Decision for dispute CAC-UDRP-103131

Case number	**CAC-UDRP-103131**
Time of filing	**2020-06-26 09:19:13**
Domain names	**INTESASANLOGIN.COM**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Intesa Sanpaolo S.p.A.**

Complainant representative

Organization	**Perani Pozzi Associati**

Respondent

Organization	**ALIGHIERO CALABRESE**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name <INTESASANLOGIN.COM>.

IDENTIFICATION OF RIGHTS

The Complainant is an Italian banking group which was established on 1 January 2007 resulting from the merger of Banca Intesa S.p.A and San Paolo IMI S.p.A being effected. Intesa Sanpaolo is among the top banking groups in the eurozone, with a market capitalisation exceeding 27,2 billion euro, and an undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

The Complainant further states and provides evidence to support, that it is the owner, among others, of multiple trademark 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;

- 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 www.intesasanpaolo.com.

FACTUAL BACKGROUND

The Complainant claims it 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.

The Complainant states and provides evidence of his well-known trademarks and provides a list of some of its trademark registrations.

The Complainant provides that the Respondent registered the disputed domain name "INTESASANLOGIN.COM" ("Disputed Domain Name" or "Domain Name") on March 12, 2020.

PARTIES’ CONTENTIONS:

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

COMPLAINANT:

• The Disputed Domain Name is confusingly similar to the protected mark

According to the Complainant, the Respondent’s registered Disputed Domain Name is identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”. Essentially, <INTESASANLOGIN.COM> exactly reproduces the Complainant's well-known trademark “INTESA SANPAOLO”, with the mere substitution of the term “PAOLO” in the mark’s verbal portion “SANPAOLO” with the word “LOGIN”.

• Respondent does not have any rights or legitimate interest in the Disputed Domain Name

The Complainant argues that 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 Disputed Domain Name.

The Disputed Domain Name does not correspond to the name of the Respondent and, to the best of the Complainant's knowledge, the Respondent is not commonly known as “INTESASANLOGIN”.

• The Disputed Domain Name has been registered and is being used in bad faith

The Complainant claims that the Disputed Domain Name 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.

The Complainant contends it is evident from a basic Google search in respect of the wordings “INTESA” and “INTESA SANPAOLO”, the same would have yielded obvious references to the Complainant. 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 Disputed Domain Name would not have been registered if it were not for Complainant’s trademark. This is clear evidence of registration of the Disputed Domain Name in bad faith.

Also, the Disputed Domain Name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that the Respondent has registered or acquired the Disputed 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 Disputed Domain Name (par. 4(b)(i) of the Policy).

The Disputed Domain Name is not used for any bone fide offerings, even if it is not connected to any website, by now. Countless UDRP decisions confirmed that the passive holding of a domain name with the 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 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.).

According to the Complainant, the risk of wrongful use of the Disputed Domain Name 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 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 Disputed Domain Name in the present case, the Complainant claims there is no other possible legitimate use of <INTESASANLOGIN.COM>. The sole further aim of Respondent under consideration might be to resell it to the Complainant, which represents, in any case, evidence of the registration and use in bad faith, according to par. 4(b)(i).

PARTIES CONTENTIONS

RESPONDENT:

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).

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that a complainant must prove each of the following to obtain transfer or cancellation of a domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

2. that respondent has no rights or legitimate interests in respect of the domain name; and

3. the domain name has been registered and is being used in bad faith.

1) The Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights (Para.4(a)(i) of the Policy).

The Complainant has provided evidence and proved to be the owner of several “INTESA” and “INTESA SANPAOLO” trademarks in various jurisdictions. Essentially, the Respondent has appropriated the trademark “INTESA SANPAOLO” with the substitution of the term “PAOLO” with the word "LOGIN" to lead consumers to believe that it is affiliated with the Complainant.

The Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademarks “INTESA” and “INTESA SANPAOLO” since the mere substitution of the term “PAOLO” with the word “LOGIN” does not eliminate any confusing similarity. This is especially true where, as here, the trademark is “the dominant portion of the domain name,” LEGO Juris A/S v. Domain Tech Enterprises, WIPO Case No. D2011-2286, or where the trademark in the domain name represents “the most prominent part of the disputed domain name[] which will attract consumers’ attention.” Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768.

In conclusion, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademarks “INTESA” and “INTESA SANPAOLO”.

2) The Respondent lacks rights or legitimate interests in the Disputed Domain Name (Para. 4(a)(ii) of the Policy).

Under the Policy, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

According to the Complainant, the Respondent has no rights in respect of the Disputed Domain Name, and any use of the trademarks “INTESA SANPAOLO” and “INTESA SANPAOLO” has to be authorized by the Complainant. The Respondent has not been authorized or licensed by the above-mentioned banking group to use the Disputed Domain Name.

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the Disputed Domain Name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

3) The Disputed Domain Name has been registered and is being used in bad faith (Paragraph 4(a)(iii) of the Policy).

The Panel agrees with the Complainant that its trademarks “INTESA SANPAOLO” and “INTESA SANPAOLO” are distinctive and well known globally. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent, according to this Panel, had knowledge (or should have known) of the Complainant’s trademarks and that they had such knowledge prior to the registration and use of the Disputed Domain Name.

The fact that a complainant’s trademark has a strong reputation and is widely used and the absence of evidence whatsoever of any actual or contemplated good faith use are further circumstances that may evidence bad faith registration and use in the event of passive use of domain names (see section 3.3, WIPO Overview 3.0).

In the present case, the Panel is of the opinion that the Complainant’s trademarks are distinctive and well known, which makes it difficult to conceive any plausible legitimate future use of the Disputed Domain Name by the Respondent.

Also, the Disputed Domain Name is not used for any bone fide offerings. The Panel believes that it is likely that the Respondent has registered or acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed 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). Countless UDRP decisions confirmed that the passive holding of a domain name with the knowledge that the domain name infringes another party’s trademark rights is evidence of bad faith registration and use.

The Panel further notes the undisputed submission of Complainant that the risk of wrongful use of the Disputed Domain Name issue is high in the present case since the Complainant has already been targeted by some cases of “phishing” in the past few years. In the view of the Panel, this risk of “phishing” could especially be true in view of the “login” part of the Disputed Domain Name in combination with the “intesasan” part of the Disputed Domain Name.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of the Disputed Domain Name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANLOGIN.COM**: Transferred

PANELLISTS

Name	**Mgr. Barbora Donathová, LL.M.**

DATE OF PANEL DECISION 2020-07-27

Publish the Decision