

Decision for dispute CAC-UDRP-103540

Case number CAC-UDRP-103540

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Domain names INTESANOPAOLO.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 tonkin katia sonia

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 of the following registered trademarks in respect of the marks INTESA and INTESA SANPAOLO:

International registered trademark no. 793367 for the word mark INTESA, granted on September 4, 2002 in class 36 and designated in respect of over 40 territories;

International registered trademark no. 920896 for the word mark INTESA SANPAOLO, granted on March 7, 2007 in classes 9, 16, 35, 36, 38, 41 and 42 and designated in respect of over 60 territories;

European Union registered trademark no. 12247979 for the word mark INTESA, granted on March 05, 2014 in classes 9, 16, 35, 36, 38, 41 and 42; and

European Union registered trademark no. 5301999 for the word mark INTESA SANPAOLO, granted on June 18, 2007 in classes 35, 36 and 38.

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

The Complainant is an Italian banking group resulting from the merger between two of the top Italian banking groups, Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., with effect from January 1, 2007.

The Complainant has approximately 14.6 million customers and a market capitalisation exceeding EUR 37.4 billion. It engages in retail, corporate and wealth management banking activities, and maintains approximately 5,360 branches throughout Italy. It has a market share of more than 21% in most Italian regions. The Complainant also 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, specialised in supporting corporate customers, is present in 26 countries, notably in the Mediterranean area and the United States, Russia, China and India.

The Complainant is the owner of the INTESA and INTESA SANPAOLO registered trademarks. The Complainant is also the owner of multiple domain names bearing these marks, including for example, <intesasanpaolo.com> which is used for the Complainant's official website.

The Respondent registered the disputed domain name on May 15, 2020. The disputed domain name is identical, or at least confusingly similar to the Complainant's marks and exactly reproduces the Complainant's INTESA SANPAOLO mark, with the mere substitution of the mark's verbal portion "SAN" with letters "N" and "O". This is a clear example of typosquatting, being a slight alphabetical variation from a famous mark.

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized or licensed anyone to use the disputed domain name. The disputed domain name does not correspond to the name of the Respondent and the Respondent is not commonly known as "intesanopalo". There are no fair or non-commercial uses of the disputed domain name in consideration.

The disputed domain name has been registered and is being used in bad faith. The Complainant's trademarks INTESA and INTESA SANPAOLO are distinctive and well-known globally. The registration of a confusingly similar domain name indicates that the Respondent had knowledge of such marks at the time of registration. Even a basic Google search in respect of the wording INTESA and INTESA SANPAOLO would have yielded obvious references to the Complainant. It is more than likely that the disputed domain name would not have been registered if it were not for Complainant's trademarks.

The disputed domain name is not used for any bona fide offerings. There are circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling it to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs.

The disputed domain name is passively held and countless UDRP decisions confirm that 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. Such finding is particularly indicated where the Complainant's trademark is well-known and there is no conceivable use that could be made of the disputed domain name that would not amount to an infringement of the Complainant's trademark rights. It is not possible objectively to understand what kind of use the Respondent could make of the disputed domain name which is so similar to the Complainant's domain names currently used to provide online banking services for enterprises. The very act of having acquired the disputed domain name raises the probability of the Respondent using it in a manner that is contrary to Complainant's legal rights and legitimate interests.

The risk of a wrongful use of the disputed domain name is even higher since the Complainant has already been targeted by some cases of phishing in the past few years. Certain clients of the Complainant have received e-mail messages seeking, by the means of web pages which were very similar to the Complainant's ones, sensitive data, such as user ID, password etc.

On July 8, 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 this request.

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).

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 Panel notes that the second level of the disputed domain name consists of a typographical variant of the Complainant's INTESA SANPAOLO mark. The only difference between said second level and the Complainant's mark (besides a space which cannot be reproduced in a domain name for technical reasons) is that the letters "SAN" in the Complainant's mark have been substituted with the letters "NO". Despite such substitution, the Complainant's mark is still readily recognizable within the disputed domain name, which consists of an obvious misspelling of such mark and is thereby confusingly similar thereto. The generic Top-Level Domain, in this case ".com", is typically disregarded for the purposes of the comparison exercise. In these circumstances, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name. The Complainant asserts that the Respondent is not commonly known by the disputed domain name, that the Complainant has not authorized or licensed anyone to use its mark in the disputed domain name and that the Respondent is not making a non-commercial or fair use of the disputed domain name.

The Respondent has not filed a Response in this case, nor did it reply to the Complainant's cease and desist notice. Accordingly, the Respondent has not taken either of these opportunities to set out any alleged rights or legitimate interests in the disputed domain name. There are no submissions or evidence on the record which might serve to rebut the Complainant's prima facie case. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has established that the disputed domain name has been registered and is being used in bad faith. As was noted in CAC Case No. 102359, Intesa Sanpaolo S.p.A. v. Emeka Nkwo, the Complainant's INTESA SANPAOLO trademark has a significant reputation and is of distinctive character. Said trademark pre-dates the registration of the disputed domain name by a considerable period. In these circumstances, it is reasonable for the Panel to infer that the Respondent was aware of the Complainant's rights in said mark when it registered the disputed domain name. The fact that the disputed domain name itself contains a close typographical variant of the Complainant's mark also suggests that it was registered with intent to target the same. Such targeting is evident in the fact that the disputed domain name seeks to capitalize on any mistyping of the Complainant's primary domain name by its customers. It is also apparent in the fact that, in general terms, the disputed domain name promotes confusion by its close similarity in appearance to the Complainant's

mark.

There is no website at the disputed domain name and accordingly it is being “passively held”. Such passive holding does not allow the Respondent to escape a finding of registration and use in bad faith in circumstances where, as here, the disputed domain name is confusingly similar to the Complainant’s mark, which is distinctive and of considerable reputation, the Respondent has failed to submit a Response or otherwise to provide any evidence of actual or contemplated good faith use, and it is implausible that the disputed domain name could be put to any such good faith use if its website were to become active (see, on this topic, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003).

The Respondent has not taken up the opportunity to address the Complainant’s allegations of bad faith registration and use, nor has it attempted to advance any explanation for the registration and use of the disputed domain name which might indicate that its actions were in good faith. On the basis of the present record, and in the absence of such a Response, the Panel has not identified any likely or reasonable explanation which the Respondent might have given regarding its registration and use of the disputed domain name which would have avoided a finding of registration and use in bad faith in accordance with the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESANOPAOLO.COM**: Transferred

PANELLISTS

Name	Andrew Lothian
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DATE OF PANEL DECISION 2021-03-02

Publish the Decision
