Decision for dispute CAC-UDRP-103104

Case number	CAC-UDRP-103104
Time of filing	2020-06-16 09:02:17
Domain names	INTESASANPALO.INFO, INTESANPAOLO.INFO

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	ms tonkin katia sonia

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Names.

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it is the owner of multiple registrations for the trademarks INTESA and INTESA SANPAOLO, including Int'l Reg. No. 793,367 for INTESA (registered September 4, 2002); and Int'l Reg. No. 920896 for INTESA SANPAOLO (registered March 7, 2007). These marks are referred to hereafter as the "INTESA Trademark."

FACTUAL BACKGROUND

Complainant states that it "the leading Italian banking group and also one of the protagonists in the European financial arena"; that it "is among the top banking groups in the euro zone, with a market capitalisation exceeding 27,2 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management)"; that it has "approximately 3,700 branches" in Italy; and that it "offers its services to approximately 11,8 million customers" in Italy.

Complainant is the registrant of and uses the domain name <intesasanpaolo.com> in connection with its "official website."

Paragraph 4(a)(i): Complainant states, inter alia, that the Disputed Domain Names are confusingly similar to the INTESA

Trademark because they “exactly reproduce the well-known trademark ‘INTESA SANPAOLO’”; the Disputed Domain Name <intesasanpalo.info> merely omits a letter “o” from the same trademark; and the Disputed Domain Name <intesanpaolo.info> merely omits the letters “s” and “a” from the same trademark.

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in the Disputed Domain Names because, inter alia, Complainant has not “authorized or licensed” Respondent to use the INTESA Trademark; the Disputed Domain Names “do not correspond to the name of the Respondent and, to the best of [Complainant’s] knowledge, the Respondent is not commonly known as ‘INTESASANPALO’ and ‘INTESANPAOLO’”; and Complainant “do[es] not find any fair or non-commercial uses of the domain names at stake.”

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Names were registered and are being used in bad faith because, inter alia, the INTESA Trademark is “distinctive and well known all around the world”; “the consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith”; “[t]he risk of a wrongful use of the domain names 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”; “Complainant believes that the current owner registered the disputed domain names with the “phishing” purpose, in order to induce and divert the Complainant’s legitimate customers to its website and steal their money and the above could be easily verified given the particular nature of the disputed domain names”; and Respondent did not reply to a demand letter from Complainant sent on April 3, 2020.

PARTIES CONTENTIONS

No administratively compliant response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Names are 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 Names (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 Names have been registered and are 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

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the trademark registration cited by Complainant, it is apparent that Complainant has rights in and to the INTESA Trademark.

As to whether the Disputed Domain Names are identical or confusingly similar to the INTESA Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Names only (i.e., “intesasanpalo” and “intesanpaolo”) because “[t]he applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.” WIPO

Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.11.1.

Here, each of the Disputed Domain Names contains the trademark INTESA in its entirety. As set forth in section 1.7 of WIPO Overview 3.0, "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Further, as noted above, each of the Disputed Domain Names contains only minor variations of the trademark INTESA SANPAOLO. As set forth in, section 1.9 of WIPO Overview 3.0 states: "A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element."

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states, inter alia, that Complainant has not "authorized or licensed" Respondent to use the INTESA Trademark; the Disputed Domain Names "do not correspond to the name of the Respondent and, to the best of [Complainant's] knowledge, the Respondent is not commonly known as 'INTESASANPALO' and 'INTESANPAOLO'"; and Complainant "do[es] not find any fair or non-commercial uses of the domain names at stake."

WIPO Overview 3.0, section 2.1, states: "While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has 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 the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

Further, section 3.3 of WIPO Overview 3.0 states: "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding." The same section adds: "While panelists will look at the totality of the circumstances in each case, 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."

Here, the Panel finds that the INTESA Trademark has a high degree of distinctiveness or reputation. Further, Respondent has not only failed to submit a response to the complaint, but Respondent also failed to reply to Complainant's demand letter. Therefore, the Panel finds that the passive holding doctrine is applicable here.

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPALO.INFO**: Transferred
2. **INTESANPAOLO.INFO**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2020-07-14

Publish the Decision