Decision for dispute CAC-UDRP-103004

Case number	CAC-UDRP-103004
Time of filing	2020-04-22 09:38:22
Domain names	INTESAVRIFICADATI.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	Whois Privacy Corp.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is, inter alia, a registered owner of the following trademarks containing word element "INTESA":

(i) INTESA (word), International Trademark, filing (priority) date 4 September 2002, registration no. 793367, registered for services in class 36;

(ii) INTESA (word), EU Trademark, filing (priority) date 23 October 2013, registration no. 12247979, registered for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;

(iii) INTESA SANPAOLO, international Trademark, filing (priority) date 7 March 2007, registration no. 920896, registered for goods and services in classes 36;

(iv) INTESA SANPAOLO, EU trademark, filing (priority) date 8 September 2006, registration no. 5301999, registered for goods and services in classes 35, 36, 38,

besides other national and international trademarks consisting of or containing the "INTESA" wording.

(Collectively referred to as "Complainant's trademarks").

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term „INTESA", such as INTESASANPAOLO.COM (official website), INTESA.COM, INTESA.EU, INTESA.ORG and others.

FACTUAL BACKGROUND

The Complainant (Intesa Sanpaolo S.p.A.) is a leading Italian banking group and also one of the protagonists in the European financial arena. The Complainant 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 disputed domain name was registered on 31 October 2019 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) is automatically redirected to a third party website <care-protect.online> with a malicious content.

The Complainant seeks transfer of the disputed domain names to the Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain name contains the “INTESA” word element of the Complainant's trademarks in its entirety and thus they are almost identical (i.e. confusingly similar) to the Complainant’s trademarks since the domain names differ from the Complainant trademarks only by the descriptive and incorrect Italian expression "VRIFICA DATI" (instead of "VERIFICA DATI", meaning "DATA VERIFICATION" in Italian).

Thus, according to the Complainant the confusing similarity between Complainant’s trademarks and the disputed domain name is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain name.

- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant’s trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name.

- Furthermore, the domain name website has not been used for any legitimate or fair purposes.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain name's registration and such trademarks are well known in relevant business circles. The Respondent can be considered aware of the Complainant's trademarks when registering the disputed domain name due to well-known character thereof, which should have been checked by the Respondent by performing a simple internet search.

- The disputed domain name (at the time of filing of the complaint) 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

- The domain name has been blocked by Google Safe Browsing through a warning page. In the light of the foregoing, the Complainant asserts that the disputed domain name was registered for "phishing" purposes, in order to defraud visitors into providing financial information.

- Even excluding any "phishing" purposes, the disputed domain name was registered and used with the sole purpose of selling the disputed domain name to the Complainant, which constitutes an evidence of the registration and use in bad faith, according to par. 4(b)(i).

- It is well-founded that registration of the disputed domain names that are confusingly similar to the Complainant’s trademarks which enjoys strong reputation, plus other facts, such as above described unfair use of the disputed domain names, are sufficient to establish bad faith under the 4(a)(iii) of the Policy.

- The Complainant refers to previous domain name decisions contending that registering a “phishing” website is perhaps the clearest evidence of registration and use of a domain name in bad faith”, especially when it concerns trademarks of financial institutions that enjoy high level of notoriety and well-known character.
- Complainant has tried to reach the Respondent by a cease-and-desist letter requesting that the Respondent voluntary transfers the disputed domain name to the Complainant, with which they did not comply.

The Complainant presents the following evidence that has been assessed by the Panel:

- Information about the Complainant and its business;
- Excerpts from various trademark databases regarding Complainant's trademarks and copies of certificates of registration of such trademarks;
- Screenshots of the disputed domain name website;
- Screenshots of Google search results for “INTESA SANPAOLO”;
- A letter from Complainant to Respondent (dated 27 November 2019) requesting transfer of the disputed domain name to the Complainant;
- Various WIPO ADR decisions concerning similar domain names disputes.

RESPONDENT:
The Respondent has not provided any response to the complaint.

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

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

RIGHTS

The disputed domain name and the Complainant’s trademarks are nearly identical since both fully incorporate the word “INTESA”.

Since the disputed domain name and the Complainant’s trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of a term “INTESAVRIFICADATI” is confusingly similar to the Complainant’s trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the disputed domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name. An addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name in question.

Applying the principles described above, the Panel contends that incorporation of a dominant “INTESA” element of Complainant’s trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitutes confusing similarity between the Complainant’s trademark and the disputed domain name. Addition of a non-distinctive element – incorrect, descriptive term “VRIFICADATI” (misspelled Italian words " VERIFICA DATI") cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant’s trademarks and thus the likelihood of confusion still exists. On the contrary, it may mislead the internet users that the disputed domain name is somehow related to Complainant's business.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the “.com”) must be disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant’s assertions that the Respondent is not commonly known by the disputed domain names and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

Given the facts above and in the absence of the Respondent's response, the Panel concludes that there is no indication that the disputed domain names were intended to be used in connection with a bona fide offering of goods or services as required by UDRP.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or

legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

BAD FAITH

It is clear that by adding the phrase "VRIFICA DATI" to the Complainant trademarks, it was the Respondent's intention to target Internet users who are searching for more specific information (about data verification) about the Complainant and would type incorrectly into their web browser, an illicit activity recognised as „typosquatting". There are several different reasons for typosquatting, as for example:

- to try to sell the disputed domain back to the Complainant;
- to monetize the disputed domain through advertising revenues from direct navigation misspellings of the intended domain;
- to redirect the typo-traffic to Complainant's competitor;
- as a phishing scheme to mimic the Complainant's site, while intercepting passwords or other information which the visitor enters unsuspectingly;
- to install drive-by malware or revenue generating adware onto the visitors' devices;
- to harvest misaddressed e-mail messages mistakenly sent to the typo domain.

All of the activities above are considered as malicious activities.

For the reasons described above, since (i) there is only a remote chance that the Respondent has registered the disputed domain name just by a chance and without having a knowledge about the existence of the Complainant's rights and business, and (ii) the Respondent is engaged in typosquatting, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith.

Thus, the Panel has taken a view that 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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESAVRIFICADATI.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2020-06-01

Publish the Decision