

Decision for dispute CAC-UDRP-104951

Case number CAC-UDRP-104951

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Domain names INTESAUTENTE.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 Privacy service provided by Withheld for Privacy ehf

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 of the following trademark registrations for the sign "INTESA" (the "INTESA trademark"):

- the International trademark INTESA with registration No. 793367, registered on 4 September 2002 for services in International Class 36; and
- the European Union trademark INTESA with registration No. 12247979, registered on 5 March 2014 for goods and services in International Classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

The Complainant is the leading Italian banking group, formed as a result of the merger in 2007 between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups. The market capitalisation of the Complainant exceeds 32.8 billion Euro, and it has a network of 3700 branches and 13.5 million customers in Italy. The Complainant has a strong presence in Central and Eastern Europe with a network of approximately 1000 branches and over 7 million customers. The international network of the Complainant specialised in supporting corporate customers is present in 25 countries in the Mediterranean area, the United States, Russia, China and India.

The Complainant's official website is located at the domain name <intesananpaolo.com>. The Complainant is also the owner of the domain names <intesa.com>, <intesa.info>, <intesa.biz>, <intesa.org>, <intesa.us> and <intesa.eu>, all of which resolve to the Complainant's official website.

The Respondent registered the disputed domain name on 28 April 2022. When an attempt is made to access it, the browser displays a warning in Italian translated in English as: "Deceptive site in sight. Malicious users present on the intesautente.com site could trick you into carrying out dangerous operations, how to install software or disclose personal information (e.g., passwords, phone numbers or credit cards)."

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's INTESA trademark, as it exactly reproduces this well-known trademark with the addition of the Italian dictionary word "utente" (meaning "user"), which makes reference to the Complainant's Internet users.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant submits that it has never authorized the Respondent to use the INTESA trademark, and the Respondent is not commonly known by the disputed domain name and is not making any fair or non-commercial use of it.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It maintains that the INTESA trademark is distinctive and well known around the world, and the fact that the Respondent has registered the disputed domain name which is confusingly similar to it, indicates that it had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. The Complainant submits that it has not been used for any bona fide offerings. Rather, the circumstances of the case indicate that the Respondent has registered or acquired the domain name primarily for "phishing" financial information in an attempt to defraud the Complainant's customers. This is evident from the fact that Google promptly stopped the illicit activity carried out by the Respondent by blocking its website. Apart from phishing, there is according to the Complainant no other possible use of the disputed domain name except to resell it to the Complainant.

The Complainant submits that on 15 June 2022 its attorneys sent a cease-and-desist letter to the Respondent, asking for the voluntary transfer of the disputed domain name at issue, but the Respondent did not respond to this letter.

RESPONDENT:

The Respondent did not submit a Response in this proceeding.

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

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 Provider 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.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond 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 ...”

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the INTESA trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” gTLD section of the disputed domain name.

The relevant part of each of the disputed domain names is therefore the sequence “intesautente”, which reproduces the INTESA trademark entirely with the addition of the Italian dictionary word “utente”, which translates as “user”. The INTESA trademark is recognizable within the disputed domain name. As discussed in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the “WIPO Overview 3.0”), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

Taking all the above into account, the Panel finds that the disputed domain name is confusingly similar to the INTESA trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because the Respondent was not authorized to use the INTESA trademark and is not commonly known under the disputed domain name. According to the Complainant, the Respondent has registered the disputed domain name for phishing attacks against the Complainant’s legitimate customers or to resell it to the Complainant or a competitor of the Complainant. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not provided an explanation of the reasons why it has registered the disputed domain name.

In the Panel’s view, the circumstances of this case do not contradict the prima facie case made by the Complainant and do not support a finding that the Respondent has rights and legitimate interests in the disputed domain name. It is confusingly similar to the INTESA trademark and includes the Italian word for “user”, which may create an impression in Internet users that it resolves to an official website of the Complainant dedicated to the users of its services, and the evidence submitted by the Complainant shows that Internet browsers display warning messages about phishing or other illegitimate activities with the disputed domain name when one attempts to access it. This may mean that the disputed domain name resolves to a website that is unsafe to access or that is related to phishing or other illegitimate activities. In the lack of any arguments or evidence to the contrary, all the above leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant’s INTESA trademark, has registered the disputed domain name targeting this trademark in an attempt to exploit its goodwill by confusing and attracting Internet users who may believe that the disputed domain name, a website to which it resolves and the content of such website, or any eventual correspondence from an email account activated with the disputed domain name are

connected to the Complainant.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(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; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The registration of the distinctive INTESA trademark predates by twenty years the registration date of the disputed domain name. It reproduces the INTESA trademark entirely with the addition of the Italian dictionary word for “user”, which may lead Internet users to believe that it resolves to an official website of the Complainant for its clients. The Panel is therefore of the view that the Respondent is more likely to have registered the disputed domain name with knowledge of the Complainant’s trademark rights and with the intention of taking advantage of its goodwill.

The composition of the disputed domain name makes it to appear as an official online location of the Complainant for its clients and when it is accessed, the Internet browser displays a warning message about phishing or other illegitimate activities with the disputed domain name. The Respondent has not provided any plausible explanation of its choice of domain name, and given the circumstances of this case, the Panel is not aware of any good faith use to which the disputed domain name may be put without the consent of the Complainant.

This satisfies the Panel that the disputed domain name has been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. INTESAUTENTE.COM: Transferred

PANELLISTS

Name	Assen Alexiev
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DATE OF PANEL DECISION **2022-11-24**

Publish the Decision
