

Decision for dispute CAC-UDRP-103542

Case number	CAC-UDRP-103542
Time of filing	2021-02-02 14:50:41
Domain names	ASSISTENZA-INTESASANPAOLO.COM

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Intesa Sanpaolo S.p.A.
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Complainant representative

Organization	Intesa Sanpaolo S.p.A.
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Respondent

Name	Jones Andrew
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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 trademarks:

- INTESA, International registration No. 793367, of 4 September 2002, duly renewed, for services in class 36;
- INTESA SANPAOLO, International registration No. 920896, of 7 March 2007, duly renewed, for goods and services in classes 9, 16, 35, 36, 41 and 42;
- INTESA, EU registration No. 12247979, filed on 23 October 2013 and registered on 5 March 2014, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42; and
- INTESA SANPAOLO, EU registration No. 5301999, filed on 8 September 2006 and registered on 18 June 2007, duly renewed, for services in classes 35, 36 and 38.

The Complainant is also the owner of various domain names including the trademark INTESA SANPAOLO and INTESA, such

as <intesianpaolo.com>, < intesa-sanpaolo.com>, < intesa.com> and corresponding others under different gTLDs and ccTLDs. All these domain names redirect to the Complainant's official website at "www.intesianpaolo.com".

FACTUAL BACKGROUND

The Complainant is among the top banking groups in the euro zone, with a market capitalisation exceeding 37,4billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). The Complainant operates under a network of approximately 5,360 branches spread throughout Italy, with a market share exceeding 21% in most Italian regions. As such, the Complainant's group offers its services to approximately 14,6million customers. The Complainant also operates in Central-Eastern Europe with a network of approximately 1,000 branches and over 7,2 million customers. Moreover, the Complainant supports corporate customers in 26 countries, in particular in the Mediterranean area and in those areas where Italian companies are most active, such as the United States, Russia, China and India.

The disputed domain name was registered on 8 June 2020. On 11 August 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 Complainant's request.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant maintains that the disputed domain name is identical or at least confusingly similar to its INTESA SANPAOLO and INTESA trademarks as the disputed domain name exactly reproduces the well-known trademark INTESA SANPAOLO, with the mere addition of the term "assistenza", whose meaning is "assistance".

The Complainant further argues that the Respondent lacks any rights and legitimate interests in the disputed domain name, as it never authorised the Respondent to use the trademarks INTESA and INTESA SANPAOLO. Moreover, the disputed domain name does not correspond to the name of the Respondent and, to the best of the Complainant's knowledge, the Respondent is not commonly known by the disputed domain name. Lastly, according to the Complainant, the Respondent is not making any fair or non-commercial use of the disputed domain name.

With respect to the registration of the disputed domain name in bad faith, the Complainant points out that its trademarks INTESA and INTESA SANPAOLO are distinctive and well known. The fact that the Respondent registered a domain name confusingly similar to them indicates that the Respondent was aware of their existence at the time it registered the disputed domain name. Furthermore, a simple Google search against the wordings INTESA and INTESA SANPAOLO would have revealed several findings unequivocally associated with the Complainant. Therefore, it is more than likely that the disputed domain name would not have been registered if it were not for the Complainant's trademarks.

Lastly, in connection with use in bad faith, the Complainant points out that even if there is no current use of the disputed domain name, passive holding of a domain name cannot prevent a finding of bad faith. This is so, especially in circumstances, like those at issue, where the disputed domain name corresponds to a well-known trademark and there is no conceivable use of the disputed domain name that the Respondent could possibly make without infringing the Complainant's trademarks.

In the instant case, the risk of a wrongful use of the disputed domain name is even higher, since the Complainant operates in the banking field and has already been the victim of phishing activities in the past. Anyhow, even excluding phishing activities, as there is no conceivable legitimate use of the disputed domain name, the only other possibility is that the Respondent acquired the disputed domain name for selling, renting or otherwise transferring it to the Complainant, or to a Complainant's competitor for a valuable consideration in excess of the documented out-of-pocket costs.

The fact that the Respondent failed to voluntarily transfer the disputed domain name to the Complainant upon its request, is further indication of the Respondent's bad faith.

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

I. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (paragraph 4(a)(i) of the Policy).

The disputed domain name consists of the Complainant's trademark INTESA SANPAOLO preceded by the generic Italian word "assistenza" (in English "assistance"). The word "assistenza" and the Complainant's trademark INTESA SANPAOLO are separated by a hyphen, in a manner that renders the trademark well recognizable within the domain name. According to the general opinion of UDRP Panels, whenever a domain name includes a complainant's trademark there is confusing similarity. The addition of the descriptive Italian term "assistenza" to the Complainant's trademark cannot prevent a finding of confusing similarity under the first element of the Policy (see §1.8 of the "WIPO Jurisprudential Overview 3.0" stating as follows: "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element").

In the instant case, the fact that the word "assistenza" is in Italian enhances the confusing similarity with the Complainant's trademark INTESA SANPAOLO, considering that the Complainant is an Italian entity. Hence, the Internet users, when facing the disputed domain name will find it natural that it originates from the Complainant and will therefore be misled by its origin. For all these reasons, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of rights or legitimate interests in respect of the disputed domain name (paragraph 4(a)(ii) of the Policy)

It is a generally accepted principle that when a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of proof of the rights or legitimate interests on the domain name shifts to the respondent. In the instant case, the Complainant affirms that the Respondent is not known to the Complainant and that the Complainant never licensed its trademarks INTESA and INTESA SANPAOLO to the Respondent, nor authorised the Respondent to make use of them.

Moreover, nothing in the case file shows that the Respondent is known by the disputed domain name.

At the time of the filing of the Complaint, the Respondent was passively holding the disputed domain name. Accordingly, and for the reasons further discussed below, the Respondent was not using, nor was making any demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services, nor was making any non-commercial or fair use of the disputed domain name in accordance with para. 4 c. (iii) of the Policy.

The Respondent could have rebutted the Complainant's allegations, but failed to do so. Consequently, the Panel takes the view that the Complainant has at least established a prima facie case of the Respondent's lack of rights or legitimate interests in the disputed domain name.

Thus, the Panel is satisfied that also the second condition under the Policy is met.

III. Bad faith (paragraph 4(a)(iii) of the Policy)

The Policy requires that in order to meet the third and last requirement under the Policy, the Complainant must successfully prove that both the registration and use of the disputed domain name have been made in bad faith.

The Panel agrees with the Complainant that the Respondent was aware of the Complainant's trademark at the time of the registration of the disputed domain name. The Complainant's trademark is distinctive and well known. It therefore cannot be by simple coincidence that the Respondent chose to register a domain name exactly reproducing the Complainant's trademark preceded by the generic Italian word "assistenza". It is rather highly likely that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark.

Currently, the Respondent is passively holding the disputed domain name. Passive holding cannot prevent a finding of bad faith under some given circumstances, such as (without limitation): (i) when the complainant's trademark is distinctive or well known, (ii) the Respondent fails to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) there cannot be any plausible good faith use to which the disputed domain name may be put.

In the instant case, as mentioned above, the Complainant's trademarks are distinctive and well known. The Respondent failed to submit a response or to provide evidence of actual or contemplated good faith use of the disputed domain name. Prior to filing its Complaint, the Complainant attempted to solve the matter amicably, through the sending of a cease and desist letter, to which the Respondent failed to reply. Furthermore, in consideration of the fact that the trademarks INTESA and INTESA SANPAOLO can solely be linked to the Complainant, and of the field of activity of the Complainant, there appears to be no plausible good faith use of the disputed domain name by the Respondent. Indeed, as also argued by the Complainant, the only possible use of the disputed domain name by the Respondent could be in relation to phishing or other illegitimate activities, or to exploit the Complainant's goodwill and reputation for the Respondent's own profit.

For all the aforementioned reasons, the Panel concludes that the Respondent registered and has been using the disputed domain name in bad faith. Consequently, also the third and last condition under the Policy is met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	Angelica Lodigiani
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DATE OF PANEL DECISION	2021-03-07
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Publish the Decision
