

Decision for dispute CAC-UDRP-104048

Case number	CAC-UDRP-104048
Time of filing	2021-10-04 09:53:15
Domain names	CONTOLNTESA-AGGIORNA.XYZ

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

Organization	IDDP.Net, LLC - ID Domain Privacy Network
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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 supports its Complaint, supported by evidence, in the following trademark registrations:

- International trademark registration n. 920896 "INTESA SANPAOLO", granted on March 7, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration n. 5301999 "INTESA SANPAOLO", applied on September 8, 2006 and granted on June 18, 2007, in classes 35, 36 and 38;
- International trademark registration n. 793367 "INTESA", granted on September 4, 2002 and duly renewed, in connection with class 36;
- EU trademark registration n. 12247979 "INTESA", filed on October 23, 2013 and granted on March 5, 2014, in connection with classes 9, 16, 35, 36 38, 41 and 42.

The Complainant's trade mark registrations predate the registration of the disputed domain name.

The Complainant also mentioned to be 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 now connected to the official website <http://www.intesasanpaolo.com>.

FACTUAL BACKGROUND

FACTS PROVIDED BY THE COMPLAINANT:

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.

The Complainant indicates that Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 46,6 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,300 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 7,2 million customers. Moreover, the international network specialised in supporting corporate customers is present in 25 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 different trademarks registrations for the terms "INTESA SANPAOLO" and "INTESA".

On October 3, 2020, the Respondent registered the disputed domain name <CONTOLNTESA-AGGIORNA.XYZ>.

The Respondent failed to reply this Complaint.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLAINT RESPONSE HAS BEEN FILED.

The Complainant included the following contentious:

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

The Complainant indicates that the disputed domain name at issue is identical, or – at least – confusingly similar, to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA".

The Complainant is of the opinion that <CONTOLNTESA-AGGIORNA.XYZ> exactly reproduces the trademark "INTESA", with the mere substitution of the first letter "I" with the letter "L", in conjunction with the words "CONTO" and "AGGIORNA", meaning "account" and "update", which refer to a financial service, for which the Complainant's trademarks have been registered and are used.

b. THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME.

The Complainant mentioned that 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 Complainant confirmed that nobody has been authorized or licensed by the above-mentioned banking group to use the disputed domain name at issue.

Furthermore, the Complainant indicates that the disputed domain name at stake does not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as “CONTOLNTESA-AGGIORNA”.

c. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH.

The Complainant provided with evidence indicating that the disputed domain name <CONTOLNTESA-AGGIORNA.XYZ> is currently passively held and that the webpage connected to the disputed domain is currently blocked by Google Safe Browsing because of a suspected phishing activity.

In accordance with the Complainant, their 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 provided with evidence that the disputed domain name is not used for any bona fide offerings, considering that the same is connected to a website which has been blocked by Google Safe Browsing through a warning page.

From Complainant’s opinion, it is clear that the main purpose of the Respondent was to use the above website for “phishing” financial information in an attempt to defraud the Complainant’s customers and that Google promptly stopped the illicit activity carried out by the Respondent.

In conclusion, even excluding any current “phishing” purposes or other illicit use of the disputed domain name in the present case, the Complainant was not able to find other possible legitimate use of <CONTOLNTESA-AGGIORNA.XYZ>. Lastly, it shall be noted that on February 18, 2021 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.

Based on the above mentioned facts, the Complainant is of the opinion that the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

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.

I. The disputed domain name is confusingly similar to the trademark INTESA of the Complainant.

Paragraph 4(a)(i) of the Uniform Domain Name Dispute Resolution Policy (the Policy) establishes the obligation of Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

Complainant has provided with evidence about the registration of different trademarks “INTESA SANPAOLO” and “INTESA”.

Based on the evidence at hand, the Panel is the opinion that the element LNTESA is confusingly similar to Complainant’s trademarks INTESA with the only difference of the first letter; i.e. instead of the letter I the disputed domain name starts with the letter L. Furthermore, the addition of the elements “CONTO” and “AGGIORNA” do not help to eliminate the confusion. In fact, the terms are Italian words with the following meanings in the English language: CONTO = BILL or ACCOUNT and AGGIORNA = UPDATE. Both terms are normally used within the financial sector where Complainant operates and it has registered trademark rights and, therefore, the elements increase the risk of confusion to the bank customers.

Lastly, the addition of new generic top level domain “.xyz” does not serve to distinguish the disputed domain name from the Complainant’s INTESA trademarks.

The Panel holds that Paragraph 4(a)(i) of the Policy has been satisfied.

II. The Respondent has no rights or legitimate interests in terms of the Policy.

Paragraph 4(a)(ii) of the Policy requires the Complainant to show that the Respondent has no rights or interests in respect of the disputed domain name. Once the Complainant establishes that the Respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the Respondent (see WIPO Jurisprudential Overview, version 3.0., paragraph 2.1).

In accordance with the Complaint, Complainant has not granted authorization to Respondent to use their INTESA and INTESA SAN PAOLO trademarks. The fact that Respondent did not reply to the Complaint gives an additional indication that Respondent lacks rights or legitimate interest since Respondent did not provide with information about possible rights.

From the information provided by Complainant, there is no evidence or reason to believe that the Respondent (as individual, business or other organization) has been commonly known by the disputed domain name. In fact, Complainant has provided evidence which demonstrates that the disputed domain name is currently blocked by Google Safe Browsing due to a suspected phishing activity. This is of course a strong indication that Respondent might not be making a legitimate non-commercial or fair use of the disputed domain name.

For the reasons above mentioned and in absence of Respondent’s reply, the Panel concludes that Respondent does not have rights or legitimate interest in the disputed domain name and Complainant has satisfied the second element of the Policy.

III. The disputed domain name has been registered and is being used in bad faith in accordance with the Policy.

Paragraph 4(a)(iii) of the Policy indicates that Complainant must assert that the Respondent registered and is using the disputed domain name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or 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 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 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 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.

In accordance with the evidence, the disputed domain name is currently not in use. It is well established at different UDRP panel resolutions that the lack of use of a domain name does not prevent from finding bad faith (e.g. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. 2000-0003). WIPO Jurisprudential Overview, version 3.0. at paragraph 3.3. provides some factors that have been considered relevant in applying the passive holding doctrine such as: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

For the current case, the evidence at hand confirms that Complainant's INTESA trademark is distinctive and it has a strong reputation in the financial industry, at least in Europe. Furthermore, Complainant has provided evidence that the Respondent should have found information over the internet about Complainant's trademarks rights over INTESA and INTESA SAN PAOLO before registering the disputed domain name.

Respondent did not reply neither this Complaint nor the Cease-and-Desist letter sent by Complainant on February 18, 2021. Respondent had a chance to provide with evidence of actual or contemplated good faith use but failed to do so.

Third, Respondent appears to have registered the disputed domain name using a Domain Privacy Network service.

Finally, Complainant indicates in the Complaint that the disputed domain name was probably used for phishing purposes, however, did not provide with clear evidence regarding a concrete phishing attack. Complainant provided with a screen shot of the disputed website blocked by Google Safe Browsing. In accordance with Google's website, the Google Safe Browsing was launched in 2007 to protect users across the web from phishing attacks and, therefore, the Panel relies on Complainant's allegation that the disputed domain name might have been used for a phishing attack, confirming the implausibility of any good faith use to which the domain name may be put.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the disputed domain name and the Complainant's INTESA and INTESA SAN PAOLO trademarks, b) the lack of reply to this Complaint by Respondent as well as to the Cease-and-Desist letter sent by Complainant to Respondent, c) the fact that the disputed domain name is being passively held and probably used for a phishing attack, d) the Respondent's hidden identity behind privacy shields, the Panel draws the inference that the disputed domain name was registered is being used in bad faith.

In addition to the above described and from the Panel perspective, the following circumstances also confirm Respondent's bad faith in the registration of the disputed domain name:

(a) By conducting a search over the Internet, Respondent should have been made aware of Complainant's trademarks INTESA and INTESA SAN PAOLO as well as their reputation in the financial industry in Europe;

(b) The disputed domain name is composed with the words CONTO and AGGIORNA together with INTESA. Absent of Respondent's reply, this combination is only a confirmation of Respondent's knowledge of Complainant's trademark INTESA prior to the registration of the disputed domain name;

(c) Complainant's trademark rights over INTESA and INTESA SAN PAOLO predate the date of registration of the disputed domain name.

These factors make the Panel believe that the disputed domain name was registered with the intention 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.

Therefore, the Panel concludes that Respondent registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CONTOLNTESA-AGGIORNA.XYZ**: Transferred

PANELLISTS

Name	Victor Hugo Garcia Padilla, LL.M.
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DATE OF PANEL DECISION	2021-11-07
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Publish the Decision