Decision for dispute CAC-UDRP-103092

Case number	CAC-UDRP-103092
Time of filing	2020-06-08 11:56:09
Domain names	INTESA-SAMPAOLO.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	marco rizzoli

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns the following trade mark registrations:

• International trade mark registration number 793367 for INTESA, which was registered on 4 September, 2002 in class 36;
• International trade mark registration number 920896 for INTESA SANPAOLO, which was registered on 7 March, 2007 in classes 9, 16, 35, 36, 38, 41 and 42;
• EU trade mark registration number 12247979 for INTESA, which was registered on 5 March, 2014, in classes 9, 16, 35, 36, 38, 41 and 42; and
• EU trade mark registration number 005301999 for INTESA SANPAOLO, which was registered on 18 June, 2007, in classes 35, 36 and 38.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is an Italian banking group, resulting from the merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A.

The Complainant owns trade mark registrations for INTESA SANPAOLO and INTESA. It also owns numerous domain names incorporating those name, which are connected to the Complainant's official website <http://www.intesasanpaolo.com>.

The Respondent registered the disputed domain name on 27 February, 2020.

On 19 March, 2020 the Complainant's attorneys sent the Respondent a cease and desist requesting the voluntary transfer of the disputed domain name. The Respondent did not comply with this request.

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 trade mark 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

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements:
(i) The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
(ii) The Respondent has no rights or legitimate interests in the disputed domain name; and
(iii) The disputed domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar

The Complainant submits that the disputed domain name is identical or confusingly similar to the Complainant's trade marks INTESA SANPAOLO and INTESA. It asserts the Respondent is typo squatting because the disputed domain name exactly reproduces its well-known trade mark INTESA SANPAOLO, except for the substitution of the letter "N" in SANPAOLO with the letter "M".

It is generally accepted that the addition of the top-level suffix ".com" does not add any distinctiveness to a domain name and can be disregarded when assessing whether the disputed domain name is confusingly similar to the Complainant's trade mark. (See International Business Machines Corporation v. Sledge, Inc./Frank Sledge, WIPO Case No. D2014-0581.)

Ignoring the top-level suffix ".com", the only difference between the Complainant's well-known mark is the letter "M" in place of the letter "N" in SANPAOLO and the addition of a hyphen between the INTESA and SAMPAOLO. The change of a single letter and the addition of a hyphen does not avoid the conclusion that the disputed domain name is confusingly similar to the Complainant's INTESA SANPAOLO trade mark.

The Panel therefore finds that the disputed domain name is confusingly similar to the Complainant's trade mark INTESA SANPAOLO and that the requirements of paragraph 4(a)(i) of the Policy have been met.

B. No rights or legitimate interests

The Complainant asserts that:

(i) Any use of its trade marks INTESA and INTESA SANPAOLA must be authorised by the Complainant and states that it has not authorised or licensed the Respondent to use the disputed domain name.
(ii) The disputed domain name does not correspond to the name of the Respondent, nor is the Respondent commonly known as Intesa-Sampaola.
(iii) The homepage of the website using the disputed domain name shows no fair or non-commercial use of the disputed domain name.

The Complainant has established a prima facie case that the Respondent lacks rights in the disputed domain name. The Respondent has not filed a Response nor denied any of the Complainant's assertions that the Respondent lacks rights or legitimate interests in the disputed domain name. There is nothing to show that the Respondent has any rights in the disputed domain name, nor any evidence to show that it has used, or intends to use the disputed domain name in connection with a bona fide offering of goods or services, or is commonly known by the disputed domain name, or that it is making a legitimate non-commercial or fair use of the disputed domain name.

Considering all the circumstances and the evidence submitted, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been met.

C. Registered and used in bad faith

The Complainant asserts that:

(i) The trade marks INTESA and INTESA SANPAOLO are distinctive and well-known all around the world. The fact that the Respondent registered the disputed domain name that is confusingly similar to its trade marks indicates that the Respondent knew of the Complainant's trade marks when registering the disputed domain name. If the Respondent had carried out a basic Google search for INTESA and INTESA SANPAOLO it would have yielded obvious references to the Complainant. It submits this is evidence of registration of the domain name in bad faith.
(ii) The disputed domain name is not used for any bone fide offerings and the website associated with it has been blocked by Google Safe Browsing through a warning page. The main purpose of the Respondent was to use the website for "phishing" financial information in an attempt to defraud the Complainant's customers.
(iii) There appears no possible legitimate use of the disputed domain name.
(iv) On 19 March, 2020 the Complainant's attorneys sent the Respondent a cease and desist letter but the Respondent did not comply.

The Complainant's well-known trade marks predate the registration of the disputed domain name. The use of the disputed domain name for "phishing" is clear evidence that it was registered and is being used in bad faith. (See The Royal Bank of Scotland Group plc v. Secret Registration Customer ID 232883/Lauren Terrado, WIPO Case No. D2012-2093.) The website associated with the disputed domain name has been blocked by Google. The Respondent has not filed a Response to dispute the Complainant's submissions, nor submitted any actual or intended good-faith use, nor responded to the cease and desist letter.

Having considered the submissions and evidence submitted, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-SAMPAOLO.COM**: Transferred

PANELLISTS

Name	**Veronica Bailey**

DATE OF PANEL DECISION 2020-07-08

Publish the Decision