Decision for dispute CAC-UDRP-103315

Case number	CAC-UDRP-103315
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Domain names	INTESASANMILAN.COM, INTESASANPAOLOMILANBA.COM, INTESASANPAOLOMILAN.COM

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	Alighiero Calabrese

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

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

- International trademark registration n. 793367 “INTESA”, granted on September 04, 2002 and duly renewed, in class 36;

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 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 05, 2014, in classes 9, 16, 35, 36, 38, 41 and 42;

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 08, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

(" the INTESA and INTESA SANPAOLO trademarks".)

FACTUAL BACKGROUND

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The Complainant is the leading Italian banking group 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.

It is among the top banking groups in the euro zone, with a network of approximately 3,700 branches, a prominent presence and approximately 11,8 million customers. It is therefore very well known, as are its trademarks.

The Complainant is the owner of the prominent INTESA and INTESA SANPAOLO trademarks defined above.

It also owns many domain names incorporating its trademarks and which resolve to its official website at <www.intesasanpaolo.com>.

The Complainant has become aware that on March 12, 2020, the Respondent registered the disputed domain names. It has become very concerned at this development not only because of the transgression on its intellectual property rights, but because banks and other prominent companies and their clients have become targets for phishing and other disreputable activities and the Complainant wishes to guard against that eventuality happening with respect to itself and its clients in the light of the improper registration of the disputed domain names. The Complainant therefore wants to obtain the disputed domain names before they also are put to this improper and illegal use and it has brought this proceeding to that end.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:
COMPLAINANT

The Complainant made the following contentions.

A. The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

On March 12, 2020, the Respondent registered the domain names <intesasanmilan.com>, <intesasanpaolomilanba.com> and <intesasanpaolomilan.com> ("the disputed domain names") . That has been established by evidence that has been tendered by the Complainant and which the Panel accepts.

The disputed domain names incorporate the well-known INTESA and INTESA SANPAOLO trademarks with various slight additions and variation of terms and letters, namely adding the geographic indicator “Milan”, the deletion of “Paolo” and the addition of some letters, all of which make them typical cases of typosquatting. That view is supported by many prior UDRP decisions that are analogous to the present case.

It is apparent from a comparison between the domain names and the trademarks that the domain names are confusingly similar to the trademarks.

B. The Respondent has no rights or legitimate interests in the disputed domain names.

The Respondent has not been authorized by the Complainant to use its trademarks in domain names or in any other manner.

The Respondent is not commonly known by the disputed domain names.

The Respondent has not used any of the disputed domain names for a fair or legitimate purpose.

It is not possible to conceive of any legitimate reason for the Respondent having registered the disputed domain names or any legitimate use to which they could be put.

C. The disputed domain names were registered and are used in bad faith.

That is so because the Complainant's INTESA and INTESA SANPAOLO trademarks are distinctive and well known all around the world. The fact that the Respondent has registered three domain names that are confusingly similar to them shows that the Respondent had knowledge of the Complainant's trademarks at the time of registration of the disputed domain names. In addition, the Respondent could easily have found obvious references to the Complainant on Google. Therefore, it is more than likely that the domain names at issue would not have been registered if it were not for the existence of the Complainant's well known trademarks. This is a clear evidence of registration of the domain names in bad faith.

The disputed domain names are not used for a bona fide purpose. It is more likely than not that the Respondent has registered or acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring them to the Complainant who is the owner of the trademarks 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 (paragraph. 4(b)(i) of the Policy).

The disputed domain names are not used for a bona fide purpose even if they are not connected to a web site. In fact, many UDRP decisions have decided 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, for example Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

Moreover, it is objectively not possible to understand what kind of use the Respondent could make with 3 domain names which correspond exactly with the Complainant's trademarks other than an improper use.

This is therefore a case of passive holding which is considered to be use in bad faith.

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 has 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, for sensitive data of clients, such as user ID, password etc. Then, some clients have been cheated of their savings.

Also in the present case, the Complainant believes that the current owner registered the disputed domain names for "phishing", in order to induce and divert the Complainant's legitimate customers to its website and steal their money.

Even excluding any "phishing" purposes or other illicit use of the domain names in the present case, there is no conceivable legitimate use of the disputed domain names. 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, evidence of the registration and use of the domain names in bad faith, according to paragraph.4(b)(i) of the Policy, i.e., in circumstances indicating that the Respondent registered the domain names primarily for the purpose of selling, renting, or otherwise transferring them to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain names.

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.

RESPONDENT

The Respondent did not submit a Response in this proceeding.

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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) of the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

A. ADMINISTRATIVE DEFICIENCY

By notification dated September 30, 2020 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that:

The Respondent was not the current domain name holder and that the Registrar's Verification should be consulted for the correct domain name holder.

On September 30, 2020, the Complainant filed an Amended Complaint providing inter alia the name of the current domain name holder as Respondent and the CAC determined that in view of the amendments so made, the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiency has been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. SUBSTANTIVE MATTERS

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the Complainant to make out its case and past UDRP panels have consistently said that the Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

(i) The disputed domain names are 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 names; and

(iii) The disputed domain names have been registered and are being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

IDENTICAL OR CONFUSINGLY SIMILAR

The first issue that arises is whether the Complainant has a trademark or service mark on which it may rely in this proceeding. The Complainant has established, by evidence that the Panel accepts, that it is is the owner of the following registrations for the trademarks INTESA and INTESA SANPAOLO.

- International trademark registration n. 793367 “INTESA”, granted on September 04, 2002 and duly renewed, in class 36;
- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 07, 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 05, 2014, in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 08, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.
("the INTESA and INTESA SANPAOLO trademarks").

It is now well established that if a complainant has a trademark that has been registered with a national or international authority, that fact will establish that it has trademark rights that give it standing in a UDRP proceeding. Accordingly, it is clear that the Complainant has so established that requirement.

The next question that arises is whether the disputed domain names are identical or confusingly similar to the trademarks relied on. On March 12, 2020, the Respondent registered the domain names <intesasanmilan.com>, <intesasanpaolomilanba.com> and <intesasanpaolomilan.com>. Accordingly, the question is whether the disputed domain names are identical or confusingly similar to those trademarks.

The first domain name,<intesasanmilan.com> incorporates the whole of the INTESA trademark and adds the word "milan" which would clearly be interpreted by internet users to mean that it was a domain name of the Complainant that would lead to a website relating to its activities in Milan. The second domain name, <intesasanpaolomilanba.com> incorporates the whole of the INTESA SANPAOLO trademark, also includes "milan" and some additional letters, which as a whole would be interpreted by internet users to mean that it was a domain name of the Complainant that would lead to a website relating to its activities in Milan. The third domain name, <intesasanpaolomilan.com> incorporates the whole of the INTESA SANPAOLO trademark with the word "milan" added, which would also be interpreted by internet users to mean that it was a domain name of the Complainant that would lead to a website relating to its activities in Milan.The Panel also agrees with the Complainant that it is obvious that the domain names are confusingly similar to the trademarks.

The Panel therefore finds that each of the disputed domain names is confusingly similar to the INTESA and INTESA SANPAOLO trademarks relied on.

The Complainant has thus made out the first of the three elements that it must establish.

RIGHTS AND LEGITIMATE INTERESTS

It is now well established that Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain names under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have such rights or legitimate interests. See Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii)); see also Neal & Massey Holdings Limited v. Gregory Ricks, FA 1549327 (FORUM Apr. 12, 2014) ("Under Policy paragraph 4(a)(ii), Complainant must first make out a prima facie case showing that Respondent lacks rights and legitimate interests in respect of an at-issue domain name and then the burden, in effect, shifts to Respondent to come forward with evidence of its rights or legitimate interests").

The Panel finds that Complainant has made out a prima facie case that arises from the following considerations:

(a) the Respondent has chosen without permission of the Complainant to take the Complainant's INTESA and INTESA SANPAOLO trademarks and to use them in its disputed domain names, containing the entire marks and merely making minor spelling alterations, rightly described by the Complainant as typosquatting, which do not negate the confusing similarity between the domain names and the trademarks;
(b) the Respondent registered the disputed domain names on March 12, 2020 ;
(c) the Respondent is clearly not using the domain names for a bona fide or legitimate purpose;
(d) There is no evidence to show or even suggest that the Respondent is commonly known by any of the disputed domain names;
(e) It is impossible, given the fame of the Complainant and its trademarks, to conceive of any right or legitimate interest that the Respondent could have in any of the disputed domain names;
(f) Respondent has engaged in these activities without the consent or approval of Complainant.

All of these matters go to make out the prima facie case against Respondent. As Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain names.

Complainant has thus made out the second of the three elements that it must establish.

BAD FAITH

It is clear that to establish bad faith for the purposes of the Policy, Complainant must show that the disputed domain names were registered in bad faith and have been used in bad faith. It is also clear that the criteria set out in paragraph 4(b) of the Policy for establishing bad faith are not exclusive, but that Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

Having regard to those principles, the Panel finds that the disputed domain names were registered and used in bad faith. That is so for the following reasons.

First, the Complainant's INTESA and INTESA SANPAOLO trademarks are distinctive and well known all around the world, giving rise to the irresistible inference that the Respondent had knowledge of the Complainant's trademarks at the time of the registration of the disputed domain names. It is the regular practice of UDRP Panelist to find that if a registrant had actual knowledge of a prominent trademark, it probably registered the corresponding domain name in bad faith. The Panel finds that this was so in the present case as the Respondent must have known of the Complainant and its marks when it registered the domain names.

Secondly, as has already been noted, it is inconceivable that the Respondent could have had good motives in registering and holding onto the domain names. It is far more likely that the Respondent was motivated by bad faith in both registering and using the domain names whether this came about for a phishing expedition or some even more discreditable plan.

Thirdly, it is more likely than not that the Respondent intended to try to sell the domain names to the Complainant or a competitor, use them to disrupt the Complainant's business or generate confusion in the market as to whether the domain names would resolve to a genuine site of the Complainant or not. All of these contingencies bring the case squarely within the indicia of bad faith registration and use set out in the Policy.

Fourthly, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain names using the INTESA and INTESA SANPAOLO trademarks and in view of the conduct that Respondent has engaged in when using the disputed domain names, Respondent registered and used them in bad faith within the generally accepted meaning of that expression.

Complainant has thus made out the third of the three elements that it must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANMILAN.COM**: Transferred
2. **INTESASANPAOLOMILANBA.COM**: Transferred
3. **INTESASANPAOLOMILAN.COM**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2020-10-27

Publish the Decision