Decision for dispute CAC-UDRP-103472

Case number	CAC-UDRP-103472
Time of filing	2020-12-23 10:58:22
Domain names	PERSICUREZZAINTESA.COM, QUIINTESASAPAOLO.COM, LAINTESASAPAOLO.COM, SICUREZZAINTESA.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	bruno davino

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following registrations for the trademarks “INTESA” and “INTESA SANPAOLO”:

- International trademark registration no. 793367 “INTESA”, granted on 2002-09-04 and duly renewed, in class 36;
- International trademark registration no. 920896 “INTESA SANPAOLO”, granted on 2007-03-07 and duly renewed, in classes 9, 16, 35, 36, 41, 42;
- EU trademark registration no. 12247979 “INTESA”, applied on 2013-10-23 and granted on 2014-03-05, in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration no. 5301999 “INTESA SANPAOLO”, applied on 2006-9-08, granted on 2007-6-18 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 <intesasanpaolo.com>).

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 protagonists in the European financial arena. Intesa Sanpaolo is the company resulting from the merger (effective as of 2007-01-01) between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups.

The Complainant is among the top banking groups in the eurozone, with a market capitalisation exceeding 37,4 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). It has 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 Complainant offers its services to approximately 14.6 million customers and has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,2 million customers. The Complainant's international network specialise in supporting corporate customers and 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 2020-04-08, the Respondent registered the domain names <PERSICUREZZAINTESA.COM, QUIINTESASAPAOLO.COM, LAINTESASAPAOLO.COM and SICUREZZAINTESA.COM> ('the disputed domain names').

The Complainant challenges the Respondent's registration of the disputed domain names under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("Policy") and seeks relief that the disputed domain names be transferred to the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant's Legal Grounds are set out in its Amended Complaint filed on 2020-12-23. The Panel refers to and repeats them herein seriatim.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are 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.

The Complainant contends that the disputed domain names are identical, or at least, confusingly similar to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”.

The disputed domain names <PERSICUREZZAINTESA.COM> and <SICUREEZZAINTESA.COM> have their roots in the phrase “INTESA”, which clearly incorporate the identical sign “INTESA” which is the registered trademark of the Complainant. The addition of the descriptors “PERSICUREZZA” or “SICUREZZA” in the Panel’s view does not make the respective disputed domain names sufficiently distinguishable from the Complainant’s trademark “INTESA”. The Panel considers that the lack of distinctiveness makes the disputed domain names <PERSICUREZZAINTESA.COM> and <SICUREEZZAINTESA.COM> confusingly similar to the Complainant’s trademark “INTESA”.

The Panel considers that when part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner. It is, therefore, sufficient to establish identity or confusing similarity for the purposes of the Policy. See Oki Data Americas, Inc. v. ASD, Inc, WIPO Case No. D2001-0902; Dr. Ing. h.c. F. Porsche AG v Vasiliy Terkin, WIPO Case No D2003-003-0888.

The disputed domain names <QUIINTESASAPAOLO.COM> and <LAINTESASAPAOLO.COM>similarly have their roots in the phrase “INTESA” but with the additions of either a noun or pronoun (ie QUI or LA”) before the phrase “INTESA” combined with the phrase “SAPAOLO” which is a slight subtraction of the letter “N” from the phrase “SANPAOLO”, which on one view could “herein” or “therein” be alluding to the person of “Saint Paul” (from the Italian translation of the name San Paolo) or the municipality of San Paolo in Lombardy. There is no basis, however, to conclude this.

The Complainant contends, insofar as the contention is directed to the disputed domain names <QUIINTESASAPAOLO.COM> and <LAINTESASAPAOLO.COM>, that the aforesaid disputed domain names exactly reproduce its well-known trademark “INTESA SANPAOLO”, with the mere slight addition/subtraction/variation of terms and letters (namely the descriptive word “SICUREZZA”, the deletion of the letter “N” in the mark’s verbal portion “SAN”), which make all of them typical cases of “typosquatting”.

In support of this contention, the Complainant referred to the 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 in the WIPO decision 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.

While the Panel does not consider that this is strictly a clear example of ‘typosquatting’ given the additions of the noun or pronoun “QUI” or “LA” to “INTESASAPAOLO” to form the disputed domain name, the Panel considers that the aforesaid disputed domain names are confusingly similar to the Complainant’s trademark “INTESA SANPAOLO” to satisfy the requirement 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 names within the meaning of paragraph 4(a)(ii) of the Policy.

The Complainant contends that it has not authorised or licensed the Respondent to use any of the trademarks “INTESA SANPAOLO” and “INTESA”, and has no rights on the disputed domain names. The Panel accepts this uncontradicted contention.

The evidence does not indicate that the Respondent is commonly known by the disputed domain names, but the Respondent’s name suggests one ‘Bruno Davino’.

The evidence shows that the disputed domain names were registered many years after the registrations of the Complainant's trademarks.

The disputed domain names also did not resolve to any active website nor have the disputed domain names been used for any offering of goods or services. A message ‘403 Forbidden Access to this resource on the server is denied’ is being displayed instead when seeking to access each of the disputed domain names.

The Panel considers that this suggests that there is no bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain names. See Ustream.TV, Inc. v. Vertical Axis, Inc, WIPO Case No. D2008-0598.

The Panel is prepared to draw the adverse inference that the Respondent is likely profiting from the confusion likely to arise from consumers believing that the disputed domain names are connected to or associated with the Complainant's trademarks and its business.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

There are two elements that must be satisfied – registration and use in bad faith.

As for registration of the disputed domain names, the Panel accepts the Complainant's evidence to support this element. In particular the Panel is persuaded by the evidence that the Complainant's trademark registrations predate the registration of the disputed domain names, and the Respondent has never been authorised by the Complainant to register the disputed domain names.

Further, the evidence shows that the Complainant's trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and well-known around the world, including in Italy where the Respondent is alleged to reside, and prima would indicate that the Respondent knew or ought to have known of the Complainant or the Complainant's trademarks or business at the time the Respondent registered the disputed domain names.

Use in bad faith

In "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246, the Panel said:

"The Domain Name was not resolving to an active website at the time of filing. However, the consensus view amongst WIPO panellists is that 'the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith."
See also the Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-000; Comerica Inc. v. Horoshiy, Inc. WIPO Case No. D2004-0615.

The Panel has already referred to the uncontroverted facts set out in the Amended Complaint and accepts the evidence and contention that the disputed domain names do not resolve to any active websites, which constitutes passive holding and/or non-use of the disputed domain names. The Czech Arbitration Court has also provided written notice of the Complaint to the Respondent with no administratively compliant responses made in respect to any good faith use of the disputed domain names.

In the circumstances, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain names by the Respondent that would be legitimate. The Panel, therefore, concludes that the Respondent's passive holding of the disputed domain names in this particular case satisfies the requirement of that the disputed domain names are being used in bad faith by the Respondent.

Accordingly, the Panel finds that the registration of the disputed domain names and its use were in bad faith.

PROCEDURAL FACTORS

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On 2021-01-19 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):
that neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court. The CAC is therefore unaware whether the written notice was received by the Respondent or not;

As far as the e-mail notice is concerned, the CAC received a confirmation that the e-mail sent to capudenis263@gmail.com was successfully relayed;
The e-mail notice sent to postmaster@laintesasapaolo.com was returned back undelivered as the e-mail address had permanent fatal errors;
The e-mail notice sent to postmaster@persicurezzaintesa.com was returned back undelivered as the e-mail address had permanent fatal errors;
The e-mail notice sent to postmaster@sicurezzaintesa.com was returned back undelivered as the e-mail address had permanent fatal errors;
The e-mail notice sent to postmaster@quiintesasapaolo.com was returned back undelivered as the e-mail address had permanent fatal errors;

No further e-mail address could be found on the disputed site. The Respondent never accessed the online platform.'

Given the reasonable measures employed by CAC as set out in the above non-standard communication, the Panel is satisfied that CAC has discharged this responsibility.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain names are confusingly similar to the Complainant's well-known trademarks by either incorporating wholly the Complainant's trademarks or a slight subtraction of a letter from the Complainant's trademarks to combine with other descriptive words.

The disputed domain names do not resolve to any active websites and is, therefore, a classic case of passive holding or non-use of the disputed domain names. That fact alone does not make it improper but coupled with other cumulative circumstances it can only be inferred that the Respondent does not have any rights or legitimate interests in the disputed domain names.

The Complainant trademark is well-known around the world. By incorporating the Complainant's trademarks into the disputed domain names without any authorisation from the Complainant, the Respondent is likely seeking to capitalise on the Complainant's business reputation and trademarks. Such registration and use can only be inferred to have been done in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PERSICUREZZAINTESA.COM**: Transferred
2. **QUIINTESASAPAOLO.COM**: Transferred
3. **LAINTESASAPAOLO.COM**: Transferred
4. **SICUREZZAINTESA.COM**: Transferred

PANELLISTS

Name	**Adjunct Prof William Lye, OAM QC**

DATE OF PANEL DECISION 2021-01-30

Publish the Decision