Decision for dispute CAC-UDRP-102107

Case number	CAC-UDRP-102107
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Domain names	intesasanpauolo.com

Case administrator

Name	Sandra Lanczová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Ogbonna Morikwe

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following:

- the International trademark INTESA SANPAOLO (Registration n°920896) dated March 07, 2007;
- the EU trademark INTESA SANPAOLO (Registration n°5301999) dated September 08, 2006;
- the EU trademark INTESA SANPAOLO (Registration n°5421177) dated October 27, 2006;

Moreover, the Complainant is also the owner of the official website www.intesasanpaolo.com and the connected following domain names bearing the sign „INTESA SANPAOLO“: INTESASANPAOLO.COM,.ORG,.EU,.INFO,.NET,.BIZ and INTESA-SANPAOLO.COM,.ORG,.EU,.INFO,.NET,.BIZ.

FACTUAL BACKGROUND

The Complainant holds several trademark registrations for “INTESA SANPAOLO” and the Complainant also holds domain names including “INTESA SANPAOLO”.
On May 08, 2018, the Respondent registered the domain name <intesasanpauolo.com>. The domain name is currently

unavailable which shows that there is no use at the disputed domain name.
On June 7, 2018, the Complainant sent a cease and desist letter to the Respondent but the Respondent did not reply such letter.
Thereon, the Complainant has filed the present complaint.

PARTIES' CONTENTIONS:
COMPLAINANT:
The Complainant is the leading Italian banking group and also one of the protagonists in the European financial arena. 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, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,600 branches capillary and well distributed throughout the Country, with market shares of more than 17% in most Italian regions, 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.

1. THE DOMAIN NAME IS ALMOST IDENTICAL TO THE COMPLAINANT'S TRADEMARKS „INTESA SANPAOLO"
It is more than obvious that the disputed domain name is almost identical to the Complainant's trademarks "INTESA SANPAOLO", as it differs only for the addition of letter "U" in the word "SANPAOLO".
In particular, it is undeniable that this case represents a clear example of typosquatting, 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 more recently confirmed by Société Nationale des Chemins de fer Français - SNCF v. Damian Miller / Miller Inc., Case No. D2009-0891), and very recently by CAC decision No. 101715 on the domain name <arcelormittla.com>.

2. THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME
The Complainant states that the Respondent has no rights on the Disputed Domain Name, since Ogbonna Morikwe 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, Ogbonna Morikwe is not commonly known as "INTESASANPAUOLO".

Lastly, the Complainant states that there is no fair or non-commercial uses of the disputed domain name .

3. THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH
The Complainant states that the disputed domain name was registered and is being used in bad faith. The Complainant alleges that, as is stated before, minor changes are not sufficient to vanish the confusing similarity between the disputed domain name and the registered international and EU trademarks. The Complainant also asserts that the disputed domain name is widely-known and that the Respondent has registered and used the disputed domain name with full knowledge of the Complainant's trademark INTESA SANPAOLO. Moreover, the Complainant indicates that the Respondent might have the disputed domain name registered for phishing purposes since such similar attempts had occured in the past. Lastly, the Complainant also mentions that the Respondent has been contacted by sending a cease and desist letter requesting the voluntary transfer of the disputed domain name yet there was not a response given by the Respondent.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:
A. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
B. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
C. The Disputed Domain Name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. IDENTICAL OR CONFUSINGLY SIMILAR
The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of the INTESA SANPAOLO trademarks.

The Panel finds that the disputed domain name is nearly identical with the Complainant’s INTESA SANPAOLO trademarks since the amendment of the letter “U” into the second word of the trademark is not sufficient to vanish the similarity.

The Panel is of the opinion that the internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademarks. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

B. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is open to a Respondent to establish its rights or legitimate interests in the disputed domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has have acquired no trademark or service mark rights; or
(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the Respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the Complainant will have failed to discharge its burden of proof and the Complaint will fail. The burden is on the Complainant to demonstrate a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name. Once the Complainant has made out a prima facie case, then the Respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complaint and any use of the trademark INTESA SANPAOLO has to be authorized by the Complainant and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commanly known as the disputed domain name. Finally, there is no fair or non-commercial uses of the disputed domain name found.

In the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the Disputed Domain Name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. BAD FAITH

The Panel concludes that the Complainant's INTESA SANPAOLO trademarks have significant reputation and is of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the INTESA SANPAOLO trademarks and the associated domain name, the Respondent, was aware of the Complainant and its trademarks at the time of registration of the Disputed Domain Name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant’s trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAUOLO.COM**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2018-09-10

Publish the Decision