Decision for dispute CAC-UDRP-103411

Case number	CAC-UDRP-103411
Time of filing	2020-11-20 10:16:21
Domain names	I-INTESASANPAOLO.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

Organization	Milen Radumilo

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, inter alia, 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”, granted on March 5, 2014, in classes 9, 16, 35, 36, 38, 41 and 42; and
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38.

The Complainant is also the owner, inter alia, of the following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”: INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET and.BIZ, INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, and .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 and INTESA.ME. All of them are now connected to the official

website <intesasanpaolo.com>.

FACTUAL BACKGROUND

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

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 capitalisation exceeding 27,6 billion Euros. With a network of approximately 5,360 branches distributed throughout Italy, with market shares of more than 21% in most regions, the Group provides its services to approximately 14,6 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,2 million customers. The international division specialised in supporting corporate customers is present in 26 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.

On August 31, 2020, the Respondent registered the disputed domain name <I-INTESASANPAOLO.COM>.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The disputed domain name is confusingly similar, to the Complainant's trademarks "INTESA" and "INTESA SANPAOLO". I-<INTESASANPAOLO.COM> exactly reproduces the Complainant's well-known trademark "INTESA SANPAOLO", with the mere addition of the letter "I". This is a clear example of typosquatting.

In WIPO decision Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc, Case n. D2001-1314 – regarding the domain names <duetschebank.com> and <duetsche-bank.com>" the Panel considered such domain names to be confusingly similar and a clear example of "a case of 'typosquatting' where the domain name is a slight alphabetical variation from a famous mark.

The Respondent has no rights in the disputed domain name or any use of the trademarks "INTESA SANPAOLO" and "INTESA". 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. The Respondent is not commonly known as "I-INTESASANPAOLO".

There is no fair or non-commercial usage of the disputed domain name. The disputed domain name is not used for any bona fide offering of goods or services.

The disputed domain name is connected to a website sponsoring, among others, competing banking and financial services Consequently, Internet users, while searching for information on the Complainant's services, are confusingly led to the websites of the Complainant's competitors.

The disputed domain name <I-INTESASANPAOLO.COM> was registered and is used in bad faith.

The Complainant's trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and well known all around the world. The 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. In addition, if the Respondent had carried out even a basic Google search in respect of "INTESA SANPAOLO" and "INTESA", the same would have yielded obvious references to the Complainant. This raises a clear inference of knowledge of the Complainant's trademark on the part of the Respondent. Therefore, it is more than likely than not that the disputed domain name would not have been registered if it were not for Complainant's trademark. This is a clear evidence of registration of the domain name in bad faith.

The registration and use of a domain name to redirect internet users to websites of competing organizations constitutes bad faith registration and use under the Policy. See YAHOO! INC. v. David Murray, Case No. D2000-1013 (finding bad faith where respondent chooses a domain name similar to the complainant's mark for a site which offers services similar to the complainant).

The Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated.

On October 26, 2020 the Complainant's attorneys sent to the Respondent a cease and desist letter asking for the voluntary transfer of the disputed domain name. The Respondent did not comply with the above request.

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

The disputed domain name registered in 2020 is confusingly similar to the Complainant's prior INTESA SAN PAOLO trade mark adding only a hyphen, the letter 'i' and the gTLD .com which do not prevent confusing similarity between the Complainant's mark and the disputed domain name under the Policy.

The Respondent is not commonly known by the disputed domain name and is not authorised by the Complainant. Use of the domain name to point to commercial pay per click links to competing services is not a bona fide offering of goods or services or a legitimate non-commercial or fair use. It is registration and use in bad faith diverting Internet users for commercial gain and disrupting the Complainant's business. The combination of 'Intesa' and 'San Paolo' in the disputed domain name is distinctive of the Complainant and shows that the Respondent had actual knowledge of the Complainant, its business, rights and services.

The Panel also notes that the disputed domain name is offered for sale on the Respondent's web site which, in itself, is suggestive of bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

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Accepted

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

1. **I-INTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2020-12-15

Publish the Decision