Decision for dispute CAC-UDRP-102105

Case number	CAC-UDRP-102105
Time of filing	2018-07-31 10:02:09
Domain names	intesasanpa0lobank.com

Case administrator

Name	Sandra Lanczová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	william michael

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant adduced evidence of a word mank portraying the name "INTESA SANPAOLO" which was registered internationally as trademark 920896 under the Madrid System in relation to Nice Classification System classes 9, 16, 35, 36, 38, 41 and 42, although it is worth noting that not all these classes relate to the Complainant's main field of activity, banking and insurance. This trademark was registered on 07.03.2007 with a renewal date in 2027. It was introduced on the basis of an Italian mark. The designations operate in numerous countries of the world, with indications of use in only four of them.

The Complainant further adduced evidence of EU trademarks 005301999 of 18.06.2007 in Nice Classification System classes 35, 36, 38 (word mark) and 005421177 of 05.11.2007 in classes 9, 16, 35, 36, 38, 41 and 42 (figurative).
The Complainant lastly presented a Google search result to show it holds a domain name that includes its protected name. This elicited a paid search result that provides details of the Complainant also contained in other evidence submitted.

As to the Respondent, no indication of any rights in the disputed domain name on the part of the Respondent is apparent within the name itself or in evidence submitted.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

On 12 April 2018 the Respondent registered the domain name INTESASANPA0LOBANK.COM.
This domain name does not correspond to the name of the Respondent, given as "Contact Privacy Inc. Customer 1242513103“ and, following the CAC Case Administrator’s request for the registrar’s verification of identity, as "william michael“. Neither resemble “INTESASANPA0LOBANK”.

The Complainant is the leading Italian banking group and a major player on the European financial scene. The name Intesa Sanpaolo results from the merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups, in 2007.

The Complainant‘s international network is specialized in supporting corporate customers in 25 countries, in particular in the Mediterranean area and those countries where Italian companies are most active, such as the United States, Russia, China and India.

The Complainant is the owner, among others, of the trademark registrations given in evidence and claims it is also the owner, among others, of the following domain names bearing the Complainant’s mark “INTESA SANPAOLO”: “INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ” and INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ”. It avers that all of them are connected to the official website http://www.intesasanpaolo.com.

Lastly, there is no evidence of any fair or non-commercial use of the disputed domain name by the Respondent, but instead a search for it resolves to an error page according to evidence submitted.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims that, with regard to the first limb of the UDRP test, the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (see "Identification of Rights“, above), saying that it is obvious that the name is almost identical to the Complainant’s trademarks incorporating “INTESA SANPAOLO”, as it differs only in the replacement of letter “o” with the number “0” in the word “SANPAOLO” and the addition of the generic and descriptive term “bank”.

In particular, the Complainant contends that this case represents a clear example of typo-squatting, where the disputed domain name is one letter less than or different from the Complainant's mark. Such attempts have been disapproved of in various WIPO decisions (e.g. Telstra Corp. Ltd. v. Warren Bolton Consulting Pty. Ltd. D2000-1293; Playboy Enterprises International Inc. v. SAND Webnames-For Sale D2001-0094). These decisions were recently confirmed in Société Nationale des Chemins de fer Français - SNCF v. Damian Miller / Miller Inc., WIPO Case No. D2009-0891), and very recently by CAC decision No. 101715 on the domain name <arcelormittla.com>.

The Complainant further claims, with regard to the second limb of the UDRP test, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, since Contact Privacy Inc. Customer 1242513103 (or "william michael“) has nothing to do with Intesa Sanpaolo, wheras the latter’s rights are infringed.

Lastly, in regard to the third limb of the UDRP test, the Complainant contends that INTESASANPA0LOBANK.COM was registered and is used in bad faith on a number of grounds.

In first place, 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 out even a basic Google search in respect of the wording "INTESA SANPAOLO", it would have yielded obvious references to the Complainant. This raises an 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 were it not for the existence of the Complainant's trademark.

In second place, the disputed domain name is not used for any bone fide offerings. To the contrary, the circumstances indicate that the Respondent has registered or acquired the disputed 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 (citing from para. 4(b)(i) of the Policy).

Even if the disputed domain name has not been connected to any web site, its use can still be considered in bad faith, as recognized by many UDRP decisions on passive holding of a domain name with knowledge that the domain name infringes another party's trademark rights (e.g. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; see also the consensus view on this point reflected in the "WIPO Overview of WIPO Views on Selected UDRP Questions", paragraph 3.2.). WIPO UDRP panellists in particular have been of the view that such passive holding may be consistent with a finding of bad faith when, as here, 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 trademark rights.

The Complainant further referred to the "specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests" in the present circumsances based on Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., which also concerned a bank. The Complainant added, however, that the risk of wrongful use of the disputed domain name is even higher in the present case, since the Complainant has been the target of phishing in the past few years by means of web pages very similar to the Complainant's ones. Some clients were cheated of their savings. The Complainant fears the same in this instance.

Lastly, the Complainant's attorneys sent the Respondent a cease and desist letter on 18 April 2018 asking for the voluntary transfer of the disputed domain name, to which the Respondent did not reply.

RESPONDENT: None.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or 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 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

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).

PROCEDURAL FACTORS

It notes in particular the return of the postal communication concerning this proceeding but the apparent delivery of e-mail from the Case Administrator to the Respondent. The one reply to the Case Administrator did, however, require some clarification which might be material to other circumstances in this proceeding. The Panel therefore exercised its general powers under Para. 10 of the Rules for Uniform Domain Name Dispute Resolution Policy to examine further the information provided by the registrar on the disputed domain name to the Case Administrator.

The Panel upon investigation immediately determined that the postal address given by the registrar for "william michael“ does not exist and that none of the Respondent’s contact details as provided by the registrar bear any relation to each other. The reply to the Case Administrator in addition appears to the Panel to have been sent by an unrelated person who herself sought to obtain information as to use of her email address. The Panel therefore concludes that the contact details as furnished by the Respondent serve to conceal rather than reveal the Respondent’s identity.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds without any difficulty in favour of the Complainant in this case, which is one of typosquatting.

The Complainant has in particular shown amply through evidence it adduced that it has rights in the disputed domain name, thus satisfying the first criterion of the three-part UDRP test. It moreover easily satisfied the second criterion in pointing to the lack of any authorization given to the Respondent to use a name almost identical to the Complainant's and to the fact that it can be ruled out that this Respondent, who has concealed its identity, might, behind the curtain it created, have a name proximate to the disputed domain name or be performing any fair use with the name.

As to the third criterion of bad faith, the Panel finds for the Complainant on the ground of the improbability of a legitimate purpose pursued by the Respondent in the circumstances and thus the corrollory probability here of an illegitimate one. The self-evident fact of typosquatting with so distinctive a name weighs heavily in this regard in conjunction with the nature of the name and its potential attraction to those intending to obtain some illegitimate advantage from its registration.

Beyond this, all is speculation. Thus, the Panel does not accept the Complainant's contention 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 inference to which the Complainant urges the Panel is not the sole inference disclosed by the circumstances. Indeed, the Complainant itself raises a concern that might be consistent with an alterantive scenario, namely use of the disputed domain name to engage in phishing. While it is possible to imagine in that scenario that some form of blackmail might be attempted in regard to the Complainant so as to avoid or end phishing, there would be risks to the phisher in such a course of action, and it is harder still to conceive of a phisher seeking to make a transfer or rent to a competitor bank. This ground is hence insufficiently demonstrated to convince the Panel.

Further, as to the Complainant's contention that "a basic Google search in respect of the wording 'INTESA SANPAOLO', the same would have yielded obvious references to the Complainant", this may certainly be true but this argument potentially drifts towards an obligation on registrants that is not contained in the UDRP and which this Panel declines to read into it.

These points do not, however, have the effect of undermining the strong inference of bad faith in this case and thus, all three conditions of the UDRP test being fulfilled, the Panel orders the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPA0LOBANK.COM**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2018-08-27

Publish the Decision