

Decision for dispute CAC-UDRP-103767

Case number	CAC-UDRP-103767
Time of filing	2021-05-03 09:34:07
Domain names	LNTESASANPAOLO-CARTE.COM, LNTESASANPAOLO-SICUREZZA.COM, LNTESASANPAOLO-ASSISTENZA.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	ANDREA BENAZZO
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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 names.

IDENTIFICATION OF RIGHTS

Complainant's trademarks, including:

- International trademark registration n. 920896 "INTESA SANPAOLO", granted on March 07, 2007;
- EU trademark registration n. 5301999 "INTESA SANPAOLO", applied on September 08, 2006 and granted on June 18, 2007; and
- EU trademark registration n. 12247979 "INTESA", filed on October 23, 2013 and granted on March 5, 2014.

FACTUAL BACKGROUND

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

PRELIMINARY REQUEST FOR CONSOLIDATION

According to the Registrar verification, the three disputed domain names would be owned by two different people, namely:

First Name: ANDREA
Last Name: BENAZZO
AND

First Name: CARMELLO
Last Name: GIANLUCCI

The Complainant request consolidation in this proceeding under following facts:

According to paragraph 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, WIPO panels have articulated principles governing the question of whether a single complaint filed with WIPO may be brought against multiple respondents. In particular, "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario".

In this regard, "Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s)".

Most of the above factors are included in the present case.

First of all, it shall be considered that all the disputed domain names have common DNS, common Registrar and common service of privacy protection.

In addition, it shall be underlined that some of the new Registrants' contact details provided by the concerned Registrar are fake. In particular, the address "viatorini 33 - Ariccia" does not exist.

Furthermore, it shall be noted that both of the domain names at issue are passively held and such circumstance is a clear evidence of a common pattern of conduct which is aimed to damage Intesa Sanpaolo and its trademark rights on the signs "INTESA" and "INTESA SANPAOLO" (see the Complaint filed for further details in this concern).

It is clear that there is also a naming pattern in the disputed domain names, as all of them exactly reproduces the trademark "INTESA SANPAOLO" in the same typoquatted manner (namely the word LNTESASANPAOLO) with the addition of Italian generic/descriptive words like "carte", "sicurezza" and "assistenza" (meaning "cards", "security" and "assistance"), that are typical of internet banking, a business sector in which the Complainant is fully involved.

Hence the Complainant requests the Panel to treat all Domain Names in a single proceeding. As a matter of fact, it would be quite cumbersome and inequitable for the Complainant to start three separate proceedings in this matter, while the consolidation would be fair and equitable to all parties, in view of the aforesaid common ownership or control.

Consolidation would permit to deal in a single proceeding multiple domain name disputes arising from a common nucleus of facts and involving common legal issues. Doing so promotes the shared interests of the parties in avoiding unnecessary duplication of time, effort and expenses, and generally fulfils the fundamental goals of the Policy".

THE DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH

THE COMPLAINANT HAS RIGHTS

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 January 01, 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 44,9 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.

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 and INTESA.ME> (all of them are now connected to the official website <http://www.intesasanpaolo.com>).

On August 20 and 24, 2020 the Respondent registered the domain names <LNTESASANPAOLO-CARTE.COM, LNTESASANPAOLO-SICUREZZA.COM and LNTESASANPAOLO-ASSISTENZA.COM>.

It is more than obvious that the domain names at issue are identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”. In particular <LNTESASANPAOLO-CARTE.COM, LNTESASANPAOLO-SICUREZZA.COM and LNTESASANPAOLO-ASSISTENZA.COM> exactly reproduce my Client’s trademark “INTESA SANPAOLO”, with the mere substitution of the letter “I” in the mark’s verbal portion “INTESA” with the letter “L” and the addition of Italian descriptive terms “CARTE”, “SICUREZZA” and “ASSISTENZA”.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAMES

The Respondent has no rights on the disputed domain names, and any use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain names at issue.

The domain names at stake do not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as “LNTESASANPAOLO-CARTE” and/or “LNTESASANPAOLO-SICUREZZA” and/or “LNTESASANPAOLO-ASSISTENZA”.

Lastly, the Complainant did not find any fair or non-commercial uses of the domain names at stake (see <https://www.intesasanpaolo-carte.com/> <https://www.intesasanpaolo-sicurezza.com/> and <https://www.intesasanpaolo-assistenza.com/>).

THE DOMAIN NAMES WERE REGISTERED AND ARE USED IN BAD FAITH

The domain names <LNTESASANPAOLO-CARTE.COM, LNTESASANPAOLO-SICUREZZA.COM and LNTESASANPAOLO-ASSISTENZA.COM> were registered and are used in bad faith.

The Complainant’s trademarks “INTESA SANPAOLO” and “INTESA” are distinctive and well known all around the world. The fact that the Respondent has registered three domain names that are confusingly similar to it indicates that the Respondent had knowledge of the Complainant’s trademarks at the time of registration of the disputed domain names. 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 submits an extract of a Google search in support of its allegation. According to Complainant 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 domain names at issue would not have been registered if it were not for Complainant's trademark.

In addition, the disputed domain names are not used for any bona fide offerings. More particularly, there are present circumstances indicating that, by using the domain names, the Respondent has registered or acquired the domain names primarily for the purpose of selling, renting, or otherwise transferring the domain names registration to the Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain names (par. 4(b)(i) of the Policy).

The contested domain names are not used for any bona fide offerings, even if they are not connected to any web site, by now. In fact, 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 the light of the above, the present case completely matches to the above requirements and the passive holding of the contested domain names 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 risk of a wrongful use of the domain names at issue is even higher in the present case, since the Complainant 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. It happened 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, some of the Clients have been cheated of their savings.

Also in the present case, the Complainant believes that the current owner registered the disputed domain names with the "phishing" purpose, in order to induce and divert the Complainant's legitimate customers to its website and steal their money and the above could be easily verified given the particular nature of the disputed domain names (typosquatting).

Even excluding any "phishing" purposes or other illicit use of the domain names in the present case, anyway we could find no other possible legitimate use of <LNTESASANPAOLO-CARTE.COM, LNTESASANPAOLO-SICUREZZA.COM and LNTESASANPAOLO-ASSISTENZA.COM>. The sole further aim of the owner of the domain names under consideration might be to resell them 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").

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

THE PROCEDURE

Two Domain Names are at stake, apparently registered by two different Respondent.

It is accepted that a single complaint may be brought against multiple respondents in certain situation, in particular, when it appears that the domain names or corresponding websites are subject to common control, and the consolidation would be fair and equitable to all parties.

The Panel notes that consolidation has become, over time, a reasonable and proportionate means of resolving domain name registration abuses. Such registration is easy and inexpensive, so that overly stringent procedural requirements on this issue will likely make prosecution much more complicated and, ultimately, could result in a system in which ADR no longer serves its purpose and deprives the Complainant of the exercise of its rights.

The Panel has taken into account the need to ensure fair treatment of the Respondent. The consolidation of several domain names in a single proceeding does not appear to prejudice the Respondent's right to fair treatment insofar as, on the one hand, consolidation is only accepted if there are elements that reasonably allow the conclusion that there is a single person or group of persons behind multiple registrations, and on the other hand, the adversarial procedure gives the Respondents the opportunity to express their views on this issue.

In this case, the disputed domain names:

- Have common DNS
- Have common Registrar
- Have common service of privacy protection
- Have fake references indicated in the whois
- Are passively held within a common pattern of conduct
- Have been registered in the context of a naming pattern, as they all exactly reproduce Complainant's trademark + generic/business terms

The Panel accepts the single complaint.

FIRST CONDITION

It is commonly accepted that the first condition functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the

disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In this comparison, the cc- or g-TLD is usually not taken into account.

The disputed domain names include entirely the Complainant's trademark with the adjunction of a generic word and the replacement of the Complainant's first letter "I" by "L". The Panel is of the opinion that in a situation where the Complainant's trademark is entirely included in the disputed domain names, the adjunction of generic terms and/or the replacement of a single letter do(es) not generally change the assessment as far as the first condition is concerned. (see also WIPO, Swiss Re, No. D2014-1873).

First condition is satisfied.

SECOND CONDITION

Panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.

The Complainant claims, without being contradicted, that:

- The Complainant has not licensed or authorized the Respondent to register or use the disputed domain names;
- There is no evidence that the Respondent is known by the disputed domain names or owns any corresponding registered trademarks; and
- The Respondent could have easily performed a search before registering the disputed domain names and would have quickly learnt about the Complainant's trademarks and activities worldwide.

The Respondent has chosen not to answer to the Complaint.

Based on the elements presented by Complainant, the Panels find that the second condition is satisfied.

THIRD CONDITION

Save for the replacement of a single letter, the disputed domain names incorporate nearly entirely the Complainant's trademark. In the absence of any credible explanation, such incorporation appears as a direct reference to the Complainant's trademark. It is even more probable when the notoriety of the Complainant's trademark is taken into account. There is no apparent plausible reason for the Respondent to register the domain name, except its probable intention of taking advantage of the distinctiveness of the Complainant's trademark.

It is therefore prima facie highly probable that the Respondent registered and used the disputed domain names having the Complainant in mind, and acted in order to attract traffic by using the notoriety of the Complainant in order to make money when a visitor clicks on the commercial links inserted on the Respondent's website.

Also, the contested domain names are not used for any bona fide offerings, even if they are not connected to any web site, by now. In a sensible sector like bank and financial services, passive holding can be seen as particularly risky because it could be the sign of the preparation of a fraud and it is even more important for the Respondent to be as transparent as possible regarding the passive holding.

The Respondent has chosen not to answer to the Complaint.

Based on the elements presented by Complainant, the Panel finds that the third condition is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LNTESASANPAOLO-CARTE.COM**: Transferred
 2. **LNTESASANPAOLO-SICUREZZA.COM**: Transferred
 3. **LNTESASANPAOLO-ASSISTENZA.COM**: Transferred
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PANELLISTS

Name	Mr. Etienne Wéry
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DATE OF PANEL DECISION	2021-05-28
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Publish the Decision
