Decision for dispute CAC-UDRP-102760

Case number	CAC-UDRP-102760
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Domain names	intesagroups-sanpaolo.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	marco caltagirone

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, inter alia, of the following registrations for the trademarks “INTESA SANPAOLO” and “GRUPPO INTESA SANPAOLO”:

-International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 41 and 42;
-International trademark registration n. 924099 “INTESA SANPAOLO & device”, granted on March 27, 2007 and duly renewed, in classes 9, 16, 35, 36, 41 and 42;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38;
- EU trademark registration n. 5344544 “GRUPPO INTESA SANPAOLO”, granted on July 6, 2007 and duly renewed, in connection with classes 35, 36 and 38.

Moreover, the Complainant is also the owner, amongst others, of the following domain names containing the signs “INTESA SANPAOLO” and “GRUPPO INTESA SANPAOLO”: INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ, GRUPPOINTESASANPAOLO.COM, .INFO, .BIZ, .ORG, .NET, .EU and

INTESAGROUP.COM. All of them are connected to the official website www.intesasanpaolo.com.

FACTUAL BACKGROUND

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

THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is the leading Italian banking group 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 39,3 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,800 branches well distributed throughout the Country, with market shares of more than 15% in most Italian regions, 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 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-SANPAOLO.COM.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant’s contentions are as follows:

The domain name at issue is identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “GRUPPO INTESA SANPAOLO”. As a matter of fact, INTESAGROUPS-SANPAOLO.COM exactly reproduces the well-known trademark “INTESA SANPAOLO”, with the mere addition of the word “groups”, between the terms “INTESA” and “SANPAOLO”, (INTESAGROUPS-SANPAOLO). Therefore, the disputed domain name seems to refer also to the Complainant’s trademark “GRUPPO INTESA SANPAOLO”, “groups” being an English translation.

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

The Respondent has no rights in the disputed domain name, and any use of the trademarks “INTESA SANPAOLO” and “GRUPPO INTESA SANPAOLO” has not been authorized by the Complainant. Nobody has been authorized or licensed by the Complainant’s banking group to use the domain name at issue.

The disputed domain name does not correspond to the name of the Respondent and the Respondent is not commonly known as “INTESAGROUPS-SANPAOLO”.

There are no fair or non-commercial uses of the disputed domain name.

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The disputed domain name INTESAGROUPS-SANPAOLO.COM was registered and is used in bad faith.

The Complainant's trademarks "INTESA SANPAOLO" and "GRUPPO INTESA SANPAOLO" 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. In addition, if the Respondent had carried out even a basic Google search in respect of the wordings "INTESA SANPAOLO" and "GRUPPO INTESA SANPAOLO", 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 a clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bona fide offerings of goods or services. More particularly, there are circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy).

The disputed domain name is not used for any bona fide offerings, even if it is connected to a Registrar's web page without particularly active contents. In fact, countless UDRP decisions confirmed that the passive holding of a domain name with knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, and also the panels' consensus view on this point, as reflected in the "WIPO Overview of WIPO Views on Selected UDRP Questions" at paragraph 3.2.).

In particular, the consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, panels have tended to make such findings in circumstances in which, for example, a complainant's mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the complainant's trade mark rights.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain name has to be considered a use in bad faith: «The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the spectre of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests» (Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., concerning the case of a bank).

The risk of a wrongful use of the domain name at issue is even higher in the present case, since the Complainant has already been targeted by some cases of phishing in the past few years. Such a practice consists of attracting the customers of a bank to a web page which imitates the real page of the bank, with a view to having customers disclose confidential information like a credit card or bank account number, for the purpose of unlawfully charging such bank accounts or withdrawing money out of them. It has happened that some clients of the Complainant have received e-mail messages asking, by the means of web pages which were very similar to the Complainant's ones, for the sensitive data of the Clients, like user ID, password etc. Then, some of the Clients have been cheated of their savings. Also in the present case, the Complainant believes that the current owner registered the disputed domain name in order to induce and divert the Complainant's legitimate customers to its website and steal their money.

Even excluding any "phishing" purposes or other illicit use of the domain name in the present case, anyway the Complainant could find no other possible legitimate use of INTESAGROUPS-SANPAOLO.COM. The sole further aim of the owner of the

disputed domain name might be to resell it to the Complainant, which represents, in any case, an evidence of the registration and use in bad faith, according to par. 4(b)(i) («circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name»).

Lastly, it shall be noted that on August 29, 2019 the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the domain name at issue. Despite such communication, the Respondent did not comply with the above request.

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

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 domain name is confusingly similar to the Complainant's trade mark INTESA SAN PAOLO adding only a hyphen, the generic term 'groups' and the gTLD .com which do not prevent confusing similarity between the disputed domain name and the Complainant's INTESA SANPAOLO mark.

The Respondent is not commonly known by the disputed domain name or authorised by the Complainant.

There has been no use of the disputed domain name and, therefore no evidence of any use of the disputed domain name for a bona fide offering of goods or services or legitimate non commercial or fair use.

Although there is no evidence that the Respondent has tried to sell the disputed domain name or used it for phishing, the disputed domain name is being passively held and contains a mark with a reputation with no justification given for the registration.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2020-01-07

Publish the Decision