Decision for dispute CAC-UDRP-102776

Case number	CAC-UDRP-102776
Time of filing	2020-01-20 10:01:27
Domain names	intesatsanpaolo.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	twopointtwo million

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant uses the domain name <intesasanpaolo.com> which is connected to its official website, and is also the owner of the trademark for the name “INTESA” and for the name “INTESA SANPAOLO”:

- International trademark registration n. 793367 “INTESA”, in class 36, priority September 4, 2002 duly renewed, in class 36;

- EU trademark registration n. 12247979 “INTESA”, in classes 9, 16, 35, 36, 38, 41 and 42, priority October 23, 2013;

- International trademark registration n.920896 “INTESA SANPAOLO”, in class 36, priority March 7, 2007, designating the United States of America;

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, in classes 35, 36 and 38, priority September 8, 2006.

FACTUAL BACKGROUND

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

THE DISPUTED 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 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 41,1 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 capillary and 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.

The Complainant is the owner, among others, of the following registrations for the trademarks “INTESA” and “INTESA SANPAOLO”:

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

-International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in class 36, also covering the United States of America;

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

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

Moreover, the Complainant is also the owner, among the others, 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 www.intesasanpaolo.com.

On October 6, 2019, the Respondent registered the domain name <INTESATSANPAOLO.COM>.

It is more than obvious that the disputed domain name is identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”. As a matter of fact, <INTESATSANPAOLO.COM> exactly reproduces my Client’s well-known trademark “INTESA SANPAOLO”, with the mere addition of the letter “T” between the mark’s verbal portions “INTESA” and “SANPAOLO” (INTESATSANPAOLO). Consequently, the disputed domain name represents a clear example of typosquatting.

In support of the above, the Complainant wishes to draw the Panel’s attention to WIPO decision Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc, Case n. D2001-1314 – regarding the domain names <duetschebank.com> and <duetsche-bank.com>”. 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 case lies before us in this matter.

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

The Respondent has no rights in the disputed domain name, and any use of the trademarks “INTESA SANPAOLO” and “INTESA” 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 disputed domain name does not correspond to the name of the Respondent and, to the best of Complainant´s knowledge, the Respondent is not commonly known as “INTESATSANPAOLO”.

Lastly, the Complainant does not find any fair or non-commercial uses of the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The disputed 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. In addition, if the Respondent had carried even a basic Google search in respect of the wordings “INTESA SANPAOLO” and “INTESA”, the same would have yielded obvious references to the Complainant. The Complainant submited an extract of a Google search in support of its allegation. 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 disputed domain name would not have been registered if it were not for Complainant’s trademark. This is a clear evidence of registration of a domain name in bad faith.

In addition, the disputed domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the disputed 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 [par. 4(b)(iv) of the Policy].

First of all, several services can be detected, but not in good faith: in fact, the disputed 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 disputed domain name.

Therefore, the Complainant deems that the Respondent has registered and is using the disputed domain name in order to intentionally divert traffic away from the Complainant’s website.

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, e.g., Encyclopaedia Britannica Inc. v. Shedon.com, WIPO Case No. D2000-0753 (“Respondent’s Ownership of a site which is a mis-spelling of Complainant’s britannica.com site and which Respondent used to hyperlink to a gambling site demonstrates Respondent’s bad faith registration and use of the britannnica.com domain name”); YAHOO! INC. v. David Murray, Case No. D2000-1013 (finding bad faith where respondent chooses a domain name similar to the complainant’s mark for a site which offers services similar to the complainant); Edmunds.com v. Ultimate Search, Inc., WIPO Case No. D2001-1319 (“Registration and use of a domain name to redirect Internet users to websites of competing organizations constitutes bad faith registration and use under the Policy”); Netwizards, Inc. v. Spectrum Enterprises, WIPO Case No. D2000-1768 (“Registration and continued use of the contested domain name for re-directing Internet users, i.e. particularly customers and potential customers of the

Complainant, from the Complainant's website to the website of…a company which directly competes with the Complainant, constitutes bad faith registration and use"); Oly Holigan, L.P. v. Private, Case No. FA0011000095940 (finding bad faith where respondent used the disputed domain name to "redirect the Complainant's consumers and potential consumers to commercial websites which are not affiliated with Complainant"); Marriott International, Inc. v. Kyznetsov, Case No. FA0009000095648 (finding bad faith where respondent registered the domain name <marriottrewards.com> and used it to route internet traffic to another website that "promotes travel and hotel services . . . identical to the services offered by the Complainant"); Zwack Unicom Ltd v. Duna, WIPO Case No. D2000-0037 (respondent's linking to complainant's competitor held to constitute bad faith); Schneider Electric SA v. Ningbo Wecans Network Technology Co., Ltd, Ningbo Eurosin International Trade Co., Ltd., Case No. D2004-0554; Microsoft Corporation v. StepWeb, Case No. D2000-1500; Baudville, Inc. v. Henry Chan, Case No. D2004-0059; National City Corporation v. MH Networks LLC, Case No. D2004-0128.

The current use of the disputed domain name, which allows accessing to the websites 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).

The Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated.

There is something more. It is no coincidence that this speculation has involved a big financial institution such as Intesa Sanpaolo. In fact, the diversion practice in banking realm is very frequent due to the high number of online banking users. In fact, it has also to be pointed out that the Complainant has already been part of other WIPO Cases where the Panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations.

Lastly, it shall be noted that on November 7, 2019 the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the disputed domain name. 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.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Complainant, INTESA SANPAOLO S.P.A. is the leading Italian banking group. The company was formed 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.

It has a network in Italy of approximately 3,800 branches, giving it a 15% market share in this country. It has an international presence, with some 1,100 branches in 12 countries in Central Eastern Europe, as well as in the Middle East and in North Africa. It also has an international network of specialists in support of corporate customers in 25 countries, incusing in Brazil, Russia, India, China, and the United States, where Respondent is located.

Complainant stated in its Complaint that the <intesatsanpaolo.com> domain name (thereafter the "Disputed Domain Name") was registered on October 6, 2019, by Respondent, but did not provide evidence of the date of the registration of the Disputed Domain Name, such as a copy of the Whois record of the Disputed Domain Name. It provided as evidence a cease and desist letter sent to Respondent by Complainant's counsel on November 7, 2019, c/o the proxy WhoisGuard Protected, which states that the Disputed Domain Name was registered on October 6, 2019.

Under paragraph 10 (d) of the Rules, the Panel determines the admissibility, relevance, materiality and weight of the evidence. The Panel determines that Complainant's counsel declaration on the cease and desist letter sent to Respondent that the disputed domain name was registered on October 6, 2019 as evidence that this is the date of the registration of the disputed domain name.

The Complainant is the owner of several INTESA and INTESA SANPAOLO registered trademarks. The INTESA SAN PAOLO trademark is protected in class 36 in the United States of America by the International Trademark No. 920896 granted on March 7, 2007 and duly renewed, which designates, inter alia, the United States.

The Complainant contends to be the registrant of numerous domain names consisting of and/or containing the INTESA and the INTESA SANPAOLO trademarks, among them <intesasanpaolo.com>, <intesasanpaolo.org>, <intesasanpaolo.eu>, <intesasanpaolo.info>, <intesasanpaolo.biz>, <intesa-sanpaolo.com>, <intesa-sanpaolo.org>, <intesa-sanpaolo.eu>, <intesa-sanpaolo.info, <intesa-sanpaolo.net>, <intesa-sanpaolo.biz>, <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>, which all point to Complainant's official website, www.intesasanpaolo.com.

Complainant, however, did not provide any evidence of these registrations, particularly the date of these registrations, and thus the Panel was not able to assess whether Complainant is indeed the registrant of these domain names, nor was the Panel able to assess whether these domain names have been registered prior to the disputed domain name. Complainant, however, provided evidence that the www.intesasanpaolo.com website indeed points to Complainant's official website, and therefore the Panel will accept the statement that it is indeed Complainant's official website.

RESPONDENT:

Respondent did not respond to Complainant's contentions.

RIGHTS

Paragraph 4(a) of the Policy provides that, in order to divest a respondent of a domain name, a complainant must demonstrate each of the following:

(i) the 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 rights or legitimate interests in respect of the domain name; and

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

I. The Disputed Domain Name is confusingly similar to Complainant's trademarks

Complainant has, to the satisfaction of the Panel, shown that the Disputed Domain Name is identical or confusingly similar to the trademarks in which Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

Complainant is a leading Italian banking group known as INTESA SANPAOLO and provides banking services around the world, including in the United States, Respondent's country of residence.

The disputed domain name reproduces entirely Complainant's INTESA registered trademark and is confusingly similar to Complainant's INTESA SANPAOLO registered trademark.

The disputed domain name is almost identical to INTESA SANPAOLO trademark, but for the mere addition of the "t" between "Intesa" and "SanPaolo", which is not enough to prevent likelihood of confusion. Instead, it is an example of typosquatting, a

practice consisting of registering a domain name which is typographically close to a desirable domain name. A typosquatting registration is “designed to confuse” (WIPO Case No. D2019-1600, <eedbox.com>).

The Panel finds that the disputed domain name is confusingly similar for the purpose of UDRP Paragraph 4(a)(i) to Complainant’s INTESA and INTESA SANPAOLO trademarks.

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

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Complainant has, to the satisfaction of the Panel, shown 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).

Complainant sent Respondent a cease and desist letter on November 7, 2019, which informed Respondent of Complainant’s prior rights in the INTESA and INTESA SANPAOLO trademarks, and informed him that it is <intesasasnpaolo.com> domain name’s registrant.

Respondent did not answer this cease and desist letter.

Respondent did not submit a response to the Complaint either and therefore has not submitted any claim or evidence of rights or legitimate interests he may have in the disputed domain name.

WIPO Overview 3.0, section 2.1, states that “While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

While Respondent has not submitted any information which may allow the Panel to reasonably assume that Respondent has rights or legitimate interest in the disputed domain name, Complainant has stated that Respondent has no rights on the disputed domain name, that it has not been authorized by Complainant to use the INTESA and INTESA SANPAOLO trademarks, nor has it been provided a license to use these two trademarks.

Given the lack of response from Respondent, or any other information indicating the contrary, the Panel concludes that Respondent has no rights or legitimate interests in respect of the disputed domain name, for the purpose of Paragraph 4(a)(ii) of the Policy.

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

III. The Disputed Domain Name has been registered and is being used in bad faith

Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Name has ben registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

WIPO Overview 3.0, section 3.1 explains that Paragraph 4(b) of the Policy provides that any one of the following non-

exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the registrant has registered or the registrant has 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 the registrant's documented out-of-pocket costs directly related to the domain name; or

(ii) the registrant has registered the 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 registrant has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's 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 the registrant's website or location or of a product or service on the registrant's website or location.

A registration in bad faith occurs, inter alia, where the Respondent knew or should have known of the registration and use of the trademarks prior to registering the disputed domain name (WIPO Case No. D2019-2643, <ziprecruitr.com>).

The Panel notes that Complainant's INTESA trademark has been used and registered for more than 17 years and that Complainant's INTESA SANPAOLO trademark has been used and registered for more than 13 years, that they are both protected in several countries around the world, and are thus vested with significant goodwill.

Moreover, a search on Google for INTESA and a search on Google for INTESA SANPAOLO provided as evidence by Complainant demonstrated that all firsts results relate to Complainant and to Complainant's services.

The disputed domain name incorporates Complainant's INTESA trademark in its entirety and reproduces almost exactly its INTESA SANPAOLO trademark which indicates that Respondent knows about Complainant.

As such, Respondent likely had knowledge of Complainant's trademarks prior of registering the disputed domain name and thus the registration was made in bad faith within the meaning of Paragraph 4(b)(iv) of the Policy.

Complainant contends that Respondent has made no use of, or demonstrable preparations to use, either of the domain names in connection with a bona fide offering of goods or services, is not making a legitimate non-commercial or fair use of the disputed domain names, and is not commonly known under the disputed domain name.

The disputed domain name points to a parking page comprised of pay-per-click (PCC) links promoting financial services, which is the service industry where Complainant is active. Respondent profits financially from each click made by web users who are likely to have landed on the page while researching Respondent and its financial services activities. Respondent uses the disputed domain name merely to cause confusion for its commercial benefit via the PCC links placed on the parking page (WIPO Case No. D2019-1764 <siemensenergy.com>).

As such, Respondent uses the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to Respondent website by creating a likelihood of confusion with complainant's INTESA and INTESA SANPAOLO trademarks as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website.

The Panel further notes that Respondent registered the disputed domain name using a privacy proxy service and that it chose not to answer Respondent's counsel's cease and desist letter nor to the Complaint or to Complainant's

communications before filing the Complaint.

These facts, including the absence of a response confirm that Respondent registered and uses the disputed domain name in bad faith to create a likelihood of confusion with Complainant's INTESA and INTESA SANPAOLO trademarks to disrupt Complainant's business.

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 disputed domain name entirely reproduces Complainant's INTESA trademark and fully incorporates Complainant's INTESA SANPAOLO trademark with the mere addition of one letter. It is thus confusingly similar with these marks.

Respondent has not been authorized to use the INTESA and the INTESA SANPAOLO marks, and thus has no rights or legitimate interest in the disputed domain name.

Complainant's trademarks have been used and registered for more than 17 years and 13 years, respectively, and are vested with significant goodwill. The disputed domain name is used to attracts users to a parking page with pay-per-click links promoting financial services. The Panel finds therefore that the disputed domain name has been 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. **INTESATSANPAOLO.COM**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2020-02-21

Publish the Decision