

Decision for dispute CAC-UDRP-104884

Case number	CAC-UDRP-104884
Time of filing	2022-09-30 13:48:17
Domain names	INTESANPAOLOO.COM

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	ahmed kinnek
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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 the owner, among others, of the following registrations for the trademarks "INTESA SANPAOLO" and "INTESA":

- International trademark registration n. 920896 "INTESA SANPAOLO", granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 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", applied on September 8, 2006 and granted on June 18, 2007, in 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.

Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the signs "INTESA SANPAOLO" and "INTESA": INTESASANPAOLO.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. All of them are now connected to the official website <http://www.intesasampaolo.com>.

FACTUAL BACKGROUND

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

According to the Complainant, it is the leading Italian banking group and also one of the protagonists 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 is among the top banking groups in the Euro zone, with a market capitalization exceeding 47,7 billion Euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,300 branches well distributed throughout the Country, with market shares of more than 19% 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 7,2 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.

On May 9, 2022 the Respondent registered the domain name <INTESANPAOLOO.COM>.

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

Language of the proceedings

According to the information provided by the Registrar, the language of the Registration Agreement is German. Under paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requests the language of this administrative proceeding to be English, submitting that this is a universally known and used language. The Respondent has not objected to the Complainant's request concerning the language of the proceedings.

Neither of the Parties has brought forward any arguments that using the English language in this proceeding would not be fair and efficient. The Complainant proposed accepting a German response to the Complaint and appointing a Panel familiar with both the English and German languages.

In the decision in *Groupe Auchan v. xmxzl*, WIPO Case No. DCC2006 0004, the Panel ruled as follows: "Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the

Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel's discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case."

Taking these considerations into account and keeping in mind that the Panel in this case is sufficiently familiar with both English and German to draft and issue decisions in both languages, the Panel, exercising its powers under paragraph 11 of the Rules, decides that the language of these administrative proceedings will be English. At the same time, the Panel will consider any evidence in the case file that is in the German language.

The Panel is therefore 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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

SIMILARITY TO THE EARLIER RIGHTS

The disputed domain name is confusingly similar to the Complainant's Trademark, company name and domain. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of

- a) disregarding the top-level suffix in the domain name (i.e. ".com"), and
- b) not finding that omitting or replacing single letters within a long and complex name (intesanpaolo v. intesanpaoloo) would be sufficient to distinguish a domain name from a trademark. This is a clear case of typosquatting since the letters "sa" are omitted once in the middle of the domain name and an additional letter "o" added at the end in otherwise identical and complex names.

Previously, panels have decided e.g. in the case *Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc*, Case No. D2001-1314 – regarding the domain names <duetschebank.com> and <duetsche-bank.com> – that such domain names are confusingly similar and a clear example of typosquatting. It was further stated that WIPO jurisprudence offers many examples of confusing similarity brought about through easily made typing errors by Internet users – particularly when the mark is another language from that of the user's mother tongue. This applies in the case at hand, where the substituted letters may be pronounced very similarly.

Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*).

The Complainant has put forward that the Respondent is not commonly known by the disputed domain name. Neither is the Respondent in any way related to the Complainant. Nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent failed to provide any information and evidence whatsoever that could have shown 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). In fact, the Respondent appears to have simply ignored the communications regarding these proceedings as no reply was received.

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest in the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name. The Respondent is also in no way commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

In the absence of any response to the complaint and given the reputation of the Complainant and its trademarks, company name and domain as supported by the Complainant's evidence, the Panel can only conclude that the Respondent was fully aware of the Complainant's trademarks, domain and company name "INTESA SANPAOLO" and "INTESA" at the time of registering the disputed domain name <INTESANPAOLOO.COM>. Therefore, it has been established to the satisfaction of the Panel that the disputed domain name was registered and is being used (at least passively) in bad faith, in order to prevent the Complainant from making proper use of the mark in the disputed domain name.

Therefore, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under 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. **INTESANPAOLOO.COM**: Transferred

PANELLISTS

Name	Udo Pfleghar
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DATE OF PANEL DECISION	2022-11-08
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Publish the Decision
