

Decision for dispute CAC-UDRP-103906

Case number	CAC-UDRP-103906
Time of filing	2021-07-02 09:36:07
Domain names	INFORMAZIONIUTENTEINTESA.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

Organization	IceNetworks Ltd.
--------------	------------------

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 has adduced evidence that the Panel accepts that it is the registered owner of the INTESA trademark and as such has rights in that trademark. That evidence is to the effect that the Complainant is the owner of the following registered trademarks, namely:

- (a) International trademark registered number 793367 for INTESA granted on September 4, 2002 and duly renewed; and
- (b) EU trademark registered number 12247979 for 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:

The Complainant is the leading Italian banking group and also an active participant in the European financial arena. The Complainant 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.

The Complainant has a very active banking business and both the Complainant and its trademark are well-known to the public.

The Complainant has become concerned that the Respondent has registered the disputed domain name and caused it to resolve to a website where the clear intention is to use the website for a suspected phishing operation. As a result, the Respondent's webpage is currently blocked by Google Safe Browsing because of the suspected phishing activity.

On October 19, 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 has not complied with the request.

As the disputed domain name and the suspected phishing activity have damaged the Complainant's reputation and tarnished its trademark, the Complainant has been left with little choice but to file the present proceeding and request the transfer of the domain name to the Complainant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

A COMPLAINANT

1. The Complainant is a prominent Italian and international bank.
2. The Complainant is the owner of several registered trademarks for INTESA.
3. The Respondent registered the disputed domain name on June 5, 2020.
4. The disputed domain name is confusingly similar to the INTESA trademark as it embodies the entire trademark and the additional words "informazioni" and "utenteintesa" which would inculcate in the mind of internet users that the disputed domain name is related to information for users of the Complainant's services.
5. The Respondent registered the disputed domain name with the intention of using it to perpetrate a fraud by phishing.
6. The Respondent has no rights or legitimate interests in the disputed domain name.
7. The Respondent registered and has used the disputed domain name in bad faith.

B RESPONDENT

The Respondent did not file a Response in this proceeding.

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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the CAC Supplemental Rules.

A. Administrative deficiency

By notification dated July 19, 2021 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint had not sufficiently identified the Respondent. The CAC invited the Complainant in that regard to review the Registrar's verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder.

On July 20, 2021, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The 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 domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts that it is the registered owner of the INTESA trademark and as such has rights in that trademark. That evidence is to the effect that the Complainant is the owner of the following registered trademarks, namely:

- (a) International trademark registered number 793367 for INTESA granted on September 4, 2002 and duly renewed; and
- (b) EU trademark registered number 12247979 for INTESA, filed on October 23, 2013 and granted on March 5, 2014.

The Panel next finds that the disputed domain name <informazioneutenteintesa.com> is confusingly similar to the INTESA trademark for the following reasons.

First, the domain name includes the entirety of the INTESA trademark as well as two other words. As the word INTESA is a

prominent word in the domain name and as it is clearly a reference to the Complainant, the attention of the internet user would naturally be drawn to that part of the domain name and would inculcate in the mind of the user the idea that the domain name is an official domain name of the Complainant.

Secondly, the domain name includes two words that have been added before the word INTESA, namely “informazioni” and “utenteintesa”. The former word means “information” and the second word means “users” in the English language. This must strengthen in the mind of the internet user the notion that the domain name is an official domain name of the Complainant dealing with information for users of the Complainant’s services and that it would lead to an official website dealing with that subject, which is of course not the case.

Thirdly, as internet users would assume that the domain name and its resolving website dealt with that subject, the domain name gives rise to inevitable confusion.

It is also now well established that the addition of a generic top-level domain, such as “.com” in the present case, cannot negate confusing similarity that is otherwise present, as it is in the present case.

Accordingly, the domain name is confusingly similar to the Complainant’s trademark and the Complainant has thus shown the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the domain name.

That prima facie case is made out from the following considerations.

The evidence of the Complainant is to the effect that the Respondent is not related in any way to the Complainant’s business, is not affiliated with the Complainant or authorized by it in any way to use the trademark INTESA and does not carry out any activity for, nor has any business with, the Complainant.

It is also clear from the evidence that the Respondent is not commonly known by the domain name under Policy paragraph

4(c)(ii).

There is no evidence that the domain name has been used for any fair or non-commercial activities.

These facts give rise to the prima facie case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(i) circumstances indicating that 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 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 domain name; or

(ii) the respondent has registered the 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 domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website 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 website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b) (iv) of the Policy and probably within other provisions of paragraph 4 (b).

That is so for the following reasons.

First, the Complainant first submits that the Respondent was aware of the Complainant and its well-known business and trademark at the time of registration of the disputed domain name. The Panel agrees. Because of the fame and strong reputation of the INTESA trademark, the Respondent must have been aware of the existence of the Complainant and its reputation when it registered the disputed domain name. Even if it were not so aware, it could easily have become aware of the Complainant and its mark by making a simple Google search. The Panel therefore finds that the Respondent registered the domain name because it knew of the Complainant's trademark and wanted to benefit from its alleged association with the name. In any event, having regard to the evidence as a whole it is inconceivable that there was or could have been a legitimate reason for the Respondent registering the domain name.

Secondly, the Panel accepts the Complainant's submission that it is highly likely that the Respondent chose such combination of words to invoke the concept of the Complainant and its activities. By that means the Respondent, in

registering the domain name deceptively and without any authority to do so, must be taken to have created a likelihood of confusion, with the intention of attracting current and potential users of the Complainant's services looking for its services and doing so in this misleading manner. Accordingly, the domain name was registered in bad faith within the meaning of paragraph 4(b) (iv) of the Policy.

Thirdly, it is clear and as the Complainant submits, the domain name is not used for any bona fide purpose, considering that the domain name is connected with a website which has now been blocked by Google Safe Browsing because of its suspected use for phishing. The Panel accepts the Complainant's evidence to that effect. It is therefore clear that the Respondent was attempting to use the domain name for phishing, which is a fraudulent activity. Thus, the Complainant contends that the Respondent registered and has used the domain name for a fraud. The Panel accepts that submission and notes that there are many analogous UDRP decisions to that effect which have been cited by the Complainant.

Fourthly, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name using the INTESA mark and in view of the conduct that Respondent has engaged in when using the domain name, Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

The Complainant has therefore proved all of the required constituent elements of the proceeding and is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. INFORMAZIONIUTENTEINTESA.COM: Transferred

PANELLISTS

Name	The Hon. Neil Brown, QC
-------------	--------------------------------

DATE OF PANEL DECISION 2021-08-16

Publish the Decision
