

Decision for dispute CAC-UDRP-103534

Case number	CAC-UDRP-103534
Time of filing	2021-02-01 09:19:22
Domain names	INTESA-SANPAOLO-SICUREZZA-ONLINE-OTP.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	Giovanni Iovino
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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 bases its Complaint on the:

- International trademark registration "INTESA", no. 793367, registered on 04.09.2002, for services in class 36, designating several countries for protection;
- International trademark registration "INTESA SANPAOLO", no. 920896, registered on 07.03.2007, for goods and services in classes 9, 16, 35, 36, 41, 42, designating several countries for protection;
- EU trademark registration "INTESA", no. 12247979, filed on 23.10.2013, registered on 05.03.2014, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration "INTESA SANPAOLO", no. 5301999, filed on 08.09.2006, registered on 18.06.2007, for services in classes 35, 36 and 38.

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

The Complainant is Intesa Sanpaolo S.p.A., a 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 37,4 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 Italy, 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 owns several trademarks "INTESA" and "INTESA SANPAOLO" such as:

- International trademark registration "INTESA", no. 793367, registered on 04.09.2002, for services in class 36, designating several countries for protection;
- International trademark registration "INTESA SANPAOLO", no. 920896, registered on 07.03.2007, for goods and services in classes 9, 16, 35, 36, 41, 42, designating several countries for protection;
- EU trademark registration "INTESA", no. 12247979, filed on 23.10.2013, registered on 05.03.2014, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration "INTESA SANPAOLO", no. 5301999, filed on 08.09.2006, registered on 18.06.2007, for services in classes 35, 36 and 38.

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>.

The disputed domain name < INTESA-SANPAOLO-SICUREZZA-ONLINE-OTP.COM> was registered on 21.02.2020.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant's contentions are the following:

The disputed domain name <INTESA-SANPAOLO-SICUREZZA-ONLINE-OTP.COM> is identical, or – at least – confusingly similar to the Complainant's earlier trademarks "INTESA SANPAOLO" and "INTESA" since it reproduces exactly the Complainant's well-known trademark "INTESA SANPAOLO", with the mere addition of the terms "SICUREZZA" (meaning "security") and "ONLINE" and the addition of letters "O", "T" and "P".

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain name for a number of reasons.

First, the Complainant asserts that the Respondent has no rights on the disputed domain name, and any use of the trademarks "INTESA SANPAOLO" and "INTESA" has not been authorized or licensed by the Complainant.

Further, the Complainant asserts that the domain name at stake does not correspond to the name of the Respondent and, to the best of its knowledge, the Respondent is not commonly known as "INTESA-SANPAOLO-SICUREZZA-ONLINE-OTP".

Lastly, the Complainant asserts that it does not find any fair or non-commercial uses of the domain name at stake.

The Complainant further argues that the disputed domain name has been registered and is used in bad faith.

The Complainant's asserts that that its "INTESA" and "INTESA SANPAOLO" trademarks are distinctive and well known and therefore, that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks.

In addition, the Complainant further asserts 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.

Furthermore, the disputed domain name is not used for any bona fide offerings as the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name.

The Complainant further asserts that the disputed domain name is not used for any bona fide offerings, even if it is not connected to any web site, by now, thus, being passively held, which is also an evidence of bad faith. The Complainant asserts that 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 asserts that it has already extensively proved the renown of its trademarks. For what concern the second circumstance, the Complainant asserts 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, in the Complainant's view, the present case completely matches to the above requirements and the passive holding of the contested 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 names 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 disputed domain names 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).

The Complainant also asserts that the Respondent has engaged in abusive domain name registration and use.

Thus, in the Complainant's view, the risk of a wrongful use of the domain name at issue is even higher in the present case, since the Complainant apparently 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. The Complainant asserts 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, the Complainant asserts that some of the Clients have been cheated of their savings.

The Complainant further asserts that, even excluding any "phishing" purposes or other illicit use of the domain name in the present case, it could not find other possible legitimate use of <INTESA-SANPAOLO-SICUREZZA-ONLINE-OTP.COM>. The sole further aim of the owner of the domain name under consideration might be, as per the Complainant's assertions to resell it to the Complainant, which represents, in any case, an 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»).

Also, the Complainant underlined that, on July 6, 2020 the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the domain names in dispute. Despite such communication, according to the Complainant's assertions, the Respondent did not comply with the above request.

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. Confusing Similarity

The Panel agrees that the disputed domain name <INTESA-SANPAOLO-SICUREZZA-ONLINE-OTP.COM> is confusingly similar to the Complainant's earlier trademarks "INTESA SANPAOLO" since it reproduces exactly the Complainant's trademarks "INTESA SANPAOLO", while the mere addition of the descriptive terms "SICUREZZA" (meaning "security") and "ONLINE" as well as of the letters "O", "T" and "P" are insufficient to avoid confusing similarity.

Moreover, the extension “.com” is not to be taken into consideration when examining the similarity between the Complainant’s trademarks and the disputed domain name (WIPO Case No. D2005-0016, *Accor v. Noldc Inc.*). The mere adjunction of a gTLD such as “.com” is irrelevant as it is well established that the generic Top-Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, *L’Oréal v Tina Smith*, WIPO Case No. D2008-0820 *Titoni AG v Runxin Wang* and WIPO Case No. D2009-0877, *Alstom v. Itete Peru S.A.*).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

The Complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name and also the domain name in dispute does not correspond to the name of the Respondent. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised or licensed the Respondent to make use of its trademarks, nor of a confusingly similar trademark in the disputed domain name.

Finally, based on the available evidence, the disputed domain name does not appear to be connected to any web site, by now. Such use does not amount to a bona fide offering of goods or services, or to a legitimate non-commercial or fair use of the disputed domain name.

The Panel notes that the Respondent had an opportunity to comment on the Complaint’s allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

Based on the provided proofs, the Complainant’s trademark “INTESA SANPAOLO” is a well-known one and the disputed domain name incorporates it in its entirety. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant’s trademark and has intentionally registered the domain name, by incorporating the well-known trademark “INTESA SANPAOLO” in its entirety.

Based on the available evidence, the disputed domain name is being passively held.

Under certain circumstances, the passive holding of a domain name cannot prevent a finding of bad faith. Factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put (See paragraph 3.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (WIPO Jurisprudential Overview 3.0)).

In the present case, the following factors should be considered:

(i) the Complainant's trademark is a well-known one;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;

(iii) the Respondent registered the disputed domain name by incorporating in its entirety the well-known trademark "INTESA SANPAOLO"; and

(iv) any good faith use of the disputed domain name would be implausible, as the trademark INTESA SANPAOLO is univocally linked to the Complainant and the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name confusingly similar to the Complainant's trademark.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. INTESA-SANPAOLO-SICUREZZA-ONLINE-OTP.COM: Transferred

PANELLISTS

Name	Delia-Mihaela Belciu
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DATE OF PANEL DECISION 2021-03-07

Publish the Decision
