

Decision for dispute CAC-UDRP-104459

Case number	CAC-UDRP-104459
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Time of filing	2022-04-01 09:52:27
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Domain names	INTESA-EU.COM
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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	Stephane Teboul
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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 claims rights on several trademark registrations composed with "INTESA SANPAOLA" and "INTESA", such as:

- International registration trademark INTESA SANPAOLO No. 920896, registered on March 7, 2007, in connection with goods and services in classes 9, 16, 35, 36, 41 and 42, and dully renewed;
- EU trademark INTESA SANPAOLO No. 005301999, registered on June 18, 2007, in connection with services in classes 35, 36 and 38, and dully renewed;
- International registration trademark INTESA No. 793367, registered on September 4, 2002, in connection with services in class 36, and dully renewed; and
- EU trademark INTESA No. 012247979, registered March 5, 2014, in connection with goods and services in classes 9, 16, 35, 36, 38, 41 and 42.

The Complainant also claims ownership on important domain names portfolio, composed the signs "INTESA SANPAOLO" and "INTESA", such as: <intesasanpaolo.com>, <intesasanpaolo.org>, <intesasanpaolo.eu>, <intesasanpaolo.info>, <intesasanpaolo.net>, <intesasanpaolo.biz>, <Intesa-sanpaolo.com>, <Intesa-sanpaolo.org>, <Intesa-sanpaolo.eu>, <Intesa-

sanpaolo.info>, <Intesa-sanpaolo.net>, <Intesa-sanpaolo.biz>, <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>. However, the Complainant did not produce details of registration.

The Respondent has registered the Disputed Domain Name <Intesa-eu.com> on November 26, 2021.

FACTUAL BACKGROUND

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

The Complainant is the leading Italian banking group. 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 capitalization exceeding 44,6 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,700 branches capillary and well 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. Moreover, the international network specialized 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 owns several trademarks "INTESA SANPAOLO" and "INTESA", such as the IR INTESA SANPAOLO No. 920896 registered on March 7, 2007, and INTESA No. 793367 registered on September 4, 2022, and the EU trademarks INTESA SANPAOLO No. 005301999 registered on June 18, 2007, and INTESA No. 012247979 registered on March 5, 2014.

The Respondent has registered the Disputed Domain Name <Intesa-eu.com> on November 26, 2021. It does not redirect to a specific website.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Confusing similarity

The Complainant claims that the Disputed Domain Name exactly reproduces the well-known trademark INTESA, with the mere addition of the acronym EU, meaning European Union.

No rights or legitimate interest

The Complainant claims that the Respondent has no rights on the Disputed Domain Name. It did not authorize the Respondent to use the INTESA SANPAOLO and INTESA trademarks.

The Complaint contends that the Respondent is not commonly known by the Disputed Domain Name and that the Respondent's name does not correspond to it.

The Complainant argues that the Respondent does not make a fair or non-commercial use of the Disputed Domain Name.

Registration and use in bad faith

Since the INTESA SAN PAOLO and INTESA trademarks are distinctive and well-known and since simple Google search of said trademarks only shows results relating to the Complainant, the Complainant claims that it is more than likely that the Disputed Domain Name would not have been registered if not for the Complainant's trademarks. Then, the Disputed Domain Name was registered in bad faith.

The Complainant argues that the passive holding of the Disputed Domain Name is consistent with a finding of bad faith.

It relies on the Telstra decision (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003) and on the panels' consensus view on this point, as reflected in the "WIPO Overview" at paragraph 3.2.

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 contends it has proved the renowned of its trademarks. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant's trademarks and that results so similar to the Complainant's domain names currently used by the latter to provide online banking services for enterprises.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the Disputed Domain Name has to be considered a 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 spectre of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests». The Complainant relies on the UDRP Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., concerning the case of a bank.

The risk of a wrongful use of the Disputed Domain Name 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.

Also in the present case, the Complainant believes that the current owner registered the Disputed Domain Name with the "phishing" purpose, in order to induce and 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 (typosquatting).

The sole further aim of the owner of the Disputed 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»).

Lastly, it shall be underlined that – on January 18, 2022 – the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the Disputed Domain Name to the Complainant. The Respondent's never replied to such communication.

RIGHTS

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Disputed Domain Name wholly incorporates the INTESA trademarks and partially reproduces the INTESA SAN PAOLO trademarks.

It only differs from the INTESA trademarks by the addition of the geographical term "EU", which means "European Union". This geographical term only refers to the historic territory of exploitation of the Complainant's trademarks. It does not avoid a finding of confusing similarity.

Thus, the Disputed Domain Name <intesa-eu.com> is confusingly similar to the Complainant's trademarks.

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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
- (ii) the Respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

The Complainant did not authorize or license the Respondent to use the INTESA and INTESA SANPAOLO trademarks to register the Disputed Domain Name.

There is no indication that the Respondent is commonly known as "Intesa.eu".

The Disputed Domain Name does not redirect to a specific website. There is no evidence that the Respondent is using the Disputed Domain Name with a bona fide offering of goods or services.

The Respondent did not respond to the Complainant to rebut its prima facie case. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the Disputed Domain Name.

Therefore, the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in respect to the Disputed Domain Name.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of the Disputed Domain Name.

It provides that:

"For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, 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 the Respondent has 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 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the 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 your 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 or service on the respondent's website or location."

The Complainant registered its INTESA and INTESA SANPAOLO trademarks long before the registration of the Disputed Domain Name on November 26, 2021.

The Complainant's trademarks are well known all around the world.

A simple Google search of the terms "Intesa" and "Intesa Sanpaolo" only shows results relating to the Complainant.

The Respondent knew or could not have ignored the existence of the Complainant's trademark when registering the Disputed Domain Name.

The Panel is of the opinion that it is sufficient evidence for a finding of bad faith registration of the Disputed Domain Name.

The Panel notes that the Disputed Domain Name does not redirect to a specific website, that there is no evidence of use of the Disputed Domain Name in relation to advertising or promotion, or the sale of goods or services. There is also no evidence that

the Respondent has offered to sell, rent or otherwise transfer the Disputed Domain Name to the Complainant or any other person. Then, the Respondent is passively holding the Disputed Domain Name.

Nonetheless, the following circumstances must be taken into consideration:

- The Complainant's trademarks have a strong reputation and are widely known, as shown by its substantial use in Italy, in most of Europe and in several countries around the world;
 - The Respondent has provided no evidence of a real and actual use in good faith of the Disputed Domain Name;
 - The Respondent could not be reached by the CAC case administrator, who used the available email addresses to contact him;
 - Considering the reputation and the field of activity of the Complainant, the Respondent can only plan to use the Disputed Domain Name for unlawful/illicit purposes, such as phishing, or trying to sell, rent or otherwise transfer it to the Complainant or another person. Then, it is implausible that the Respondent is using or will use the Disputed Domain Name in good faith.
- Therefore, despite the absence of use of the Disputed Domain Name, and in accordance with the passive holding doctrine (See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; Comerica Inc. v. Horoshiy, Inc., WIPO Case No. D2004-0615; WIPO Overview 3.0, paragraph 3.3), the Panel concludes that the Disputed Domain Name is being used in bad faith as appears from the circumstances set forth above.

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 <intesa-eu.com> incorporates the well-known trademarks INTESA and INTESA SANPAOLO, with the addition of the geographic term "EU", meaning "European Union", which is the historic territory of the Complainant's trademarks. The addition of this acronym does not avoid a finding of confusing similarity. The Disputed Domain Name is therefore confusingly similar to the INTESA and INTESA SANPAOLO trademarks.

The Respondent is not authorized in any manner to register or use the Disputed Domain Name. It is not commonly known as "INTESA EU". There is no evidence of the use of the Disputed Domain Name with a bona fide offering of goods or services.

The Respondent knew or could not have ignored the existence of the Complainant's trademark when registering the Disputed Domain Name. In accordance with the passive holding doctrine, the Panel concludes that the Disputed Domain Name is being used in bad faith as appears from the circumstances of the case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-EU.COM**: Transferred

PANELLISTS

Name	Marie-Emmanuelle Haas, Avocat
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DATE OF PANEL DECISION	2022-05-05
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Publish the Decision