Decision for dispute CAC-UDRP-103387

Case number	CAC-UDRP-103387
Time of filing	2020-11-12 10:59:05
Domain names	INTESAONPAOLO.COM

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.

Respondent

Name	tonkin katia sonia

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following registrations for the trademarks “INTESA” and “INTESA SANPAOLO” (hereinafter referred to as the "INTESA SANPAOLO trademark"):

- 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.

FACTUAL BACKGROUND

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

The Complainant is the leading Italian banking group and also one of the principal players 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.
Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalization exceeding 31,1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). It has a network of approximately 3,700 branches 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.
Intesa Sanpaolo also 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 specialized in supporting corporate customers is present in 25 countries, in particular in the Mediteranean area and those areas where Italian companies are most active, such as the United States, Russia, China and India.
On May 16, 2020, the Respondent registered the domain name <intesaonpaolo.com>. Complainant notes that on June 19, 2020 its attorneys sent to the Respondent a cease and desist letter asking for the voluntary transfer of the domain name at issue. Despite such communication, the Respondent did not comply with the above request. The domain name does not resolve to an active website.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:
The Complainant submits that < intesaonpaolo.com > is confusingly similar to its INTESA and INTESA SANPAOLO trademarks in that it contains in whole the word “Intesa” and in confusing part “San Paolo” by replacing “San” with a typographic misspelling with the letters "on." Removing or substituting letters of a trademark does not create a distinctive name such as to distinguish the domain name from the trademark. These minor changes to the trademark rather enhance infringement than lessen the confusing similarity.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has not been authorized by the Complainant to use the INTESA SAN PAOLO trademark, and the disputed domain name does not correspond to the name of the Respondent. The Complainant adds that the Respondent does not carry out a fair or non-commercial use of the disputed domain name as it currently does not resolve to an active website.

The Complainant contends further that the disputed domain name was registered and is being used in bad faith. According to the Complainant, the INTESA SAN PAOLO trademark is distinctive and well-known around the world, and that it is evident that the Respondent registered the disputed domain name with knowledge of Complainant’s trademark. The disputed domain name is not used for any bona fide purpose.

Complainant speculates that the domain name can be used for phishing customers’ personal information or for some other abusive purpose. As Complainant has the burden of proving its contentions, and here they are only presented as speculations, it is unnecessary to take them into account in reaching a determination.

RESPONDENT:
The Respondent did not reply to the Complainant's contentions and did not submit any arguments or evidence in its defense. In such event, UDRP Rule 14 provides (a) that the “Panel shall proceed to a decision on the complaint” and (b) that “the Panel shall draw such inferences therefrom as it considers appropriate.”

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
(ii) the respondent has no rights or legitimate interests in respect of the domain name; and
(iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Czech Arbitration Court has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case and defend its registration of <intesaonpaolo.com> the subject domain name.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name …”

Notwithstanding Respondent’s default Complainant is not relieved from the burden of establishing its claim. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0, § 4.3: “Noting the burden of proof on the complainant, a respondent’s default (i.e., failure to submit a formal response) would not by itself mean that the complainant is deemed to have prevailed; a respondent’s default is not necessarily an admission that the complainant’s claims are true."

A. Identical or confusingly similar, §4(a)(i).

A side-by-side comparison of the domain name and the INTESA SAN PAOLO trademark indicates that <intesaonpaolo.com> is confusingly similar to the mark because it incorporates the mark in its entirety albeit by substituting “on” for “San”. This change is inconsequential in creating a separate or distinctive term. See Bloomberg Finance L.P. v. Nexperian Holding Limited, FA 1782013 (Forum June 4, 2018) (<bloombertvoice.com>); and WIPO Overview, § 1.8: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive . . . meaningless or otherwise) would not prevent a finding of confusing similarity under the first element."
Having demonstrated that <intesaonpaolo.com> is confusingly similar to Complainant’s INTESA SAN PAOLO trademark the Panel finds Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights and legitimate interests, §4(a)(ii)

Under paragraph 4(a)(ii) of the Policy, a complainant has the burden of establishing that a respondent lacks rights or legitimate interests in respect of the disputed domain name, but this burden is light. It is sufficient in the first instance for Complainant to allege a prima facie case, and if the evidence presented is conclusive or yields an inference that Respondent lacks rights or legitimate interests, the burden shifts to Respondent to rebut the allegations. Croatia Airlines d.d. v. Modern Empire Internet Ltd., D2003-0455 (WIPO August 21, 2003) (holding that “[s]ince it is difficult to prove a negative ... especially where the Respondent, rather than complainant, would be best placed to have specific knowledge of such rights or

interests–and since Paragraph 4(c) describes how a Respondent can demonstrate rights and legitimate interests, a Complainant's burden of proof on this element is light.") See also Euromarket Designs, Inc. v. Domain For Sale VMI, D2000-1195 (WIPO October 26, 2000) ("[I]n the absence of direct evidence, complainant and the panel must resort to reasonable inferences from whatever evidence is in the record."

Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because the Respondent has no permission to use the INTESA SAN PAOLO trademark. The evidence adduced in the record is conclusive that Respondent is not commonly known under the disputed domain name. See Amazon Technologies, Inc. v. Suzen Khan / Nancy Jain / Andrew Stanzy, FA 1741129 (FORUM Aug. 16, 2017) (finding that respondent had no rights or legitimate interests in the disputed domain names when the identifying information provided by WHOIS was unrelated to the domain names or respondent's use of the same).

The Complainant also points out that the disputed domain name is passively held. While passive holding is not conclusive that Respondent lacks rights or legitimate interests, the composition of the domain name in this dispute cannot support the conclusion that Respondent has either rights or legitimate interests. This is supported by the principle formulated in Telstra Corporation Limited v. Nuclear Marshmallows, D2000-0003 (WIPO February 18, 2000) that where "it is not possible to conceive of any plausible actual or contemplated active use of the Domain Name by respondent that would not be illegitimate" there can be no legal basis for finding either a right or a legitimate interest.

Accordingly, the Panel finds that Complainant has satisfied its prima facie burden. See Malayan Banking Berhad v. Beauty, Success & Truth International, D2008-1393 (December 8, 2008) (holding that once a complainant makes such a prima facie showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant.).

Once the burden shifts, Respondent may demonstrate its right or legitimate interest by showing the existence of any of the following nonexclusive circumstances:
(i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [respondent] are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

If a respondent proves any of these circumstances or indeed anything else that shows it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail. Where respondent fails to respond the Panel must assess the record before it. Here, the misspellings in the second level domains are highly informative of Respondent's intent and it is thus called upon to explain its choice of <intesaonpaolo.com>. See Deutsche Telekom AG v. Britt Cordon, D2004-0487 (WIPO September 13, 2004) (holding that "once a complainant establishes a prima facie case that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondent. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP); also Malayan Banking Berhad, supra. (holding that If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.).

The Panel finds that the domain name typosquatts the INTESA SANPAOLO trademark and this supports the conclusion that it lacks rights and legitimate interests in the domain name. See Gannett Co., Inc. v. Henry Chan, D2004-0117 (WIPO April 8, 2004) ("In order to make such modifications to Complainant's trademarks, respondent necessarily knew these trademarks prior to registering the contested domain names"); The Hackett Group, Inc. v. Brian Herns / The Hackett Group, FA1412001597465 (Forum February 6, 2015) ("The Panel agrees that typosquatting is occurring, and finds this is additional evidence that Respondent has no rights or legitimate interests under Policy paragraph 4(a)(ii)"); Royal Bank of Canada - Banque Royale du Canada v. Domain Administrator, Fundacion Privacy Services Ltd. D2020-2709 (WIPO November 23, 2020) ("[T]he mere act of typosquatting, by itself, also squarely undermines a claim of rights or legitimate interest.") There being no

rebuttal proof explaining Respondent's choice of the subject domain name the Panel concurs with the well-established principle that typosquatting supports the conclusion that Respondent lacks rights or legitimate interests in the subject domain name.

C. Registered and Used in Bad Faith, §4(a)(iii)

Having determined that Respondent lacks rights or legitimate interests, the Complainant must then prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith. The consensus expressed in WIPO Overview 3.0, section 3.1.4. is 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.”

The Panel finds that the present case is one in which the presumption of bad faith is satisfied. The presumption is further strengthened by the strong inference that in registering a domain name composed of misspelling the inner part of Complainant's trademark by substituting "on" for "San" the Respondent had actual knowledge of Complainant and the INTESA SAN PAOLO trademark.

Paragraph 4(b) of the Policy sets out four nonexclusive circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or 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 respondent’s documented out-of-pocket costs directly related to the domain name; or
(ii) the respondent 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 respondent has engaged in a pattern of such conduct; or
(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent’s website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on the site or location.

The domain name in this case is passively held, but for no conceivably lawful use. Telstra, supra. See National Football League v. Thomas Trainer, D2006-1440 (WIPO December 29, 2006) (<nflnetwork.com>) (holding that “when a registrant, such as respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted.”). The Panel finds that Complainant has adduced sufficient evidence to prove Respondent’s bad faith based on the following considerations.

In this case, the INTESA SAN PAOLO trademark has a long history of use in commerce significantly predating the registration of the domain name, and in its niche, it cannot be considered otherwise than as being a famous mark. As the evidence demonstrates bad faith use, so priority of the trademark and actual presumed knowledge establishes bad faith registration. The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent’s conduct puts the case squarely within paragraph 4(b)(iv) as well as within the larger notion of abusive conduct.

As previously noted, Complainant also argues bad faith registration and use based on certain speculative contentions which are not supported by evidence. For instance, there is no evidence of bad faith under UDRP 4(b)(i). Complainant has adduced no proof that Respondent approached it to sell the domain name. Nor is there any evidence of phishing for customers’ private information. Thus, neither add anything of substance that needs to be addressed. It is clear from the record that the

choice of the subject domain name was to target the INTESA SANPAOLO trademark. Therefore, the Panel finds it unnecessary to address these speculations since they are merely theoretical possibilities. In setting these issues aside, however, the Panel does not mean to downplay Complainant's concerns since such use is not improbable. The abusive registration of <intesaonpaolo.com> securely rests on other factors.

Accordingly, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith and that its conduct firmly supports the conclusion the registration of <intesaonpaulo.com> was an abusive act. Thus, Complainant has also 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. **INTESAONPAOLO.COM**: Transferred

PANELLISTS

Name	**Gerald M. Levine, Ph.D, Esq.**

DATE OF PANEL DECISION 2020-12-06

Publish the Decision