Decision for dispute CAC-UDRP-103410

Case number	CAC-UDRP-103410
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Domain names	INTESAENPAOLO.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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 one of the leading banking groups in the Euro zone with a market capitalisation exceeding 27.6 billion euro. It 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.

The Complainant is the owner 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;

- 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.

The Complainant is also the owner 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.

FACTUAL BACKGROUND

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

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

The Complainant is the leading Italian banking group and also 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 euro zone, with a market capitalisation exceeding 27,6 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 5,360 branches capillary and well distributed throughout the Country, with market shares of more than 21% in most Italian regions, the Group offers 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. Moreover, the international network 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.

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;

- 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.

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 August 31, 2020, the Respondent registered the disputed domain name <INTESAENPAOLO.COM>.

It is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant's trademarks "INTESA" and "INTESA SANPAOLO". As a matter of fact, INTESAENPAOLO.COM exactly reproduces well-known trademark "INTESA SANPAOLO", with the mere substitution of the mark's verbal portion "SAN" with letters "E" and "N". This is a clear example of typosquatting.

In support of the above, the Complainant wishes to draw the Panel's attention to 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 as being confusingly similar and a clear example of "a case of 'typosquatting' where the domain name is a slight alphabetical variation from a famous mark. WIPO jurisprudence offers many examples of confusing similarity brought about through easily made typing errors by an Internet user – particularly when the mark is another language from that of the user's mother tongue." The same case lies before us in this matter.

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

The Respondent has no rights on 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 domain name at issue.

The domain name at stake does not correspond to the name of the Respondent and, to the best of our knowledge, The Respondent is not commonly known as "INTESAENPAOLO".

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

THE DISPUTED 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 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 even a basic Google search in respect of the wordings "INTESA SANPAOLO" and "INTESA", the same would have yielded obvious 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 domain name at issue 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.

In addition, the disputed domain name is not used for any bone fide offerings More particularly, there are present circumstances indicating that, by using the 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).

First of all, several services can be detected, but not in good faith: in fact, the disputed domain name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used (see also the Complainant's official site http://www.intesasanpaolo.com home page).

Consequently, Internet users, while searching for information on the Complainant's services, are confusingly led to the

websites of the Complainant's competitors, sponsored on the websites connected to the domain name at issue.

Therefore, the Complainant deems that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant's web site.

Several WIPO decisions stated that the registration and use of a domain name to re-direct internet users to websites of competing organizations constitute bad faith registration and use under the Policy. See, e.g., Encyclopaedia Britannica Inc. v. Shedon.com, WIPO Case No. D2000-0753 ("Respondent's Ownership of a site which is a mis-spelling of Complainant's britannica.com site and which Respondent used to hyperlink to a gambling site demonstrates Respondent's bad faith registration and use of the britannnica.com domain name"); 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); Edmunds.com v. Ultimate Search, Inc., WIPO Case No. D2001-1319 ("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"); Netwizards, Inc. v. Spectrum Enterprises, WIPO Case No. D2000-1768 ("Registration and continued use of the contested domain name for re-directing Internet users, i.e. particularly customers and potential customers of the Complainant, from the Complainant's website to the website of…a company which directly competes with the Complainant, constitutes bad faith registration and use"); Oly Holigan, L.P. v. Private, Case No. FA0011000095940 (finding bad faith where respondent used the disputed domain name to "redirect the Complainant's consumers and potential consumers to commercial websites which are not affiliated with Complainant"); Marriott International, Inc. v. Kyznetsov, Case No. FA0009000095648 (finding bad faith where respondent registered the domain name <marriottrewards.com> and used it to route internet traffic to another website that "promotes travel and hotel services . . . identical to the services offered by the Complainant"); Zwack Unicom Ltd v. Duna, WIPO Case No. D2000-0037 (respondent's linking to complainant's competitor held to constitute bad faith); Schneider Electric SA v. Ningbo Wecans Network Technology Co., Ltd, Ningbo Eurosin International Trade Co., Ltd., Case No. D2004-0554; Microsoft Corporation v. StepWeb, Case No. D2000-1500; Baudville, Inc. v. Henry Chan, Case No. D2004-0059; National City Corporation v. MH Networks LLC, Case No. D2004-0128.

The current use of the disputed domain name, which allows accessing to the web sites of the Complainant's competitors, also through the Complainant's trademark, causes, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones. So, the Respondent's conduct is even worse (see WIPO Decisions n. D2000-1500, Microsoft Corporation v. StepWeb, and D2001-1335, The Vanguard Group, Inc v. Venta).

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

There is something more. It is no coincidence that this speculation has involved a big financial institution such as Intesa Sanpaolo. In fact, the diversion practice in banking realm is very frequent due to the high number of online banking users. In fact, it has also to be pointed out that the Complainant has already been part of other WIPO Cases where the Panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations. A list of the WIPO Cases in which Intesa Sanpaolo has been part as the Complainant is enclosed.

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.

PARTIES CONTENTIONS

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).

First, the Complainant claims rights in the INTESA and INTESA SANPAOLO mark through its trademark registrations with the

EUIPO and WIPO. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

Second, the Complaint claims that the prominent part of the disputed domain name is confusingly similar to its trademark registration and its primary domain name <intesasanpaolo.com>. In particular, the Complainant points out that the disputed domain name reproduces its trademark INTESA SANPAOLO with the mere substitution of the mark's verbal portion "SAN" with letters "E" and "N" as below:

- Complainant's primary domain name <intesaSANpaolo.com>; and

- disputed domain name: <intesaENpaolo.com>

The Panel accepts that the changes of the characters do not alter the overall impression of the designation as being connected to the Complainant and its trademarks, and the ".com" generic top-level domain ("gTLD") is irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of paragraph 4(a)(i) of the Policy. See Belron International Limited v Andrea Paul, 103381, (CAC 2020-12-09) and LESAFFRE ET COMPAGNIE v Tims Dozman, 102430, (CAC 2019-04-02).

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, the Respondent is not authorized or licensed to use of the trademarks INTESA and INTESA SANPAOLO as well as the disputed domain name. The Complainant further contends that the disputed domain name does not correspond to the name of the Respondent and, to the best of Complainant's knowledge, the Respondent is not commonly known by as "INTESAENPAOLO". In addition, the use of the disputed domain name is not fair or non-commercial.

Having reviewed the screenshot of the website, the Panel notes that the website resolves to a pay-per-click website and there is a statement at the bottom of the website mentioning "The domain intesaenpaolo.com may be for sale. Click here to inquire about this domain." It is commonly accepted by the UDRP panels that use of domain name in connection with a pay-per-click website does not amount to a bona fide offering of goods or services or to a legitimate non-commercial or fair use, see Avast Software s.r.o. v Pham Dinh Nhut, 102373 (CAC 2019-04-20).

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name and the Respondent has not rebutted the assertion.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

First, the Complainant argues that the Respondent had actual knowledge of the Complainant's rights in its asserted trademarks INTESA SANPAOLO and INTESA as both are distinctive and well-known around the world. The disputed domain name is confusingly similar to Complainant's trademarks and the results shown on Google search in respect of the terms INTESA SANPAOLO and INTESA are obviously referencing the Complainant. The Panel agrees that Complainant's INTESA SANPAOLO and INTESA are well-known and notes that the trademarks were registered well before the registration date of the disputed domain name. Registering a domain name similar to a well-known brand with actual knowledge clearly constitutes to registration in bad faith, see ARCELORMITTAL (SA) v acero, 102399, (CAC 2019-04-22). On this basis, the Panel accepts that the disputed domain name was registered in bad faith.

Second, the Complainant asserts that the disputed domain name is not used for any bone fide offerings and the Respondent has had 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). Furthermore, the disputed domain name resolves to a website featuring different URLs related Complainant's industry which is banking and financial services. Internet users may be confusingly led to the website of Complainant's competitors. It is commonly agreed that Respondent cannot disclaim responsibility for content appearing on the website associated with its domain name and it constitutes bad faith, see Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-04-19). In this circumstance, the Panel finds that Respondent's use of the disputed domain name is in bad faith.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESAENPAOLO.COM**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2020-12-17

Publish the Decision