Decision for dispute CAC-UDRP-103116

Case number	CAC-UDRP-103116
Time of filing	2020-06-19 08:20:56
Domain names	INTESAEANPAOLO.COM, INTESASANPAOLOLOGINMILAN.COM, INTESASOPAOLO.COM, INTESANSPAOLO.COM, INTESAASNPAOLO.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	carlos daniel dos santos

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings related to the disputed domain names.

IDENTIFICATION OF RIGHTS

- International trademark registration n. 920896 “INTESA SANPAOLO”, March 7, 2007;

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, September 8, 2006.

FACTUAL BACKGROUND

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

PRELIMINARY REQUEST FOR CONSOLIDATION

According to the Registrar verification, the disputed domain names would be owned by two different people, namely:

carlos daniel dos santos
R. guaicui, 72 - Pinheiros 72
Sao Paulo

BR
(see further details above)

and

Alghiero Calabrese
Vicolo Tre Marchetti 132
Loro Piceno MC
31032
+39.32990213023
biedermanjacob11@gmail.com

According to paragraph 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, WIPO panels have articulated principles governing the question of whether a single complaint filed with WIPO may be brought against multiple respondents. In particular, “Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario”.

In this regard, “Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants’ identity(ies) including pseudonyms, (ii) the registrants’ contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s)”.

Most of the above factors are included in the present case.

First of all, it shall be considered that all the disputed domain names have common DNS, common Registrar and common service of privacy protection.

In addition, it shall be underlined that almost all of the new Registrants’ contact details provided by the concerned Registrar are fake. In particular:

- the address "vicolo tre marchetti" in Loro Piceno (MC) does not exist;

- the Administrative e-mail fescity@web.de is a German e-mail box which has nothing to do with the Respondent's Country of origin. Furthermore, there is no Carlos Dos Santos residing in that address.

In addition, it shall be noted that ALL the domain names at issue were carrying out phishing activity against the Complainant, and that is a clear evidence of a common pattern of conduct which is aimed to damage Intesa Sanpaolo and its trademark rights on the signs “INTESA” and “INTESA SANPAOLO”.

There is something more. It is clear that there is also a naming pattern in the disputed domain names, as all of them are typosquatting versions of the well-known trademark INTESA SANPAOLO.

To sum up, the disputed domain names:

- Have common DNS
- Have common Registrar
- Have common service of privacy protection
- Have fake references indicated in the whois
- Were carrying out phishing activity against the Complainant within a common patter of conduct
- Have been registered in the context of a naming pattern, as they all exactly reproduce Complainant's trademark + generic/business terms

Therefore, it is undeniable the disputed domain names only appear to be registered by different subjects, although they clearly have been registered by the same subject/entity and/or are subject to a common control.

As confirmed by WIPO in Decision D2015-2244 (Moncler S.p.A. v. Yao Tom, Lee Fei, Geryi Wang), "it is clear that all Domain Names are prima facie either own[ed] by the same individual […] or are subject to a common control. Hence the Complainant requests the Panel to treat all Domain Names in a single proceeding. As a matter of fact, it would be quite cumbersome and inequitable for the Complainant to start three separate proceedings in this matter, while the consolidation would be fair and equitable to all parties, in view of the aforesaid common ownership or control. Consolidation would permit to deal in a single proceeding multiple domain name disputes arising from a common nucleus of facts and involving common legal issues. Doing so promotes the shared interests of the parties in avoiding unnecessary duplication of time, effort and expenses, and generally fulfills the fundamental goals of the Policy".

The above approach perfectly squares the present case, considering that the relevant criteria for consolidation have been met.

In the light of the above, the Complainant respectfully submitted a request for consolidation.

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THE DISPUTED DOMAIN NAMES ARE 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 27,2 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.

The Complainant is the owner, among others, of the following registrations for the trademarks "INTESA" and "INTESA SANPAOLO":

- International trademark registration n. 793367 "INTESA", granted on September 4, 2002 and duly renewed, in class 36;

- International trademark registration n. 920896 "INTESA SANPAOLO", granted on March 7, 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 5, 2014, in classes 9, 16, 35, 36, 38, 41 and 42; and

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

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 March 12, 2020, the Respondent registered the domain names <INTESAEANPAOLO.COM>, <INTESASANPAOLOLOGINMILAN.COM>, <INTESASOPAOLO.COM>, <INTESANSPAOLO.COM> and <INTESAASNPAOLO.COM>.

It is more than obvious that the domain names at issue are identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”. As a matter of fact, each of the disputed domain names exactly reproduces the well-known trademark “INTESA SANPAOLO”, with the mere slight addition/subtraction/variation of letters, which make all of the them typical cases of typosquating.

In support of the above, the Complainant wishes to draw the Panel’s attention to WIPO decision Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc, Case n. D2001-1314 – regarding the domain names <duetschebank.com> and <duetsche-bank.com>”. The Panel considered such domain names as being confusingly similar and a clear example of “a case of ‘typosquatting’ where the domain name is a slight alphabetical variation from a famous mark. WIPO jurisprudence offers many examples of confusing similarity brought about through easily made typing errors by an Internet user – particularly when the mark is another language from that of the user’s mother tongue.” The same case lies before us in this matter.

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

The Respondent has no rights on the disputed domain names, 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 names at issue.

The domain names at stake do not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as “INTESAEANPAOLO”, “INTESASANPAOLOLOGINMILAN”, “INTESASOPAOLO”, “INTESANSPAOLO” and “INTESAASNPAOLO.COM”.

Lastly, we do not find any fair or non-commercial uses of the domain names at stake (see https://www.intesaeanpaolo.com/ http://intesasanpaolologinmilan.com/ https://www.intesasopaolo.com/ https://www.intesanspaolo.com/ and http://www.intesaasnpaolo.com/ home-page).

THE DISPUTED DOMAIN NAMES WERE REGISTERED AND ARE USED IN BAD FAITH

The disputed domain names <INTESAEANPAOLO.COM, <INTESASANPAOLOLOGINMILAN.COM>, <INTESASOPAOLO.COM>, <INTESANSPAOLO.COM> and <INTESAASNPAOLO.COM> were registered and are used in bad faith.

The Complainant’s trademarks “INTESA SANPAOLO” and “INTESA” are distinctive and well known all around the world. The fact that the Respondent has registered three domain names that are confusingly similar to it indicates that the Respondent

had knowledge of the Complainant's trademarks at the time of registration of the disputed domain names. In addition, if the Respondent had carried even a basic Google search in respect of the wordings "INTESA SANPAOLO" and "INTESA", 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 names at issue would not have been registered if it were not for Complainant's trademark. This is a clear evidence of registration of the disputed domain names in bad faith.

In addition, the contested domain names are not used for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the domain names, the Respondent has registered or acquired the domain names primarily for the purpose of selling, renting, or otherwise transferring the domain names 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 names (par. 4(b)(i) of the Policy).

The disputed domain names are not used for any bone fide offerings, even if they are 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 panellists 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 3 domain names which do exactly correspond to the Complainant's trademarks and that result 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 disputed domain names 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 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. 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.

Also in the present case, the 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 (typosquatting).

Even excluding any “phishing” purposes or other illicit use of the domain names in the present case, anyway we could find no other possible legitimate use of <INTESAEANPAOLO.COM>, <INTESASANPAOLOLOGINMILAN.COM>, <INTESASOPAOLO.COM>, <INTESANSPAOLO.COM> and <INTESAASNPAOLO.COM>. The sole further aim of the owner of the domain names under consideration might be to resell them 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 names 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 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

THE PROCEDURE

Pursuant to article 3, c), of ICANN Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), "The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder".

It is common knowledge that the cost of registering a domain name and the ease of the procedure have led to an explosion in the number of registrations.

At the same time, increasingly protective regulations on personal data have created a situation where it is very easy to register a domain name by providing incorrect or even anonymous contact information. Moreover, when a dispute arises, these same regulations make it more difficult for the complainant to understand complex patterns involving several domain names divided into several registrations.

In some complex cases, the procedure involves several domain names that are apparently registered in a grouped or

coordinated manner, whereas the information provided at the time of registration (Whois?) indicates autonomous registrations.

It is in this context that the Panel has to assess the scope of the expression "the same domain-name holder" referred to in Article 3 of the Rules.

Is it a formal requirement? If so, the Rules would limit consolidation to situations in which all elements of the registrations match because they are identical.

Is this a substantive requirement? In this case, the Regulation would allow consolidation, under the control of the Panel, where there are indications which, beyond appearances, reveal the likelihood of coordinated registration(s) being made by one or more persons acting in concert or coordination.

The Panel is of the opinion that the second interpretation must prevail:

- An overly formal approach would render meaningless this possibility left by the Rules since the person who, hypothetically, would wish to register domain names in an abusive manner would only have to change one element of the registration(s) to prevent any consolidation and complicate or try to avoid ADR procedures;

- The second interpretation has the advantage of better justice. Indeed, it is by having a complete picture that the panel can, at best, assess the existence of the three conditions provided for in the Rules. In particular, the implementation of a strategy of concealment of the domain name holder may, depending on the case, be an indication of bad faith: in this view, the substantive interpretation of Article 3, c), has the advantage to contribute to a better appreciation of the three conditions laid down by the Rules;

- It should also be emphasised that the second interpretation does not disproportionately harm bona fide holders. If two unrelated holders were to be wrongly concerned in the context of a consolidation request, the procedure would allow (one of) them to provide an explanation very easily and almost free of charge. The panel, duly informed, can then either refuse the consolidation or, depending on the specifics of the case, order the transfer of some but not all domain names at stake;

- In the end, the most delicate situation is a request for consolidation in which none of the respondents respond. This delicate situation is not such as to prevent the second interpretation from being adopted. Not only can the simultaneous default of several apparent registrants be taken into account in the panel's assessment, but the panel can always look for similarities between registrations in order to take its decision on consolidation.

In the present case, the facts that (1) both Respondents are in default, and (2) all domain names were registered on the same date and (3) with the same registrar, are sufficient to accept the request for consolidation.

THE FIRST CONDITION

It is commonly accepted that the first condition functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. It this comparison, the cc- or g- TLD is usually not taken into account.

The disputed domain names are very close from he Complainant's trademark:

<INTESAEANPAOLO.COM>: letter "E" instead of "S".
<INTESASOPAOLO.COM>: letter "O" instead of "SA".

<INTESANSPAOLO.COM>: letters "SA" omitted.
<INTESAASNPAOLO.COM>: letters "ASN" instead of "SAN".
<INTESASANPAOLOLOGINMILAN.COM>: trademark fully included with the adjunction of "LOGINMILAN".

These slight differences are not enough to exclude confusing similarity as far as the first four domain names are concerned.

The adjuntion of a generic term wich directly relates to the banking industry (login) or a city where the Complainant has activities (Milan, i.e. Milano in some foreign langages) does ot exclud confusins similarity.

The first condition is satisfied.

THE SECOND CONDITION

Panels have recognized that proving that 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.

Complainant claims, without being contradicted, that:

- The Complainant has not licensed or authorized the Respondent to register or use the disputed domain names;

- The Respondent is not commonly known as “INTESAEANPAOLO”, “INTESASANPAOLOLOGINMILAN”, “INTESASOPAOLO”, “INTESANSPAOLO” and “INTESAASNPAOLO.COM”;

- The disputed domain names has not been resolving to any active web page (passive registration): there is therefore no evidence that the Respondent engages in, or has engaged in, any activity, work, or preparatory work, that would demonstrate a legitimate interest in the disputed domain names.

The Respondent has chosen not to answer to the Complaint.

Based on the elements presented by Complainant, the Panels finds that the second condition is satisfied.

THE THIRD CONDITION

The number of domain names registered based on the same scheme (mispelling varieties around the word "SAN" in the Complainant's trademark) indicates that the Respondent had knowledge of the Complainant’s trademarks at the time of registration of the disputed domain names.

In addition, if the Respondent had carried even a basic Google search in respect of the wordings “INTESA SANPAOLO” and “INTESA”, the same would have yielded obvious references to the Complainant.

In the absence of any credible explanation, such misspelling scheme appears as a direct reference to the Complainant’s trademark.

It is highly probable that the Respondent registered and used the disputed domain name having the Complainant in mind.

Based on the elements presented by Complainant, the Panels finds that the third condition is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESAEANPAOLO.COM**: Transferred
2. **INTESASANPAOLOLOGINMILAN.COM**: Transferred
3. **INTESASOPAOLO.COM**: Transferred
4. **INTESANSPAOLO.COM**: Transferred
5. **INTESAASNPAOLO.COM**: Transferred

PANELLISTS

Name	**Mr. Etienne Wéry**

DATE OF PANEL DECISION 2020-07-23

Publish the Decision