Decision for dispute CAC-UDRP-103242

Case number	CAC-UDRP-103242
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Domain names	e-intesasanpaolo.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Marchesi Carlo Giuseppe

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks:

(a) International trademark registration no. 793367 “INTESA”, granted on September 04, 2002 and duly renewed, in class 36;

(b) International trademark registration no. 920896 “INTESA SANPAOLO”, granted on March 07, 2007 and duly renewed, in classes 9, 16, 35, 36, 41, 42;

(c) EU trademark registration no. 12247979 “INTESA”, applied on October 23, 2013 and granted on March 05, 2014, in classes 9, 16, 35, 36, 38, 41 and 42; and

(d) EU trademark registration no. 5301999 “INTESA SANPAOLO”, applied on September 08, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

("Complainant's Trademarks").

FACTUAL BACKGROUND

As the Respondent did not file any response to the complaint, the Panel took into account the following facts asserted by the Complainant (and supported by the documentary evidence submitted by the Complainant) and unchallenged by the Respondent:

(a) the Complainant is among the top banking groups in the euro zone, with a market capitalisation exceeding 29,9 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. The Complainant 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;

(b) 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;

(c) the disputed domain name was registered on 27 February 2020; and

(d) the disputed domain name is inactive.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

In addition to the above factual assertions, the Complainant also contends the following

(a) it is more than obvious that the disputed domain name is identical, or – at least – confusingly similar, to the Complainant’s Trademarks “. The disputed domain name exactly reproduces Complainant’s well-known trademark “INTESA SANPAOLO”, with the mere addition of the letter “E”. This is a clear example of typosquatting;

(b) the Respondent is not affiliated with the Complainant nor authorized by it in any way to use Complainant’s Trademarks. The Complainant does not carry out any activity for, nor has any business with the Respondent. There is no website under the disputed domain name and no indication of preparation for its use was established in these proceedings. Therefore, the Respondent has no legitimate interest in the disputed domain name; and

(c) passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. Such circumstances include situation occurring in this case when Complainant’s Trademark is well-known, and there is no conceivable use that could be made of the disputed domain name that would not amount to an infringement of the Complainant’s trade mark rights. Therefore, the Disputed domain name was registered and is being used in bad faith.

RESPONDENT:

The Respondent did not provide any response to the complaint.

RIGHTS

The Panel concluded that the disputed domain name is confusingly similar to Complainant’s Trademarks within the meaning of paragraph 4(a)(i) of the Uniform Domain Name Dispute Resolution Policy ("UDRP" or "Policy").

For details, please see "Principal Reasons for the Decision".

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.

For details, please see "Principal Reasons for the Decision".

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.

For details, please see "Principal Reasons for the Decision".

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the Policy were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy requires that the Complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or revoked:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in these proceedings.

RIGHTS

The disputed domain name is confusingly similar to Complainant’s Trademarks. It reproduces Complainant's Trademarks and mere addition of a letter "e" with a dash in front of Complainant's Trademarks cannot diminish confusing similarity of the disputed domain name with Complainant`s Trademarks. However, the Panel is not convinced that this is a case of typosquatting as asserted by the Complainant. A typical typosquatting case exploits a typographic error in the domain name. The present case rather amounts to registering of a domain name corresponding to Complainant's Trademarks with addition of a non-distinctive term ("e-"). That, however, does not change the conclusion that the disputed domain name is confusingly similar to Complainant's Trademarks.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel concludes that the Complainant satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The 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 Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (for example, WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

As asserted by the Complainant (and unchallenged by the Respondent), the Respondent is not commonly known by the disputed domain name. Neither is the Respondent in any way related to the Complainant. The Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

Given the reputation of the Complainant and well-known nature of its trademarks the Panel cannot find any conceivable good faith registration and use of the disputed domain name by the Respondent in a situation where there is no legitimate website under the disputed domain name and there was no response to the complaint in which the Respondent could have established such good faith use of the disputed domain name (or at least preparations for such good faith use). Both parties are domiciled in Italy and therefore existence of the Complainant and its reputation must have been well known to the Respondent.

As a result, the Panel found that the disputed domain name has been registered and used by the Respondent in bad faith (within the meaning of 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. **E-INTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	**Michal Matějka**

DATE OF PANEL DECISION 2020-10-03

Publish the Decision