Decision for dispute CAC-UDRP-102320

Case number	CAC-UDRP-102320
Time of filing	2019-01-29 16:09:34
Domain names	INTESASANPAOLLO.COM, INTESASANPPAOLO.COM, INTEESASANPAOLO.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	cao bing

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is, inter alia, a registered owner of the following trademarks containing word elements "INTESA" and “SANPAOLO”:

(i) INTESA SANPAOLO (word), EU Trademark, filing (priority) date 8 September 2006, registration no. 5301999, registered for services in classes 35, 36 and 38;

(ii) INTESA SANPAOLO & device (combined), EU Trademark, filing (priority) date 8 September 2006, registration no. 5421177, registered for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;

besides other national and international trademarks consisting of the " INTESA SANPAOLO" denomination.
(collectively referred to as "Complainant's trademarks").

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term „INTESA" and “SANPAOLO”.

FACTUAL BACKGROUND

FACTUAL BACKGROUND

The Complainant (Intesa Sanpaolo S.p.A.) is a leading Italian banking group and also one of the protagonists in the European financial arena. The Complainant 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.

All disputed domain names <intesasanpaollo.com>, <intesasanppaolo.com> and <inteesasanpaolo.com> were registered on 7 December 2018 and are held by the Respondent.

The domain name websites (i.e. website available under internet address containing the disputed domain names) are automatically redirected to various websites offering financial or similar services.

The Complainant seeks transfer of the disputed domain names to Complainant.

PARTIES CONTENTIONS

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain names contain “BANCA” and “SANPAOLO” word elements of Complainant's trademarks in its entirety and thus they are almost identical (i.e. confusingly similar) to Complainant’s trademarks since the domain names differ from the Complainant trademarks by only one extra letter in each disputed domain name.

Thus, according to the Complainant the confusing similarity between Complainant’s trademarks and the disputed domain name is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain names.

- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant’s trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by any of the disputed domain names.

- Furthermore, the domain name websites have not been used for any legitimate or fair purposes.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain names registration and such trademarks are well known in relevant business circles. The Respondent can be considered aware of the Complainant's trademarks when registering the disputed domain names due to well-known character thereof, which should have been checked by the Respondent by performing a simple internet search.

- The disputed domain names (at the time of filing of the complaint) are not used for any bona fide offerings. More particularly, there are present circumstances indicating that, by using the domain names, the Respondent has intentionally

attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site.

- It is well-founded that registration of the disputed domain names that are confusingly similar to the Complainant's trademarks which enjoys strong reputation, plus other facts, such as above described unfair use of the disputed domain names, are sufficient to establish bad faith under the 4(a)(iii) of the Policy.

- The Complainant refers to previous domain name decisions contending that registering a domain name incorporating trademarks that enjoy high level of notoriety and well-known character constitute prima facie registration in bad faith, despite a fact that such domain names are not genuinely used.

The Complainant presents the following evidence that has been assessed by the Panel:

- Information about the Complainant and its business;
- Excerpts from various trademark databases regarding Complainant's trademarks and copies of certificates of registration of such trademarks;
- Screenshots of the disputed domain name website (evidencing unfair use of the same);
- Screenshots of Google search results for "Banca Sanpaolo";
- A letter from Complainant to Respondent (dated 17 January 2019) requesting transfer of the disputed domain name to the Complainant;
- Various WIPO ADR decisions concerning similar domain names disputes.

RESPONDENT:

The Respondent has not provided any response to the complaint.

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

RIGHTS

The disputed domain name and the Complainant's trademarks are nearly identical since both fully incorporate words "BANCA SANPAOLO" in only very slightly modified form.

Each disputed domain name differs only in one character – a letter "L" is replaced by a double letter "LL", a letter "P" is

replaced by a double letter “PP” and a letter “E” is replaced by a double letter “EE” – from the Complainant’s trademarks. This, however, cannot prevent the association in the eyes of internet consumers between the disputed domain names and the Complainant’s trademarks and thus the likelihood of confusion still exists.

For sake of completeness, the Panel asserts that the top-level suffix in the domain names (i.e. the “.com”) must be disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant’s assertions that the Respondent is not commonly known by the disputed domain names and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

Given the facts above and in the absence of the Respondent's response, the Panel concludes that there is no indication that the disputed domain names were intended to be used in connection with a bona fide offering of goods or services as required by UDRP.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

BAD FAITH

It is clear that by adding a single letter to the Complainant trademarks (while all other characters of the disputed domain names are identical to the Complainant trademarks) it was Respondent’s intention to target Internet users who incorrectly type a website address into their web browser, an illicit activity recognised as „typosquatting“. There are several different reasons for typosquatting, as for example:

- to try to sell the disputed domain back to the Complainant;
- to monetize the disputed domain through advertising revenues from direct navigation misspellings of the intended domain;
- to redirect the typo-traffic to Complainant’s competitor;
- as a phishing scheme to mimic the Complainant’s site, while intercepting passwords or other information which the visitor enters unsuspectingly;
- to install drive-by malware or revenue generating adware onto the visitors' devices;
- to harvest misaddressed e-mail messages mistakenly sent to the typo domain.

All of the activities above are considered as malicious activities.

For the reasons described above, since (i) there is only a remote chance that the Respondent has registered the disputed domain name just by a chance and without having a knowledge about the existence of the Complainant’s rights and business, and (ii) the Respondent is engaged in typosquatting, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith.

Thus, the Panel has taken a view that 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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLLO.COM**: Transferred
2. **INTESASANPPAOLO.COM**: Transferred
3. **INTEESASANPAOLO.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2019-03-18

Publish the Decision