Decision for dispute CAC-UDRP-103026

Case number	CAC-UDRP-103026
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Domain names	VERIFICA-INTESANPAOLO.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	salvatore sanzone

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 submitted evidence that it is the registered owner of the following registrations for the trademarks "INTESA" and "INTESA SANPAOLO":

- the international trademark registration No. 793367 for "INTESA", registered since 4 September 2002 for the class 36;

- the international trademark registration No. 920896 for "INTESA SANPAOLO", registered since 7 March 2007 for the classes 9, 16, 35, 36, 41 and 42;

- the EU trademark registration No. 12247979 for "INTESA", applied on 23 October 2013 and granted on 5 March 2014, for the classes 9, 16, 35, 36, 38, 41 and 42;

- the EU trademark registration No. 5301999 for "INTESA SANPAOLO", applied on 8 September 2006, granted on 18 June 2007, for the classes 35, 36 and 38; and

- the Italian trademark registration No. 1042140 for "INTESA SANPAOLO", applied on 2 February 2007, granted on 7 March

2007, for the classes 9, 16, 35, 36, 38, 41 and 42.

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 1 January 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 26.1 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 1,000 branches and over 7.2 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.

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 <http://www.intesasanpaolo.com>.

The disputed domain name <verifica-intesanpaolo.com> was registered on 9 September 2019.

The Complainant’s representatives sent a cease and desist letter to the Respondent on 23 October 2019 asking for the voluntary transfer of the disputed domain name, but the Respondent did not comply with such request.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is English.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

The Complainant argues that 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, VERIFICA-INTESANPAOLO.COM exactly reproduces the Complainant’s well-known trademark "INTESA SANPAOLO", with the mere omission of letters "S" and "A" in the mark’s verbal portion "INTESA" and the addition of the Italian descriptive term "VERIFICA", meaning "VERIFICATION".

The Complainant further contends that the Respondent has no right or legitimate interest in respect of the disputed domain name. In particular, the Complainant states that the Respondent has no rights on the disputed domain name, and any use of the trademark "INTESA SANPAOLO" and "INTESA" has to be authorized by the Complainant, whereas nobody has been authorized or licensed by the Complainant to use the disputed domain name.

The disputed domain name does not correspond to the name of the Respondent and, to the best of the Complainant's knowledge, the Respondent is not commonly known as "VERIFICA-INTESANPAOLO".

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

Turning to the bad faith argument, the Complainant asserts that its trademarks "INTESA" and "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 even a basic Google search in respect of the wordings "INTESA" and "INTESA SANPAOLO", the same would have yielded obvious references to the Complainant. The Complainant submitted 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 the Complainant's trademark. The Complainant argues that this is a clear evidence of registration of the domain name in bad faith.

In addition, the Complainant submits that the disputed domain name is not used for any bona fide offerings. More particularly, there are present circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name 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 (paragraph 4(b)(i) of the Policy).

The disputed domain name is not used for any bona fide offerings, even if it is not connected to any web site, at the time of filing the Complaint. The Complaint refers to numerous UDRP decisions which 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 (e.g. WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows, and also paragraph 3.2 of the WIPO Jurisprudential Overview 3.0). In particular, the Complainant infers that the consensus view of the WIPO UDRP panels 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.

As regards the first aspect, the Complainant argues it has extensively proved the renown of its trademarks. For what concern the second circumstance, the Complainant states that it is objectively not possible to understand what kind of use the Respondent could make with the disputed domain name which does exactly correspond to the Complainant's trademarks and that is so similar to the Complainant's domain names currently used by the Complainant to provide online banking services for enterprises.

The Complainant then quotes the reasoning from the WIPO Case No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., and concludes that the present case completely matches the above requirements and that the passive holding of the disputed domain name has to be considered a use in bad faith.

Pursuant to the Complainant, the risk of a wrongful use of the disputed domain name 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 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, the sensitive data of the clients, like user ID, password etc. Then, some of the clients have been cheated of their savings.

Even excluding any "phishing" purposes or other illicit use of the disputed domain name, the Complainant could find any other possible legitimate use of VERIFICA-INTESANPAOLO.COM anyway. 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 paragraph 4(b)(i) of the Policy.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

According to Paragraph 4(a) of the Policy, a complainant must prove 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; (ii) the respondent has no rights or legitimate interests in respect of the domain name; (iii) the domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar domain name

The Complainant demonstrated that it owns the asserted trademark registrations for the word marks "INTESA SANPAOLO" and "INTESA", all of which were registered long before the registration of the disputed domain name by the Respondent. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

It is also well established that the generic top-level suffix .com may be disregarded when considering whether a disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights, as it is a necessary technical requirement of a domain name.

The disputed domain name incorporates the Complainant's trademark "INTESA SANPAOLO", except that the letters "SA" which happen to be both at the end of "INTESA" as well as the beginning of "SANPAOLO" are missing. Such small omission however has virtually no effect on the overall similarity between the "INTESA SANPAOLO" trademark and the "INTESANPAOLO" element in the disputed domain name, both phonetically and visually.

The adding of the terms "VERIFICA-" must be considered as insufficient to prevent or diminish confusing similarity. The

Panel believes that such addition does not change the overall impression of the disputed domain name as being connected to the Complainant's trademarks "INTESA" and "INTESA SANPAOLO", particularly given the descriptiveness of the added word "VERIFICA". With respect to financial services for which the Complainant's trademarks are registered, and which is the main area of the Complainant's business, the word "verifica" (Italian for "verification") would be commonly used in connection with the verification of access or verification of a transaction. Therefore, the Panel is of the view that such addition cannot prevent the likelihood of confusion between the disputed domain name and the Complainant's trademarks.

The Panel, therefore, finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights.

B. Lack of rights or legitimate interests

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not in any way connected with the Complainant nor is it authorized to use the Complainant’s trademark for its commercial activities. In addition, the Respondent is not commonly known by the disputed domain name pursuant to Paragraph 4(c)(ii) of the Policy. Furthermore, it was demonstrated by evidence submitted by the Complainant that the disputed domain name has not been used for a bona fide offering of goods or services or a legitimate non-commercial or fair use.

The Panel, therefore, finds that the Respondent has no rights or legitimate interest in the disputed domain name.

C. Registration and use of the disputed domain name in bad faith

With respect to the bad faith argument, the Complainant states, in summary: (a) that the disputed domain name is confusingly similar to its well-known trademarks; (b) that the Respondent had actual knowledge of the Complainant's rights in its trademarks; (c) that the disputed domain name is not used for any bona fide offerings; and (d) that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the Complainant or to a competitor of the Complainant.

The Panel has already found that the disputed domain name is confusingly similar to the Complainant's trademarks "INTESA" and "INTESA SANPAOLO". It is well established that mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith.

In addition, the Panel believes that the Complainant submitted evidence that sufficiently demonstrates the Respondent must have (or should have) been aware of the existence of the Complainant, its trademarks and its numerous domain names, and the Complainant is a prominent undertaking especially in the banking and financial sector on the national (Italian) as well as global basis. It is really difficult to conceive that the Respondent, being domiciled also in Italy, would have no prior knowledge of the Complainant and it is equally difficult to find any good faith reason for the registration of the disputed domain name by the Respondent.

With respect to the fact that the disputed domain name has not been put to any use, the Panel notes that the so-called passive holding of a domain name cannot prevent a finding of bad faith. In this present case, the Complainant's trademarks are distinctive, the Respondent failed to respond to the Complaint and there seems no plausible good faith use for the disputed domain name. Quite the contrary, the Panel agrees with the Complainant that there is a relatively high risk that the disputed domain name could be used for "phishing" activities or other wrongful use. The Complainant has not submitted any evidence of actual "phishing" activity on the disputed domain name but that does not prevent the finding of bad faith registration of the disputed domain name.

The Panel has not been, however, satisfied that the Respondent has registered or acquired the disputed domain name

primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the Complainant or to a competitor of the Complainant. There is no support for such a conclusion in the facts of the case, nor in the evidence submitted by the Complainant.

Nevertheless, the Panel still concludes that several signs of bad faith in registering and use of the disputed domain name by the Respondent can be found in this case. Therefore, the Panel finds that the disputed domain name has been registered and has been used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by Paragraph 4(a) of the Policy were met and makes the following decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **VERIFICA-INTESANPAOLO.COM**: Transferred

PANELLISTS

Name	**Mgr. Vojtěch Chloupek**

DATE OF PANEL DECISION 2020-06-08

Publish the Decision