

Decision for dispute CAC-UDRP-104207

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| Case number | CAC-UDRP-104207 |
| Time of filing | 2021-12-02 09:36:59 |
| Domain names | INTESASPAONLINE.COM |

Case administrator

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| Organization | Denisa Bilík (CAC) (Case admin) |
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Complainant

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| Organization | Intesa Sanpaolo S.p.A. |
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Complainant representative

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| Organization | Intesa Sanpaolo S.p.A. |
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Respondent

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| Name | Gabriella Campora |
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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 owns a portfolio of registered marks including:

- EUTM registration no. 5301999 "INTESA SANPAOLO," filed on 8 September 2006, and granted on 18 June 2007 and duly renewed, in classes 35, 36 and 38; and
- EUTM registration n. 12247979 "INTESA", filed on 23 October 2013 and granted on 5 March 2014, in classes 9, 16, 35, 36, 38, 41 and 42.

It also owns various national and international marks including

- International trademark registration n. 920896 "INTESA SANPAOLO", granted on 7 March 2007 and duly renewed, in classes 9, 16, 35, 36, 41 and 42; and
- International trademark registration n. 793367 "INTESA", granted on 4 September 2002 and duly renewed, in class 36.

Further, the Complainant is also the owner, among the others, of many domain names including and comprising the signs, including for example: "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 which resolve to the official website <http://www.intesasanpaolo.com>.

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

The Complainant is a leading Italian banking group, created by a merger in 2007 between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banks. It is also among the top banking groups in the euro zone, with a market capitalisation exceeding EURO 47 billion. It is the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). It has a network of approximately 4,200 branches throughout Italy and a market share of over 17% in most Italian regions. It has approximately 13.5 million customers. It also has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7 million customers. It also has a corporate business 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.

On 29 July 2021 the Respondent registered the disputed domain name, <INTESASPAONLINE.COM>.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. IDENTICAL OR CONFUSINGLY SIMILAR

It is obvious that the disputed domain name is identical, or – at least – confusingly similar, to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA". In fact, INTESASPAONLINE.COM exactly reproduces the well-known trademark "INTESA", with the addition of generic letters "SPA", for "Società per Azioni", meaning "company limited" in Italian with the addition of the term "ONLINE". The SPA represents Complainant's legal form. These generic words do not alter the fact the whole mark is used. This impersonation is classic typosquatting.

2. 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 disputed 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 "INTESASPAONLINE" based on the WHOIS data. Finally, there are no fair or non-commercial uses of the disputed domain name on the face of it and based on the home page to which it resolves [DESCRIBE].

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

The disputed domain name INTESASPAONLINE.COM was registered and is used in bad faith. The Complainant's trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and are well known marks all over 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 out 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 relies on an extract of a Google search in support of its submissions. 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 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 offering. In particular, there are 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 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 offering, even though it is no longer connected to any web site. 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, see, in this regard, *Telstra Corporation Limited v. Nuclear Marshmallows*, 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 trade mark rights. As regards to the first aspect, the Complainant has proved the fame and renown of its trademarks. As to the second circumstance, it is objectively not possible to understand what kind of use the Respondent could make with a domain name which exactly corresponds to the Complainant's trademarks and the Complainant's domain names – all currently used by the latter to provide online banking services. In the light of the above, the passive holding of the disputed domain name must be considered use in bad faith: "The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests" from Decision No. D2004-0615, *Comerica Inc. v. Horoshiy, Inc.*

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. 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. In the present case, the Complainant believes that the current owner registered the disputed domain name with "phishing" as its purpose, in order to induce and/or 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, here classic 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 INTESASPAONLINE.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) "circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name." 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.

RESPONDENT:

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

This is a simple case of classic typosquatting. There is no doubt as to the Complainant's Rights as it is a well-known Bank and its marks are marks with a reputation and include registered EUTMs. The generic word "online" adds nothing to the analysis. Previous UDRP Panels have stated in this regard that "minor alterations cannot prevent a finding of confusing similarity between the trademark and the domain name" (see *LinkedIn Corporation v. Daphne Reynolds*, WIPO Case No. D2015-1679). The disputed domain name includes, and so is conceptually, aurally and visually similar to the distinctive name and registered marks of the Complainant. Also, previous Panels have stated the following: "...Respondent has engaged in typosquatting ...a practice by which a registrant deliberately introduces slight deviations into well-known marks for commercial gain. See, e.g., *Marriott International, Inc. v. Seocho*, Forum Claim No. 149187 (finding <marriottt.com> confusingly similar to <marriott.com>). ..Because Respondent has committed typosquatting, the Domain Name is, by definition, confusingly similar to Complainant's RANDSTAD Mark" (see *Edmunds.com, Inc v. Triple E Holdings Limited*, WIPO Case No. D2006-1095). Furthermore, the generic Top-Level Domain ".com" in the second-level portion is a standard registration requirement and should be disregarded when assessing whether a disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see *Arcelormittal S.A v. James*, supra and *Credit Mutuel Arkea v. Domain Administration*, CAC Case No. 102345).

The Complainants' burden under the second limb of the Policy is to make a prima facie case for the Respondent to rebut. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.* WIPO Case No. D2003-0455. Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name. See Forum Case No. FA 1781783, *Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>*. There is also no "evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name" (see *Bollore v. Tywonia W Hill*, WIPO Case No. DCO2017-0012). There is no evidence that the Respondent has made a bona fide offering or use or that it holds any financial services licence or is regulated by any recognised regulator. There is no active use. While passive holding is fact sensitive, here there are no relevant facts on the face of it and the Respondent has not come forward to explain her reasons for registration and holding. In such a case, we are entitled to draw such inferences as are appropriate and they are that registration was not for a legitimate purpose or interest. The Respondent has therefore been granted an opportunity to come forward and answer or present compelling arguments that it has rights or legitimate interests in the disputed domain name but has failed to do so.

As to bad faith, it is most likely that the disputed domain name was registered for phishing perhaps by email. Such a practice consists of attracting the customers of a bank or brokerage 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 is certainly typosquatting and previously panels have stated: "There can be no doubt that the Respondent registered the disputed domain name and is using it to attract, for commercial gain, Internet users to its website. The evidence also establishes the Respondent must have been aware of the Complainant's rights at the time of registration; indeed, those rights are the reason for having chosen the disputed domain name for typosquatting purposes. Such conduct qualifies as 'bad faith' within the meaning of paragraph 4(b)(iv) of the Policy" (see *Accenture Global services Limited v. Vistaprint Tenchologies Ltd*, WIPO Case No. D2015-1922). WIPO Overview 3.0 para. 3.1.4 states that "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Previously panels also stated the following: "The Panel established that the

registration and passive holding of a domain name which has no other legitimate use and clearly refers to the Complainant's trademark may constitute registration and use in bad faith" (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

The Panel finds that the three limbs of the policy are made out by the Complainant, which has discharged its burden and proved bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. INTESASPAONLINE.COM: Transferred

PANELLISTS

| | |
|-------------|-------------------------|
| Name | Victoria McEvedy |
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DATE OF PANEL DECISION **2022-01-11**

Publish the Decision
