# Decision for dispute CAC-UDRP-103098

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| Case number | CAC-UDRP-103098 |
| Time of filing | 2020-06-08 11:55:55 |
| Domain names | CLIENTE-INTESASANPAOLO.ONLINE |

## Case administrator

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| Name | Šárka Glasslová (Case admin) |

## Complainant

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| Organization | Intesa Sanpaolo S.p.A. |

## Complainant representative

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| Organization | Perani Pozzi Associati |

## Respondent

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| Name | Mina Haase |

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings the Panel is aware of which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following registrations for the trademarks “INTESA” and “INTESA SANPAOLO” (enclosed as Annex B):

- 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.

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 24,9 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,700 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.

On January 21, 2020, the Respondent registered the domain name CLIENTE-INTESASANPAOLO.ONLINE.

It is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”. As a matter of fact, CLIENTE-INTESASANPAOLO.ONLINE exactly reproduces my Client’s well-known trademark “INTESA SANPAOLO”, with the mere addition of the Italian descriptive term "CLIENTE", meaning “client”, which refers to Complainant's services users.

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

The Respondent has no rights on 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, to the best of Complainant´s knowledge, the Respondent is not commonly known as “CLIENTE-INTESASANPAOLO”.

Lastly, the Complainant does not find any fair or non-commercial uses of the domain name at stake ( as may be seen from the disputed domain name’s home - page,).

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH
The domain name CLIENTE-INTESASANPAOLO.ONLINE 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. The Complainant submits 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 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 bona 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 bona fide offerings, even if it is not connected to any web site, by now. In fact, countless UDRP decisions 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, enclosed as Annex E, 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. 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 to the first aspect, the Complainant has already extensively proved the renowned of its trademarks. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant’s trademarks and that results 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., 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. 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 domain name in the present case, anyway we could find no other possible legitimate use of CLIENTE-INTESASANPAOLO.ONLINE. 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).

The Complainant is the owner 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.

The disputed domain name is identical to the registered trademark, plus the generic word 'cliente' referencing a client of the Complainant.

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).

The Respondent apparently has no authority to use the trademarks “INTESA SANPAOLO” and “INTESA”. The domain name at stake does not correspond to the name of the Respondent. There is no evidence of any fair or non-commercial use of the domain name at stake.

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).

The Complainant’s trademarks “INTESA” and “INTESA SANPAOLO” are distinctive and registered in the EU. 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. 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 indicates registration of the domain name in bad faith, particularly as this disputed domain name could be used for phishing attempts because it could be confusingly similar to a login URL.

The disputed domain name apparently is not used for any bona fide offering of goods or services, or for any legitimate non-commercial purpose. Some UDRP decisions confirm 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). 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. Complainant has demonstrated those elements to the satisfaction of the panel.

This is a close case, as there is no documented use of the domain name, other than "passive holding" of a domain that is more likely to be used to impersonate a bank login URL than for any other conceivable purpose. The Respondent has not appeared to defend her registration or document any other use or intent to use the domain. Thus the panel finds inferences in favor of the Complainant, particularly because of the potential for phishing with this domain. 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.

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 Complainant's trademarks "INTESA" and "INTESA SANPAOLO" are distinctive and registered in the EU.

The disputed domain name apparently is not used for any bona fide offering of goods or services, or for any legitimate non-commercial purpose.

UDRP panels have found bad faith in circumstances in which 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.

The Respondent has not appeared to defend her registration or document any other use or intent to use the domain. Thus the panel finds inferences in favor of the complainant, particularly because of the potential for phishing with this domain.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CLIENTE-INTESASANPAOLO.ONLINE**: Transferred

## PANELLISTS

| Name | **Mike Rodenbaugh** |
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DATE OF PANEL DECISION 2020-07-02

Publish the Decision