

Decision for dispute CAC-UDRP-103617

Case number	CAC-UDRP-103617
Time of filing	2021-03-02 09:32:35
Domain names	INTESASANPAOLO.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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	Carmela D'ambrosio
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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 submitted evidence that it is the registered owner of the following registrations for the trademarks "INTESA SANPAOLO" and "INTESA":

- the international trademark registration No. 920896 for "INTESA SANPAOLO", registered since 7 March 2007 for the classes 9, 16, 35, 36, 41 and 42;
- the EU trademark registration No. 5301999 for "INTESA SANPAOLO", applied on 8 September 2006, granted on 18 June 2007, for the classes 35, 36 and 38;
- the international trademark registration No. 793367 for "INTESA", registered since 4 September 2002 for class 36; and
- the EU trademark registration No. 12247979 for "INTESA", applied on 23 October 2013 and granted on 5 March 2014, for the classes 9, 16, 35, 36, 38, 41 and 42.

Moreover, 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>>.

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 1 January 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 35.1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 5,300 branches capillary and well distributed throughout the Country, with market shares of more than 21% in most Italian regions, the Group offers its services to approximately 14.7 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1,000 branches and over 7.1 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 disputed domain name <intesasanpa0lo.com> was registered on 22 December 2020.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is English.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

The Complainant argues that it is more than obvious that the disputed domain name is identical or – at least – confusingly similar to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA". As a matter of fact, <INTESASANPA0LO.COM> exactly reproduces the well-known trademark "INTESA SANPAOLO", with the mere substitution of the letter "O" with the number "0" in the mark's verbal portion "PAOLO". In view of the Complainant, this represents a clear example of typosquatting.

In support of the above, the Complainant draws the Panel's attention to 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> in which the Panel 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.

The Complainant further contends that the Respondent has no right or legitimate interest in respect of the disputed domain name. In particular, the Complainant states that the Respondent has no rights on the disputed domain name, and any use of the trademark "INTESA SANPAOLO" and "INTESA" has to be authorized by the Complainant, whereas nobody has been authorized or licensed by the Complainant to use the disputed domain name.

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 as "INTESASANPAOLO".

Lastly, the Complainant does not find any fair or non-commercial uses of the disputed domain name.

Turning to the bad faith argument, the Complainant asserts that the disputed domain is currently passively held. However, it was registered and is used in bad faith. Besides, the Complainant underlines that the webpage connected to the disputed domain name is currently blocked by Google Safe Browsing because of suspected phishing activity.

The Complainant also contends that its trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wordings "INTESA SANPAOLO" and "INTESA", the same would have yielded obvious references to the Complainant. The Complainant submitted an extract of a Google search in support of its allegation. This raises a clear inference of knowledge of the Complainant's trademark on the part of the Respondent. Therefore, it is more than likely that the disputed domain name would not have been registered if it were not for the Complainant's trademark. The Complainant argues that this is clear evidence of the registration of the domain name in bad faith.

In addition, the Complainant submits that the disputed domain name is not used for any bona fide offerings. More particularly, there are present circumstances indicating that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site (paragraph 4(b)(iv) of the Policy).

The disputed domain name is not used for any bona fide offerings, considering that the same is connected to a website which has been blocked by Google Safe Browsing through a warning page. The Complainant therefore argues that it is clear that the main purpose of the Respondent was to use the above website for "phishing" financial information in an attempt to defraud the Complainant's customers and that Google promptly stopped the illicit activity carried out by the Respondent.

The Complainant then refers to numerous UDRP decisions which defined phishing as a form of Internet fraudulent activity (WIPO Case No. D2004-0237 and WIPO Case No. D2005-0251); and which came to the conclusion that the "use of a disputed domain name for the purpose of defrauding Internet users by the operation of a 'phishing' website is perhaps the clearest evidence of registration and use of a domain name in bad faith" (in particular WIPO Case No. D2012-2093, WIPO Case No. D2006-0614, WIPO Case No. D2005-0871 and WIPO Case No. D2006-0228).

Pursuant to the Complainant, even excluding any current "phishing" purposes or other illicit use of the disputed domain name, the Complainant could find any other possible legitimate use of INTESANPAOLO.COM anyway. The sole further aim of the owner of the disputed domain name might be to resell it to the Complainant, which represents, in any case, an evidence of the registration and use in bad faith, according to paragraph 4(b)(i) of the Policy.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in 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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

According to Paragraph 4(a) of the Policy, a complainant must prove each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in respect of the domain name; (iii) the domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar domain name

The Complainant demonstrated that it owns the asserted trademark registrations for the word marks "INTESA SANPAOLO" and "INTESA", all of which were registered long before the registration of the disputed domain name by the Respondent. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

It is also well established that the generic top level suffix .com may be disregarded when considering whether a disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights, as it is a necessary technical requirement of a domain name.

The disputed domain name incorporates the Complainant's trademark "INTESA SANPAOLO" in its entirety, except that the first letter "O" is substituted with the number "0". Such small difference has no effect whatsoever on the overall similarity between the "INTESA SANPAOLO" trademark and the "INTESANPA0LO" element in the disputed domain name, both phonetically and visually. The Panel agrees with the Complainant that this is a blatant case of typosquatting, especially given the very close similarity between the letter O and the number 0.

The Panel therefore finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights.

B. Lack of rights or legitimate interests

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not in any way connected with the Complainant nor is it authorized to use the Complainant's trademark for its commercial activities. In addition, the Respondent is not commonly known by the disputed domain name pursuant to Paragraph 4(c)(ii) of the Policy. Furthermore, it was demonstrated by evidence submitted by the Complainant that

the disputed domain name has not been used for a bona fide offering of goods or services or a legitimate non-commercial or fair use.

The Panel therefore finds that the Respondent has no rights or legitimate interest in the disputed domain name.

C. Registration and use of the disputed domain name in bad faith

With respect to the bad faith argument, the Complainant states, in summary: (a) that the disputed domain name is suspected of phishing activity; (b) that it is confusingly similar to its well-known trademarks; (c) that the Respondent had actual knowledge of the Complainant's rights in its trademarks; (c) that the disputed domain name is not used for any bona fide offerings; and (d) that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site.

The Panel has already found that the disputed domain name is confusingly similar to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA". It is well established that mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith.

In addition, the Panel believes that the Complainant submitted evidence that sufficiently demonstrates the Respondent must have (or should have) been aware of the existence of the Complainant, its trademarks and its numerous domain names, and the Complainant is a prominent undertaking especially in the banking and financial sector on the national (Italian) as well as global basis. It is really difficult to conceive that the Respondent, being domiciled also in Italy, would have no prior knowledge of the Complainant and it is equally difficult to find any good faith reason for the registration of the disputed domain name by the Respondent.

With respect to the fact that the disputed domain name has not been put to any use, the Panel notes that the so-called passive holding of a domain name cannot prevent a finding of bad faith. In this present case the Complainant's trademarks are distinctive, the Respondent failed to respond to the Complaint and there seems no plausible good faith use for the disputed domain name. Quite the contrary, having considered the submitted evidence and having tested the disputed domain name, the Panel agrees with the Complainant that the disputed domain name is most likely used for "phishing" or other fraudulent activities, as it is blocked by various web browsers for being unsafe.

Consequently, the Panel has no problem in finding that the disputed domain name has been registered and has been used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by Paragraph 4(a) of the Policy were met and makes the following decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	Mgr. Vojtěch Chloupek
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DATE OF PANEL DECISION 2021-04-08

Publish the Decision
