

Decision for dispute CAC-UDRP-104465

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| Case number | CAC-UDRP-104465 |
| Time of filing | 2022-04-01 09:54:37 |
| Domain names | INTESA-ONLINE.COM, INTESA-ONLINE.ORG |

Case administrator

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| Organization | Iveta Špiclová (Czech Arbitration Court) (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 names.

IDENTIFICATION OF RIGHTS

The Complainant is, inter alia, a registered owner of the following trademarks containing word element "INTESA":

- (i) INTESA (word), International Trademark, filing (priority) date 4 September 2002, registration no. 793367, registered for services in class 36;
 - (ii) INTESA (word), EU Trademark, filing (priority) date 23 October 2013, registration no. 12247979, registered for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;
 - (iii) INTESA SANPAOLO, International Trademark, filing (priority) date 7 March 2007, registration no. 920896, registered for goods and services in classes 36;
 - (iv) INTESA SANPAOLO, EU trademark, filing (priority) date 8 September 2006, registration no. 5301999, registered for goods and services in classes 35, 36, 38,
- besides other national and international trademarks consisting of or containing the "INTESA" wording.
(Collectively referred to as "Complainant's trademarks").

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code

Top-Level Domains ("ccTLD") containing the term „INTESA" such as <INTESASANPAOLO.COM> (official website), <INTESA.COM>, <INTESA.EU>, <INTESA.ORG> and others.

FACTUAL BACKGROUND

The Complainant (Intesa Sanpaolo S.p.A.) is a leading Italian banking group and also one of the protagonists in the European financial arena. The Complainant is the company resulting from the merger (effective as of 1 January 2007) between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups.

Both disputed domain names were registered on 19 July 2021 and they are held by the Respondent.

The domain name websites (i.e. websites available under internet address containing the disputed domain names) do not resolve to any active website (this is the same for both disputed domain names).

The Complainant seeks transfer of both disputed domain names to the Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain names contain the "INTESA" word element of the Complainant's trademarks in its entirety and thus they are almost identical (i.e. confusingly similar) to the Complainant's trademarks since the domain names differ from the Complainant trademarks only by a descriptive expression "ONLINE".

Thus, according to the Complainant the confusing similarity between Complainant's trademarks and the disputed domain names is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain names;
- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant's trademarks in any manner.

The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by either of disputed domain names;

- Furthermore, the domain name websites (with respect to both disputed domain names) have not been used for any legitimate or fair purposes.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain names' registration and such trademarks are well known in relevant business circles. The Respondent can be considered aware of the Complainant's trademarks when registering the disputed domain name due to well-known character thereof, which should have been checked by the Respondent by performing a simple internet search;
- The disputed domain names (at the time of filing of the complaint) were not used for any bona fide offerings of goods or services;
- It is well-founded that registration of the disputed domain names that are confusingly similar to the complainant's trademarks which enjoys strong reputation, plus other facts, such as above described unfair use of the disputed domain names, are sufficient to establish bad faith under the 4(a)(iii) of the Policy;
- The Complainant refers to previous domain name decisions contending that registering a "phishing" website is perhaps the clearest evidence of registration and use of a domain name in bad faith", especially when it concerns trademarks of financial institutions that enjoy high level of notoriety and well-known character;
- Complainant has tried to reach the Respondent by a cease-and-desist letter requesting that the Respondent voluntary transfers the disputed domain name to the Complainant, with which they did not comply.

RESPONDENT:

The Respondent has not provided any response to the complaint.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

RIGHTS

The disputed domain names and the Complainant's trademarks are nearly identical since both fully incorporate the word element "INTESA".

Since the disputed domain names and the Complainant's trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain names consisting also of a term "ONLINE" are confusingly similar to the Complainant's trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the disputed domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name. An addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold for Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name in question. Applying the principles described above, the Panel contends that incorporation of a dominant "INTESA" " element of Complainant's trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain names constitutes confusing similarity between the Complainant's trademark and the disputed domain names.

Addition of a non-distinctive element – descriptive term "ONLINE" - cannot prevent the association in the eyes of internet consumers between the disputed domain names and the Complainant's trademarks and thus the likelihood of confusion still exists. On the contrary, it may mislead the internet users that the disputed domain name is somehow related to Complainant's internet (online) business.

For sake of completeness, the Panel asserts that the top-level suffix in the domain names (i.e. the ".com" and ".org") must be disregarded under the identity and confusing similarity tests, as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant's assertions that the Respondent is not commonly known by the disputed domain names and is not affiliated with nor authorised by the Complainant are sufficient to constitute prima facie showing of absence of rights or legitimate interest in the disputed domain names on the part of the Respondent.

Given the facts above and in the absence of the Respondent's response, the Panel concludes that there is no indication that the disputed domain names were intended to be used in connection with a bona fide offering of goods or services as required by UDRP.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant 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 Respondent has not used the disputed domain names in any manner, however, the Panel concludes (as it has been ruled in many similar cases, as for example *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, <telstra.org>, *Jupiters Limited v. Aaron Hall*, WIPO Case No. D2000-0574, <jupiterscasino.com>, *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. D2002-0131, <ladbrokespoker.com>) that the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name(s) without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.

Examples of what may be cumulative circumstances found to be indicative of bad faith include cases in which (i) the Complainant has a well-known trademark and (ii) there is no genuine use (e.g. a mere "parking") of the disputed domain name by the Respondent (irrespective of whether the latter should also result in the generation of incidental revenue from advertising referrals).

Based upon the concepts above, which the Panel finds satisfied in this case, even though there is no real use of the dispute domain names, the Panel contends, on the balance of probabilities, that the disputed domain names have been registered and are being used (held) by the Respondent in bad faith.

The use of term ONLINE also indicates that the disputed domain names might be intended for "phishing" purposes as it may mislead internet users that both domain names are dedicated for online communication with the Complainant – for hosting a web page imitating a real page of the Complainant (i.e. bank website) with an intention to mislead customers and have them disclosed confidential information as, for example, passwords, login etc.

It is well-founded that registration of the domain names that are confusingly similar to the Complainant's trademarks which enjoys strong reputation, plus other facts, such as above-described potential unfair use of the domain names, are sufficient to establish bad faith under the 4(a)(iii) of the Policy.

Thus, the Panel has taken a view that the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-ONLINE.COM**: Transferred
2. **INTESA-ONLINE.ORG**: Transferred

PANELLISTS

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| Name | JUDr. Jiří Čermák |
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| DATE OF PANEL DECISION | 2022-05-02 |
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Publish the Decision
