Decision for dispute CAC-UDRP-103188

Case number	CAC-UDRP-103188
Time of filing	2020-07-29 16:48:36
Domain names	INTESAPOALO.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	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 Name.

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it is the owner of certain trademark registrations that consist of or contain the mark INTESA SANPAOLO (the "INTESA SANPAOLO Trademark"), including Int'l Reg. No. 920,896 for the mark INTESA SANPAOLO (registered March 7, 2007) and EU Reg. No. 5,301,999 for the mark INTESA SANPAOLO (registered June 18, 2007).

FACTUAL BACKGROUND

Complainant states that it is "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 29,8 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management)"; that it has "a network of approximately 3,700 branches" serving "approximately 11,8 million customers… 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 Disputed Domain Name was created on April 29, 2020, and is not being used in connection with an active website.

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant states that the disputed domain name is confusingly similar to the INTESA SANPAOLO Trademark because, inter alia, the domain name "exactly reproduces" the INTESA SANPAOLO Trademark "with the mere omission of the mark's verbal portion 'SAN' and the inversion of letters 'A' and 'O' in the term 'PAOLO' (a clear example of typosquatting)."

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "[n]obody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue"; the Disputed Domain Name "does not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as 'INTESAPOALO'"; and "we do not find any fair or non-commercial uses of the domain name at stake."

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Name was registered and is being used in bad faith because, inter alia, the INTESA SANPAOLO Trademark "is distinctive and well known all around the world"; "[t]he 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"; although the Disputed Domain Name "is not connected to any web site,… 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"; "[t]he risk of a wrongful use of the domain name 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"; and Respondent did not reply to a cease and desist letter sent by Complainant's attorneys on June 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 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 UDRP).

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 UDRP).

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 UDRP).

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 registrations cited by Complainant, it is apparent that Complainant has rights in and to the INTESA SANPAOLO Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the INTESA SANPAOLO Trademark, the

relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., "intesapoalo") 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 Overview 3.0, section 1.11.1.

Here, the Disputed Domain Name contains a typographical variation of the INTESA SANPAOLO Trademark, by including the entirety of the INTESA SANPAOLO Trademark with two variations: the word "san" has been omitted from the Disputed Domain Name, and the letters "o" and "a" have been transposed. 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, 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…. Examples of such typos include… the inversion of letters and numbers."

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

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

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "[n]obody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue"; the Disputed Domain Name "does not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as 'INTESAPOALO'"; and "we do not find any fair or non-commercial uses of the domain name 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 UDRP.

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.

WIPO Overview 3.0, section 3.1.4, states: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive

term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

Further, WIPO Overview 3.0, section 3.3, 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.

"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."

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.
Further, Respondent's failure to respond to Complainant's demand letter is additional evidence of bad faith. Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party, WIPO Case No. D2000-0330; and RRI Financial, Inc., v. Ray Chen, WIPO Case No. D2001-1242.

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. **INTESAPOALO.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2020-08-25

Publish the Decision