

Decision for dispute CAC-UDRP-103766

Case number CAC-UDRP-103766

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Domain names 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 james right

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 is the registrant, among others, of the following trademarks:

- International trademark registration No. 920896 "INTESA SANPAOLO", registered on March 7, 2007, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;
- International trademark registration No. 793367 "INTESA", registered on September 4, 2002, for goods and services in class 36; and
- EU trademark registration No. 5301999 "INTESA SANPAOLO", registered on June 18, 2007, for goods and services in classes 35, 36 and 38.

The disputed domain name was registered by the Respondent on January 18, 2021.

FACTUAL BACKGROUND

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

The Complainant is the leading Italian banking group.

The Complainant is the company resulting from the merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups.

The Complainant is among the top banking groups in the euro zone, with a market capitalisation exceeding 44,9 billion euro.

The Complainant has a network of approximately 5.300 branches throughout Italy and has approximately 14,7 million customers.

The Complainant has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,1 million customers.

Moreover, the Complainant's 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 Complainant is the owner of several registrations for the trademarks "INTESA SANPAOLO" and "INTESA".

Moreover, the Complainant is also the owner, among others, of the following domain names bearing the signs "INTESA SANPAOLO" and "INTESA": <INTESASANPAOLO.COM, INTESASANPAOLO.ORG, INTESASANPAOLO.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, INTESA.ME>. All of them are pointing to the main Complainant's website.

On January 18, 2021, the Respondent registered the disputed domain name.

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, <INTESAŞANPAOLO.COM> exactly reproduces the well-known trademark "INTESA SANPAOLO", with the mere the substitution of the letter "A" with an "Ă" (with a dot under the letter) in the term "INTESA".

The Respondent has no rights on the disputed domain name, 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 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 "INTESAŞANPAOLO".

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

The domain name <INTESAŞANPAOLO.COM> was registered and is 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 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. 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. This is a clear evidence of registration of the disputed domain name in bad faith.

In addition, the disputed domain name is not used for any bona fide offering of goods or services. More particularly, there are present circumstances indicating that the Respondent has registered or acquired the disputed 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 the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name.

The disputed domain name is not used for any bona fide offering of goods or services, even if it is 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.

In particular, the consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, 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 use that could be made of the domain name that would not amount to an infringement of the Complainant's trademark rights.

As regards to the first aspect, the Complainant has already extensively proved the renown of its trademarks. As regards the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant's trademarks and that results so similar to the Complainant's domain names currently used by the latter to provide online banking services.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the contested domain name has to be considered a use in bad faith.

The risk of a wrongful use of the disputed domain name 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 to a web page which imitates the Complainant's web page, 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.

Also in the present case, the Complainant believes that the current owner registered the disputed domain name 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 easily occur given the particular nature of the disputed domain name (typosquatting).

Even excluding any "phishing" purposes or other illicit use of the domain name in the present case, the Complainant could find no other possible legitimate use of the disputed domain name. 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 March 2, 2021 the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the disputed domain name. Despite such communication, the Respondent did not comply with the above 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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

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

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "INTESA SANPAOLO", identified in section "Identification of rights" above.

The Panel observes that the registration of the Complainant's trademark predates the registration of the disputed domain name.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

It is well established that a domain name which contains a common or obvious misspelling of a trademark normally will be found to be confusingly similar to such trademark, where the misspelled trademark remains the dominant or principal component of the domain name (see, for example, WIPO Case No D2016-2545).

Other Panels have considered that using a character closely resembling the original Latin character in the trademark presents a visual image of the trademark that is likely to cause confusion, therefore the use of such similar character does not prevent the finding of confusing similarity (see, for example, WIPO Case No. D2019-1005). The Panel shares this view.

In the present case, the Panel considers that the disputed domain name is confusingly similar to the Complainant's "INTESA SANPAOLO" trademark for the following reasons: (a) "INTESA SANPAOLO" is a distinctive trademark; (b) the only difference between the "INTESA SANPAOLO" trademark and the disputed domain name is that in the latter the first "A" has been

replaced by the similar character "À"; (c) the fact of replacing the first "A" by the similar character "À" in the disputed domain name does not create any new word, or give the disputed domain name any distinctive meaning; (d) the disputed domain name is a deliberate misspelling of the Complainant's "INTESA SANPAOLO" trademark; and (e) visually the disputed domain name is so close to the Complainant's well-known "INTESA SANPAOLO" trademark that confusion is inevitable between them.

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or
- (iii) [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 trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- the Respondent has no license or authorization to use the disputed domain name;
- the disputed domain name does not correspond to the name of the Respondent;
- the Respondent is not commonly known by the disputed domain name;

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

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, the disputed domain name is not used for any website.

Taking into account that the Respondent has no license or authorization to use the disputed domain name, that the disputed domain name does not correspond to the name of the Respondent, that the Respondent is not commonly known by the disputed domain name, that there is no evidence of any fair or non-commercial use of the disputed domain name, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] 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 [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

The Panel observes that it is well established that the scenarios described in UDRP paragraph 4(b) are non-exclusive and

merely illustrative. Therefore, even where a complainant is not able to demonstrate the literal application of one of the above-mentioned scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behaviour detrimental to the complainant's trademark would also satisfy the complainant's burden.

Taking into account the distinctiveness and reputation of the trademark "INTESA SANPAOLO", the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark "INTESA SANPAOLO" when registering the disputed domain name. Other panels considered that knowledge of a corresponding mark at the time of the domain name's registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100) and the Panel share this view.

The fact that the disputed domain name is not currently used does not prevent a finding of bad faith (see, for example, WIPO Case No. D2018-1264). Previous panels have indeed confirmed that the prerequisites under paragraph 4(a)(iii) of the Policy can be met under the doctrine of passive holding, giving close attention to all circumstances of the Respondent's behaviour (see, for example, WIPO Case No. D2000-0003).

Without the need to assess whether paragraph 4(b)(i) of the Policy is applicable to the present case, the Panel, having taken into account the distinctiveness and reputation of the Complainant's trademark, the fact that no response to the Complaint has been filed, the absence of compliance with the request contained in the Complainant's cease and desist letter, and the passive holding of the disputed domain name, considers that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. INTESA_àSANPAOLO.COM: Transferred

PANELLISTS

Name	Michele Antonini
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DATE OF PANEL DECISION 2021-06-06

Publish the Decision
