Decision for dispute CAC-UDRP-102580

Case number	CAC-UDRP-102580
Time of filing	2019-07-23 10:03:32
Domain names	INTESAPAOLO.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

Organization	Balticsea LLC

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of several trademarks very similar to the disputed domain name, such as:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 41 and 42;

- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in connection with class 36;

-EU trademark registration n. 5301999 “INTESA SANPAOLO”, filed on September 8, 2006, granted on June 18, 2007 and duly renewed, in connection with the classes 35, 36 and 38;

- EU trademark registration n. 12247979 “INTESA”, filed on October 23, 2013 and granted on March 5, 2014, in connection with classes 9, 16, 35, 36 38, 41 and 42.

Moreover, the Complainant is also the owner of the following domain names bearing the signs “INTESA SANPAOLO” and

“INTESA”: INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ; INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ and 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. All of them are now connected to the official website, available at http://www.intesasanpaolo.com.

FACTUAL BACKGROUND

The Complainant is one of the leading Italian banking groups 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. The Group offers its services to approximately 11,8 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,3 million customers. Moreover, the international network specialised in supporting corporate customers is present in 25 countries.

In addition, the Complainant is the owner of several trademarks and domain names including the words "INTESA" and "SANPAOLO" separately or together.

The Complainant recently realized that the disputed domain name had been registered on April 4, 2012 by the Respondent even though the Complainant did not grand any right to the Respondent to use the trademark names. The Complainant sent a cease and desist letter to the Respondent on May 29, 2019 asking for the voluntary transfer of the domain name at issue. The Respondent did not respond nor comply with that request.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

In order to determine whether the trademark "INTESA SANPAOLO" and the disputed domain name are confusingly similar in the sense of paragraph 4(a)(I) of the Policy, a comparison has to be made and the likelihood of the Internet user confusion should be determined. It should be taken into account that “INTESA SANPAOLO” is a distinctive and well-known trademark in the financial services industry, which is not challenged by the Respondent.

In this context, it is generally found that when a trademark constitutes the dominant or principal component of the domain name, the addition of an extra letter or the omission of a letter to it, is generally insufficient to avoid confusing similarity in the sense of paragraph 4(a)(I) of the Policy.

In the present case, the omission of the three letters "S , "A", and "N" before the verbal portion "PAOLO" represents an example of typosquatting which creates confusion. Indeed, the public may not immediately see the difference between the INTESA SANPAOLO trademark and the disputed domain name, when looking for the website or receiving e-mails coming from the disputed domain name.

The decision "Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc, Case n. D2001-1314" – regarding the domain names <duetschebank.com> and <duetsche-bank.com>” is a similar example where the Panel considered such domain names as being confusingly similar and a clear example of “a case of ‘typosquatting’ where the domain name is a slight alphabetical variation from a famous mark. 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.” The same occurs here.

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

To determine whether a respondent has rights or legitimate interests in the domain name, the complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name (Accor v. Eren Atesmen, WIPO D2009-0701; Malayan Banking Berhad v. Beauty, Success & Truth International, WIPO D2008-1393).

The Complainant argues that the Respondent has no rights on the disputed domain name, and no use of the trademarks “INTESA SANPAOLO” and “INTESA” has been authorized by the Complainant.

Paragraph 4(c) of the Policy provides that the following circumstances can demonstrate rights or legitimate interests in the domain name for the purpose of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or 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) you (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or tarnish the trademark or service mark at issue.

The Panel is of the opinion that these conditions have not been met in the present case.

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

1. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

The Respondent has never been authorized by the Complainant to use the “INTESA SAN PAOLO” trademarks nor to register the disputed domain name. The Respondent seems to have registered the disputed domain name in the sole purpose of attracting more people to his websites or creating confusion with e-mail addresses.

2. THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly the disputed domain name is not being used for any bona fide offerings. More particularly, there are present circumstances indicating that, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website (paragraph 4(b)(iv) of the Policy).

Consequently, Internet users, while searching for information on the Complainant’s services, are confusingly led to the websites of the Complainant’s competitors, sponsored on the websites connected to the disputed domain name.

Several WIPO decisions stated that the registration and use of a domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy. See for example "Encyclopaedia Britannica Inc. v. Shedon.com, WIPO Case No. D2000-075".

Secondly, the Complainant tried to contact the Respondent on May 29, 2019 through a cease-and-desist letter. The Respondent however, disregarded all communications from the Complainant. It has been mentioned in earlier cases that the failure of a respondent to respond to a cease and desist letter, or a similar attempt of contact, can be relevant in a finding of

bad faith, e.g., WIPO Case No. D2000-1623, News Group Newspapers Limited and News Network Limited v. Momm Amed Ia; WIPO Case No. D2000-1598 Nike, Inc. v. Azumano Travel.

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

For the abovementioned reasons, it appears to the Panel that the Respondent has registered and used a domain name that is confusingly similar to the Complainant's trademarks, in which the Respondent has no rights or legitimate interest and which is registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESAPAOLO.COM**: Transferred

PANELLISTS

Name	**Tom Joris Heremans**

DATE OF PANEL DECISION 2019-08-27

Publish the Decision