

Decision for dispute CAC-UDRP-103818

Case number	CAC-UDRP-103818
Time of filing	2021-05-24 09:31:41
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	Milen Radumilo
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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 is the owner, among others, of the registrations for the trademarks “INTESA” and “INTESA SANPAOLO” as follows:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 41, 42;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38;
- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in class 36;
- EU trademark registration n. 12247979 “INTESA”, applied on October 23, 2013 and granted on March 5, 2014, in 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 connected with the official website <http://www.intesasanpaolo.com>.

On August 14, 2020, the Respondent registered the disputed domain name <INTESASANPAEOLO.COM>.

FACTUAL BACKGROUND

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

i) The Complainant states 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, <INTESASANPAEOLO.COM> is almost identical to well-known trademark “INTESA SANPAOLO”, with the mere addition of the letter “E” in the mark's verbal portion “PAOLO”. This is a clear example of typosquatting.

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 1, 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 45,1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

Thanks to a network of approximately 4,700 branches capillary and well distributed throughout the Country, with market shares of more than 19% in most Italian regions, the Group offers its services to approximately 13,5 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 Complainant is the owner of the registrations for the trademarks “INTESA SANPAOLO” and “INTESA” and of the domain names bearing the signs “INTESA SANPAOLO” and “INTESA” which are connected to the official website <http://www.intesasanpaolo.com>. The Respondent registered the disputed domain name <INTESASANPAEOLO.COM>.

The Complainant recalled:

- WIPO Case n. D2001-1314 Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc. – regarding the domain names <duetschebank.com> and <duetsche-bank.com>” - the domain names are 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 same case lies before in this matter.

ii) 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 above-mentioned banking group to use the domain name at issue. The domain name at stake does not correspond to the name of the Respondent and, to the best of Complainant's knowledge, the Respondent is not commonly known as “INTESASANPAEOLO”. Lastly, the Complainant does not find any fair or non-commercial uses of the domain name at stake by visiting the disputed domain name's home page.

iii) The disputed domain name <INTESASANPAEOLO.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. The Complainant submits 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 domain name at issue would not have been registered if it were not for Complainant's trademark. This is a clear evidence of registration of the domain name in bad faith.

In addition, 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.

Several services can be detected, but not in good faith: in fact, the domain name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used.

Consequently, Internet users, while searching for information on the Complainant's services, are confusingly led to the websites of the Complainant's competitors, sponsored on the websites connected to the domain name at issue. Therefore, the Complainant deems that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant's web site.

The current use of the disputed domain name, which allows accessing to the web sites of the Complainant's competitors, also through the Complainant's trademark, causes, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones. So, the Respondent's conduct is even worse. The Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated.

It is no coincidence that this speculation has involved a big financial institution such as Intesa Sanpaolo. In fact, the diversion practice in banking realm is very frequent due to the high number of online banking users. In fact, it has also to be pointed out that the Complainant has already been part of other WIPO Cases where the panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations. A list of the WIPO Cases in which Intesa Sanpaolo has been part as the Complainant was enclosed.

It shall be noted that on October 26, 2020 the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the domain name at issue. Despite such communication, the Respondent did not comply with the above request. In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

The Complainant recalled:

- WIPO Case No. D2000-0753 Encyclopaedia Britannica Inc. v. Shedon.com ("Respondent's Ownership of a site which is a misspelling of Complainant's britannica.com site and which Respondent used to hyperlink to a gambling site demonstrates Respondent's bad faith registration and use of the britannica.com domain name");
- WIPO Case No. D2000-1013 YAHOO! INC. v. David Murray, (finding bad faith where respondent chooses a domain name similar to the complainant's mark for a site which offers services similar to the complainant);
- WIPO Case No. D2000-1768 ("Registration and continued use of the contested domain name for re-directing Internet users, i.e. particularly customers and potential customers of the Complainant, from the Complainant's website to the website of...a company which directly competes with the Complainant, constitutes bad faith registration and use");
- WIPO Case No. D2000-0037 Zwack Unicom Ltd v. Duna, ("Respondent's linking to complainant's competitor held to constitute bad faith");
- WIPO Case No. D2001-1319 Edmunds.com v. Ultimate Search, Inc., ("Registration and use of a domain name to redirect Internet users to websites of competing organizations constitutes bad faith registration and use under the Policy");

- WIPO Case No. D2001-1335, The Vanguard Group, Inc v. Venta;
 - WIPO Case No. D2004-0554; Microsoft Corporation v. StepWeb;
 - WIPO Case No. D2004-0059; National City Corporation v. MH Networks LLC, Case No. D2004-0128;
 - Case No. FA0011000095940 (finding bad faith where respondent used the disputed domain name to “redirect the Complainant’s consumers and potential consumers to commercial websites which are not affiliated with Complainant”);
 - Case No. FA0009000095648 (finding bad faith where respondent registered the domain name <marriottrewards.com> and used it to route internet traffic to another website that “promotes travel and hotel services . . . identical to the services offered by the Complainant”).
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PARTIES CONTENTIONS

No administratively compliant Response has been filed.

The Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed allegations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules because of the Respondent's failure to submit a response.

Therefore, in the absence of a response, it is appropriate to accept as true all allegations of the Complainant.

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs the Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (i) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

(ii) respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

The Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations because of the Respondent's failure to submit a response. Therefore, it accepted as true all allegations of the Complainant.

(i) The disputed domain name is confusingly similar to trademarks in which Complainant has rights

The Panel finds that the Complainant has rights in the trademarks as well in its domain pages which are directly connected to the web page of the Complainant: www.intesasanpaolo.com. The Complainant is the leading Italian banking group and also one of the protagonists in the European financial arena. The Respondent registered the domain name <INTESASANPAEOLO.COM>. The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA" while the dispute domain name <INTESASANPAEOLO.COM> is almost identical to the well-known trademark "INTESA SANPAOLO", with the mere addition of the letter "E" in the mark's verbal portion "PAOLO". Where the domain name is a slight alphabetical variation from a famous mark this is a clear example of "a case of 'typosquatting'".

Thus, the Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the trademarks in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name

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. The Respondent does not prove that it has been authorized or licensed by the above-mentioned banking group to use the domain name at issue. The domain name at stake does not correspond to the name of the Respondent and the Panel cannot find that the Respondent is not commonly known as "INTESASANPAEOLO" because its name Milen Radumilo is not identical with the name of the Complainant. The Panel finds any fair or non-commercial uses of the domain name at stake by visiting the disputed domain name's home page.

Thus, 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).

(iii) The disputed domain name has been registered and is being used in bad faith

The disputed domain name <INTESASANPAEOLO.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 domain name at issue would not have been registered if it were not for Complainant's trademark and it is a clear evidence of registration of the domain name in bad faith.

The Panel finds that the disputed domain name is not used for any bona fide offerings. The domain name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used and it is obvious that the Respondent's sponsoring activity is being remunerated. Consequently, Internet users, while

searching for information on the Complainant's services, are confusingly led to the websites of the Complainant's competitors, sponsored on the websites connected to the domain name at issue. It is no coincidence that this speculation has involved a big financial institution such as Intesa Sanpaolo. In fact, the diversion practice in banking realm is very frequent due to the high number of online banking users.

Therefore, the Panel finds that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant's web site. The current use of the disputed domain name, which allows accessing to the web sites of the Complainant's competitors, also through the Complainant's trademark, causes, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones.

In fact, it has also to be pointed out that the Complainant has already been part of other WIPO and CAC Cases where the panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations. After the finding of the Panel the list of the WIPO Cases which contents the cases from 2007 to 2020 and in which the Complainant has been part should have amounted to six pages. Also the list of the CAC Cases confirm several disputes when the Respondent has been part (for instance CAC Cases No.103410, No. 103410 and No. 103543).

The Panel finds that the disputed domain name resolves to a parking page with commercial links, which is an evidence of bad faith.

The Panel finds that on October 26, 2020 the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the domain name at issue. Despite such communication, the Respondent did not comply with the above request. In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

Thus, 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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAEOLO.COM**: Transferred

PANELLISTS

Name	JUDr. Vojtěch Trapl
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DATE OF PANEL DECISION	2021-06-17
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Publish the Decision
