Decision for dispute CAC-UDRP-103023

Case number	CAC-UDRP-103023
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Domain names	INTIESSASANPAOLO.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	alaa ddin

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

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 04, 2002 and duly renewed, in class 36;
- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 2007 and duly renewed, in classes 9, 16, 35, 36, 41, 42;
- EU trademark registration n. 12247979 “INTESA”, applied on October 23, 2013 and granted on March 05, 2014, in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 08, 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

http://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 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 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.

On January 30, 2020, the Respondent registered the domain name INTIESSASANPAOLO.COM.

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 “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 domain name at stake does not correspond to the name of the Respondent and the Respondent is not commonly known as “INTIESSASANPAOLO”.

Lastly, there is no fair or non-commercial use of the domain name at stake.

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The domain name INTIESSASANPAOLO.COM was registered and is used in bad faith.

The Complainant’s 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. 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 bone fide offerings. More particularly, there are present 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 bone fide offerings, even if it is not connected to any web site.

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 specter 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 just 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.

Even excluding any "phishing" purposes or other illicit use of the domain name in the present case, the Complainant could find no other possible legitimate use of INTIESSASANPAOLO.COM. The sole further aim of the owner of the domain name under consideration 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»).

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.

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

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According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the Disputed domain name should be transferred or cancelled:

(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 rights 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 has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Disputed domain name is confusingly similar to the Complainants' Trademark, company name and domain. This finding is based on the well-established practice of disregarding the top-level suffix in the domain name (i.e. ".com") in evaluating the existence of a likelihood of confusion and holding that in cases of mere typo squatting, where the domain name in question is a mere variation of a famous name, and in this case, is pronounced practically identically to the name of the Complainant INTESA SANPAOLO, there is a likelihood of confusion due to the confusing similarity of the names.

The Disputed domain name INTIESSASANPAOLO.COM includes a letter "I" and a third letter "S". Such typographical errors can easily be made by internet users, especially when languages are involved which may not be the users' native language. This was the case e.g. in the decision Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc, WIPO Case n. D2001-1314 concerning the domain names <duetschebank.com> and <duetsche-bank.com>". It was concluded that these names also were confusingly similar. The same reasoning applies to the case on hand.

The Panel therefore comes to the conclusion that the Complainants have satisfied the requirement under paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the Disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP which has been concluded e.g. in WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

The Complainants have put forward that the Respondent is not commonly known by the Disputed domain name. Neither is the Respondent in any way related to the Complainants. Nor has the Respondent been granted an authorization or license to use the Disputed domain name by the Complainants. This has not been contested by the Respondent. Instead, the Respondent failed to provide any information or evidence whatsoever that could have shown 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).

The Panel therefore also concludes that the Respondent did not establish any right or legitimate interest to the Disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainants have therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainants have established that the Disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainants have successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the Disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the Disputed domain name. It does not appear to be connected to any website.

Past UDRP decisions have 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 panelists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. 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 to the first aspect, the Complainant has extensively shown the reputation of its trademarks. As far as the second condition is concerned, it must be underlined that it is objectively not possible to comprehend the type of use the Respondent could make of a domain name which is so close to the Complainant's trademarks and so similar to the Complainant's domain names currently used by the latter to provide online banking services for enterprises.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the contested 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 specter 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.).

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. Even excluding any "phishing" purposes or other illicit use of the domain name in the present case, there appears to be no other possible legitimate use of INTIESSASANPAOLO.COM. The sole further aim of the owner of the domain name under consideration might be to resell it to the Complainant, which represents evidence of 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»).

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.

Therefore, the Panel concludes that the Respondent has registered and is using the Disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainants have therefore also satisfied the requirement under 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. **INTIESSASANPAOLO.COM**: Transferred

PANELLISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2020-06-29

Publish the Decision