

Decision for dispute CAC-UDRP-104542

Case number CAC-UDRP-104542

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Domain names INTESASP.LIVE

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Intesa Sanpaolo S.p.A.

Complainant representative

Organization Intesa Sanpaolo S.p.A.

Respondent

Name Domenico Vitali

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

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

The Complainant states that it is the leading Italian banking group as well as one of the major banking groups 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. According to Complainant it has a market capitalization exceeding 40,5 billion euro, and is the undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

The Complainant further states that it services its customers through a network of approximately 3,700 branches that are 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. In addition, 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.

According to Complainant Respondent registered the domain name <INTESASP.LIVE> on February 16, 2022. Complainant has no business relationship with Respondent and Respondent had no authority to register the disputed domain name which at present is being passively held.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant is renown in its field of business and has a worldwide presence. It contends that the evidence of record supports the conclusion that Respondent lacks rights or legitimate interests in the disputed domain name and that it was registered and is being used in bad faith. It points out that <INTESASP.LIVE> is virtually identical to its trademark in that it simply contracts "San Paolo" to "SP" and although it is not currently resolving to an active website if it were to do so it would mislead and possibly be a vehicle for committing fraud with damaging consequences to Complainant, its customers, and consumers.

The Complainant also contends that Its 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, indeed virtually identical 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, it is implausible that Respondent lacked actual knowledge of Complainant and that if it were deny it a basic Google search would have brought Complainant's "INTESA SANPAOLO" and "INTESA" to its attention and the same would have yielded obvious references to the Complainant. The Complainant submits as part of its evidence an extract of a Google search in support of its allegation. This raises a clear inference of actual knowledge of the Complainant's trademark on the part of the Respondent. Therefore, it is more likely than not that the disputed domain name was registered for the purposes of targeting Complainant.

The Complainant further contends that it neither authorized nor did it give Respondent permission to register <INTESASP.LIVE>. The disputed domain name does not correspond to the name of the Respondent and no conceivable evidence can possibly be offered that Respondent is commonly known as "INTESASP". Passive holding under the circumstances present in this case supports the conclusion that Respondent cannot make any legitimate use of <INTESASP.LIVE> that would support a claim for rights or legitimate interests. It is inconceivable that Respondent could use the disputed domain name for any fair or non-commercial uses.

The Claimant further states that Respondent registered and is using <INTESASP.LIVE> in bad faith. More particularly, and in

view of Respondent's failing to appear or defend his registration of the disputed domain name, and the lack of any evidence to the contrary, there are present circumstances indicating that the Respondent has registered the domain name for one of the proscribed purposes set forth in UDRP Paragraph 4(b) and that its continued holding is in bad faith.

The Complainant reminds the Panel that 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, particularly where the disputed domain name is identical or confusingly similar to well-known and famous marks and where conceivable use that could be made of the domain name that would not amount to an infringement of the complainant's trade mark rights.

Complainant refers the Panel to *Comerica Inc. v. Horoshiy, Inc.*, Case No. D2004-0615, also involving a bank in which the Panel held

"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."

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. with the result that some of the Clients have been cheated of their savings.

Finally, Complainant believes that the Respondent 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 which for all practical purposes is virtually identical to Complainant's trademarks and to its domain names. Even excluding any "phishing" purposes or other illicit use of the domain name in the present case, Complainant is unable to find any possible legitimate use of INTESASP.LIVE.

RESPONDENT

The Respondent did not reply to the Complainant's contentions and did not submit any arguments or evidence in its defense. In such event, UDRP Rule 14 provides (a) that the "Panel shall proceed to a decision on the complaint" and (b) that "the Panel shall draw such inferences therefrom as it considers appropriate." In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at Para. 4.3.e. In such event, UDRP Rule 14 provides (a) that the "Panel shall proceed to a decision on the complaint" and (b) that "the Panel shall draw such inferences therefrom as it considers appropriate." In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at Para. 4.3.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that 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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Czech Arbitration Court has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case and defend its registration of the subject domain name <intesasp.live> .

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[respond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ..." Notwithstanding Respondent's default, however, Complainant is not relieved from the burden of establishing its claim. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0, § 4.3: "Noting the burden of proof on the complainant, a respondent's complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the default (i.e., failure to submit a formal response) would not by itself mean that the Complainant's claims are true." However, if a complainant's adduced evidence supports any element of the Policy, a respondent has an opportunity to contest the contention that its registration of the challenged domain name was unlawful. Here, Respondent has not availed itself of contesting the evidence, and for the reasons further explained the disputed domain name is forfeited to Complainant.

This first limb of the Policy requires Complainant to prove that it has a trademark right and that the disputed domain name is identical or confusingly similar to that mark. The Panel finds that Complainant has demonstrated that it has a registered trademark right to the term INTESASANPAOLO. Having established that element of the Policy the next question is whether the disputed domain name is identical or confusingly similar to Complainant's mark. A side-by-side comparison of the domain name and the INTESASANPAOLO trademark indicates that <INTESASP.LIVE> is virtually identical to the mark by simply contracting "San Paolo" to the letters "SP."

At the threshold it is necessary only to consider "whether a domain name is similar enough in light of the purpose of the Policy to justify moving on to the other elements of a claim for cancellation or transfer of a domain name." The Panel in *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, Case No. D2000-1415 notes that "numerous prior panels have held [the purposes of the Policy are satisfied] when a domain name wholly incorporates a complainant's registered mark." Similarly, *Magnum Piering, Inc. v The Mudjackers and Garwood S. Wilson, Sr.*, Case No. D2000-1525 (WIPO January 21,

2001). Panelists generally disregard the top-level suffixes as functional necessities, thus the top-level extension is irrelevant in determining the issue under the first requirement of the Policy.

Having demonstrated that <INTESASP.LIVE> is virtually identical to Complainant's INTESASANPAOLO trademark the Panel finds Complainant has satisfied Para. §4(a)(i) of the Policy.

B. Rights and legitimate interests, Para. 4(a)(ii)

Under paragraph 4(a)(ii) of the Policy, a complainant has the burden of establishing that a respondent lacks rights or legitimate interests in respect of the disputed domain name, but this burden is light. It is sufficient in the first instance for Complainant to allege a prima facie case, and if the evidence presented is conclusive or yields a positive inference that Respondent lacks rights or legitimate interests, the burden shifts to Respondent to rebut the allegations. This concept of shifting burdens is clearly explained in *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, Case No. D2003-0455 in which the Panel held that "[s]ince it is difficult to prove a negative ... especially where the Respondent, rather than complainant, would be best placed to have specific knowledge of such rights or interests—and since Paragraph 4(c) describes how a Respondent can demonstrate rights and legitimate interests, a Complainant's burden of proof on this element is light."

The Panel finds that Complainant has made a prima facie showing that Respondent lacks rights or legitimate interests in the disputed domain name. Once the complainant makes such a prima facie showing, "the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence rebutting the prima facie case or showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP," *Malayan Banking Berhad v. Beauty, Success & Truth International*, Case No. D2008- 1393. Finally, "in the absence of direct evidence, complainant and the panel must resort to reasonable inferences from whatever evidence is in the record," *Euromarket Designs, Inc. v. Domain For Sale VMI*, Case No. D2000-1195.

In this case, Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name, because the Respondent has no permission to use the INTESASANPAOLO trademark and in fact is not using the disputed domain name. Further, the evidence in the record is conclusive that Respondent Domenico Vitali is not commonly known under the disputed domain name. See *Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group*, Case Number FA1804001781783 ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy 114(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 114(c)(ii)"); *Amazon Technologies, Inc. v. Suzen Khan / Nancy Jain / Andrew Stanzy*, Case Number FA 1741129 (finding that respondent had no rights or legitimate interests in the disputed domain names when the identifying information provided by WHOIS was unrelated to the domain names or respondent's use of the same).

Once the burden shifts, Respondent has the opportunity of demonstrating its right or legitimate interest by showing the existence of any of the following nonexclusive circumstances:

- (i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

If a respondent proves any of these circumstances or indeed anything else that shows it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the respondent must succeed. However, where respondent fails to respond, the Panel must assess the record before it. Here, the choice of the domain name is virtually identical to the trademark. Respondent merely contracts San Paolo to "SP." This does not create a distinctive term separate from the mark, but in fact reinforces the identity of domain name to the mark. Therefore, Respondent's default and its failure to rebut Complainant's evidence is particularly telling. Since there is no proof otherwise, the record supports the conclusion that Respondent lacks any right or legitimate interest as measured by the three circumstances of paragraph 4(c). See *Deutsche Telekom AG v. Britt Cordon*, Case No. D2004 -0487 (holding that "once a complainant establishes a prima facie case that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on

this factor shifts to the Respondent. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP). Similarly in *Malayan Banking Berhad, supra.* (holding that "[i]f the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.").

Accordingly, as the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name, Complainant has satisfied Paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith, §4(a)(iii)

Having determined that Respondent lacks rights or legitimate interests, the Complainant must then prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith. The consensus expressed in WIPO Overview 3.0, section 3.1.4. is that "the mere registration of a domain name that is identical or confusingly similar. . . to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Particularly probative in this case is that Complainant holds the domain name <intesanpaolo.com> and the only difference with the disputed domain name is the contraction of "San Paolo" to "SP." Absent a cogent explanation from Respondent justifying its choice of domain name, this supports the conclusion that it registered <INTESASP.LIVE> with the purpose of taking advantage of its goodwill and reputation with the purpose of committing fraud on consumers and Complainant's clients.

The Panel finds that the present case is one in which the presumption of bad faith is satisfied. The presumption further strengthened by the strong inference of Respondent's actual knowledge of Complainant's and its INTESANPAOLO trademark and of its intention to take advantage of its attractive value on the Internet solely for the reason of its goodwill flowing from its widely known or famous brand.

Paragraph 4(b) of the Policy sets out four nonexclusive circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (i) circumstances indicating that 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 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 the respondent's 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 site or location.

Although the first circumstance cannot be ruled out, of the four the fourth most readily applies as the domain name is clearly intended to attract Internet users seeking to reach Complainant's website or purchase its products and services. The domain name in this case is passively held, but for no conceivably lawful use. *Telstra Corporation Limited v. Nuclear Marshmallows*, Case No. D2000-0003; also *National Football League v. Thomas Trainer*, Case No. D2006-1440 (<nflnetwork.com>, holding that "when a registrant, such as respondent here, obtains a domain name that is [identical or confusingly similar] to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted.").

Where the facts demonstrate an intent to capitalize on an owner's mark in the manner in which Complainant describes and which is supported by proof in the record, the registration is prima facie abusive. *Royal Bank of Canada - Banque Royale Du Canada v. Registration Private, Domains By Proxy, LLC / Randy Cass*, Case No. D2019-2803 (<investease.com>. "It is clear that where the facts of the case establish that the respondent's intent in registering or acquiring a domain name was to

unfairly capitalize on the complainant's nascent . . . trademark, panels have been prepared to find the respondent acted in bad faith.). See WIPO Overview 3.0, section 3.8.2. The Panel finds that the Complainant has shown that the Respondent registered and is using the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b)(iv) as well as within the larger notion of abusive conduct. The Panel finds that Complainant has adduced more than sufficient evidence to prove Respondent's bad faith based on the foregoing considerations.

Accordingly, the Panel finds that Respondent has registered and used the disputed domain name in bad faith and that its conduct firmly supports the conclusion that the registration of <intesasp.live> was abusive. Having thus demonstrated that Respondent registered and is using the disputed domain name in bad faith, Complainant has also satisfied 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. **INTESASP.LIVE**: Transferred

PANELLISTS

Name	Gerald M. Levine, Ph.D, Esq.
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DATE OF PANEL DECISION 2022-06-07

Publish the Decision
