

Decision for dispute CAC-UDRP-104462

Case number CAC-UDRP-104462

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Domain names BANCA-INTESA-SICUREZZA.COM

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization Intesa Sanpaolo S.p.A.

Complainant representative

Organization Intesa Sanpaolo S.p.A.

Respondent

Organization Host Master / 1337 Services LLC

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 submitted evidence that it is the owner of the following trademarks "INTESA SANPAOLO", "INTESA" and "BANCA INTESA SANPAOLO" (hereafter the "Trademarks"):

- International trademark registration n. 920896 "INTESA SANPAOLO" (word trademark), registered on March 7, 2007 and duly renewed, valid for classes 9, 16, 35, 36, 41 and 42;
- EU trademark registration n. 5301999 "INTESA SANPAOLO" (word trademark), registered on June 18, 2007 and duly renewed, valid for classes 35, 36 and 38;
- International trademark registration n. 793367 "INTESA" (word trademark), registered on September 4, 2002 and duly renewed, valid for class 36;
- EU trademark registration n. 12247979 "INTESA" (word trademark), registered on March 5, 2014, valid for classes 9, 16, 35, 36 38, 41 and 42;

- EU trademark registration n. 5302377 "BANCA INTESA SANPAOLO" (word trademark), registered on July 6, 2007 and duly renewed, valid for classes 35, 36 and 38.

FACTUAL BACKGROUND

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

The Complainant claims to be the leading Italian banking group and one of the protagonists in the European financial arena. The Complainant 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 claims to be among the top banking groups in the euro zone, with a market capitalisation 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 Complainant and its related group companies offer services to approximately 13,5 million customers. The Complainant further claims to have a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,1 million customers. Moreover, the Complainant asserts that its international network specialised 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.

Furthermore, the Complainant claims to be the owner of the following domain names which contain the signs "intesa sanpaolo", "intesa" and "banca intesa sanpaolo": <intesasanpaolo.com>, <intesasanpaolo.org>, <intesasanpaolo.eu>, <intesasanpaolo.info>, <intesasanpaolo.net>, <intesasanpaolo.biz>, <intesa-sanpaolo.com>, <intesa-sanpaolo.com.org>, <intesa-sanpaolo.com.eu>, <intesa-sanpaolo.com.info>, <intesa-sanpaolo.com.net>, <intesa-sanpaolo.com.biz>, <intesa.com>, <intesa.info>, <intesa.biz>, <intesa.org>, <intesa.us>, <intesa.eu>, <ntesa.cn>, <intesa.in>, <intesa.co.uk>, <intesa.tel>, <intesa.name>, <intesa.xxx>, <intesa.me>, <bancaintesasanpaolo.com>, <bancaintesasanpaolo.biz>, <bancaintesasanpaolo.info>, <bancaintesasanpaolo.net>, <bancaintesasanpaolo.org>, <bancaintesasanpaolo.eu>, and <bancaintesasanpaolo.it>. According to the Complainant, all these domain names link to its official website <http://www.intesasanpaolo.com>. No evidence was submitted about the ownership of these domain names.

The Complainant submitted evidence that it is the registered owner of the trademarks mentioned above under "Identification of rights".

The disputed domain name was registered on May 26, 2021.

The website available via the disputed domain name displays the following message in Italian:

"Sito ingannevole in vista

Gli utenti malintenzionati presenti sul sito banca-intesa- sicurezza.com potrebbero indurti con l'inganno a effettuare operazioni pericolose, come installare software o rivelare informazioni personali (ad esempio password, numeri di telefono o carte di credito). Ulteriori informazioni.

Per il massimo livello di sicurezza di Chrome, attiva la protezione avanzata"

This message can be translated in English as follows:

"Misleading site detected

Cyber criminals on the website banca-intesa-sicurezza.com may try to trick you into doing something dangerous, such as installing software or revealing your personal information (such as passwords, phone numbers, or credit card details). More

information

For Chrome's highest level of security, turn on the advanced protection”

This seems to be a security warning by Google (via the Google Chrome browser).

PARTIES CONTENTIONS

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

1. Confusing similarity

The Complainant has submitted evidence that it is the owner of the trademarks “INTESA SANPAOLO”, “INTESA” and “BANCA INTESA SANPAOLO” listed above under “Identification of rights” (the “Trademarks”).

The disputed domain name consists of the Complainant's trademark “INTESA”, with the addition of the terms “banca” and “sicurezza”. The disputed domain name also consists of the Complainant's trademark “BANCA INTESA SANPAOLO”, whereby the term “SanPaolo” has been replaced by “sicurezza”.

Numerous previous panels have accepted that the incorporation of a trademark in its entirety into a domain name is sufficient to establish that the disputed domain name is identical or confusingly similar to a registered trademark. Indeed, in most cases where a domain name incorporates the entirety of a trademark, the domain name is, for the purposes of the Policy, considered as confusingly similar to the trademark.

In this case, the Panel notes that the disputed domain name incorporates the entirety of the Complainant's “INTESA” trademark. The Panel finds that the addition of the terms “banca” and “sicurezza” and the “.com” gTLD does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. By adding the word “banca” (Italian for “bank”), the respondent in fact creates more confusion with the Complainant given the fact that the Complainant offers banking and other financial services to the public. The addition of the generic word “sicurezza” (Italian for “security”) does not change the finding of confusing similarity. The “.com” suffix may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

The Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has

rights within the meaning of paragraph 4(a)(i) of the Policy.

2. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant contends that:

- (1) The Respondent has not been authorised or licensed by the Complainant to use the Trademarks or the disputed domain name;
- (2) The disputed domain name does not correspond to the name of the Respondent;
- (3) The Respondent is not commonly known as the disputed domain name;
- (4) The domain name is not used in a fair or non-commercial way.

The Respondent did not file an administratively compliant (or any) response. In such circumstances, the Panel finds from the facts put forward that:

There is no evidence to show that the Respondent may have used the disputed domain name for any bona fide offering of goods or services of its own or has made any preparations to do so in the future.

There is no evidence to show that 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 trademarks at issue.

The Complainant has sufficiently shown that the Respondent does not appear to have any rights or legitimate interests associated with the Trademarks, nor with variations thereof such as "BANCA-INTESA-SICUREZZA". The Respondent does not seem to own any registered trademarks consisting of the terms "BANCA INTESA SICUREZZA". The Respondent does not seem to have any consent to use the Trademarks or variations thereof. The disputed domain name does not correspond to the name of the Respondent. There is no evidence that the Respondent is commonly known by the Trademarks or with variations thereof such as "BANCA-INTESA-SICUREZZA".

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name.

3. Bad faith

The Complainant argues that the disputed domain name is “passively held”. The Complainant also states that the disputed domain name was registered and is being used in bad faith since the webpage connected to the disputed domain name is currently blocked by Google Safe Browsing because of suspected phishing activity.

Furthermore, the Complainant states that the Complainant’s trademarks “INTESA SANPAOLO”, “INTESA” and “BANCA INTESA SANPAOLO” are distinctive and well known all around the world. According to the Complainant, the fact that the Respondent has registered a domain name that is confusingly similar to these Trademarks indicates that the Respondent had knowledge of the Complainant’s Trademarks at the time of registration of the disputed domain name. The Complainant argues that a basic internet search under the terms “INTESA SANPAOLO”, “INTESA” and “BANCA INTESA SANPAOLO” would have led the Respondent to the Complainant. The Complainant argues that it is more than likely that the disputed domain name would not have been registered if it were not for Complainant’s Trademarks.

According to the Complainant, the disputed domain name is not being used for any bona fide offerings. More particularly, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant’s Trademarks as to the source, sponsorship, affiliation, or endorsement of his website (par. 4(b)(iv) of the Policy). The Complainant asserts that the main purpose of the Respondent was to use the disputed domain name for “phishing” to defraud the Complainant’s customers. The Complainant claims that the disputed domain name is connected to a website which has been blocked by Google Safe Browsing through a warning page.

The Panel finds that, on the balance of probabilities, it can be presumed that the Respondent had actual knowledge of the existence of the Complainant and its activities as well as of the Complainant’s Trademarks and the scope of the Trademarks for the following reasons:

The Complainant is a big Italian banking group which is active in many countries around the world under the name “INTESA SANPAOLO”.

All of Complainant’s Trademarks predate the registration of the disputed domain name.

It is highly unlikely that the Respondent would have come up with a domain name consisting of the terms “intesa”, “banca” and “sicurezza” without having prior knowledge of the Complainant and the Complainant’s trademarks and activities.

On the balance of probabilities, it may be expected that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence of the Complainant’s Trademarks and the scope of these Trademarks (i.e., banking services).

The Panel believes from the facts in this case that the Respondent had the Trademarks of the Complainant in mind when registering and subsequently using the disputed domain name.

Moreover, the Complainant has submitted evidence that Google displays a pop-up warning when visiting the website available via the disputed domain name (this warning is quoted above under “factual background”). The Respondent did not contest this and did not provide any explanation concerning this security pop-up warning. In this regard, the Panel considers that the use of the term “sicurezza” (Italian for “security”) in the domain name weighs against the Respondent. The Panel concludes that there is at least a risk that the disputed domain name is being used for the purpose of defrauding Internet users.

For all the reasons set out above, the Panel concludes that the disputed domain name was registered and is 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. BANCA-INTESA-SICUREZZA.COM: Transferred

PANELLISTS

Name	Bart Van Besien
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DATE OF PANEL DECISION 2022-05-18

Publish the Decision
