

Decision for dispute CAC-UDRP-104002

Case number	CAC-UDRP-104002
Time of filing	2021-09-02 09:57:13
Domain names	INTESASANPAOLO.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

Organization	Giovanni Esposito Montefusco
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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 following registrations for the trademarks “INTESA SANPAOLO” and “INTESA”:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006 and granted on June 18, 2007;
- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002; and
- EU trademark registration n. 12247979 “INTESA”, filed on October 23, 2013 and granted on March 5, 2014.

The Complainant is also the owner of the certain domain names bearing the signs “INTESA SANPAOLO” and “INTESA” including <INTESASANPAOLO.COM> or <INTESA.COM>.

On April 30, 2021, the Respondent registered the domain name <INTESASANPAOLO.COM>.

FACTUAL BACKGROUND

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

THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is the leading Italian banking group being among the top banking groups in the euro zone, with a market capitalisation exceeding 45,3 billion euro, thousands of branches, millions of customers and strong presence in 25 countries including Central-Eastern Europe.

It is more than obvious 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, <INTESASANPAOLO.COM> exactly reproduces the well-known trademark "INTESA SANPAOLO", with the mere the substitution of the letter "O" with the number "0" in the mark's verbal portion "PAOLO" (a clear example of typosquatting).

WIPO jurisprudence (for example Case n. D2001-1314) offers many examples of confusing similarity brought about through easily made typing errors by an Internet user – particularly when the mark is another language from that of the user's mother tongue.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE 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. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue.

The disputed domain name does not correspond to the name of the Respondent, and, to the best of our knowledge, the Respondent is not commonly known as "INTESASANPAOLO".

Lastly, there are no fair or non-commercial uses of the disputed domain name.

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The domain name <INTESASANPAOLO.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. 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 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 Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy).

The disputed domain name is not used for any bona fide offerings, 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 (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 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 renowned of its trademarks. For what concern 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 for enterprises.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain name has to be considered a use in bad faith (WIPO Decision No. D2004-0615).

The risk of a wrongful use of the domain name 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 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 be easily verified 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, anyway we could find no other possible legitimate use of <INTESASANPAOLO.COM>. The sole further aim of the owner of the domain name under consideration 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 par. 4(b)(i).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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.

The Complainant has established the fact that it has valid rights for the (i) international trademark registration n. 920896 "INTESA SANPAOLO", granted on March 07, 2007; (ii) EU trademark registration n. 5301999 "INTESA SANPAOLO", applied on September 08, 2006; (iii) international trademark registration n. 793367 "INTESA", granted on September 4, 2002 and (iv) EU trademark registration n. 12247979 "INTESA", filed on October 23, 2013.

The disputed domain name has been registered on April 30, 2021, i.e. almost 19 years after the first international trademark registration.

The disputed domain name consists of two parts: INTESA and SANPAOLO. The first part of the disputed domain name is identical to the international and EU trademarks "INTESA" and first part of the international and EU trademarks "INTESA SANPAOLO".

The second part of the disputed domain name corresponds to the second part of the international and EU trademarks "INTESA

SANPAOLO” with the only difference – the letter “O” at the end of the disputed domain name is substituted by number “0”. The substitution of the letter “O” by number “0” does not change the overall impression of the designation as being connected to Complainant’s trademarks as the words SANPAOLO and SANPAL0 are visually similar and this could cause confusion with the Complainant’s trademarks.

Therefore, the Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the Complainant’s trademarks “INTESA SANPAOLO” in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy). Furthermore, the addition of the generic top-level domain “.COM” does not change the overall impression of the designation as being connected to Complainant’s trademark.

NO RIGHTS OR LEGITIMATE INTERESTS

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (ii) the respondent has no rights or legitimate interests in respect of the domain name.

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant and there is no indication that the Respondent is commonly known by the term “INTESA SANPAOLO” or “INTESASANPAOLO” or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. There is also no evidence, that the Respondent is 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.

The Panel therefore considers that 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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (iii) the domain name has been registered and is being used in bad faith.

The Respondent has registered the disputed domain name which consists of the Complainant’s trademarks “INTESA” and “INTESA SANPAOLO” with the misspelled second part of the trademarks. There are no doubts that the Complainant’s trademarks are distinctive and well-known. It could be therefore concluded that the domain name has been registered in bad faith as the Respondent had or should have the Complainant and its prior trademark rights in mind when registering the disputed domain name. Moreover, it is clear that the substitution of the letter “O” for number “0” has been made intentionally by the Respondent as there is no good reason for such substitution within this disputed domain name.

It is clear, that the disputed domain name is a typosquatting variant of the Complainant’s trademarks since number “0” looks similarly to letter “O”. Use of the disputed domain name could, therefore, attract the internet users to the corresponding web page by creating a likelihood of confusion with the Complainant’s trademark (paragraph 4(b)(iv) of the Policy). Although there is no evidence that the disputed domain name has been used for phishing, the use of the disputed domain name visually almost identical to the Complainant’s trademarks could lead to the confusion of the web page visitors.

Considering the (i) confusing similarity between the Complainant’s trademarks and the disputed domain name, (ii) obviously intentional substitution of one letter by visually similar number, (iii) distinctiveness of the Complainant’s trademarks and (iv) the failure of the Respondent to submit a response or to provide any evidence of good faith use, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

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).

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 Panel considers that the Complainant has shown that the disputed domain name <intesasanpaol0.com> is confusingly similar to the trademarks in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOL0.COM**: Transferred
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PANELLISTS

Name	JUDr. Petr Hostaš
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DATE OF PANEL DECISION 2021-09-30

Publish the Decision
