# Decision for dispute CAC-UDRP-102359

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| Case number | CAC-UDRP-102359 |
| Time of filing | 2019-02-25 09:28:26 |
| Domain names | INTESSASANPAOLLO.COM |

## Case administrator

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

## Complainant

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| Organization | Intesa Sanpaolo S.p.A. |

## Complainant representative

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| Organization | Perani Pozzi Associati |

## Respondent

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| Name | Emeka Nkwo |

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 7, 2007;
- the EU trademark INTESA SANPAOLO (Registration n°5301999) dated September 8, 2006;
- the EU trademark INTESA SANPAOLO (Registration n°5421177) dated October 27, 2006;
- the international trademark INTESA (Registration n°793367) dated September 4, 2002;
- the U.S. trademark INTESA (Registration n°4196961) dated June 30, 2011;
- the EU trademark INTESA (Registration n°12247979) dated October 23, 2013.

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.

The Complainant is also owner of the following connected domain names bearing the sign „INTESA“:

INTESA.COM, INTESA.INFO, INTESA.BIZ, INTESA.ORG, INTESA.US, INTESA.EU, INTESA.CN, INTESA.IN, INTESA.CO.UK, INTESA.TEL, INTESA.NAME, INTESA.XXX, INTESA.ME.

FACTUAL BACKGROUND

As it is seen from the documents, the Complainant holds several trademark registrations for “INTESA SANPAOLO” and the Complainant also holds domain names including “INTESA SANPAOLO”.

On November 14, 2018, the Respondent registered the disputed domain name. The disputed domain name is currently unavailable which shows that there is no use at the subject domain name.

On November 26, 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

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 34,9 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,200 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 1.100 branches and over 7,5 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.

The Complainant holds several trademark registrations for the trademarks “INTESA SANPAOLO” and “INTESA”.

The Complainant also is the owner of the domain names bearing the signs “INTESA SANPAOLO” and “INTESA”.

1. THE DISPUTED DOMAIN NAME IS ALMOST IDENTICAL TO THE COMPLAINANT’S TRADEMARKS „INTESA SANPAOLO“

The disputed domain name is almost identical or at least confusingly similar to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA, as it reproduces the “INTESA SANPAOLO” trademark with addition of “S” letter in “INTESSA” and of letter “L” in “SANPAOLLO”.

The Complainant states that the disputed domain name is a clear example of typo-squatting, where the disputed domain name is a slight alphabetical variation from the Complainant’s mark. Such attempts have been disapproved of in various WIPO decisions e.g. Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc, Case n. D2001-1314 – regarding the domain names <duetschebank.com> and <duetsche-bank.com>”. The Complainant states that WIPO jurisprudence offers many examples of confusing similarity brought about through easily made typing errors by an Internet user – particularly when the mark is another language from that of the user’s mother tongue and the same case lies in this matter.

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

The Complainant states that the Respondent has no rights on the disputed domain name, the Respondent has no relationship with Intesa Sanpaolo. In fact, any use of the trademark “INTESA SANPAOLO” and ‘INTESA‘‘ has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned to use the disputed domain name.

It is also argued that the disputed domain name does not correspond to the name of the Respondent which is PERFECT PRIVACY, LLC and the Respondent is not commonly known as “INTESSASANPAOLLO” either.

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

3. THE DISPUTED 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.

The Complainant also states that the disputed domain name is not being used for any bona fide offering and this fact, not being used of the disputed domain name, alone is sufficient to prove the bad faith of the Respondent according to many WIPO UDRP decisions.

Moreover, the Complainant indicates that the Respondent might has the Disputed Domain Name registered for phishing purposes since such similar attempts had occurred in the past. It was also stated that the disputed domain name which is almost identical to the trademarks of the Complainant cannot be used for no purpose but to act like being the Complainant to obtain special information of the internet users who believe the disputed domain name belong to the Complainant and enters its passwords etc.

Lastly, the Complainant also mentions that the Respondent has been contacted with 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.

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 additional letter “S“ into the first word and the additional letter “L“ into the second word of the trademark is not sufficient to vanish the similarity.

In particular, this case represents a clear example of typo-squatting, where the disputed domain name is two letters more than the Complainant's mark where the additional letters are the repetition of the previous one.

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 a 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 bone 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 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 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 domain name. Once the complainant has made out a prima facie case, than the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the 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 commonly known as the disputed domain name. Finally, there is no fair or non-commercial use of the disputed domain name found as well.

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 has a 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. **INTESSASANPAOLLO.COM**: Transferred

## PANELLISTS

| Name | **Mrs Selma Ünlü** |
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2019-04-23

DATE OF PANEL DECISION 2019-04-22

Publish the Decision