Decision for dispute CAC-UDRP-102230

Case number	CAC-UDRP-102230
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Domain names	AGGIORNATUOCARTEINTESASANPAOLO.FUN, ATTIVACARTEINTESASANPAOLO.FUN, ATTIVARECARTEINTESASANPAOLO.FUN, ATTIVARETUOCARTEINTESASANPAOLO.FUN, ATTIVATUOCARTEINTESASANPAOLO.FUN, LECARTEINTESASANPAOLO.FUN, ATTIVALECARTEINTESASANPAOLO.FUN, INZIARECARTEINTESASANPAOLO.FUN, AGGIORNACARTEINTESASANPAOLO.FUN

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Luca Perlini

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the Disputed Domain Names.

IDENTIFICATION OF RIGHTS

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

1. International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;

2. EU trademark registration n. 5301999 “INTESA SANPAOLO”, granted on June 18, 2007, in classes 35, 36 and 38;

3. EU trademark registration n. 5421177 “INTESA SANPAOLO & device”, granted on November 5, 2007, in classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

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

The Complainant is the leading Italian banking group and 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 capitalization exceeding 34,2 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,400 branches capillary and well distributed throughout the Country, with market shares of more than 16% in most Italian regions, the Group offers its services to approximately 11,9 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,5 million customers. Moreover, the international network specialized 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.

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, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ. All of them are now connected to the official website http://www.intesasanpaolo.com.
On September 1, 2018, the Respondent registered the Disputed Domain Names:

AGGIORNATUOCARTEINTESASANPAOLO.FUN, ATTIVACARTEINTESASANPAOLO.FUN, ATTIVARECARTEINTESASANPAOLO.FUN, ATTIVARETUOCARTEINTESASANPAOLO.FUN, ATTIVATUOCARTEINTESASANPAOLO.FUN, LECARTEINTESASANPAOLO.FUN, ATTIVALECARTEINTESASANPAOLO.FUN, INZIARECARTEINTESASANPAOLO.FUN and AGGIORNACARTEINTESASANPAOLO.FUN.

PARTIES CONTENTIONS

COMPLAINANT:

THE DISPUTED DOMAIN NAMES ARE CONFUSINGLY SIMILAR TO THE TRADEMARK

The Disputed Domain Names are identical, or – at least – confusingly similar, to the Complainant’s trademark “INTESA SANPAOLO”.

As a matter of fact, AGGIORNATUOCARTEINTESASANPAOLO.FUN, ATTIVACARTEINTESASANPAOLO.FUN, ATTIVARECARTEINTESASANPAOLO.FUN, ATTIVARETUOCARTEINTESASANPAOLO.FUN, ATTIVATUOCARTEINTESASANPAOLO.FUN, LECARTEINTESASANPAOLO.FUN, ATTIVALECARTEINTESASANPAOLO.FUN, INZIARECARTEINTESASANPAOLO.FUN and AGGIORNACARTEINTESASANPAOLO.FUN exactly reproduce the trademark “INTESA SANPAOLO” with the addition of generic Italian words such as “aggiorna”, “carte” and “attivare” (Italian for “update”, “cards” and “activate”), all merely descriptive and even alluding of the online banking services offered by the Complainant to is clients.

As widely known, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

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

The Respondent has no rights on the Disputed Domain Names, since Luca Perlini 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 Disputed Domain Names.

The Disputed Domain Names do not correspond to the name of the Respondent and, to the best of our knowledge, Luca Perlini is not commonly known as AGGIORNATUOCARTEINTESASANPAOLO, ATTIVACARTEINTESASANPAOLO, ATTIVARECARTEINTESASANPAOLO, ATTIVARETUOCARTEINTESASANPAOLO, ATTIVATUOCARTEINTESASANPAOLO, LECARTEINTESASANPAOLO, ATTIVALECARTEINTESASANPAOLO, INZIARECARTEINTESASANPAOLO and/or AGGIORNACARTEINTESASANPAOLO.

Lastly, we do not find any fair or non-commercial uses of the disputed domain names.

THE DOMAIN NAMES WERE REGISTERED AND ARE USED IN BAD FAITH

The Disputed Domain Names: AGGIORNATUOCARTEINTESASANPAOLO.FUN, ATTIVACARTEINTESASANPAOLO.FUN, ATTIVARECARTEINTESASANPAOLO.FUN, ATTIVARETUOCARTEINTESASANPAOLO.FUN, ATTIVATUOCARTEINTESASANPAOLO.FUN, LECARTEINTESASANPAOLO.FUN, ATTIVALECARTEINTESASANPAOLO.FUN, INZIARECARTEINTESASANPAOLO.FUN and AGGIORNACARTEINTESASANPAOLO.FUN were registered and are used in bad faith.

The Complainant's trademark "INTESA SANPAOLO" is distinctive and well known all around the world. The fact that the Respondent registered domain names that are confusingly similar to the Trademark indicate that the Respondent had knowledge of the Complainant's trademark at the time of registration of the Disputed Domain Names. In addition, if the Respondent had carried even a basic Google search in respect of the wording "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 Names would not have been registered if it were not for Complainant's trademark. This is a clear evidence of registration of the Disputed Domain Names in bad faith.

In addition, the Disputed Domain Names are not used for any bone fide offerings. More particularly, there are present circumstances indicating that the Respondent has registered or acquired the Disputed Domain Names primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registrations 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 Disputed Domain Names.

The Disputed Domain Names are not used for any bone fide offerings, even if they are not connected to any web site, as of now. In fact, 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.

In particular, the consensus view of WIPO UDRP panelists 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.

As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademarks. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make of domain names which correspond exactly with the Complainant's trademarks and that results are so similar to the Complainant's domain names currently used by the latter to provide online banking services for enterprises.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the Disputed Domain Names has to be considered a use in bad faith.

The risk of a wrongful use of the Disputed Domain Names 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.

Even excluding any "phishing" purposes or other illicit use of the Disputed Domain Names in the present case, anyway we could find no other possible legitimate use of AGGIORNATUOCARTEINTESASANPAOLO.FUN, ATTIVACARTEINTESASANPAOLO.FUN, ATTIVARECARTEINTESASANPAOLO.FUN, ATTIVARETUOCARTEINTESASANPAOLO.FUN, ATTIVATUOCARTEINTESASANPAOLO.FUN, LECARTEINTESASANPAOLO.FUN, ATTIVALECARTEINTESASANPAOLO.FUN, INZIARECARTEINTESASANPAOLO.FUN and AGGIORNACARTEINTESASANPAOLO.FUN. The sole further aim of the owner of the Disputed Domain Names might be to resell them 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.

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registrations and uses the Disputed Domain Names in bad faith has been established.

RESPONDENT:

No administratively compliant Response was filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Names are 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 Names (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 Names have been registered and are 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 have been met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

As per paragraph 4(a) of the Policy, for the Complaint to succeed in relation to the Disputed Domain Names, the Complainant must prove the following:

(i) The Disputed Domain Name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name(s); and
(iii) The Disputed Domain Name(s) has/have been registered and is/are being used in bad faith.

Since in this case, the Respondent failed to produce a Response, the Panel may treat as uncontested the Complainant's factual assertions. The Panel will now turn to review each of these elements.

A. Identical or Confusingly Similar

The Complainant, through evidence on record, has established its rights in the trademark "INTESA SANPAOLO", since 2007. Moreover, the Complainant provided evidence showing the trademark is well-known and has achieved recognition through its use.

We now turn to determine if the Disputed Domain Names are confusingly similar to the Complainant's trademarks. For this, the Panel, through a side-by-side comparison of the Disputed Domain Names and the textual components of the Complainant's mark, attempts to assess whether the "INTESA SANPAOLO" Trademark is recognizable within the Disputed Domain Names. The Disputed Domain Names, without exception, incorporate the entirety of the "INTESA SANPAOLO" Trademark. Each one of the Disputed Domain Names also include additional text anteceding the portion replicating the Trademark. For ease of reference, please see below:

AGGIORNATUOCARTEINTESASANPAOLO.FUN: addition of the text "aggiornatuocarte"
ATTIVACARTEINTESASANPAOLO.FUN: addition of the text "attivacarte"
ATTIVARECARTEINTESASANPAOLO.FUN: addition of the text "attivarecarte"
ATTIVARETUOCARTEINTESASANPAOLO.FUN: addition of the text "attivaretuocarte"
ATTIVATUOCARTEINTESASANPAOLO.FUN: addition of the text "attivatuocarte"
LECARTEINTESASANPAOLO.FUN: addition of the text "lecarte"
ATTIVALECARTEINTESASANPAOLO.FUN: addition of the text "attivalecarte"
INZIARECARTEINTESASANPAOLO.FUN: addition of the text "inziarecarte"
AGGIORNACARTEINTESASANPAOLO.FUN: addition of the text "aggiornacarte"

It is widely acknowledged, as per paragraph 1.7 of WIPO Overview 3.0, that where a disputed domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that trademark for the purposes of the first element of the Policy. This is the case in all of the Disputed Domain Names. Additionally, in all of these cases, the additional text relates to generic and/or descriptive words in the Italian language that are commonly associated with online banking services offered by the Complainant. This fact reinforces a conclusion that the additional text is therefore of secondary importance to the main element of the Disputed Domain Names, namely "INTESA SANPAOLO".

Based on the above, and the evidence on record, the Panel determines that the additional text is not enough to dispel the confusing similarity between the Disputed Domain Names and the Complainant's trademark, as stated under paragraph 1.8 of WIPO Overview 3.0.

The Panel therefore finds that the Complaint has satisfied the first element set under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant alleges that the Trademark is well-known and it is more than likely that the Respondent was aware of it at the time of registration of the Disputed Domain Names. There is no evidence that the Respondent has been commonly known by the Disputed Domain Names. The Complainant also claims that the Respondent is not affiliated to the Complainant nor has the Complainant authorized the Respondent in any way to use the Trademark in connection to domain names. Furthermore, the Complainant states that there is no conceivable bona fide use of the Disputed Domain Names other than taking advantage of the goodwill associated with the trademark through the Disputed Domain Names. It is the Panel's view that these allegations are sufficient to establish a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name as per paragraph 2.1 of WIPO 3.0 Overview.

Based on the above, and given that there is no available evidence on record that would otherwise allow the Panel to find any rights or legitimate interests for the Respondent in the Disputed Domain Names, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Names and therefore the Complainant has fulfilled the second requirement set under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Respondent registered nine domain names incorporating the entirety of the Complainant's well-known Trademark, and given the evidence on record, the Panel is of the view that the Respondent was clearly aware of the existence of the Complainant's Trademark, a conclusion further supported by the domicile of the Respondent. The Panel also concludes that it is highly likely that the Respondent targeted the Complainant's Trademark in order to benefit commercially from a perceived association with the Complainant while at the same time; it is highly improbable that the Respondent has a conceivable bona fide offering in mind. Although no Response was provided, there is no evidence on record of actual or contemplated good faith use, a finding that is further supported by the pattern of conduct, albeit limited, that the Respondent has exhibited by registering nine domain names that are confusingly similar with the Complainant's mark, and with a very limited conceivable bona fide offering possible.

Accordingly, the Panel finds that the Complainant has satisfied the last element required under paragraph 4(a)(iii) of the Policy.

D. Decision

For the aforementioned reasons and in accordance with the provisions contained under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the Disputed Domain Names to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AGGIORNATUOCARTEINTESASANPAOLO.FUN**: Transferred
2. **ATTIVACARTEINTESASANPAOLO.FUN**: Transferred
3. **ATTIVARECARTEINTESASANPAOLO.FUN**: Transferred
4. **ATTIVARETUOCARTEINTESASANPAOLO.FUN**: Transferred
5. **ATTIVATUOCARTEINTESASANPAOLO.FUN**: Transferred
6. **LECARTEINTESASANPAOLO.FUN**: Transferred
7. **ATTIVALECARTEINTESASANPAOLO.FUN**: Transferred
8. **INZIARECARTEINTESASANPAOLO.FUN**: Transferred
9. **AGGIORNACARTEINTESASANPAOLO.FUN**: Transferred

PANELLISTS

Name	**Rodolfo Carlos Rivas Rea**

DATE OF PANEL DECISION 2018-12-21

Publish the Decision