Decision for dispute CAC-UDRP-102546

Case number	CAC-UDRP-102546
Time of filing	2019-06-27 11:43:21
Domain names	BANCAINTESANPAOLO.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Milen Radumilo

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

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. Intesa Sanpaolo is among the top banking groups in the eurozone, with a market capitalisation exceeding 32,1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

The Complainant further states and provides evidence to support, that it is the owner, among others, of multiple trademark registrations for the trademarks “INTESA SANPAOLO” and “BANCA INTESA SANPAOLO”:

• International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42;
• 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. 5302377 “BANCA INTESA SANPAOLO”, filed on September 8, 2006, granted on July 6, 2007 and duly renewed, in connection with the classes 35, 36 and 38.

The Complainant also provides that it is the owner, among the others, of the following domain names bearing the signs “INTESA SANPAOLO” and “BANCA INTESA SANPAOLO”: INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ and BANCAINTESASANPAOLO.COM, .EU, .INFO, .BIZ, .ORG, .NET.
All of them are now connected to the official website www.intesasanpaolo.com.

FACTUAL BACKGROUND

The Complainant claims it 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.

The Complainant states and provides evidence of his well-known trademarks and provides a list of some of its trademark registrations.

The Complainant provides that the Respondent registered the disputed domain name "BANCAINTESAPAOLO.COM" ("Domain Name") on November 8, 2018.

PARTIES’ CONTENTIONS:

COMPLAINANT:

• The domain name is confusingly similar to the protected mark

According to the Complainant, the Respondent’s registered Domain Name is identical, or - at least- confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “BANCA INTESA SANPAOLO”. Essentially, the Respondent has appropriated the trademark “BANCA INTESA SANPAOLO” with the mere substitution of the term “INTESA” with the abbreviation “INTE” to lead consumers to believe that it is affiliated with the Complainant. This, according to the Complainant, represents a clear example of typosquatting.

• Respondent does not have any rights or legitimate interest in the domain name

The Complainant argues that the Respondent has no rights on the disputed Domain Name, and any use of the trademarks “INTESA SANPAOLO” and “BANCA INTESA SANPAOLO” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the Domain Name at issue.

• The domain name has been registered and is being used in bad faith

The Complainant claims that the Domain Name was registered and is used in bad faith. The Complainant’s trademarks “INTESA SANPAOLO” and “INTESA” are distinctive and well known all around the world. The fact that the Respondent has registered a Domain Name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed Domain Name.

The Complainant contends it is evident from a basic Google search in respect of the wordings “INTESA SANPAOLO” and “INTESA”, that 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 Domain Name at issue would not have been registered if it were not for Complainant’s trademark. This is clear evidence of registration of the Domain Name in bad faith.

Moreover, the disputed Domain Name is not used for any bone 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 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 (par. 4(b)(iv) of the Policy).

The Complainant provides that several services can be detected, but not in good faith: in fact, the Domain Name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used. 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 Domain Name at issue.

Therefore, the Complainant deems that the Respondent has registered and is using the Domain Name at issue in order to intentionally divert traffic away from the Complainant's web site.

The Complainant claims that the current use of the disputed Domain Name, which allows accessing to the web sites of the Complainant's competitors, also through the Complainant's trademark, causes, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones. So, the Respondent's conduct is even worse (see WIPO Decisions n. D2000-1500, Microsoft Corporation v. StepWeb, and D2001-1335, The Vanguard Group, Inc v. Venta).

PARTIES CONTENTIONS

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY of the Internet Corporation for Assigned Names and Numbers (ICANN) (the "Policy") provides that Complainant must prove each of the following to obtain transfer or cancellation of the disputed domain names:
1. that Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
2. that Respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.

1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights (Para.4(a)(i) of the Policy).

The Complainant has provided evidence and proved to be the owner of several "INTESA SANPAOLO" and "BANCA INTESA

SANPAOLO" trademarks in various jurisdictions. Essentially, the Respondent has appropriated the trademark "BANCA INTESA SANPAOLO" with the mere substitution of the term "INTESA" with the abbreviation "INTE" to lead consumers to believe that it is affiliated with the Complainant.

The Panel finds that the Respondent's registered Domain Name is confusingly similar to the Complainant's trademarks "INTESA SANPAOLO" and "BANCA INTESA SANPAOLO" since the mere substitution of the term "INTESA" with the abbreviation "INTE" does not eliminate any confusing similarity. This is especially true where, as here, the trademark is "the dominant portion of the domain name," LEGO Juris A/S v. Domain Tech Enterprises, WIPO Case No. D2011-2286, or where the trademark in the domain name represents "the most prominent part of the disputed domain name[] which will attract consumers' attention." Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768.

In addition, 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.

Therefore, the Panel finds that the disputed Domain Name is confusingly similar to the Complainant's trademarks "INTESA SANPAOLO" and "BANCA INTESA SANPAOLO".

2) The Respondent lacks rights or legitimate interests in the disputed domain name (Para. 4(a)(ii) of the Policy).

Under the Policy, a 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 production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see WIPO Overview 2.0, paragraph 2.1).

According to the Complainant, the Respondent has no rights on the disputed Domain Name, and any use of the trademarks "INTESA SANPAOLO" and "BANCA INTESA SANPAOLO" has to be authorized by the Complainant. The Respondent has not been authorized or licensed by the above-mentioned banking group to use the Domain Name at issue.

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed Domain Name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed Domain Name.

3) The disputed domain name has been registered and is being used in bad faith (Paragraph 4(a)(iii) of the Policy).

The Panel agrees with the Complainant that its trademarks "INTESA SANPAOLO" and "BANCA INTESA SANPAOLO" are distinctive and well known globally. The fact that the Respondent has registered a Domain Name that is confusingly similar to them indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent, according to this Panel, had knowledge of the Complainant's trademarks and that they had such knowledge prior to the registration and use of the Domain Name.

The Policy defines that one of the actions which constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy is the use of the domain name to intentionally attempt to attract, for commercial gain, Internet users to respondent's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of respondent's web site or location or of a product or service on respondent's web site or location.

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.

The Panel also believes from the facts of this case that the Respondent has registered and is using the Domain Name to intentionally divert traffic away from the Complainant's web site 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 trademarks 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 reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of the disputed Domain Name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BANCAINTESANPAOLO.COM**: Transferred

PANELLISTS

Name	**Mgr. Barbora Donathová, LL.M.**

DATE OF PANEL DECISION 2019-11-21

Publish the Decision