

Decision for dispute CAC-UDRP-104952

Case number	CAC-UDRP-104952
Time of filing	2022-10-31 09:35:06
Domain names	INTESASANPAOLO-CARTE.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	Emily D'Amore
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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 of European Union trademark registration no. 5301999 "INTESA SANPAOLO", registered on June 18, 2007 for services in classes 35, 36 and 38; this trademark has been duly renewed and is in force.

FACTUAL BACKGROUND

It results from the Complainant's undisputed allegations that 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. It is among the top banking groups in the Euro zone and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,700 branches throughout Italy, 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 million customers. Moreover, the international network specialised in supporting corporate customers is present in 25 countries, in particular in the Mediterranean area and in the United States, Russia, China and India.

It also uses the official website <http://www.intesasanpaolo.com>.

The Complainant further contends its trademark INTESA SANPAOLO is distinctive and well-known all around the world.

The disputed domain name <INTESASANPAOLO-CARTE.COM> was registered on March 3, 2022.

In addition, the undisputed evidence provided by the Complainant proves that the webpage to which the disputed domain name resolves displays a warning about dangerous & deceptive content: "There is a suspicion of phishing on the website you are visiting!".

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. Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of several trademark registrations for INTESA SANPAOLO, e.g. European Union trademark registration no. 5301999 "INTESA SANPAOLO", registered on June 18, 2007 for services in classes 35, 36 and 38; this trademark has been duly renewed and is in force.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") at section 1.7).

This Panel shares this view and notes that the Complainant's registered trademark INTESA SANPAOLO is fully included in the disputed domain name, followed by a hyphen and by the generic and descriptive Italian term "carte" (meaning cards in English), which indicates the Complainant's financial products and services. Furthermore, it is the view of this Panel that the addition of the term "carte" in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see WIPO Overview 3.0 at section 1.8); and the addition of the descriptive term does not prevent a finding of confusing similarity, on the contrary it is likely to increase the possibility of confusion amongst consumers.

Finally, the generic Top-Level Domain ("gTLD") ".com" of the disputed domain name may be disregarded under the first element confusing similarity test (see WIPO Overview 3.0 at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

2. Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or

legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain names. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a prima facie case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the trademark INTESA SANPAOLO, e.g., by registering the disputed domain name comprising the said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain names in the sense of paragraph 4(c)(ii) of the Policy.

Furthermore, the Respondent has not demonstrated any bona fide offering of goods or services nor a legitimate noncommercial 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 in the sense of paragraphs 4(c)(i) and (iii) of the Policy (see, e.g., Banca Monte dei Paschi di Siena S.p.A. v. Privacy service provided by Withheld for Privacy ehf / Julius Boyler, WIPO Case No. D2021-2296). Moreover, the Panel notes that the disputed domain name is clearly constituted by the Complainant's registered trademark INTESA SANPAOLO and the term "carte", which clearly refer to the Complainant's activity, tending to suggest sponsorship or endorsement by the Complainant. The Panel finds it most likely that the Respondent selected the disputed domain name with the intent to attract Internet users for commercial gain.

In addition, the undisputed evidence provided by the Complainant proves that the webpage to which the disputed domain name resolves displays a warning about dangerous & deceptive content: "There is a suspicion of phishing on the website you are visiting!". UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see WIPO Overview 3.0 at section 2.13.1 with further references). The Panel considers this evidence of a suspected phishing activity as sufficient to support the Complainant's credible claim of the Respondent's illegal activity.

It is acknowledged that once the Panel finds a prima facie case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see WIPO Overview 3.0 at section 2.1). Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain names.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

3. According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

The Panel finds that the disputed domain name has been registered and is being used in bad faith. It is the view of this Panel that the Respondent has intentionally registered the disputed domain name which totally reproduces the Complainant's trademarks INTESA SANPAOLO. By the time the disputed domain name was registered, it is unlikely that the Respondent did not have knowledge of the Complainant's rights on its trademarks INTESA SANPAOLO.

The Panel considers the undisputed evidence provided by the Complainant of a suspected phishing activity as sufficient to support the Complainant's credible claim of the Respondent's illegal activity and such behaviour is manifestly considered evidence of bad faith (see WIPO Overview 3.0 at section 3.1.4 with further references).

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see WIPO Overview 3.0 at point 3.2.1):

- (i) the nature of the domain name (i.e. a domain name incorporating the Complainant's trademark INTESA SANPAOLO plus the term "carte", that corresponds to the complainant's area of activity);
- (ii) the content of any website to which the domain name directs (i.e. the webpage to which the disputed domain name resolves displays a warning about dangerous & deceptive content: "There is a suspicion of phishing on the website you are visiting!");
- (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Accepted

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

1. INTESASANPAOLO-CARTE.COM: Transferred

PANELLISTS

Name	Dr. Federica Togo
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DATE OF PANEL DECISION 2022-12-02

Publish the Decision
