Decision for dispute CAC-UDRP-103388

Case number	CAC-UDRP-103388
Time of filing	2020-11-12 11:03:59
Domain names	INTESA-SANPAOLO.LINK

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.

Respondent

Organization	Data Protected

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 following registrations for the trademarks “INTESA” and “INTESA SANPAOLO”:

- 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; and
- 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 one of the protagonists 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 eurozone, with a market capitalization exceeding 31,1 billion euros, 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. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of roughly 1.000 branches and over 7,2 million customers. Moreover, the international network specialized in supporting corporate customers is present in 25 countries, particularly 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 known among consumers also as “ISP” (the acronym of “Intesa SanPaolo”).

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>.

On May 17, 2020, the Respondent registered the disputed domain name <INTESA-SANPAOLO.LINK>.

PARTIES CONTENTIONS

COMPLAINANT

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

It is more than evident that the disputed domain name is identical, or – at least – confusingly similar, to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA". INTESA-SANPAOLO.LINK exactly reproduces the Complainant’s well-known trademark “INTESA SANPAOLO".

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

The Respondent has no rights in the disputed domain name, and any use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the disputed domain name.

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 "INTESA-SANPAOLO".

Lastly, we do not find any fair or non-commercial uses of the disputed domain name.

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

The disputed domain name was registered and is used in bad faith.

The Complainant’s trademarks “INTESA” and “INTESA SANPAOLO” are distinctive and well known worldwide. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent knew of the Complainant's trademark when registering the disputed domain name. Also, if the Respondent had carried even a basic Google search in respect of the wordings "INTESA" and "INTESA SANPAOLO", the same would have yielded apparent references to the Complainant. The Complainant submits an extract of a Google search in support of its allegation. This raises 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 clear evidence of the registration of the domain name in bad faith.

Besides, the disputed domain name is not used for any bona fide offerings. More particularly, present circumstances are 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 (par. 4(b)(iv) of the Policy).

The disputed domain name is not used for any bona fide offerings, considering that the same is connected to a website that has been blocked by Google Safe Browsing through a warning page. It is clear that the Respondent's primary purpose 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.

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); anyway, we could find no other possible legitimate use of <INTESA-SANPAOLO.LINK>. The sole further aim of the Respondent might be to resell it to the Complainant, which represents, in any case, evidence of the registration and use in bad faith, according to par. 4(b)(i).

Lastly, it shall be noted that on June 19, 2020, the Complainant's attorneys sent to the Respondent's Registrar a cease and desist letter, asking to forward the document to the Respondent to require the voluntary transfer of the disputed domain name. Despite such communication, the Respondent did not comply with the above request.

In light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

To the satisfaction of the Panel, the Complainant has shown that the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

To the satisfaction of the Panel, the Complainant has 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

To the satisfaction of the Panel, the Complainant has 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

As per paragraph 4(a) of the Policy, for this Complaint to succeed concerning the disputed domain name, the Complainant must prove the following:

(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.

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has shown it owns rights in the “INTESA SANPAOLO” trademark, with the earliest registration dating back to 2006.

We must now analyze if there is a confusing similarity between the disputed domain name and the trademark. As contained in the record and evidence at hand, the disputed domain name reproduces the trademark in its totality, namely, “INTESA SANPAOLO” with the addition of a hyphen between the two elements. The addition of a hyphen is often used in domain names to separate elements because of the technical requirement of having an interrupted string of characters. In any case, for this element, the mere addition of a hyphen is a small difference that is not substantive enough to dispel the confusing similarity between the disputed domain name and the Complainant’s trademarks.

Consequently, the Panel determines that the Complaint has satisfied the first element set under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the record and evidence at hand, the uncontested facts indicate that a) the Respondent is not affiliated with the Complainant; b) the Respondent is not authorized to carry out any activity for the Complainant; c) the Respondent has no license or authorization to use the trademark and d) the Respondent is not commonly known as the disputed domain name.

Going through the second element analysis, it is worth noting that the Respondent failed to produce allegations or evidence necessary to demonstrate its rights or legitimate interests in the disputed domain name.

In the Panel view, these assertions are enough to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name (see 2.1 of WIPO 3.0 Overview).

Based on the above and the probability balance, it is difficult to conceive the Respondent having rights or legitimate interest in the disputed domain name. This is closely linked to the potential of having fair or non-commercial uses of the disputed domain name; however, the analysis of this is better suited under the third element.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Therefore the Complainant has fulfilled the second requirement set under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

As per the record and evidence at hand, the Panel finds that the Respondent was likely aware of the Complainant and targeted the Complainant's trademark when registering the disputed domain name. This conclusion is reinforced by the fact that the Respondent seems to evoke a connection to the Complainant's trademark by including the trademark in its entirety, with the only addition of a technically required hyphen between the two main elements of the trademark.

In addition to this, it is worth noting that the website resolving from the disputed domain name has a security warning, which in itself is not determinative of bad faith. In conjunction with the other facts and evidence, in this case, it strengthens the

allegations and the points raised by the Complainant.

The sum of this leaves the Panel no other option than to conclude that that the most likely intention of the Respondent about the disputed domain name was to intentionally attempted to attract, for commercial gain, Internet users to its website/Domain Name, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and/or Domain Name (see 3.1 of WIPO 3.0 Overview).

In light of the case's circumstances, based on the available records, the Panel finds that the Complainant has proven that the disputed domain name was registered and is used in bad faith according to paragraph 4(a)(iii) of the Policy.

D. Decision

For the preceding reasons and concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-SANPAOLO.LINK**: Transferred

PANELLISTS

Name	**Rodolfo Carlos Rivas Rea**

DATE OF PANEL DECISION 2020-12-15

Publish the Decision