Decision for dispute CAC-UDRP-103138

Case number	CAC-UDRP-103138
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Domain names	GRUPPOBANCAINTESA.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Andrea Enne

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the registrations for the trademarks “INTESA SANPAOLO” and “INTESA”, as follows:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;

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

- EU trademark registration n. 5421177 “INTESA SANPAOLO & device”, applied on October 27, 2006 and granted on November 5, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;

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

- U.S. trademark registration n. 4196961 “INTESA”, filed on June 30, 2011 and granted on August 28, 2012, in connection with class 36;

- EU trademark registration n. 12247979 “INTESA”, filed on October 23, 2013 and granted on March 5, 2014, in connection with classes 9, 16, 35, 36 38, 41 and 42.

Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the signs “INTESA”, “GRUPPO INTESA SANPAOLO” and “BANCA INTESA”, as follows:

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, GRUPPOINTESASANPAOLO.COM, .INFO, .BIZ, .ORG, .NET, .EU, BANCAINTESA.IT, COM, .EU, .BIZ, .NET, .ORG and .CO.UK.

All of them are now connected to the official website http://www.intesasanpaolo.com.

FACTUAL BACKGROUND

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

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 is one of the leading protagonists in the European financial area. Therefore, Intesa Sanpaolo is a leading Italian banking group among the top banking groups in the euro zone, with a market capitalization exceeding 46,1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). It has a network of approximately 4,500 branches capillary and well distributed throughout the Country, with market shares of more than 18% in most Italian regions, the Group offers its services to approximately 12 million customers.

Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.100 branches and over 7,5 million customers. Moreover, the international network specialized 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 of the trademarks “INTESA SANPAOLO” and “INTESA” and of domain names bearing the signs “INTESA”, “GRUPPO INTESA SANPAOLO” and “BANCA INTESA” which all are connected to the official website of the Complainant on http://www.intesasanpaolo.com.

The Respondent registered the disputed domain name <GRUPPOBANCAINTESA.COM> on 31 March 2020.

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 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

A. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The disputed domain name is confusingly similar to the Complainant's trademarks "INTESA", "GRUPPO INTESA SANPAOLO" and "BANCA INTESA".

The Panel finds that the disputed domain name <GRUPPOBANCAINTESA.COM> exactly reproduces the well-known trademark "BANCA INTESA", with the mere addition of the Italian descriptive term "GRUPPO", meaning "group" and the change in the word order and omitting of blanks in the text for "GRUPPOBANCAINTESA.COM" cannot prevent of the conclusion that the relevant trademark is well recognizable in the disputed domain name and that the disputed domain name is confusingly similar to the first and third part of the disputed domain name and to the trademarks "BANCA INTESA" and "INTESA".

The Panel therefore finds that the disputed domain name is 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).

B. THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Respondent has no rights on the disputed domain name, and any use of the trademarks "INTESA", "GRUPPO INTESA SANPAOLO" and "BANCA INTESA" has to be authorized by the Complainant. The Respondent did not evidence any such authorization or license accorded by the Complainant.

The disputed domain name does not correspond to the name of the Respondent and the Respondent Andrea Enne is obviously not known as "GRUPPOBANCAINTESA". The Panel did not find on the web page of the disputed domain name's home-page any fair or non-commercial uses 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 (see for instance CAC No. 103107 Intesa Sanpaolo S.p.A. vs alberto porro).

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The disputed domain name <GRUPPOBANCAINTESA.COM> was registered and is used in bad faith.

The Complainant's trademarks "INTESA", "GRUPPO INTESA SANPAOLO" and "BANCA INTESA" are distinctive and well known not only in Italy but all around the world. The fact that the Respondent has registered a disputed domain name that is confusingly similar to them indicates that the Respondent would have had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. In addition, the Panel carried out a basic Google search in respect of the wordings "INTESA", "GRUPPO INTESA SANPAOLO" and "BANCA INTESA" while they would have yielded direct references to the Complainant. This raised 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 a clear evidence of registration of the disputed domain name in bad faith.

In addition, the disputed domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site. Moreover, the disputed domain name is not used for any bone fide offerings because it is connected to a website which has been blocked by Google Safe Browsing through a warning page.

It is obvious that the main purpose of the Respondent was to use the above website for "phishing" financial information in an attempt to defraud the Complainant's customers and that Google promptly stopped the illicit activity carried out by the Respondent.

As underlined by countless CAC as well WIPO decisions, "phishing" is a form of Internet fraud that aims to steal valuable information such as credit cards, social security numbers, user Ids, passwords, etc. A fake website is created that is similar to that of a legitimate organization, typically a financial institution such as a bank or insurance company and this information is used for identity theft and other nefarious activities" (see for instance CAC No. 102392 JCDECAUX SA vs Charles Russam, WIPO Case No. D2004-0237 Halifax Plc. v. Sontaja Sanduci and WIPO Case No. D2005-0251 CarrerBuilder LLC v. Stephen Baker).

In conclusion, even excluding any current "phishing" purposes or other illicit use of the disputed domain name in the present case (which, however, has been confirmed by Google Safe Browsing with a warning page, as indicated above), the Panel did not find any other possible legitimate use of the disputed domain name <GRUPPOBANCAINTESA.COM>.

The sole further aim of the owner of the disputed domain name under consideration might be to resell it 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 disputed domain name registration and use has been established.

The Panel finds that the Respondent has registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant as the owner of the trademark and service mark or to a competitor of Complainant. So that the disputed domain name is not used for any bona fide offerings but for a valuable covering of the Respondent's out-of-pocket costs which are directly and obviously related to the disputed domain name (see for instance CAC No. 102158 FEDERATION FRANCAISE DE TENNIS (FFT) v. Md Abdullah Al Muktadir as this Panel has found previously in the CAC No.102958).

The Panel is therefore convinced that the overall circumstances of this case suggest that the disputed domain name was registered and is being used in bad faith and the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GRUPPOBANCAINTESA.COM**: Transferred

PANELLISTS

Name	**JUDr. Vojtěch Trapl**

DATE OF PANEL DECISION 2020-07-30

Publish the Decision