



महाराष्ट्र MAHARASHTRA

FA 108488

अनुक्रमांक. ६८३७ दिनांक १६/१२/१९९५ रुपये १००/-
मुद्रांक कोणत्या कारणासाठी वापरावधा आहे. आलेखीद्वारे कनाउरी
मुंबई मुद्रांक अधिनियम १९५८ चे अनुच्छेद क्र. ३०
मुद्रांक वापरणाराचे संपूर्ण नाव रिडीय जितेंद्रजी स्वायदा
संपूर्ण पत्ता २७४, शांतिवाडी, पुणे-४११००१
हस्ते व्यक्तीचे संपूर्ण नाव जयदेव का. सु.
पत्ता ६७३, विवेकवाणी, पुणे-४११००१

नरेशभा. सुरे
मुद्रांक धारकाची/हस्ते व्यक्तीची सही
(सौ. जयदेवी नि. जेलसरे)
मुद्रांक विक्रेता
परवाना क्र. पुणे १/३६/१९९५
परवान्याची मुदत ३१/३/२०११
पत्ता- ४२५ ब, शनिवार पेठ, पुणे-४११००१



ARBITRATION AWARD
IN THE MATTER OF DISPUTED DOMAIN NAME
bancaintesa.co.in

INTESA SANPAOLO S.p.A.
Piazza San Carlo 156
10121 Torino (Turin)
ITALY

THE COMPLAINANT

AND

AMAR BOSE
Cambridge Center
Cambridge, Massachusetts 02142
U.S.A.

**THE RESPONDENT /
THE REGISTRANT**

DELIVERED ON THIS SIXTEENTH DAY OF DECEMBER TWO THOUSAND ELEVEN AT PUNE, INDIA.

I] SUMMARISED INFORMATION ABOUT THE DISPUTE: -

**01. Names and addresses
Of the Complainant: -**

Intesa Sanpaolo S.p.A.
Piazza San Carlo 156
10121 Torino (Turin)
Italy.

Through its authorized
representative

Ranjan Narula Associates.
Vatika Towers, 10th Floor, Block-B
Sector-54, Gurgaon. 122002
National Capital Region (Haryana)
India.

**02. Name and address of
The Registrant: -**

Amar Bose
Cambridge Center
Cambridge
Massachusetts 02142
U.S.A.

03. Calendar of Major events:

Sr. No.	Particulars	Date (Communications in electronic mode)
01	Arbitration case referred to me and acceptance given by me	23/11/2011
02	Hard copy of the complaint received & Notice of Arbitration issued	01/12/2011
03	Reminder sent to the Registrant to file his say	13/12/2011
04	Award passed	16/12/2011



II] PRELIMINARY: -

- 1) Intesa Sanpaolo S.p.A., having office at Piazza San Carlo 156, 10121 Torino (Turin), Italy (**The Complainant**) have filed complaint with National Internet Exchange of India (**NIXI**) disputing the registration of domain name '**bancaintesa.co.in**' (**the disputed domain name / domain name**), through its authorised representative M/s Ranjan Narula Associates, of Vatika Towers, 10th Floor, Block-B, Sector -54, Gurgaon 122002, National Capital Region (Haryana), India.
- 2) The Complainant has disputed registration of domain name '**bancaintesa.co.in**' in the name of **Mr.Amar Bose, Cambridge Center, Cambridge, Massachusetts, 02142, U.S.A. (The Registrant)**
- 3) Major events took place as enumerated in the above table.

III] PROCEDURE FOLLOWED IN ARBITRAION PROCEEDINGS: -

01. In accordance with INDRP read with INDRP Rules of Procedure, notice of arbitration was sent to the Registrant on 1st December 2011 with the instructions to file his say latest by 11th December, 2011.
02. The Registrant did not file reply to the Complaint till 11th December, 2011.
03. On the basis of principles of natural justice one more opportunity was provided to the Registrant to submit his say, if any, latest by 15th December 2011. However the Registrant did not file any say even within the extended period.
04. In view of non-filing of any say by the Registrant no rejoinders were called for.
05. Copies of notices were marked to the Complainant's authorised representative, Registrant and NIXI every time.
06. No personal hearing was requested / granted / held.

IV] SUMMARY OF THE COMPLAINT: -

The Complainant has raised, *inter-alia*, following important objections to registration of disputed domain name in the name of the Registrant and contended as follows in his Complaint: -

- a) The Complainant is the leading Italian Banking group and also one of the protagonists in the European financial arena. The Complainant is a company resulting from the merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. which are two top Italian banking groups. Consolidated market capitalization of the Complainant is more than 70B Euros.
- b) The Intesa Sanpaolo Group, with a network of approximately 5700 branches in Italy, offers its services to approximately 11 M customers. Its Central and Eastern Europe network consists of about 1700 branches and over 8 M customers. Its international network has a reach in 29 countries including in USA, Russia, China and India.
- c) The Complainant is a owner of number of domain names which contains the word 'bancaintesa'. They include .com, .net, .org, .info, .biz, .us, .it and .co.uk.
- d) The Complainant has attached vide Exhibit –C a list of several registrations for the Banca Intesa trademarks and its variants owned by it. Apart from registered trademarks in various other countries, the Complainant has Italian registration No.818814 dated 18.12.1997 and 816033 dated 04.09.1998, CTM registration NO.779793 dated 24.03.1998 and 2803773 dated 07.08.2002. The said registrations have been duly renewed and are in force on the date of filing the Complaint.
- e) In India the Complainant has registered 3 trademarks with the words Banca and / or Intesa vide Nos. 1291495 dated 21.06.2004, 1291496 dated 21.06.2004 and 1194213 dated 23.04.2003.
- f) The Complainant has also attached copies of articles and news items about itself and its predecessors published in India and international media.
- g) The ownership issue concerning the trademark BANCA INTESA has been considered by a number of International Arbitration panels, including the WIPO Arbitration and Mediation Panels, and decided in favor of the Complainant. The Complainant has attached a list of disputed domain names containing the words BANCA INTESA. Even in India on 1st October 2011 NIXI pronounced a decision in favour of the Complainant for another disputed domain name www.bancaintesa.in which further strengthens the reputation of the trademark in India.

- h) Due to overwhelming success of the Complainant's marks have become synonymous with premium financial products and services and has resulted in Complainant gaining extensive goodwill and reputation worldwide and also in India. Due to this the Complainant owns Intellectual property in the trademark and domain name 'Banca Intesa'.
- i) The Complaint is based on the INDRP Rules and Policies on the following main contentions of the Complainant: -
01. That the disputed domain name is identical to its trademark 'BANCA INTESA'. The Complainant has not licensed the Registrant to use or commercially exploit the same.
02. It has very strong likelihood of confusion between the disputed domain name and the Complainant, its trademarks and its other domain names associated.
03. BANCAINTESA is a well-known brand in banking and finance sector world over. The Registrant can have no plausible reason for adoption of a domain name phonetically, visually and conceptually identical to the Complainant's well known and highly distinctive trademark and domain name.
04. The disputed domain name resolves to a pay per click website which features sponsored links pertaining to different goods and services. Thus it is very clear that the Registrant has acquired the domain purely to make illegal profit there from. The Registrant has made no use of the domain name in connection with a bona-fide offering of goods or services and is holding on to the domain name in bad faith to derive monetary gains.
05. The Complainant being in the finance and investment business, confusion being created in the minds of internet users poses greater risks for the existing and potential customers of the Complainant. Similarly it will result in incalculable harm and injury to the goodwill, reputation and business in general of the Complainant, if the Registrant is allowed to maintain its domain name.
06. The Registrant has no rights or legitimate interests in the disputed domain name because it was registered on 17.05.2011 at which time the Complainant had already made use of the mark BANCA INTESA internationally and also in India.
07. The Registrant has acquired the subject domain in bad faith and purely to make illegal profit there from. There is no reason for the Registrant who seems to be a person of Indian origin to register a domain name with .in ccTLD which has been inspired from Italian language.

08. The Registrant does not use the domain name for his legitimate business purpose, for offering bona fide goods, services etc.

09. On the basis of the Complaint and supporting documents, the Complainant has requested for transfer of disputed domain name in his favour with costs.

VI] REPLY TO THE COMPLAINT / STATEMENT OF DEFENSE: -

In response to the contentions of the Complainant, the Registrant has NOT filed any say / reply even within the extended period granted for that purpose.

VI] REJOINDERS OF THE PARTIES: -

In view of non-submission of any reply by the Registrant it was not felt necessary to call for rejoinders from the parties to the dispute.

VII] ISSUES & FINDINGS: -

On the basis of policies and rules framed by NIXI in respect of dispute resolution as also on the basis of submissions of both the parties I have framed following issues. My finding on each issue is also mentioned against it respectively.

SR. NO.	ISSUE	FINDING
01	Whether the Registrant's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights?	Yes
02	Does the Complainant have trade mark or service mark directly related to the disputed domain name?	Yes
03	Whether the Registrant is owner of trade mark or service mark corresponding to the disputed domain name?	No
04	Whether the Registrant has commonly been known by the domain name?	No
05	Whether the Registrant has any legitimate interests in the disputed domain name?	No
06	Whether the Registrant's domain name has been registered or is being used in bad faith?	Yes
07	Has the Registrant registered the domain name in order to prevent	Yes

	the owner of the trademark or service mark from reflecting the mark in a corresponding domain name?	
08	Whether the Registrant has intentionally attempted to attract internet users to the Registrant's website or other online location by creating likelihood of confusion with the Complainant's name or mark?	Yes

VIII] BASIS OF FINDINGS: -

1. Whether the Registrant's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights?

The word 'bancaintesa' is an integral / prominent component of subject domain name and also is an integral / prominent component of various International and especially Indian registered Trademark of the Complainant registered vide No.1291495 dated 21st June 2004, No.1291496 dated 21st June 2004 and also No.1194213 dated 23rd April 2003 among other registered trademarks, world over.

Against this the Registrant has no registered trade mark or service mark consisting of the word 'bancaintesa'.

Therefore my finding on the first issue is affirmative.

2. Does the Complainant have trade mark or service mark directly related to the disputed domain name?

Yes. Already discussed in issue (A) above.
Therefore my finding on this issue is in affirmative.

3. Whether the Registrant is owner of trade mark or service mark corresponding to the disputed domain name?

The Registrant has not claimed nor mentioned of being owner or applicant of any trade mark or service mark corresponding to the disputed domain name.

Therefore my finding on this issue is in negative.

4. Whether the Registrant has been commonly known by the domain name?

The name of the Registrant, as available in the records is Amar Bose. As such he is not commonly been known by the domain name 'bancaintesa'.

Therefore my finding on this issue is in negative.

5. Whether the Registrant has any legitimate interests in the disputed domain name?

The Registrant has no registered trademark or service mark which includes the words 'bancaintesa'. He is not commonly known by that name. He has put up links to third party websites which are not at all connected with or similarity with any of the business of the Complainant. Obviously his intention is to make money by using pay per click method. He has not shown any other nexus of his business with the domain name.

Therefore my finding on this issue is negative.

6. Whether the Registrant's domain name has been registered or is being used in bad faith?

The Registrant appears to be of Indian origin, presently residing in USA. Therefore he has no reason to register domain name having Italian words. When visited the website, it shows only links to various third party websites which are absolutely not connected with the Complainant. This appears to be an attempt of the Registrant to attract internet users by using goodwill of the Complainant to earn money.

Therefore my finding on this issue is affirmative.

7. Has the Registrant registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name?

The Registrant has failed to establish his bona fides and nexus with the disputed domain name. The Complainant has cited various cases in confirmation of the fact that the its claims to disputed domain names with different ccTLDs have been upheld by international as well as Indian arbitral panels.

Therefore my finding on this issue is in affirmative.

8. Whether the Registrant has intentionally attempted to attract internet users to the Registrant's website or other online location by creating likelihood of confusion with the Complainant's name or mark?

The Registrant has put up links to various third party websites on his domain. The domain consists of the trade name of the Complainant which will definitely create confusion in the minds of internet users due to exact reproduction of the registered trademark in its entirety in the domain name.

Therefore my finding on this issue is affirmative.

IX] CONCLUSION AND BASIS OF AWARD: -

From above discussion I have reached the conclusion that: -

- a. The Registrant does not have any registered trade mark / service mark in his name containing the words 'bancaintesa'. Similarly he has been using the domain name for making monetary gains illegally by putting up links to third party websites and hence he does not have any legitimate interest in the same.
- b. The Registrant has not been commonly known by the disputed domain name.
- c. The Registrant is not making any non-commercial or fair use of the disputed domain name.
- d. The Registrant / Registrant has completely failed to establish his nexus with the disputed domain name in any way.

From all findings on the issues framed, it can be concluded that the Registrant has registered domain name with the purpose of selling the same to the Complainant or to his competitors for monetary benefits.

X] AWARD: -

On the basis of my findings on issues and foregoing discussion I pass the following award: -

01. The Complainant is entitled to the disputed domain name – www.bancaintesa.co.in and hence the same be transferred to the Complainant immediately.
02. The Registrant shall pay to the Complainant all documented costs of these arbitral proceedings as well as cost for transferring domain name in favor of the Complainant.

Dated: - 16.12.2011
Place: - Pune


(S.C.INAMDAR)
SOLE ARBITRATOR