Decision for dispute CAC-UDRP-102730

Case number	CAC-UDRP-102730
Time of filing	2019-10-22 10:13:02
Domain names	INTESAGROUPS-SANPAOLOO.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	marco castrone

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings, pending or decided, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of trademarks 'INTESA SANPAOLO' and 'GRUPPO INTESA SANPAOLO', registered as follows:

- International trademark registration no. 920896 'INTESA SANPAOLO', granted on March 7, 2007 and renewed, in classes 9, 16, 35, 36, 41 and 42;

- International trademark registration no. 924099 'INTESA SANPAOLO & device', granted on March 27, 2007 and renewed, in classes 9, 16, 35, 36, 41 and 42;

- EU trademark registration no. 5301999 'INTESA SANPAOLO', applied on September 8, 2006, granted on June 18, 2007 and renewed, in classes 35, 36 and 38;

- EU trademark registration no. 5344544 'GRUPPO INTESA SANPAOLO', filed on September 28, 2006, granted on July 6, 2007 and renewed, in connection with classes 35, 36 and 38.

In addition to the registered trademarks, the Complainant is also the owner of the following domain names bearing the

words ‘INTESA SANPAOLO’ and ‘GRUPPO INTESA SANPAOLO’ in the following top-level domains:

- INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ
- INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ
- GRUPPOINTESASANPAOLO.COM, .INFO, .BIZ, .ORG, .NET, .EU
- INTESAGROUP.COM

All of the above domains are connected to the Complainant’s official website.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

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 38,1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). It has a network of approximately 3,900 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 11.8 million customers.

Intesa Sanpaolo also has a strong presence in Central-Eastern Europe with a network of approximately 1,100 branches and over 7.2 million customers. Its international networks specialise in supporting corporate customers 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.

On July 29, 2019, the Respondent registered the domain name <INTESAGROUPS-SANPAOLOO.COM>.

PARTIES CONTENTIONS

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

A. Introduction

This is a Mandatory Administrative Proceeding under paragraph 4 of the Uniform Domain Name Dispute Policy (Policy) of the Internet Corporation for Assigned Names and Numbers (ICANN), and the Procedural Rules for Uniform Domain Dispute Resolution (Rules) including the Czech Arbitration Centre (CAC) UDRP Supplementary Rules.

B. Administrative Deficiencies

By notification dated October 24, 2019 and in accordance with Paragraph 4(d) of the Rules, the CAC notified the Complainant that it was administratively deficient in that it had not sufficiently identified the Respondent.

The CAC directed the Complainant to have regard to the Registrar's verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder.

The CAC requested the Complainant correct the administrative deficiency and submit an Amended Complaint.

On October 25, 2019, the Complainant filed an Amended Complaint and the CAC determined that the Complaint could proceed by way of Administrative Proceeding.

The Panel considers that the administrative deficiency has now been corrected and this matter can proceed to be considered by the Panel in accordance with the Policy and the Rules.

C. Substantive Matters

The Complainant has filed a complaint with supporting evidence disputing the registration of the domain name <INTESAGROUPS-SANPAOLOO.COM> (the disputed domain name) by the Respondent.

The disputed domain name was registered on July 29, 2019.

The Respondent has not filed any administratively compliant response or any materials in response to the Complaint by the deadline set out under the Rules.

Paragraph 15(a) of the Rules provides:

A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

Accordingly, the Complainant carries the onus to prove its case.

Paragraph 4(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no right or legitimate interests in respect of the disputed domain name; and

(iii) The disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

Taking each of these elements in turn:

Paragraph 4(a)(i) - RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

To prove this element, the Complainant must have trademark rights and the disputed domain name must be identical or confusingly similar to the Complainant's trademarks.

The Complainant has adduced evidence that it is the owner of the relevant trademarks and domain names set out in the Identification of Rights section above.

The Panel notes that the Complainant's trademarks and domain names predate the registration of the disputed domain name.

The Complainant contends that the disputed domain name is identical or at least confusingly similar to the Complainant's trademarks as the disputed domain name <INTESAGROUPS-SANPAOLOO.COM> exactly reproduces the Complainant's well-known trademark 'INTESA SANPAOLO', with the mere addition of the word 'GROUPS', between the terms 'INTESA' and 'SANPAOLO', and the addition of the letter 'O' after the verbal portion 'SANPAOLO' making up the disputed domain name 'INTESAGROUPS-SANPAOLOO'.

The Complainant contends that this is a clear example of 'typosquatting' and relies on the WIPO decision of Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc, Case n. D2001-1314 which dealt with the domain names <duetschebank.com> and <duetsche-bank.com>". In that WIPO decision, 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.

The Panel accepts the Complainant's contention.

The Panel considers that the addition of the word 'GROUPS' and the letter 'O' is a play on the Italian word 'GRUPPO' and an alphabetical variation from its trademarks 'INTESA SANPAOLO' and 'GRUPPO INTESA SANPAOLO'.

Additionally, the Panel considers that when a domain name wholly incorporates a complainant's registered trademark, it is sufficient to establish identity or confusing similarity for the purposes of the Policy. See Oki Data Americas, Inc. v. ASD, Inc, WIPO Case No. D2001-0902; Dr. Ing. h.c. F. Porsche AG v Vasiliy Terkin, WIPO Case No D2003-003-0888.

On the evidence adduced by the Complainant as to the extensive use, advertising and revenue associated with its trademarks, the Complainant enjoys a high degree of reputation not only in Italy where it is considered as the 'undisputed leader' in all business areas (retail, corporate and wealth management) but also in Central-Eastern Europe, the Mediterranean area and those areas where Italian companies are most active, such as United States, Russia, China, and India.

Although no evidence of actual confusion has been provided by the Complainant, the Panel, having reviewed the evidence of reputation in support of the Complainant's case, is satisfied that the disputed domain name is likely to cause confusion amongst Internet users given the nature and wide use of the Complainant's trademarks in the classes of goods or services in which they are registered.

Accordingly, the Panel finds that the disputed domain name <INTESAGROUPS-SANPAOLOO.COM> is identical or confusingly similar to the Complainant's trademarks and that paragraph 4(a)(i) of the Policy is satisfied.

Paragraph 4(a)(ii) - NO RIGHTS OR LEGITIMATE INTERESTS

The burden of proof is on the Complainant to establish that the Respondent lacks rights or legitimate interests in the disputed domain name.

Under the Policy, if a prima facie case is established by the Complainant, then the burden of production of evidence shifts to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. See Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110; Croatia Airlines d. d. v. Modern Empire Internet Ltd, WIPO Case No. D2003-0455; Audi AG v. Dr. Alireza Fahimipour, WIPO Case No. DIR2006-0003.

The Complainant advances three contentions in support of this ground:

(a) The Complainant has not granted the Respondent any authorisation or licence to use its trademarks 'INTESA SANPAOLO' and 'GRUPPO INTESA SANPAOLO'.

(b) The disputed domain name does not correspond to the name of the Respondent nor is the Respondent commonly known as 'INTESAGROUPS-SANPAOLOO'.

(c) There is no evidence of any fair or non-commercial use of the disputed domain name but on the contrary, when entering into the disputed domain name website it shows a '403 Forbidden' result.

The Respondent did not submit any administratively compliant response or attempt to demonstrate any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel can draw an adverse inference from the Respondent's failure to respond, in accordance with paragraph 14(b) of the Rules.

The Panel accepts that the Complainant did not grant the Respondent any authorisation or licence to use the Complainant's trademarks in the disputed domain name.

Accordingly, any use by the Respondent of the disputed domain name that incorporates the trademarks 'INTESA SANPAOLO' and 'GRUPPO INTESA SANPAOLO' is not authorised and therefore likely to be an infringement of the Complainant's legal rights.

The Panel accepts on its face the Complainant's contention that the Respondent is not commonly known by the disputed domain name nor has an interest over the disputed domain name nor the major part of it.

The Complainant's evidence suggests that the disputed domain name has not been used by the Respondent in connection with bona fide offering of goods or services. The disputed domain name is currently parked with the notice '403 Forbidden' when accessing the disputed domain name website.

In any event, the Panel considers that it cannot be inferred that the disputed domain name is for use in a fair or legitimate manner, as the disputed domain name pertains to the business, products or services created by the Complainant.

The Panel is satisfied that the use of the disputed domain name cannot be connected to the Complainant or its business, products or services to which the Complainant's trademarks apply.

The Panel is also satisfied that there is no actual or contemplated active use by the Respondent of the disputed domain name that is legitimate.

On the contrary, given the respective priority dates of the Complainant's trademarks and registered domain names, any such

use by the Respondent, to which no evidence to the contrary has been submitted, of the disputed domain name will likely mislead and direct customer or businesses away from the Complainant's legitimate websites.

By the lack of any administratively compliant response from the Respondent, or any other information indicating the contrary, the Panel finds that the Respondent has no rights or legitimate interests in respect of <INTESAGROUPS-SANPAOLOO.COM> and that paragraph 4(a)(ii) of the Policy is satisfied.

Paragraph 4(a)(iii) - BAD FAITH

For the purposes of paragraph 4(a)(iii), paragraph 4(b) of the Policy states that any of the following circumstances shall be considered evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant who is the owner of the trademark or service mark to a competitor of that complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s web site or other on-line location, by creating a likelihood of confusion with the complainant’s trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s web site or location or of a product or service on the Respondent’s web site or location.

The Complainant advances two contentions in support of this ground:

(a) The disputed domain name is being registered in bad faith.

(b) The disputed domain name is being used in bad faith.

The Complainant has generally dealt with contention (a) above concerning its date of registration and authorisation. The Panel accepts the inference, in the context of the evidence adduced by the Complainant and the Respondent's failure to submit any administratively compliant response, that the disputed domain name was registered in bad faith.

Further, upon the evidence adduced by the Complainant, the Panel is also satisfied that the disputed domain name is being used in bad faith.

The Panel has already accepted, as stated above, that the disputed domain name has been parked or is being ‘passively held’ by the Respondent. The incorporation of a well-known mark into a domain name coupled with an inactive website, as in the present case, may be evidence of bad faith registration and use. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; CBS Broadcasting, Inc. v. Dennis Toeppen, WIPO Case No. D2000-0400.

The Panel has also already accepted, as stated above, that the Complainant's trademarks are distinctive and well-known worldwide.

Given the worldwide nature of the Complainant's business and the fact that its trademarks are registered and widely used in Italy and numerous other countries, the Panel considers that it is inconceivable that the Respondent may have registered a domain name adding the word ‘GROUPS’ and the letter ‘O’ to ‘INTESA SANPAOLO’ to form the disputed domain name ‘INTESAGROUPS-SANPAOLO’ without knowing of the Complainant's trademarks and/or domain names. The Complainant has adduced evidence, which the Panel accepts, to demonstrate that a basic Google search of the Complainant’s trademarks would reveal obvious references to the Complainant.

The Panel considers that where it has already found, on the proper evaluation of the evidence submitted by the Complainant, that the disputed domain name has been registered and used in bad faith, there is, prima facie, a risk of a wrongful use of the disputed domain name, including the possibility of use for mala fide purposes. Accordingly, it is reasonable to infer that the Respondent is a cybersquatter and there would not be any legitimate use to which the disputed domain name could be put that would not violate the Complainant’s rights. See WIPO Case No. D2004-0615, Comerica Inc. v. Horoshiy, Inc.

It is, however, unnecessary for the Panel to consider the Complainant’s contention based on its ‘belief’, given no evidence has been adduced by the Complainant for the Panel to properly evaluate such ‘belief’, that the Respondent registered the disputed domain name with ‘phishing’ purpose in order to induce and divert the Complainant’s legitimate customers to its website and steal their money.

Accordingly and in all the circumstances by reference to the evidence submitted by the Complainant and the inferences to be drawn from the Respondent’s failure to submit an administratively compliant response, the Panel considers that the registration and use of the disputed domain name were in bad faith, and paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESAGROUPS-SANPAOLOO.COM**: Transferred

PANELLISTS

Name	**Professor William Lye, OAM QC**

DATE OF PANEL DECISION 2019-11-22

Publish the Decision