Decision for dispute CAC-UDRP-103386

Case number	CAC-UDRP-103386
Time of filing	2020-11-12 11:06:12
Domain names	INTESA-SAN-PAOLO-PERSONE.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	davide basso

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's name and mark is registered both nationally and internationally. It has a substantial portfolio of registered marks including:

1. International trademark registration n.793367, the word mark, "INTESA", granted on 4 September 2002 in class 36;
2. International trademark registration n. 920896, the word mark, "INTESA SANPAOLO", granted on 7 March 2007 in class36, also covering the US;
3. EUTM registration n. 12247979, the word mark, "INTESA", applied for on 23 October 2013 and granted on 5 March 2014, in classes 9, 16, 35, 36,38, 41and 42; and
4. EUTM registration n. 5301999, the word mark, "INTESA SANPAOLO", applied on 8 September 2006, granted on 18 June 2007 in classes 35, 36 and 38.

The Complainant is also the owner of a large portfolio of domain names including <INTESASANPAOLO.COM>, .EU, .INFO, .BIZ, .NET, .ORG. All point to its main presence at <www.intesasanpaolo.com>.

FACTUAL BACKGROUND

The Complainant is one of Italy's and the EU's largest retail banks. It has about 20% of the retail market which makes it one of the biggest participants. It also has international operations in select markets.

Intesa Sanpaolo is the company resulting from the merger, on 1 January 2007, between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups.

It has a market capitalisation exceeding 31,1 billion euro, and is the undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

Its international network is specialised in supporting corporate customers and 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.

On 22 April 2020, the Respondent registered the disputed domain name <INTESA-SAN-PAOLO-PERSONE.COM>.
The Panel visited the disputed domain name on 16 December 2020 when it returned a "404 not found error page".

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

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

It is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA". As a matter of fact, <INTESA-SAN-PAOLO-PERSONE.COM> exactly reproduces well-known trademark "INTESA SANPAOLO", with the mere addition of the Italian descriptive term "PERSONE" (meaning "people"), which refers to Complainant's services users.

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" must be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue. The domain name at stake does not correspond to the name of the Respondent and, to the best of Complainant´s knowledge, the Respondent is not commonly known as "INTESA-SAN-PAOLO-PERSONE". Lastly, there is no fair or non-commercial use of the disputed domain name present.

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH
The disputed domain name <INTESA-SAN-PAOLO-PERSONE.COM> was registered and is used in bad faith. The Complainant's trademarks "INTESA" and "INTESA SANPAOLO" 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 even a basic Google search in respect of the wordings "INTESA" and "INTESA SANPAOLO", the same would have yielded obvious references to the Complainant. The Complainant relies on 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 selected and registered if it were not for Complainant's trademark. This is a clear evidence of registration of the disputed domain name in bad faith.
In addition, the disputed domain name is not used for any bona fide offerings. More particularly, there are present circumstances indicating that the Respondent has registered or acquired the disputed 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 Complainant, for valuable consideration in excess of the Respondent's

documented out-of-pocket costs directly related to the disputed domain name (par. 4(b)(i) of the Policy).
The disputed domain name is not used for any bona fide offerings; indeed, it is no longer connected to any web site. In fact, countless UDRP decisions confirmed 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, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003) and also the panels' consensus view on this point, as reflected in the "WIPO Overview of WIPO Views on Selected UDRP Questions" at paragraph 3.2.). In particular, the consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, panels have tended to make such findings in circumstances in which, for example, a complainant's mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the complainant's trade mark rights.
As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademarks. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant's trademarks and that results so similar to the Complainant's domain names currently used by the latter to provide online banking services for enterprises. In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain name has to be considered a use in bad faith: «The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain name to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of the disputed domain name for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests» (Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., concerning just the case of a bank name and mark).
The risk of a wrongful use of the domain name 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 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, the sensitive data of the Clients, like user ID, password etc. Then, some of the Clients have been cheated of their savings. Even excluding any "phishing" purposes or other illicit use of the domain name in the present case, anyway we could find no other possible legitimate use of <INTESA-SAN-PAOLO-PERSONE.COM>.
The sole further aim of the owner of the disputed domain name under consideration 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) («circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name»).

Lastly, it shall be noted that on 3 June 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 reply. In the 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

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

There is no question about the Complainant's Rights. It is a famous mark world-over.

As to similarity, the disputed domain name is the same as that famous name and mark and the only differences are the hyphens between words and the generic word "persone" (people) at the end. The disputed domain name is therefore similar and also confusing to the public. It looks official as it is a .com and so comes close to impersonation. The internet user in a hurry might well think it is part of the official site.

Of course, the key issue in the case is whether there could be a fair or legitimate use and whether the Complainant's name might be being used in a nominative sense to discuss the Complainant, its management or staff. But here the disputed domain name is not now being used for such a purpose. Indeed, it has never been put to any use, not even parking. While passive holding is not abusive per se, it is highly fact sensitive and the fact, it could in future have a benign a use is not enough. Particularly in the Banking sector, when there is a serious risk of fraud and phishing, the Complainant has an interest, and a duty, to protect its mark and its customers now.

The case falls squarely within the rule in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, namely where there is a famous mark, there is no fair or legitimate use and the respondent does not come forward to explain its selection, it will often be appropriate to infer knowledge and so bad faith.

The Panel finds bad faith here.

The Complainant has met its burden on all of the three limbs of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-SAN-PAOLO-PERSONE.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2020-12-16

Publish the Decision