Decision for dispute CAC-UDRP-103703

Case number	**CAC-UDRP-103703**
Time of filing	**2021-04-06 11:36:27**
Domain names	**INTESASANPAOLON.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	**lisa brgr**

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 owns the following trade marks registrations for INTESA SANPAOLO and INTESA:

• International trade mark registration number 920896 for INTESA SANPAOLO, registered on 7 March 2007, in classes 9, 16, 35, 36, 38, 41 and 42;
• EU trade mark registration number 5301999 for INTESA SANPAOLO, registered on 18 June 2007, in classes 35, 36 and 38;
• International trade mark registration number 793367 for INTESA, registered on 4 September 2002 in class 36; and
• EU trade mark registration number 12247979 for INTESA, granted on 5 March 2014, in classes 9, 16, 35, 36 38, 41 and 42.

The Complainant also owns domain names incorporating the terms INTESA SANPAOLO and INTESA. These include <intesasanpaolo.com>; <intesa-sanpaolo.com>; <intesa.com>; and <intesa.info>, which are connected to the Complainant's official website at http://www.intesasanpaolo.com.

FACTUAL BACKGROUND

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

The Complainant was formed in 2007 by the merger of Banca Intesa S.p.A. and Sanpaolo IMI S.p.A. It is the among the top banking groups in the euro zone. It has a strong presence in Central-Eastern Europe with a network of approximately 1000 branches and over 7.1 million customers. Its international network is present in 26 countries.

The Complainant owns the registered trade marks INTESA SANPAOLO and INTESA. It also owns numerous domain names incorporating those names.

The Respondent registered the disputed domain name on 29 May 2020.

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 trade mark 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

Paragraph 4 (a) of the Policy requires the Complainant to prove each of the following three elements:

(i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
(ii) the Respondent has no rights or legitimate interests in the disputed domain name; and
(iii) the disputed domain name has been registered and used in bad faith.

A. IDENTICAL OR CONFUSINGLY SIMILAR

It is generally accepted that the addition of the top-level suffix, ".com" is a standard registration requirement and can be disregarded when assessing whether the disputed domain name is identical or confusingly similar to the Complainant's trade mark.

The disputed domain name incorporates the Complainant's well-known trade mark INTESA SANPAOLO, to which is added the letter "n". The Complainant's trade mark is distinctive and recognisable in the disputed domain name. Adding the letter "n" at the end of the trade mark INTESA SANPAOLO does not prevent the disputed domain name being confusing to the Complainant's mark. It is a clear case of typosquatting (see section 1.9 of the WIPO Jurisprudential Overview 3.0).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark INTESA SANPAOLO and

that the requirements of paragraph 4(a)(i) of the Policy have been met.

B NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant submits that the Respondent has no rights in the disputed domain name. It asserts that:

(i) it has not authorised or licensed the Respondent to use its trade marks, INTESA SANPAOLO and INTESA;
(ii) the disputed domain name does not correspond the Respondent's name, nor is the Respondent commonly known by the disputed domain name; and
(iii) the Respondent is not using the disputed domain name for any fair or legitimate non-commercial use.

The Complainant has established a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name. The burden of proof now shifts to the Respondent to show she has relevant rights or a legitimate interest.

The Respondent has not filed a Response nor challenged any of the Complainant's assertions, nor submitted any evidence to show that she is using the disputed domain name in connection with a bona fide offering of goods and services or that she has rights or any legitimate interest in the disputed domain name.

Having considered the Complainant's uncontested submissions and the evidence submitted, the Panel finds that the Respondent has no rights or legitimate interest in the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been met.

C. REGISTERED AND USED IN BAD FAITH

The Complainant's trade mark registrations INTESA SANPAOLO and INTESA are distinctive and well-known, and predate the registration of the disputed domain name.

It appears from the evidence submitted that a basic Google search for the words INTESA SANPAOLO and INTESA would reveal a reference to the Complainant. There appears no reason why an unaffiliated entity would register a domain name that is confusingly similar to the Complainant's well-known trade mark other than to create a likelihood of confusion with that mark. It is most likely that the Respondent knew of the Complainant's trade marks when she registered the disputed domain name. For these reasons, the Panel concludes that the disputed domain name was registered in bad faith.

Although the disputed domain name is being held passively, it is possible that a passive holding can amount to use in bad faith (for example, see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

The Complainant believes that the Respondent registered the disputed domain name to use it for phishing purposes in order to divert the Complainant's legitimate customers to the Respondent's website and cheat them of funds. The Respondent has not disputed this assertion. The Panel notes that the Complainant's trade mark registrations INTESA SANPAOLO and INTESA are distinctive and well-known and were registered well before the disputed domain name. The Respondent has provided no evidence of any actual or contemplated good use of the disputed domain name, and has used a privacy service to conceal her identity. In these circumstances any good faith use appears implausible.

Considering all the above factors, the Panel concludes that the disputed domain name was both registered and used in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLON.COM**: Transferred

PANELLISTS

Name	**Veronica Bailey**

DATE OF PANEL DECISION 2021-05-08

Publish the Decision