

**CANADIAN INTERNET REGISTRATION AUTHORITY  
DOMAIN NAME DISPUTE RESOLUTION POLICY**

**DECISION**

Domain Name: intesa.ca

Complainant: Intesa Sanpaolo S.p.A.

Registrant: Interex Corporate Registration Services Inc.

Registrar: Dot-ca-registry.ca (Burmac Business Systems Ltd.)

Service Provider: Resolution Canada Inc.

Panelists: David Allsebrook (Chair), Myra Tawfik, Daria A. Strachan

**A. THE PARTIES**

1. The Complainant is Intesa Sanpaolo S.p.A. (the “Complainant”).
2. The Registrant is Interex Corporate Registration Services Inc. (the “Registrant”).

**B. DISPUTED DOMAIN NAME & REGISTRAR**

3. The disputed domain name is intesa.ca (the “Domain Name”) and the Registrar is Canadian Domain Name Services Inc. Burmac Business Systems Ltd..

**C. PROCEDURAL HISTORY**

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Date of Commencement of the proceeding was March 6, 2013.
6. The Registrant’s amended Response was issued April 15, 2013. The initial Response was deemed non-compliant. The Amended Response cured the deficiencies and was accepted by Resolution Canada Inc.
7. On April 19, 2013, the Panel was appointed. As prescribed by the Policy, the Panel has declared to the Provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel which would prevent it from so acting.

**D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT**

8. The Complainant is an Italian Bank.
9. It relies upon Canadian trade mark registrations:

Mark	Registration number	Registration Date
BANQUE INTESA CANADA	TMA 640,844	May 31, 2005
INTESA BANK CANADA	TMA 640,760	May 30 2005
INTESA	TMA 641,178	June 2, 2005
Banca Intesa	TMA 660,454	March 8, 2006
Bacna Intesa	TMA673,093	September 20, 2006

10. The registered owner of these registrations is Banca Intesa S.p.A. The applicant advises that Intesa Sanpaolo S.p.A. 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. Accordingly the Panel finds that as the successor to Banca Intesa S.p.A. the Complainant owns these trade marks. As the owner of the Canadian trade mark registration INTESA the Complainant meets the Canadian presence requirements.
11. The Panel is therefore satisfied that the Complainant is eligible to initiate these proceedings.

**E. THE POSITIONS OF THE PARTIES**

The Complainant's Position

12. The Complainant advises that it is one of the top banking groups in the Euro zone, with a market capitalization exceeding 29.8 billion Euros. It has 5700 branches in Italy alone.
13. The Complainant owns the intesa domain name in approximately 24 other domains including .com.
14. The Complaint states that the Registrant has no rights or legitimate interest in the trade mark INTESA because:
  - a. the Registrant has no trade mark rights in the name INTESA, given that the Complainant has a worldwide trade mark watching service which has not detected any use of it by the Registrant,
  - b. that INTESA is neither descriptive nor generic (according to the trade mark registrations the translation of the word INTESA is "agreement"),
  - c. The registrant is not using intesa.ca for a non-commercial activity,
  - d. INTESA is not the legal name of the registrant, and
  - e. INTESA is not the geographic name of the location of the Registrant's activity Registrant or its place of business.

15. The Complaint states that the Registrant has registered the domain name in bad faith for commercial gain dependent upon confusion, contrary to paragraph 3.5(d) of the policy. The Complainant states that current and potential clients are being directed to its competitors by advertising on the Registrant's web site at intesa.ca.
16. The printout of the intesa.ca web site at appendix G to the Complaint shows a list of what appear to be 10 names of financial organizations, the first of which is HSBC and the remainder of which are in Italian. There is no other content except the name INTESA.Ca in large print and what appears to be a search tool.
17. The Complainant is seeking the transfer of the Domain Name to it.

#### The Registrant's Position

18. Nameshield on behalf of the Registrant Interex has not addressed the three elements of the complaint, namely the identity of the trade mark and domain name, the good faith with which it was registered and the existence of any bona fide interest Interex may have in intesa.ca.
19. Nameshield states that the Complainant has sold its Canadian operations and is no longer using its trade mark in Canada, and that although registered, the trade mark is now dormant.
20. Nameshield states that if the Complainant were present in Canada the complainant would be trading in the name Intesa Sanpaolo rather than Intesa.
21. Nameshield states that the web page to which the domain name resolves is a "parking page", and that the links on the parking page are generated by input from typing in banking-related terms on the web page, this will cause banking-related terms to appear on the page in an identical manner to search results from the main Google page.
22. Nameshield says that even though no banking links existed it has requested the technical staff to ensure that parking does not allow banking terms to be searched.
23. Nameshield advises that it has submitted a request to the Registrar of Trade-Marks seeking to cause the Registrar to expunge Intesa's Canadian registration of the trade mark INTESA for non-use under section 45 of the Trade Marks Act. In such proceedings the Registrar of Trade-Marks issues a notice requiring the registrant to show that the registered trade mark is still in use or circumstances excusing non-use, failing which the registration or parts of it may be expunged. The Registrar of trade Marks has no role in the registration of domain names.
24. Nameshield, on behalf of Interex, states that this section 45 request is a legal proceeding contemplated by section 13.1 of the CIRA Domain Name Dispute Resolution Rules, and that the Provider, or, failing the Provider, the Panel, should stay or terminate the proceeding prior to reaching a decision. Interex advised the Provider of its section 45 request and asked that the Provider suspend the

complaint by reason that the section 45 proceeding could eliminate the trade mark registration which it described as being the entire basis of Intesa's Complaint.

25. The Provider advised that the proceeding would continue without further explanation. Nameshield submits that the Provider is not following the Rules. Nameshield describes its own submission as "its so-called Response, which was meant to be a placeholder for a finding of a non-compliant Response so as to be given additional time for a clearly definitive response from the Provider as to the section 45 Proceedings and the logical necessity for a stay of the Complaint until such time that the underlying trade mark registration is examined."
26. Paragraph 13 of the Rules provides as follows:

### **PARAGRAPH 13 -COURT PROCEEDINGS**

**13.1 Notice of Other Proceeding.** In the event that a Party initiates or becomes a party to any legal proceeding or other arbitration during the pendency of a Proceeding in respect of a domain name Registration dispute that is the subject of the Proceeding, it shall promptly give notice to the Panel and the Provider.

**13.2 Stay or Termination.** In the event that any legal proceeding or other arbitration is initiated prior to or during a Proceeding in respect of a domain name Registration dispute that is the subject of the Proceeding, the Panel or, if no Panel has been appointed, the Provider, shall have the discretion to decide whether to stay or terminate the Proceeding or to proceed to a decision.

27. As may be seen section 13.1 operates in respect of a legal proceeding in respect of a domain name registration. Section 45 proceedings do not involve a domain name registration. They cannot resolve the issue of who owns the domain name. They will result in a determination by the Registrar of Trade Marks as to whether to expunge all or part of the Complainant's registration of the trade mark INTESA. The Registrar has no authority to determine who is entitled to own the domain name intesa.ca as part of a section 45 request. Even if the section 45 request results in the expungement of the INTESA trade mark registration, a further proceeding will be required to determine the ownership of the domain name. The fact that a favourable outcome of the section 45 proceeding may be advantageous to Interex does not make it a proceeding in respect of a domain name.
28. Section 13.2 confers discretion on the Provider or the Panel to stay or terminate the Proceeding or proceed to a decision in the event the stated conditions are met. The Provider has exercised this discretion and determined to proceed. Even if the section 45 proceedings were in respect of a domain name, it is not open to the panel to reconsider the Provider's decision. In any event the decision is not unjust. INTESA was registered in 2005. At the time intesa.ca was registered by Nameshield in May 2010, INTESA was a registered trade mark. Nameshield could have launched a section 45 proceeding at any time.

29. Expunging an existing registration for non-use does not necessarily determine who has rights in the trade mark in Canada. Canadian passing off law protects trade marks which have a reputation here generated by use abroad.
30. Nameshield does not state that Interex filed its own application to register INTESA as a trade mark. The issuance of a registration would give Interex statutory rights in the trade mark.
31. Having thus ceded to Intesa the initiative in choosing a means for raising the issue of entitlement to the intesa.ca domain name, it would be unfair to Intesa to deny it the advantages of the procedure it has chosen. CDRP proceedings are fast and are inexpensive. The panelists are typically expert trade mark lawyers and academics.
32. Nameshield could have brought a proceeding before a Superior Court to determine the issue of entitlement to the intesa.ca domain name, but it has not done so.
33. The Complaint provides Intesa Sanpaolo S.p.A.'s name, address, telephone and fax numbers. As its email addresses it gives the same two email addresses as it gives for the two named individuals who serve as its authorized representatives. Nameshield has objections to the Complainant's compliance with Rule 3.2(a), which requires the Complainant to "provide the name, postal and e-mail addresses, and the telephone and facsimile numbers of the Complainant and of any representative authorized to act for the Complainant in the Proceeding". Nameshield sees a failure to provide a different email address for the Complainant as a failure to comply with the Complainant's obligations under Rule 3.2(a). The Panel sees no reason a Complainant cannot choose to use the same email address as its representatives.
34. Nameshield objects that the Complaint does not provide the name of an individual contact person at the Complainant. The Panel notes that Rule 3.2(a) does not require it to do so.
35. Nameshield objects that the authority of Intesa's authorized representatives to bring this complaint is inadequate but mentions no rule in connection with this complaint except 3.2(a). Nameshield acknowledges that providing the information required by Rule 3.2(a) provides some proof of authority. Nameshield has not suggested a reason to doubt that the Complaint was authorized by Intesa. The Panel is satisfied that the authority of the authorized representatives is sufficiently demonstrated for the purposes of this Complaint.

**F. DISCUSSION & REASONS**

36. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove, on a balance of probabilities, that:

- (a) the Registrant's Domain Name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights; and
- (b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5 of the Policy;  
  
and the Complainant must provide some evidence that:
- (c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.4 of the Policy.

**CONFUSINGLY SIMILAR - PARAGRAPH 3.3**

- 37. In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the Domain Name is confusingly similar with the disputed domain name.
- 38. The Complainant's INTESA Trade-mark registration establishes the trade-mark rights in this case.
- 39. Where the Complainant relies upon a trade-mark registered prior to the domain name registration date, the Policy does not require or permit a Panel to go behind the registration to determine whether the mark is valid or invalid based upon non-use.
- 40. The Complainant's trade-mark registration for INTESA issued to registration in 2005, which precedes the 2010 domain name registration date. Therefore, the Panel concludes that the Complainant has established rights that precede the registration of the Domain Name.
- 41. As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.
- 42. Pursuant to paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).
- 43. The Domain Name intesa.ca is identical to the INTESA trade mark. The Panel concludes that the Domain Name is confusingly similar with the Complainant's INTESA trade mark, given that the Domain Name so nearly resembles the INTESA trade mark in appearance, sound and in the ideas suggested so as to be likely to be mistaken for the mark.
- 44. The Panel finds that the Domain Name is confusingly similar with the INTESA trade mark in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

### **BAD FAITH REGISTRATION**

45. The Complainant has alleged that the Domain Name was registered in bad faith pursuant to paragraph 3.5(d) of the Policy, namely that the Registrant registered the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement.
46. The Registrant's description of the web page explains the presence of the names of financial institutions as a result of searches typed in by users. The users seem to have typed in only financial search terms since the page refers only to financial institutions. This compels the conclusion that visitors to the page were interested in the Complainant and drawn there by the use of its name.
47. Web pages which list commercial links selected based on the collective guidance of search terms entered by users do so as part of an advertising scheme. Presumably the Registrant gets paid for each click by users on the links on the page. This is a common scheme on the Internet, and the Registrant has offered no alternative explanation of the reason its page generates these links.
48. The intesa.ca web page does not contain a link to the Complainant.
49. The Panel finds that the Complainant has established bad faith as per paragraph 3.5(d), in that the Registrant registered the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark.

### **LEGITIMATE INTEREST**

50. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name.
51. As per paragraph 4.1 of the Policy, the Complainant must provide "some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6".
52. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.
44. The Panel finds that the Complainant has provided sufficient evidence that the Registrant does not have a legitimate interest in the Domain Name to discharge its onus. The domain name is identical to its own, and is being used in connection to banking related services.
45. The Registrant's only interest in the domain name appears to be collecting revenues from diverting Internet users looking for the Complainant.

46. The Registrant has not alleged that it has a legitimate interest in the domain name.
47. Accordingly, a majority of the Panel finds that the Registrant does not have a legitimate interest in the Domain Name.

**DECISION & ORDER**

48. For the reasons set out herein, the Panel decides this dispute in favour of the Complainant.
49. Pursuant to paragraph 4.3 of the Policy, the Panel orders the transfer of the domain name intesa.ca to the Complainant.

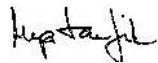
Dated at Toronto, Ontario, Canada, this 7<sup>th</sup> day of May, 2013.

David G. Allsebrook (Chair)



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Myra Tawfik



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Daria A. Strachan

