Decision for dispute CAC-UDRP-103612

Case number	**CAC-UDRP-103612**
Time of filing	**2021-03-02 09:39:18**
Domain names	**MY-INTESASANPAOLO.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	**Joshua McGirr**

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 submitted evidence that it is the registered owner of the following trademarks:

- International trademark registration n. 920896 “INTESA SANPAOLO” (word trademark), registered on March 7, 2007, and duly renewed, valid for classes 9, 16, 35, 36, 38, 41 and 42 and valid in various countries, including Australia;
- EU trademark registration n. 5301999 “INTESA SANPAOLO” (word trademark), registered on June 18, 2007, and duly renewed, valid for classes 35, 36 and 38;
- International trademark registration n. 793367 “INTESA”, registered on September 4, 2002 and duly renewed, valid for class 36;
- EU trademark registration n. 12247979 “INTESA” (word trademark), registered on March 5, 2014, and duly renewed, valid for classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

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

The Complainant (“Intesa Sanpaolo”) is a well-known Italian banking group, which is also active in the rest of Europe. 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., which are two Italian banking groups. The Complainant claims to be among the top banking groups in the euro zone, with a market capitalisation exceeding 35,1 billion euros. Besides banking, the Complainant is also active in other business areas such as retail, and corporate & wealth management. The Complainant claims to have a network of approximately 5.300 branches, with market shares of more than 21% in most Italian regions. The Complainant claims to offer its services to approximately 14,7 million customers. The Complainant also claims to have ‘a strong presence’ in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,1 million customers. Moreover, the Complainant claims to have an international network specialised in supporting corporate customers in 26 countries, in particular in the Mediterranean area and areas where Italian companies are active, such as the United States, Russia, China and India.

The Complainant has submitted evidence that it is the registered owner of the trademarks mentioned above under "Identification of rights".

The Complainant further asserts that it is the owner of various domain names consisting of the terms "INTESA" and “INTESA SANPAOLO”, and different domain extensions (including <intesasanpaolo.com, intesasanpaolo.org, ntesasanpaolo.eu, intesasanpaolo.info, intesasanpaolo.net, intesasanpaolo.biz, intesa-sanpaolo.com, intesa-sanpaolo.org, intesa-sanpaolo.eu, intesa-sanpaolo.info, intesa-sanpaolo.net, intesa-sanpaolo.biz, 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, and intesa.me>). According to the Complainant, all of these domain names are connected to its official website www.intesasanpaolo.com. However, the Complainant did not submit evidence of these assertions.

The disputed domain name was registered on August 12, 2020.

The Complainant has demonstrated evidence that, at the time of filing its complaint, the disputed domain name was not in use. On November 26, 2020, the Complainant’s attorneys sent a cease and desist letter to the Respondent (per email via the Privacy Service that was listed as contact), 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

1. Identical or confusingly similar

The disputed domain name <MY-INTESASANSPAOLO.COM> consists of the Complainant's registered trademark(s) "INTESA SANPAOLO", with the mere addition of the term "MY" and a dash symbol ("-"). There is also the addition of the '.com' suffix, which may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

The Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that 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 production 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, the complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then has to weigh all the evidence, with the burden of proof always remaining on the complainant.
The Panel notes that the Complainant contends that the Respondent was not authorised or given a license to use its trademark(s) "INTESA SANPAOLO". The Complainant further argues that the Respondent is not commonly known as the disputed domain name, i.e. "(MY-)INTESASANSPAOLO". Lastly, the Complainant contends that it has not found any fair or non-commercial uses of the disputed domain name by the Respondent.

The Respondent did not file an administratively compliant (or any) response. In such circumstances, the Panel finds from the facts put forward that:

The Respondent does not appear to have any rights or legitimate interests associated with the "INTESA SANPAOLO" trademark(s), nor with variations thereof such as "MY-INTESASANPAOLO".

There is no evidence that the Respondent is commonly known by the "INTESA SANPAOLO" trademark(s), or with variations such as "MY-INTESASANPAOLO". The Respondent does not seem to have any consent to use these trademarks or variations such as "MY-INTESASANPAOLO". The disputed domain name does not correspond to the name of the Respondent.

There is no evidence to show that the Respondent may have used the disputed domain name for any bona fide offering of goods or services of its own. Also, there is no evidence to show any demonstrable preparations to use the domain name or a name corresponding to the disputed domain name in connection with such bona fide offering of goods or services.
There is no evidence to show that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks at issue.

On the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith registration and use

The Complainant asserts that its trademarks "INTESA SANPAOLO" are distinctive and well-known.

The Complainant submitted evidence that a Google search for the terms "INTESA SANPAOLO" results in multiple search results linked to the Complainant (including the first search result). The Complainant contends that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark(s), and that the disputed domain

name would not have been registered if it were not for Complainant's trademark(s). The Complainant further contends that the fact that the Respondent registered a domain name that is confusingly similar to these distinctive and well-known trademarks indicates that the Respondent had knowledge of the Complainant's trademarks at the time of registration and use of the disputed domain name.

The Complainant contends that the disputed domain name is not used for any bona fide offering of goods and/or services, and that it is likely that 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.

The Complainant contends that the fact that the disputed domain name is currently inactive is evidence of bad faith registration and use, and that 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.

Lastly, the Complainant suspects that the Respondent registered the disputed domain name for "phishing" purposes, i.e. diverting the Complainant's customers to the disputed domain name, and try to have customers disclose confidential banking information for the purpose of unlawfully charging the customers' bank accounts, or withdraw their money.
The Complainant contends that on November 26, 2020 the Complainant's attorneys sent a cease and desist letter to the Respondent, requesting the voluntary transfer of the disputed domain name. The Respondent did not comply with this request.

The Respondent did not dispute these claims.

The Panel finds that, on the balance of probabilities, it may be expected that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence of the Complainant's "INTESA SANPAOLO" trademark(s) and the scope of these trademarks. The Panel points to the fact that the Complainant has trademark rights to the terms "INTESA SANPAOLO" for banking and financial services in the home country of the Respondent (i.e. Australia) (see International trademark with registration n. 920896 "INTESA SANPAOLO"). The term(s) selected by the Respondent ("MY-INTESASANPAOLO") seem to have no meaning in any language (including in the Respondent's home country) and seem only selected for their similarity to the Complainant's registered "INTESA SANPAOLO" trademark(s). Furthermore, the registration of the Complainant's "INTESA SANPAOLO" trademarks pre-date the registration of the disputed domain name. The disputed domain name is almost identical to the Complainant's trademark(s) "INTESA SANPAOLO", with the exception that the disputed domain name adds the term "MY" and a dash symbol ("-"). The Panel notes that the Complainant's "INTESA SANPAOLO" trademark is in itself a combination of two earlier (separate) marks, following a merger of the Italian banks Banca Intesa S.p.A. (trademark "INTESA") and Sanpaolo IMI S.p.A. (trademark "SANPAOLO") in 2007. This makes it even more unlikely that the Respondent would have chosen the term "INTESASANSPAOLO" independently from the Complainant's trademark(s). Moreover, the Panel believes that adding the term "MY" to the Complainant's trademark "INTESA SANPAOLO", which is registered for services relating to banking and financial affairs, could lead customers of the Complainant to believe that the disputed domain name refers to a particular webpage (or a 'user area') that allows them to log into their account, e.g. to manage their financial matters. In light of this, it seems unlikely that the Respondent would not have been aware of the unlawful character of the disputed domain name at the time of its registration and use.

In the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel believes from the facts in this case that the Respondent had the "INTESA SANPAOLO" trademark(s) of the Complainant in mind when registering and subsequently using the disputed domain name.

For all of the reasons set out above, the Panel determines that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2021-03-29

Publish the Decision