

Decision for dispute CAC-UDRP-104322

Case number	CAC-UDRP-104322
Time of filing	2022-02-02 09:17:16
Domain names	INTESA-MOBILE-ISP.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	saad ali
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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, inter alia, of the following registrations for the trademarks "INTESA SANPAOLO", "INTESA" and "ISP"):

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

- EU trademark registration n. 7310337 "ISP", filed on October 13, 2008, granted on February 12, 2010 and duly renewed, in connection with class 36.

Moreover, the Complainant is also the owner, inter alia, of the following domain names containing 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 and INTESA.ME. All of them are connected to the Complainant's website <http://www.intesasanpaolo.com>.

FACTUAL BACKGROUND

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

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 44,2 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). With a network of approximately 4,200 branches distributed throughout the Country, with market shares of more than 17% 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. The network serving 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.

On February 3, 2021 the Respondent registered the disputed domain name <INTESA-MOBILE-ISP.COM>.

PARTIES CONTENTIONS

COMPLAINANT:

THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR TO THE COMPLAINANT'S TRADE MARK

The disputed domain name contains the well-known trademark "INTESA", with the addition of the term "MOBILE" and "ISP" (which exactly reproduces the Complainant's trademark "ISP" and also represents the abbreviation of the well-known trademark "INTESA SANPAOLO").

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

The Respondent has no rights in the disputed domain name, and has not been authorized or licensed by the Complainant or its banking group to use the disputed domain name.

The disputed domain name does not correspond to the name of the Respondent and the Respondent is not commonly known as "INTESA-MOBILE-ISP".

There are no fair or non-commercial or bona fide uses of the disputed domain name which has only been used for a page of commercial links offering competing financial services.

THE DISPUTED DOMAIN NAME 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.

The disputed domain name does not currently resolve to an active web site. UDRP decisions confirm 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 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.

It is 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 is so similar to the Complainant's domain names currently used by the latter to provide online banking services for enterprises.

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 means of web pages which were very similar to the Complainant's ones, for the sensitive data of the Clients, like user ID, password etc. Then, some of the Clients have been cheated out of their savings. Also in the present case, the Complainant believes that the Respondent registered the disputed domain name with "phishing" in mind, in order to induce and divert the Complainant's legitimate customers to its website and steal their money.

Even excluding any "phishing" purposes or other illicit use of the disputed domain name in the present case, 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»).

On March 25, 2021 the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the disputed domain name. Despite such communication, the Respondent did not comply with this request.

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

The disputed domain name is confusingly similar to the Complainant's INTESA trade mark (registered, inter alia as an international registration in 2002) adding only hyphens, generic terms and a gTLD which do not prevent said confusing similarity.

The Respondent does not appear to be commonly known by the disputed domain name and is not authorised by the Complainant.

The disputed domain name registered in 2021 has been used for commercial competing pay per click links which is not a bona fide offering of goods or services or a legitimate non commercial or fair use. It is registration and use in bad faith that is confusing Internet consumers for commercial gain and disrupting the Complainant's business. (The Panel notes the Complainant concerns regarding 'phishing', but no evidence of this in this case has been provided.).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. INTESA-MOBILE-ISP.COM: Transferred
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PANELLISTS

Name	Dawn Osborne
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DATE OF PANEL DECISION 2022-02-28

Publish the Decision
