

Panel Decision for dispute CAC-ADREU-008496

Case number CAC-ADREU-008496

Time of filing 2023-03-27 15:08:02

Domain names INTESAMARKETS.EU

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization Intesa Sanpaolo S.p.A.

Complainant representative

Organization Intesa Sanpaolo S.p.A.

Respondent

Organization Initech

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 other legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

Intesa Sanpaolo S.p.A. ("Intesa Sanpaolo" or "Complainant") is the owner of various registrations for the trademarks INTESA, INTESA SANPAOLO on a worldwide basis.

One of them, the EU trademark Reg. No. 12247979 "INTESA", filed on October 23, 2013 and granted on March 5, 2014, in connection with classes 9, 16, 35, 36 38, 41 and 42. Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the signs "INTESA" and "INTESA SANPAOLO": 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 them are now connected to the official website <http://www.intesasanpaolo.com>.

Intesa Sanpaolo is the leading Italian banking group and is very well known among the top banking groups in the euro zone, with a market capitalisation exceeding 48,6 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Intesa Sanpaolo offers its services to approximately 13,6 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 950 branches and over 7,1 million customers. Moreover, the international network specialised in supporting corporate customers is present in 25 countries.

The disputed domain name <intesamarkets.eu> was registered on 13 February, 2023, by organization (Initech, Bonnie Aldrich), which refers its address to be in Lithuania.

On March 23, 2023, the Complainant submitted a complaint. Following submission, the standard procedures according to ADR rules took place: EURid transmitted the relevant information on the registrant, revealing in particular the identity and address of the owner of the disputed domain name. As a consequence, the Provider (ADR Centre) requested the Complainant to amend its complaint. This was done accordingly on March 30,

2023.

The Provider properly notified and informed the Respondent that if the Response will not be presented within the prescribed period of time, the Respondent would be considered in default. On May 9, 2023, the Provider issued the "Notification of Respondent's default" informing the Respondent that he failed to comply with the ADR Centre's request.

The Complainant requests the transfer of the disputed domain name to the Complainant.

A. COMPLAINANT

On the grounds of the facts mentioned above, the Complainant asserted that:

1. It is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant's trademark "INTESA". As a matter of fact, <INTESAMARKETS.EU> exactly reproduces the well-known trademark "INTESA", with the mere addition of term "MARKETS" (with obvious references to the local and international markets in which the Complainant operates).
2. The Respondent has no rights on the disputed domain name, and any use of the trademarks "INTESA SANPAOLO" and "INTESA" has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue. The domain name at stake does not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as "INTESAMARKETS". The disputed domain name's home page does not present any fair or non-commercial use of the domain name at stake.
3. The disputed domain name <INTESAMARKETS.EU> was registered and is used in bad faith. The Complainant's trademark "INTESA" is distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to this mark indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wordings "INTESA SANPAOLO" and "INTESA", the same would have yielded obvious references to the Complainant. Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant's trademark. This is a clear evidence of registration of the domain name in bad faith.
4. In addition, the disputed domain name is not used for any bona fide offerings. More particularly, there are present circumstances indicating that, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site. Moreover, the disputed domain name is connected to a website sponsoring banking and financial services, for whom the Complainant's trademarks are registered and used. In particular, this website promotes trading service using the brand "Intesamarkets" reproducing the same graphic of the above-mentioned trademarks "BANCA INTESA (logo)" registered by the Complainant prior to the registration of the disputed domain. Consequently, Internet users, while searching for information on the Complainant's services, are confusingly led to the websites of the Complainant's competitors, sponsored on the websites connected to the domain name at issue. Therefore, the Complainant deems that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant's web site.

B. RESPONDENT

The Respondent did not provide any response to the complaint, and is therefore in default (Paragraph B10 of the ADR Rules).

DISCUSSION AND FINDINGS

This dispute is governed by the Regulation (EU) 2019/517 of the European Parliament and of the Council of 19 March 2019 on the implementation and functioning of the .eu top-level domain name and amending and repealing Regulation (EC) No 733/2002 and repealing Commission Regulation (EC) No 874/2004 (hereinafter - the "Regulation 2019/517") and the .eu Alternative Dispute Resolution Rules (hereinafter - the "ADR Rules"). The Regulation (EU) 2019/517 and the ADR Rules are in force since October 13, 2022.

In accordance with Article 4(4) of Regulation 2019/517, a domain name may be revoked, and where necessary subsequently transferred to another party, following an appropriate ADR or judicial procedure, in accordance with the principles and procedures on the functioning of the .eu TLD laid down pursuant to Article 11, where that name is identical or confusingly similar to a name in respect of which a right is established by Union or national law, and where it: (a) has been registered by its holder without rights or legitimate interest in the name; or (b) has been registered or is being used in bad faith (also reflected more precisely in Paragraph B11(d)(1) of the ADR Rules).

In accordance with Paragraph B11(d)(1) of the ADR Rules, the Panel shall issue a decision granting the remedies requested (i.e. transfer of the disputed domain name to the Complainant) in the event that the Complainant proves: (i) the domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law and; either (ii) the domain name has been registered by the Respondent without rights or legitimate interest in the name; or (iii) the domain name has been registered or is being used in bad faith.

(i) Identical or confusingly similar

The Complainant evidenced that he has valid trademark rights in the INTESA sign. The Panel also agrees that the disputed domain name is confusingly similar to Complainant's INTESA trademark. The disputed domain name <intesamarkets.eu> incorporates Complainant's trademark INTESA in its entirety. The addition of word "MARKETS" does not set aside the confusing similarity between the disputed domain name and the Complainant's trademark. On the contrary, the reference to "MARKETS" refers to the known activity of the Complainant. As a result, the Panel finds that the disputed domain name is confusingly similar to the EU trademark "INTESA" in respect of which a right is established by the European Union law (the first requirement of the Paragraph B11(d)(1) of the ADR Rules has been proven by the Complainant).

(ii) No rights nor legitimate interests

Pursuant to article 4(4)(a) Regulation 2019/517, the Complainant have to prove that the Respondent registered the disputed domain name without rights or legitimate interest in the name. The burden of proof thereto shifts to the Respondent. This standard has been recognized by continuous case law (see CAC-ADREU-008361, and the cases cited there), where it was established that a Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name.

In the absence of a response, and in accordance with Paragraph B10 of the ADR Rules, the Panel agrees with the Complainant that the Respondent has not licensed, authorized, or permitted Respondent to use Complainant's trademark in any manner, including in domain names. The Respondent's name "Intecha" does not resemble the disputed domain name in any manner. Respondent's use of the disputed domain name does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use. In conclusion, the Panel finds that the Respondent registered the disputed domain name without rights or legitimate interest in the name (the second requirement of the Paragraph B11(d)(1) of the ADR Rules has been proven by the Complainant).

(c) Registration or Use in Bad Faith

Meeting of the previous conditions is deemed sufficient to decide about the transfer of the disputed domain name. The Panel nevertheless made assession of the third condition as well.

Article 4(4)(b) Regulation 2019/517 refers to the registration or use of the disputed domain name in bad faith. Therefore, the Complainant must demonstrate that the disputed domain name is registered or is being used in bad faith. The Panel agrees with the Complainant that the disputed domain name was both registered and used in bad faith. First, the Complainant's trademark INTESA is distinctive and well known all around the world. If the Respondent had carried even a basic Google search in respect of the word "INTESA", he would immediately find obvious references to the Complainant. Therefore, it is more than likely that the disputed domain name would not have been registered if it would not have been well known trademark of the Complainant. As a result, the registration of the disputed domain name was in bad faith. Second, the disputed domain name is connected to a website sponsoring banking and financial services, for whom the Complainant's trademarks are registered and used. In particular, this website promotes trading service using the brand "Intesamarkets" reproducing INTESA trademark. Consequently, Internet users, while searching for information on the Complainant's services, are confusingly led to the websites of the Complainant's competitors, sponsored on the websites connected to the domain name at issue. Therefore, the disputed domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website, by creating a likelihood of confusion with a name in respect of which a right is established the European Union law (the third requirement of the Paragraph B11(d)(1) of the ADR Rules has been proven by revealing bad faith conduct referred to in Paragraph B11(f)(4) of the ADR Rules).

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) of the Rules, the Panel orders that the disputed domain name <INTESAMARKETS.EU> be transferred to the Complainant.

PANELISTS

Name **Darius Sauliunas**

DATE OF PANEL DECISION 2023-06-06

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <intesamarkets.eu>

II. Country of the Complainant: ITALY, country of the Respondent: LITHUANIA.

III. Date of registration of the domain name: 13 February, 2023.

IV. Rights relied on by the Complainant (Paragraph B11(d)(1)(i) of the ADR Rules) on which the Panel based its decision:

1. word trademark INTESA, registered in the EU, Reg. No. 12247979, filed on October 23, 2013 and granted on March 5, 2014, in connection with classes 9, 16, 35, 36 38, 41 and 42;

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 (B(11)(e) ADR Rules):

1. No

2. Why: Default of Respondent; no evidence proving rights or legitimate interest on the part of the Respondent in the disputed domain name; no evidence that the Respondent has any connection with the Complainant.

VIII. Bad faith of the Respondent (B(11)(f) ADR Rules):

1. Yes.

2. Why: The disputed domain name is connected to a website sponsoring banking and financial services, for whom the Complainant's trademarks are registered and used.

IX. Other substantial facts the Panel considers relevant: well known trademark entirely used to register the disputed domain name (bad faith registration).

X. Dispute Result: Transfer of the disputed domain name.

XI. Procedural factors the Panel considers relevant: None.

XII. [If transfer to Complainant] Is Complainant eligible? Yes, the Complainant is located in Italy.
