Decision for dispute CAC-UDRP-102579

Case number	CAC-UDRP-102579
Time of filing	2019-07-23 10:05:30
Domain names	intesasanpolao.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	Jacob Princewill

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which relate to the disputed domain name <INTESASANPOLAO.COM> (the 'Domain Name').

IDENTIFICATION OF RIGHTS

Intesa Sanpaolo S.p.A (the 'Complainant') is the owner of a number of International and European Trade Mark registrations for INTESA SANPAOLO and/or INTESA in various classes.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The Complainant is an Italian banking group which was established on 1 January 2007 resulting from the merger of Banca Intesa S.p.A and San Paolo IMI S.p.A being effected. The Complainant operates in retail, corporate and wealth management and is among the top banking groups in the Euro zone with a market shares of more than 16 % in most Italian regions, with 4,100 branches covering 11.8 million customers. Further the Complainant's Central-Eastern European network has approximately 1,100 branches covering over 7.3 million customers.

The Complainant is the owner of a number of trade marks including the INTESA SANPAOLO and INTESA marks. In addition, the Complainant also owns numerous domain names featuring the INTESA SANPAOLO mark which all link to its official

website at www.intesasanpaolo.com.

The Domain Name was registered by 'Jacob Princewell' (the 'Respondent') on 14 May 2019. The Domain Name is currently connected to a website featuring numerous links to third party websites.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the Domain Name is identical or at least confusingly similar to its registered trade marks for INTESA SANPAOLO and INTESA. Further the Complainant argues that the mere inversion of some letters in the latter verbal portion of the mark 'PAOLO' to 'POLAO' in the Domain Name is a clear example of 'typosquatting'.

Typosquatting is the practice of registering a domain name in an attempt to take advantage of Internet users' typographical errors, and can be evidence of a respondent's lack of rights and legitimate interests in the Domain Name.

The Complainant argues that the Respondent does not have any rights or legitimate interest in the Domain Name because neither licence nor authorisation has been granted to the Respondent to make use of the Complainant's INTESA SANPAOLO and/or INTESA trade marks by the Complainant. The Complainant states that the Domain Name does not correspond to the name of the Respondent and, to the best of the Complainant's knowledge, the Respondent is not commonly known as INTESA SANPOLAO.

The Complainant also contends that the Respondent has registered and is using the Domain Name in bad faith.

The Complainant states that INTESA SANPAOLO and INTESA are well-known marks globally in relation to the Complainant. A basic Google search on the wording INTESA SANPAOLO and INTESA will only bring up results which relate to the Complainant. The Complainant argues this creates a clear inference of knowledge on the part of the Respondent of the Complainant's trade marks. As a result, the Complainant contends that the Domain Name would not have been registered by the Respondent if it were not for the Complainant's trade marks.

Further, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of his website, the Complainant argues that the Respondent is using the Domain Name to attract, for commercial gain, internet users to its website. The Complainant states the Domain Name is connected to a website which sponsors banking and financial services which are services that the Complainant's trade marks 'INTESA SANPAOLO' and 'INTESA' are registered for. In addition to sponsoring such services, the website connected to the Domain Name also provides links to the Complainant's competitors' websites. As such, the Complainant contends that the Respondent has registered and is using the Domain Name in bad faith to intentionally divert traffic away from the Complainant's website.

In addition to the Respondent's commercial gain through remuneration for the sponsored content featured on the website connected to the Domain Name, the Complainant argues that such use of the Domain Name by the Respondent to promote access to the Complainant's competitors is causing great damage to the Complainant by misleading both present and also potential new clients.

Finally, the Complainant states on 28 May 2019 the Complainant's Attorney sent a cease and desist letter to the Respondent requesting the voluntary surrender of the Domain Name. The Respondent failed to provide a response to such letter or to comply with the voluntary transfer request made therein.

RIGHTS

The Panel is satisfied the Complainant has shown the Domain Name is confusingly similar to the trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy)..

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel is satisfied the Complainant has shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Panel is satisfied the Complainant has shown the 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 the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

The Complainant, being represented by Perani Pozzi Associati, first filed its complaint in relation to the Domain Name with the Czech Arbitration Court (the 'CAC') on 19 July 2019. However, due to the Registrar name shield protection the Complainant was unable to initially sufficiently identify the Respondent. A subsequent Registrar Verification however confirmed the identity of the Respondent as Jacob Princewell based in Umuahia, Nigeria. The Complainant then filed an amended complaint and the CAC formally commenced proceedings on 26 July 2019 and the Respondent was notified of the complaint accordingly.

The Respondent failed to submit a response within the time frame required in the complaint or at all, and a Notification of Respondent's Default was issues by the CAC on 21 August 2019.

Having received a Statement of Acceptance and Declaration of Impartiality, the CAC appointed Steve Palmer of Palmer Biggs IP Solicitors as the Panel in the UDRP proceedings.

PRINCIPAL REASONS FOR THE DECISION

IDENTICAL OR CONFUSINGLY SIMILAR

The Domain Name consists of a misspelling of the Complainant's 'INTESA SANPAOLO' trade mark in that the A in the word SANPAOLO is positioned after the L. In addition, the Domain Name contains the '.com' suffix.

The '.com' suffix may be disregarded when it comes to considering whether a domain name is identical or confusingly similar to a trade mark in which a complainant has rights.

The Panel does not regard the change of the position of the letter A (in the manner stated above) to sufficiently alter the nature of the Domain Name such that it might avoid a finding of the Domain Name being confusingly similar to the Complainant's 'INTESA SANPAOLO' trade mark.

Further, given the distinctiveness and reputation of the Complainant's INTESA SANPAOLO mark, the Panel concludes that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

It is well established that typosquatting can constitute a finding that the domain name is confusingly similar (Deutsche Bank Aktiengesellschaft v. New York TV Tickets Inc., WIPO Case No. D2001-1314, DaimlerChrysler Corporation v. Worshipping, Chrisler, and Chr, aka Dream Media and aka Peter Conover, WIPO Case No. D2000-1272 and Playboy Enterprises v. Movie Name Company, WIPO Case No. D2001-1201). The Panel considers this to be a clear case of typosquatting.

The Complainant succeeds on the first element of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The Respondent failed to file an administratively compliant (or any) response to the Complainant's complaint. In the circumstances, the Panel finds from the facts put forward that:

The Respondent does not appear to have any trade marks associated with the INTESA SANPAOLO mark or any variation thereof.

There is no evidence that the Respondent is commonly known by the name INTESA SANPAOLO or any variation thereof, and the Respondent does not have authorisation from the Complainant to use the INTESA SANPAOLO trade mark.

There is no evidence to show the Respondent has used the Domain Name for any bona fide offering of goods or services of its own. On the contrary, the Domain Name is connected to a website site which features sponsored links to the third party websites, including competitors of the Complainant. This is not a bona fide use of the Domain Name under the Policy.

There is no evidence to show the Respondent has been making any legitimate non-commercial or fair use of the Domain Name without intent for commercial gain. It is likely that the Respondent is profiting from those who click on the sponsored links on the website connected to the Domain Name.

On the balance of probabilities, and in the absence of any evidence to the contrary (or any administratively compliant response at all) being put forward by the Respondent, the Panel finds that the Respondent does not have any rights or legitimate interests in the Domain Name within the meaning of paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Paragraph 4(b) of the Policy provides a non-exhaustive criteria which shall be evidence of the registration and use of a domain name in bad faith. Such list includes the use of a domain name to intentionally attract, for commercial gain, internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or location or of product or service on your website or location (paragraph 4(B)(iv) of the Policy). The Panel believes it is likely that this was at least one of the reasons behind the Respondent's registration and use of the Domain Name. The most likely source of traffic that the Domain Name would generate will be from Internet users who mistakenly type the Domain Name into their Internet browser instead of the Complainant's domain name. It is also likely that the use of the website attached to the Domain Name, to provide sponsored links to third party websites including competitors of the Complainant, will be for commercial gain (click through income).

On the balance of probabilities, and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, this Panel believes from the facts in this case that the Respondent had knowledge of the Complainant's trade mark INTESA SANPAOLO and that they had such knowledge prior to the registration and use of the Domain Name. In the circumstances, the Panel believes it therefore likely that the Respondent had the Complainant's INTESA SANPAOLO mark in mind when registering and subsequently using the Domain Name by attaching it to a website featuring links to third party websites including websites of competitors of the Complainant.

Accordingly, the Panel finds that the Respondent has engaged in typosquatting to cause confusion with the Complainant's INTESA SANPAOLO mark for their own commercial gain, and therefore the Domain name was 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. **INTESASANPOLAO.COM**: Transferred

PANELLISTS

Name	**Steve Palmer**

DATE OF PANEL DECISION 2019-09-03

Publish the Decision