Decision for dispute CAC-UDRP-103706

Case number	CAC-UDRP-103706
Time of filing	2021-04-06 10:30:52
Domain names	LNTESASANPAOLO-GRUPPO.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.

Respondent

Name	BILAL CIRO

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 <LNTESASANPAOLO-GRUPPO.COM> ('the Domain Name').

IDENTIFICATION OF RIGHTS

Intesa Sanpaolo S.p.A (the 'Complainant') is the owner of a number of International and European Trade Mark registrations including for INTESA SANPAOLO and/or GRUPPO INTESA SANPAOLO in various classes.

FACTUAL BACKGROUND

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

The Complainant is an Italian Banking group that was established on 1 January 2007 as the result of a merger between Banca Intesa S.p.A and Sanpaolo IMI S.p.A. The Complainant operates in retail, corporate and wealth management, and is amongst the top banking groups in the euro zone with a market capitalisation exceeding 41.5 billion euro. The Complainant offers its services to approximately 14.7 million customers and has 5,300 branches distributed throughout Italy with a market share of more than 21% in most Italian regions. The Complainant also has a strong presence in Central-Eastern Europe and internationally.

The Complainant is the owner of a number of trade marks including an international registration for the 'INTESA SANPAOLO'

word mark and European trade mark registrations for 'INTESA SANPAOLO' and ‘GRUPPO INTESA SANPAOLO’.

In addition, the Complainant is also the owner of numerous domain names which feature the ‘INTESA SANPAOLO’ and ‘GRUPPO INTESA SANPAOLO’ word marks. All such domain names are linked to the Complainant’s official website http://www.intesasanpaolo.com.

The Domain Name was registered by Bilal Ciro (the ‘Respondent’) on 21 August 2020. The website attached to the Domain Name is non active and merely features the following message ‘Sito web manutenzione’ meaning ‘Website under maintenance’.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the Domain Name is identical, or at least confusingly similar to its registered trade marks for ‘INTESA SANPAOLO’ and ‘GRUPPO INTESA SANPAOLO’.

Further, the Complainant argues that the Domain Name is an example of 'typosquatting' as the Domain Name exactly reproduces its well known trade mark 'INTESA SANPAOLO' with the substitution of the letter 'I' in the mark 'INTESA' with the letter 'L' along with the addition of the Italian term 'GRUPPO' meaning 'Group'. The Complainant also contends that the Domain Name is similar to the Complainant’s registered trade mark ‘GRUPPO INTESA SANPAOLO’.

The Complainant argues that the Respondent does not have any rights or legitimate interests in respect of the Domain Name because the Complainant has not granted the Respondent a licence or authorisation to make use of the 'INTESA SANPAOLO' and/or 'GRUPPO INTESA SANPAOLO' trade marks. Further the Complainant states that the 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 'LNTESASANPAOLO-GRUPPO'.

Finally, the Complainant contends that it cannot see any fair or non-commercial uses of the Domain Name present.

The Complainant also contends that the Domain Name was registered and is being used in bad faith.

The Complainant states that its registered trade marks 'INTESA SANPAOLO' and 'GRUPPO INTESA SANPAOLO' are distinctive and well known around the world and the Complainant argues that the fact the Respondent registered a domain name that is confusingly similar to its trade marks indicates that the Respondent had knowledge of the Complainant’s trade marks at the time of registration of the Domain Name.

Further, the Complainant states that if the Respondent had carried out a basic google search of the words 'INTESA SANPAOLO' and 'GRUPPO INTESA SANPAOLO' the results would have provided obvious reference to the Complainant. Accordingly, the Complainant contends that there is a clear inference of knowledge of the Complainant’s trade marks on the part of the Respondent, and it is therefore more than likely that the Domain Name in issue would not have been registered if it were not for the Complainant’s trade marks. The Complainant argues this constitutes clear evidence of registration of the Domain Name in bad faith.

In addition, the Complainant contends that the Domain Name is not used for any bone fide offerings and 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.

The Complainant argues that the Domain Name is not used for any bona fide offerings.

The Complainant argues passive holding of a domain name may, in appropriate circumstances, be consisted with a finding of bad faith, but also that 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 legitimate use that could be made of the domain name.

The Complainant believes that given this is a case of typosquatting, the Respondent has likely registered the Domain Name for the purpose of 'phishing' in order to induce and divert the Complainant's legitimate customers to its website and steal their money.

The Complainant contends that there are no possible legitimate uses of the Domain Name, and argues that another aim of the Respondent might be to resell the Domain Name to the Complainant, which in itself represents evidence of the registration and use of the Domain Name in bad faith.

RIGHTS

The Panel is satisfied the Complainant has shown the Domain Name is confusingly similar to the trade marks in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel is satisfied the Complainant has shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Panel is satisfied the Complainant has shown the 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 the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

The Complainant, being represented by itself, first filed its complaint in relation to the Domain Name with the Czech Arbitration Court (the 'CAC') on 31 March 2021. However, the Complainant had not been able to sufficiently identify the Respondent. Following a registrar verification, which identified the Respondent as Bilal Ciro located in Sanremo, Italy, the Complainant filed an amended complaint on 6 April 2021. The CAC then formally commenced proceedings on 6 April 2021 and the Respondent was notified of the complaint accordingly.

The Respondent failed to submit a response within the time frame required in the complaint or at all, and a 'Notification of the Respondent's Default' was issued by the CAC on 28 April 2021.

Having received a Statement of Acceptance and Declaration of Impartiality, the CAC appointed Steve Palmer of Palmer Biggs IP Solicitors as the Panel in the UDRP proceedings.

PRINCIPAL REASONS FOR THE DECISION

IDENTICAL OR CONFUSINGLY SIMILAR

The Domain Name is LNTESASANPAOLO-GRUPPO.COM. This consists of a misspelling of the Complainant's 'INTESA SANPAOLO' trade mark, in that the 'I' in the word INTESA has been replaced with the letter 'L'. The Panel does not regard the substitution of the letter L in place of the letter I (in the manner stated above) to sufficiently alter the nature of the Domain Name such that it might avoid a finding of the Domain Name being confusingly similar to the Complainant's trade marks not least considering the fact the letter 'L' is similar in its appearance to the character 'I'.

The Domain Name is also very similar to the Complainant's 'GRUPPO INTESA SANPAOLO' trade mark, where the word

'GRUPPO' has simply been moved to the end of the name, with an addition of a hyphen prefix.

The '.com' suffix may be disregarded when it comes to considering whether a domain name is identical or confusingly similar to a trade mark in which a complainant has rights.

From previous decisions, it is well established that typosquatting can constitute a finding that the domain name is confusingly similar (Sanofi v. Domains By Proxy, LLC / domain admin Case No. D2013-0368, Fuji Photo Film U.S.A., Inc. v. LaPorte Holdings, Case No. D2004-0971). The Panel considers this to be a clear case of typosquatting.

Given the distinctiveness and reputation of the Complainant's 'INTESA SANPAOLO' and 'GRUPPO INTESA SANPAOLO' trade marks, the Panel concludes that the Domain Name is confusingly similar to trade marks for which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

The Complainant succeeds on the first element of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The Respondent failed to file an administratively compliant (or any) response to the Complainant's complaint. In the circumstances, the Panel finds from the facts put forward that there is no evidence of any circumstances of the type specified in paragraph 4(c) of the Policy, or of any other circumstances giving rise to a right to or legitimate interest in the Domain Name.

The Respondent does not appear to have any trade marks associated with the 'INTESA SANPAOLO' or 'GRUPPO INTESA SANPAOLO' marks or any variation thereof.

There is no evidence that the Respondent is commonly known by the name 'INTESA SANPAOLO' or 'GRUPPO INTESA SANPAOLO' or any variation thereof, and the Respondent does not have authorisation from the Complainant to use the 'INTESA SANPAOLO' and/or 'GRUPPO INTESA SANPAOLO' trade marks.

Further, no evidence has been provided to show that the Respondent has used the Domain Name for any bona fide offering of goods or services of its own. There is no active website associated with the Domain Name.

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

REGISTERED AND USED IN BAD FAITH

The third element of paragraph 4(a) of the Policy requires the Complainant to establish that the Domain Name has been registered and is being used in bad faith by the Respondent. Paragraph 4(b) of the Policy provides a non-exhaustive criteria which shall be evidence of the registration and use of a domain name in bad faith.

On the balance of probabilities, and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, this Panel believes from the facts in this case that:

- The Respondent had knowledge of the Complainant's trade marks 'INTESA SANPAOLO' and 'GRUPPO INTESA SANPAOLO' and that they had such knowledge prior to the registration and use of the Domain Name. Not least as the Respondent is based in Italy and the Complainant is well known in Italy. In the circumstances, the Panel believes it therefore likely that the Respondent had the Complainant's 'INTESA SANPAOLO' and 'GRUPPO INTESA SANPAOLO' trade marks in mind when

registering the Domain Name.

- The Respondent is likely to have acquired the Domain Name for the purpose of selling, renting, or otherwise transferring the Domain Name registration to the Complainant for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the Domain Name; and/or

- The Respondent has likely engaged in typosquatting to cause confusion with the Complainant’s 'INTESA SANPAOLO' mark for their own commercial gain.

- The Domain Name does not have an active website associated with it save for a message stating the site is under maintenance. There are numerous instances where panelists have previously found that the non-use / passive use of a domain name, including where the domain name presents a blank or 'coming soon' page, does not prevent a finding of bad faith (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574, Ladbroke Group Plc v. Sonoma International LDC, Case No. D 2002-0131). The Panel considers that in the circumstances it is not possible to conceive of any plausible actual or contemplated active or inactive use of the Domain Name by the Respondent that would provide a bona fide offering and/or would not amount to use of the Domain Name in bad faith.

In light of the above, the Panel is satisfied that the requirements of the third element of paragraph 4(a) of the Policy has been met and the Domain Name was registered and is being used in bad faith by the Respondent.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LNTESASANPAOLO-GRUPPO.COM**: Transferred

PANELLISTS

Name	**Steve Palmer**

DATE OF PANEL DECISION 2021-05-12

Publish the Decision