights on the wordmark "BANCA INTESA". Moreover, the Panel is aware that registration of domain names presenting little difference with famous trademarks is a conduct commonly known as "typosquatting", oriented to maliciously create a virtually identical and/or confusingly similar name to the Complainant's trademark.
Under Wikipedia definition of typosquatting "Typosquatting, also called URL hijacking, is a form of cybersquatting which relies on mistakes such as typographical errors made by Internet users when inputting a website address into a web browser. Should a user accidentally enter an incorrect website address, they may be led to an alternative address owned by a cybersquatter."
Forms of typosquatting may be, inter alia: insertion of common extension (as "club"; "online") to the disputed name; similar sounding character combination; malicious missing characters.

Considering that the “intesa” word is the distinctive element of the well-known “banca intesa” word-mark, amplified by the massive number of corresponding domain names, it would be theorically possible for malicious typosquatters to gain from trademark’s celebrity through the registration of a nearly-identical domain name.

Bearing this in mind, pursuant art. 21 PPR it is necessary for the Panel to establish if one of the subjective conditions are met, either:
a) Lack of legitimate interest;
b) Bad faith.

The Panel believes that while complainant allegations on the first element (which is difficult to prove, dealing with negative facts) have been positively supported, respondent’s assertion are deprived of any documentation. Nothing in Respondent’s arguments may serve as serious basis for a right or legitimate interest in the use of the name BANCOINTESA. Moreover, using his discretional investigating power under par.B(7)(a) ADR Rules, the Panel have found an announcement on the http://www.acorndomains.co.uk/ (dated January 2007) site claiming that “200+ High Quality EU domains” were for sale, including bancointesa.eu.
The Panel believes that the reason of the “high quality” of DDN was essentially the fact that it was referring to complainant’s immaterial assets.
Such pattern of conduct may serve as a basis to refuse all respondent’s arguments oriented to prove a legitimate interest in DDN registration and, including the filed .jpg-file representing a videocap of www.bancointesa.eu, the fact that such DDN was applied on behalf of said “Alessandro Bancointesa”, a pretended law student at McGill University.
It is this Panel opinion that the circumstances arising from parties allegations and his discretional investigations clearly indicate that respondent failed to demonstrate a legitimate interest as provided under art. 21 (2)(a) PPR.

Unlike in ADR case under UDRP rules, there is no need, at this point, to investigate on the presence of bad faith requirement in order take decisions pursuant to art.22(11)PPR.
Beeing eligibility criteria set out in art. 4(2)(b) of Regulation 733/02 satisfied, the Panel therefore order that the domain name shall be transferred to 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 BANCOINTESA be transferred to the Complainant.

PANELISTS

Name	Roberto Manno

DATE OF PANEL DECISION 2007-03-01

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant asked the transfer of the domain name “bancointesa.eu” on the basis that it is confusingly similar with complainant’s earlier trademark rights and that it was registered and used regardless any right or legitimate interest on that name and in bad faith.
On the basis of the documentation alleged by the parties, and findings of Panel’s discretional investigations, complainant’s submissions were accepted, also because of the lack of adequate supporting evidence in respondent’s allegations.