

Decision for dispute CAC-UDRP-104386

Case number	CAC-UDRP-104386
Time of filing	2022-03-02 09:46:36
Domain names	INTESASPAONLINE.ORG

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	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 is a relevant Italian banking group with strong presence 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 owns the following Trademarks:

- International trademark registration No. 920896 INTESA SANPAOLO, granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 41 and 42;
- EU trademark registration No.5301999 INTESA SANPAOLO, filed on September 8, 2006, granted on June 18, 2007 and duly renewed, in connection with the classes 35, 36 and 38;
- International trademark registration No. 793367 INTESA, granted on September 4, 2002 and duly renewed, in connection

with class 36;

- EU trademark registration No. 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 disputed domain name <intesaspaonline.org> was registered on July 19, 2021 and resolves to an inactive website.

FACTUAL BACKGROUND

The Complainant is a relevant Italian banking group with strong presence 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 has a market capitalization exceeding 44,2 billion euro, with presence in different business areas as retail, corporate and wealth management. The Complainant has a network of approximately 4,200 branches capillary, distributed throughout Italy, with market shares of more than 17% in most Italian regions, the Complainant offers its services to approximately 13,5 million customers.

The Complainant has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,1 million customers. The Complainant supports international corporate customers in 25 countries, including in the United States, Russia, China and India.

The Complainant owns the International Trademarks INTESA since September 4, 2002 and INTESA SANPAOLO since March 7, 2007; and European's Trademark rights over INTESA SANPAOLO, at least since September 8, 2006 and INTESA at least since October 23, 2013.

The Complainant also owns a domain names portfolio, based on the Trademarks: INTESA SANPAOLO and INTESA: <intesaspaonline.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>, which are connected to the official website <http://www.intesaspaonline.com>, registered on August 24, 2006.

According to the evidence presented before the Panel, the disputed domain name <intesaspaonline.org> was registered on July 19, 2021 and resolves to an inactive website.

By the time of this Decision, the disputed domain name and the website have remained inactive.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Complainant Contentions:

1) The Complainant asserts that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA". As a matter of fact, INTESASPAONLINE.ORG exactly reproduces the well-known trademark "INTESA", with the mere addition of letters "SPA", that represent Complainant's legal form ("Società per Azioni") and the addition of term "ONLINE" that is merely descriptive.

2) 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 domain name at stake does not correspond to the name of the Respondent and, to the best of the Complainant's knowledge, the Respondent is not commonly known as "INTESASPAONLINE".

The Complainant does not find any fair or non-commercial uses of the domain name at stake.

3) 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; 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 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 (see, in this regard, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, enclosed as Annex E, 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.).

The consensus view of WIPO UDRP panelists 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.

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.

On November 4, 2021, the Complainant sent to the Respondent a Cease-and-Desist Letter, asking to forward the document to the domain name owner in order to require the voluntary transfer of the domain name at issue. The Respondent's never replied to such communication.

RESPONDENT:

The Respondent did not reply to any of the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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 Complainant has sufficiently proved before the Panel, that owns International Trademark Registration over the term INTESA since September 4, 2002 (granted date); INTESA SANPAOLO, since March 7, 2007 (granted date) and European's Trademark rights over the term INTESA SANPAOLO, at least since September 8, 2006 (application date), June 18, 2007 (granted date), and INTESA at least since October 23, 2013 (application date), March 5, 2014 (granted date).

The disputed domain name <intesaspaonline.org> registered on July 19, 2021, includes the trademark INTESA, in addition of the letters "SpA" which are the initials of a type of Italian Company "Società per Azioni" plus the generic and descriptive term of "ONLINE".

It is well established by the Domain Name Jurisprudence that for the purposes of the analysis of the First UDRP Element, in this case, the gTLD ".org", is considered "as a standard registration requirement and as such is disregarded under the first element confusing similarity test" (see point 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0").

In relation with the use of a trademark in the disputed domain name plus descriptive terms, point 1.8 of the WIPO Jurisprudential Overview has stated:

"Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements."

In this Case, the Complainant's trademark INTESA was exactly reproduced, and the letters "SpA" as previously indicated, makes reference to an Italian legal form of Company, and the term "online" is descriptive, both inferring a connection to Complainant's business activity (see Intesa Sanpaolo S.p.A. vs. marin cristoiu, CAC Case No. 103227).

Therefore, the disputed domain name <intesaspaonline.org> is confusingly similar to Complainant's INTESA trademark.

Regarding the Second UDRP Element, to this Panel it is clear that:

(1) the Respondent is not associated or affiliated or hasn't been authorized or licensed by the Complainant to register the disputed domain name.

(2) there is no evidence of the reason why the Respondent selected a well-known trademark as INTESA and added the letters "SPA" and the descriptive word "ONLINE" which are intrinsically related to Complainant's legal form and business activity.

(3) there is no evidence that the Respondent corresponds or has become commonly known by the term "INTESASPAONLINE.ORG".

(4) the Respondent registered the disputed domain name on July 19, 2021, meaning at least 19 years AFTER the Complainant's acquired its trademark rights over INTESA on September 4, 2002.

(5) the Respondent is not making a bona fide offering of goods or services, or a legitimate non-commercial or fair use of the disputed domain name, since it resolves to an inactive website, where such absence of use represents strong evidence of its lack of rights or legitimate interests over the disputed domain name.

Therefore, this Panel concludes that the Respondent to have no rights or legitimate interests in respect of the disputed domain name (see *Intesa Sanpaolo, S.p.A. vs. Leone Toscano*, CAC Case No. 103819).

In relation to the Third Element of the UDRP, the Bad Faith, this Panel analyses the following:

The Complainant acquired its trademark rights on September 4, 2002, meaning at least 19 years BEFORE the Respondent registered the disputed domain name on July 19, 2021, it is implausible to this Panel, especially due to that the disclosed Respondent "Gabriella Campora" is at Italy, the same Complainant's location (see *Confédération Nationale du Crédit Mutuel v. Whois Privacy Protection Foundation / Diego Lopeaz*, WIPO Case No. 2021-0300), in addition of the absence of any Response, including to the Cease and Desist Letter sent by the Complainant on November 4, 2021, to consider that at the time of registration the Respondent did such selection of words for the registration of the disputed domain name, without an exhaustive and previous knowledge of Complainant's trademarks value.

As the Complainant argues in its Complaint:

"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 Panel coincides with Complainant's argument and finds its emphasis at point 3.2.2. of the WIPO Jurisprudential Overview 3.0. which states:

"Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark."

Therefore, this Panel concludes that the disputed domain name was registered with Complainant's Trademark's value on mind, meaning that it was registered in bad faith.

The Domain Name Jurisprudence, has established in relation to the Passive Holding Doctrine, that:

"(...) While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include:

- (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." (see point 3.3 of the WIPO Overview 3.0").

To this Panel, it is very important to emphasize, especially in the present Bank Case scenario, that inactive domain names and websites are equal to a wide-open gate where data security is potentially exposed and under an imminent risk with endless consequences, as phishing, email scam and/or any malware, implying a significant loss of customer's trust, damaging the good-will and reputation of such Trademark Owners, undeniably. As Complainant states:

"(...) 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" (see *Comerica Inc. v. Horoshiy, Inc.*, WIPO Case No. D2004-0615).

In the present Case, the Complainant is a recognized Italian Bank Institution, with well-known trademarks, incorporated in the disputed domain name, and the Respondent has not submitted any kind of Response, or any evidence of good-faith use, facts that are sufficient to this Panel, to conclude the presence of bad faith use of the disputed domain name as well.

Therefore, this Panel concludes that, the disputed domain name has been registered and used in faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. INTESASPAONLINE.ORG: Transferred

PANELLISTS

Name	Ms. MARÍA ALEJANDRA LÓPEZ GARCÍA
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DATE OF PANEL DECISION	2022-03-28
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Publish the Decision