Decision for dispute CAC-UDRP-103107

Case number	CAC-UDRP-103107
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Domain names	SICUREZZA-INTESA-SAN-PAOLO.ONLINE, INTESA-SAN-PAOLO-SICUREZZA.ONLINE

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	alberto porro

OTHER LEGAL PROCEEDINGS

The Complainant has declared that there are no other legal proceedings, pending or decided, which relate to the disputed domain name. The Panel is not aware of any such proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of various trade marks, including EUTM 'INTESA SANPAOLO' (5301999) first granted in 2007 and subsequently renewed, subsisting in a number of classes including financial services.

FACTUAL BACKGROUND

The Complainant, a financial services business with its seat in Italy, took on its present form in 2007 after a merger. As well as its primary operations in Italy, it is active in various EU member states and European states, and in selected other jurisdictions. Its activities include retail and corporate banking. In this context, it also operates its own websites at domain names including <INTESASANPAOLO.COM> and variants with different top-level domains (e.g. <INTESA.CO.UK> or with a hyphen between INTESA and SANPAOLO (e.g. <INTESA-SANPAOLO.COM>).

The Respondent, an individual or individuals, with an address or addresses in Italy, registered the disputed domain names on 20 January 2019 and 22 January 2019. Neither of the disputed domain names currently resolves to an active website. As there has been a request for consolidation in the present Proceedings, please see 'Procedural Factors', below, for further consideration of the Respondent(s). References within this Decision to 'the Respondent' should be read in light of the said

discussion of consolidation.

PARTIES CONTENTIONS

No administratively compliant response has been filed. Neither the written notice of the Complaint nor the advice of delivery was returned to the Provider; it cannot be confirmed whether emails sent to the Respondent were successfully relayed. The Respondent never accessed the online platform.

The Complainant contends that the disputed domain name was registered and is being used in bad faith by the Respondent, emphasising (as set out in more detail below) the lack of any plausible lawful activities that the Respondent would carry out, the well-known nature of its mark (which has been confirmed in a range of cases under the Policy), and the application of the approach to 'passive holding' which is found in decisions under the Policy. It states that there are no relevant rights or legitimate interests, and asks for the disputed domain name to be transferred to itself.

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).

Disregarding the top-level domain .ONLINE, as is the normal practice in applying the Policy, it is apparent that neither of the disputed domain names are not identical to any mark in which the Complainant has rights. However, the Complainant submits that the disputed domain names are confusingly similar to its mark 'INTESA SANPAOLO'.

The differences between the mark and the disputed domain names are, in both cases, the presence of hyphens in the disputed domain names, and the addition of the string 'SICUREZZA'. The use of hyphens is a feature of the domain name system, where a space character is not possible (as seen in, for instance, some of the domain names held by the Complainant). The addition of 'sicurezza', which translates from Italian to English as 'security', makes this dispute one where a mark is accompanied by a generic or descriptive term. As set out in the WIPO Jurisprudential Overview, Third Edition, para 1.8, it is well established that the addition of a generic or descriptive term to that term in which a Complainant has rights is unlikely to be a barrier to a finding of confusing similarity.

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 Complainant declares that the Respondent has not been authorised or licensed to use any of its marks, submitting that no rights or legitimate interests exist. The Respondent has not participated in these proceedings, and so cannot assist the Panel in challenging this prima facie case of the absence of such. Indeed, there is no basis on which the Panel could find rights or legitimate interests in respect of the disputed domain name, and there is no website or other use that could support such an assumption.

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 Panel accepts the Complainant's categorisation of this dispute as a case of 'passive holding', where it is not possible to identify a situation where use would realistically be in good faith (see WIPO Jurisprudential Overview 3.0, para 3.2 including its summary of the 'Telstra' line of cases (WIPO AMC Case D2000-0003 Telstra Corporation Ltd v Nuclear Marshmallows).

The Complainant has provided sufficient evidence of how its mark 'has a strong reputation and is widely known', through Annexes setting out evidence of its activities and its prominence in Google searches for the text in question. The Panel

agrees that the mark is distinctive, and has been in use in its present form for over a decade. Moreover, the Panel notes that the Respondent has provided contact details in Italy, where the Complainant, which has a global reputation, has its most extensive operations.

The Respondent has neither participated in these proceedings nor responded to the Complainant's correspondence of 13 February 2020 (sent, without reply, prior to the commencement of this dispute), and so has (in the terms set out in the Telstra decision and widely accepted in decisions under the Policy) 'provided no evidence whatsoever of any actual or contemplated good faith use by it' of the disputed domain name'. The lack of an active website or any other relevant evidence means that the Panel cannot make any further assumptions about actual or contemplated good faith use.

In reaching this decision, the Panel notes, but does not accept, the Complainant's contention that because it has 'already been targeted by some cases of phishing in the past few years', it so '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'. There is no evidence of such in the present case, and each Panel must apply the Policy in respect of the particular matters before it.

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.

The disputed domain name <SICUREZZA-INTESA-SAN-PAOLO.ONLINE> is registered in the name 'alberto porro', whereas the disputed domain name <INTESA-SAN-PAOLO-SICUREZZA.ONLINE> is registered in the name 'valeria nadal'. The Complainant has requested that the two domain names be dealt with in a single Decision, and provided, in the Amended Complaint, factual and legal evidence in support of this submission. The Panel recalls that paragraph 4(f) of the Policy empowers a Panel to consolidate, at its sole discretion, 'multiple disputes' between a Respondent and Complainant) and notes rule 10(e) of the UDRP Rules (in similar terms), and the absence of any further reference to consolidation in the Supplemental Rules of the Provider.

The Panel is also assisted by reference works (T Bettinger and A Waddell, Domain name law and practice (2nd edn, Oxford University Press, 2015) at IIIE.106)) and the WIPO Jurisprudential Overview at 4.11.2 (where a lengthy list of relevant factors is set out). The broad acceptance of common principles for assessing requests to consolidate is also found in decisions by Panels at the present Provider, where consolidation has been requested and has taken place, e.g. CAC Case 102624 TOD'S S.p.A. v PrivacyGuardian.org; CAC Case 102078 Mammut Sports Group v Xian Wei Fa; CAC Case 101772 Novartis AG v novartis, and in the Panel's own previous decision in CAC Case 102671 UMG Recordings Inc. v Ashley Wilson / Malik Hall. Many of these decisions cite with approval the well-known decision in WIPO Case No. D2010-0281 Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons.

Reviewing these Decisions and authorities discloses a range of factors taken into account including:
(1) a similar pattern of behaviour in managing the disputed domain name,
(2) similarities in contact details (in part or in full), and
(3) factors relating to the names themselves.

In the present case, the first point is demonstrated through the registration of both names within a couple of days, with the same Registrar and privacy protection service. (The Panel does not rely upon the Complainant's contention that the disputed domain names are being used with a 'common DNS', as there is no further discussion or evidence of such in the Complaint). The second point is less relevant in the present case, with the only common factor being the presence of (fictional) addresses in different cities in Italy - which is of limited weight. The third point is however considerably more important, in that both names make use of the same (or substantially similar) variation on the Complainant's well-known mark, through the addition of 'sicurezza'. The Panel therefore finds that the Complainant makes a reasonable case for consolidation in the present proceedings, noting that the Respondent, or Respondents, has or have been given an opportunity to respond to the proposal for consolidation, with no such response having been received. As such, the Panel proceeds on the basis that the disputed domain names are subject to common control, and that it would fair and equitable to all parties to consolidate (see

Jurisprudential Overview, cited above).

PRINCIPAL REASONS FOR THE DECISION

In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain names. On the other hand, it is clear that the Complainant has rights in respect of the trade mark INTESA SANPAOLO, and that the addition of hyphens and the string 'sicurezza', which means 'security', does not prevent a finding of confusing similarity. The Panel can find for the reasons set out above that the disputed domain names were registered and are being used in bad faith, noting the present lack of use of the disputed domain names and so applying the 'passive holding' doctrine, taking into account the Complainant's submissions and the Respondent's failure to respond or participate. The Panel also considered, and ultimately accepted, the request of the Complainant that the disputes concerning two different disputed domain names be consolidated, on the grounds of the likelihood that the purported registrants were acting under common control, placing particular weight upon the similarities between the domain names and the conduct of the Respondent or Respondents in respect of each of the disputed domain names. The requirements for the acceptance of a Complaint under paragraph 4 of the UDRP have therefore been met, and the Panel ordered the transfer of both disputed domain names to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SICUREZZA-INTESA-SAN-PAOLO.ONLINE**: Transferred
2. **INTESA-SAN-PAOLO-SICUREZZA.ONLINE**: Transferred

PANELLISTS

Name	**Prof Daithi Mac Sithigh**

DATE OF PANEL DECISION 2020-07-16

Publish the Decision