Decision for dispute CAC-UDRP-102096

Case number	CAC-UDRP-102096
Time of filing	2018-07-24 12:43:47
Domain names	INTES-SANPAOLO-NEW.COM

Case administrator

Name	Sandra Lanczová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	rumeno rumeno

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following registrations for the trademark “INTESA SANPAOLO”:

International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;
EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 08, 2006 and granted on June 18, 2007, in classes 35, 36 and 38;
EU trademark registration n. 5421177 “INTESA SANPAOLO & device”, applied on October 27, 2006 and granted on November 5, 2007, in classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

The Complainant is a leading Italian banking group. Intesa Sanpaolo 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., two of the top Italian banking groups.

Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 41,9 billion euro.

Through 4,600 branches the Group offers its services to approximately 12 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,7 million customers. Moreover, the international network specialised in supporting corporate customers is present in 25 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.

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EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 08, 2006 and granted on June 18, 2007, in classes 35, 36 and 38;
EU trademark registration n. 5421177 “INTESA SANPAOLO & device”, applied on October 27, 2006 and granted on November 5, 2007, in 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 sign “INTESA SANPAOLO”: “INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ” and INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET and .BIZ”. All of them are now connected to the official website <http://www.intesasanpaolo.com>.

On May 11, 2018, the Respondent registered the domain name INTES-SANPAOLO-NEW.COM.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant’s contentions can be summarised as follows:

IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name is identical to the Complainant’s trademark “INTESA SANPAOLO”, as it exactly reproduces it, with the mere deletion of letter “a” in the word “INTESA” and the addition of the generic term “new” which is devoid of any distinctive character.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME

The Respondent has no rights or legitimate interests in the disputed domain name, since THE ENDURANCE INTERNATIONAL GROUP, INC. has nothing to do with Intesa Sanpaolo. In fact, any use of the trademark “INTESA SANPAOLO” 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 disputed domain name does not correspond to the name of the Respondent and, to the best of our knowledge, THE ENDURANCE INTERNATIONAL GROUP, INC. is not commonly known as “INTES-SANPAOLO-NEW”.

There are no fair or non-commercial uses of the domain name at stake.

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The domain name INTES-SANPAOLO-NEW.COM was registered and is used in bad faith.

The Complainant's trademark "INTESA SANPAOLO" is distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to it 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", the same would have yielded obvious references to the Complainant. This raises a clear inference of knowledge of the Complainant's trademark on the part of the Respondent. Therefore, it is more than likely that the disputed domain name 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.

In addition, the disputed domain name is not used for any bona fide offerings. More particularly, there are present circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy).

The disputed domain name is not used for any bona fide offerings, even if it is not connected to any web site, countless UDRP decisions confirmed that the passive holding of a domain name with knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, and also the panels' consensus view on this point, as reflected in the "WIPO Overview of WIPO Views on Selected UDRP Questions" at paragraph 3.2.).

In particular, the consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, panels have tended to make such findings in circumstances in which, for example, a complainant's mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the complainant's trade mark rights.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain name has to be considered a use in bad faith: «The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests» (Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., concerning just the case of a bank).

The risk of a wrongful use of the disputed domain name is even higher in the present case, since the Complainant has already been targeted by some cases of phishing in the past few years. Such a practice consists of attracting the customers of a bank to a web page which imitates the real page of the bank, with a view to having customers disclose confidential information like a credit card or bank account number, for the purpose of unlawfully charging such bank accounts or withdrawing money out of them. It happened that some clients of the Complainant have received e-mail messages asking, by the means of web pages which were very similar to the Complainant's ones, the sensitive data of the Clients, like user ID, password etc. Then, some of the Clients have been cheated of their savings. Also in the present case, the Complainant believes that the actual owner registered the disputed domain name with the "phishing" purpose, in order to induce and divert the Complainant's legitimate customers to its website and steal their money.

Even excluding any "phishing" purposes or other illicit use of the disputed domain name there is no other possible legitimate use of INTES-SANPAOLO-NEW.COM. The sole further aim of the owner of the disputed domain name might be to resell it to the Complainant, which represents, in any case, an evidence of the registration and use in bad faith, according to par. 4(b)(i) of the Policy («circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of

the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name»).

Lastly, it shall be underlined that – on June 5, 2018 – the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the contested domain name to their client. The Complainant then detected that the Respondent's e-mail address is fake.

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

RESPONDENT: No administratively compliant Response has been filed.

RIGHTS

The Domain Name registered in 2018 is confusingly similar to the Complainant's trade mark INTESA SANPAOLO (registered, in alia, in the EU as of 2007 for financial services) incorporating it in its entirety and omitting only a letter 'a', adding the non distinctive generic term 'new', two hyphens which are non distinctive as punctuation marks and the gTLD com none of which distinguish the Domain Name from the Complainant's mark.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent is not commonly known by the disputed domain name and has not been authorised by the Complainant to use the Complainant's mark. As the disputed domain name has not been used, there has been no bona fide offering of goods and services or any non commercial legitimate and fair use.

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

INTESA SANPAOLO is a distinctive mark with no generic meaning. The disputed domain name appears to be a typosquatting registration omitting the 'a' of the Complainant's mark. Typosquatting, in itself, has been held to be bad faith registration and use under the Policy. Further passive holding of a trade mark confusingly similar to a well known mark can also be bad faith registration and use. The Respondent has not answered this Complaint and has not explained why it has any bona fide reason to register and use a Domain Name confusingly similar to the Comlainant's mark. The fact that the e mail address provided for the Respondent is not valid can also be an indication of bad faith use and registration as incorrect contact details.
The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy) and there is no need to consider further additional grounds of bad faith.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain name is confusingly similar to the Complainant's distinctive mark and appears to be a typosquatting registration being passively held by a Respondent who has provided incorrect contact details.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **INTES-SANPAOLO-NEW.COM**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2018-08-17

Publish the Decision