Decision for dispute CAC-UDRP-103063

Case number	CAC-UDRP-103063
Time of filing	2020-05-25 09:43:59
Domain names	INTESSAAPPAOLO.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

Name	mr. alaa bennis

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other pending or decided legal proceedings, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant bases its Complaint on the:

- International trademark registration “INTESA”, no. 793367, registered on September 4, 2002, for services in class 36, designating several countries for protection;

- International trademark registration “INTESA SANPAOLO”, no. 920896, registered on March 7, 2007, for goods and services in classes 9, 16, 35, 36, 41, 42, designating several countries for protection;

- EU trademark registration “INTESA”, no. 12247979, filed on October 23, 2013, registered on March 5, 2014, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;

- EU trademark registration “INTESA SANPAOLO”, no. 5301999, filed on September 8, 2006, registered on June 18, 2007, for services in classes 35, 36 and 38.

FACTUAL BACKGROUND

The Complainant is Intesa Sanpaolo S.p.A., a 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 Italy, 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.

The Complainant owns several trademarks “INTESA” and “INTESA SANPAOLO” such as:

- International trademark registration “INTESA”, no. 793367, registered on September 4, 2002, for services in class 36, designating several countries for protection;

- International trademark registration “INTESA SANPAOLO”, no. 920896, registered on March 7, 2007, for goods and services in classes 9, 16, 35, 36, 41, 42, designating several countries for protection;

- EU trademark registration “INTESA”, no. 12247979, filed on October 23, 2013, registered on March 5, 2014, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;

- EU trademark registration “INTESA SANPAOLO”, no. 5301999, filed on September 8, 2006, registered on June 18, 2007, for services in classes 35, 36 and 38.

The Complainant is also the owner of a large domain names portfolio, including the signs “INTESA SANPAOLO” and “INTESA”, such as: 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 <INTESSAAPPAOLO.COM> was registered on January 20, 2020 and is connected to a Registrar’s web page without particular active contents.

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

I. Confusing Similarity

The Panel agrees that the mere addition of letters “S” and “A” in the mark’s verbal portion “INTESA” and of the letter “P” in the term “SANPAOLO” excluding also the letter “N” is insufficient to avoid confusing similarity.

As a matter of fact, despite the slight misspelling, the Complainant’s trademark is still recognizable within the disputed domain name. Previous UDRP CAC and WIPO decisions have recognized that typosquatting usually entails a finding of confusing similarity for the purpose of the first element under the Policy.

Moreover, the extension “.com” is not to be taken into consideration when examining the similarity between the Complainant’s trademarks and the disputed domain name (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as “.com” is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L’Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name. The Respondent is not a licensee of, nor has any kind of relationship with the Complainant. The Complainant has never authorised the Respondent to make use of its trademarks, nor of a confusingly similar trademark in the disputed domain name.

Finally, the disputed domain name is a typosquatted version of the Complainant’s trademarks and is connected to a Registrar’s web page without particular active contents. Such use does not amount to a bona fide offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name.

The Panel notes that the Respondent had an opportunity to comment on the Complaint’s allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

Based on the provided proofs, the Complainant's trademark “INTESA SANPAOLO” is a well known one and the disputed

domain name is a typosquatting of the Complainant's trademark. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark and has intentionally registered one of its possible misspellings.

Numerous UDRP panels have found that typosquatting constitutes bad faith (see, amongst others, FORUM case no. FA0612000877979, Microsoft Corp. v. Domain Registration Philippines; ARCELORMITTAL S.A. v. stave co ltd, CAC Case No. 102180; Calvin Klein Trademark Trust, Calvin Klein, Inc. v. Moniker Privacy Services, WIPO Case No. D2015-2305; Wikimedia Foundation Inc v. Privacy Protect.org/Domain Tech Enterprises, WIPO Case No. D2015-1705; Moneyweek Limited v. he jianyi Case No. D2015-1700).

The disputed domain name is connected to a Registrar's web page without particular active contents and thus, being passively held. Under certain circumstances, the passive holding of a domain name cannot prevent a finding of bad faith. Factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put (See paragraph 3.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (WIPO Jurisprudential Overview 3.0)).

In the present case, the following factors should be considered:

(i) the Complainant's trademark is a well-known one;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;

(iii) the Respondent registered the disputed domain name containing an obvious, common and intentional misspelling of the Complainant's trademark, which is a typical pattern used for abusive "typosquatting" registrations; and

(iv) any good faith use of the disputed domain name would be implausible, as the trademark INTESA SANPAOLO is univocally linked to the Complainant and the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name confusingly similar to the Complainant's trademark.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESSAAPPAOLO.COM**: Transferred

PANELLISTS

Name	**Delia-Mihaela Belciu**

DATE OF PANEL DECISION 2020-06-30

Publish the Decision