

Decision for dispute CAC-UDRP-104953

Case number	CAC-UDRP-104953
Time of filing	2022-10-31 10:03:38
Domain names	INTESASANPAOLOGRUPS.COM

Case administrator

Organization	Denisa Bilík (CAC) (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

Organization	Fundacion Comercio Electronico
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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 several trademarks consisting of the term “INTESA SANPAOLO®”, such as:

1. the International trademark registration “INTESA SANPAOLO®” n° 920896 registered since March 7, 2007 at classes 9, 16, 35, 38, 41 & 42;
2. the International trademark registration “INTESA®” n° 793367 registered since September 4, 2002 at classes 35, 36 & 38;
3. EU trademark registration n. 5301999 “INTESA SANPAOLO®” registered since June 18, 2007 at classes 35, 36 & 38;
4. EU trademark registration n. 12247979 “INTESA®” registered since March 5, 2014 at classes 9, 16, 35, 36, 38, 41 & 42;
5. EU trademark registration n. 5344544 “GRUPPO INTESA SANPAOLO®” registered since July 6, 2007 at classes 35, 36 & 38.

Different copies of the trademark certificates were included within the Complaint.

In addition, the Complainant claims to own domain names with the term ““INTESA SANPAOLO” and “INTESA” such as: <INTESASANPAOLO.COM>, <INTESA-SANPAOLO.COM>, <INTESA.COM>, among many others. All of them are now connected to the official website <http://www.intesasanpaolo.com>.

Even though the Complainant did not include copies of the registration of the domains, the Panel was able to conduct a search and

confirmed the validity of the registration of the domains <INTESASANPAOLO.COM>, <INTESA-SANPAOLO.COM> & <INTESA.COM>. The three of domain are indeed connected to the official website <http://www.intesasanpaolo.com>.

FACTUAL BACKGROUND

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

The Complainant 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.

The Complainant is among the top banking groups in the euro zone, with a market capitalisation exceeding 32,8 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 capillary and well distributed throughout the Country, with market shares of more than 16% 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 7,0 million customers. Moreover, the 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.

The Complainant is the owner of different trademarks registrations for the terms "INTESA SANPAOLO", "INTESA" and "GRUPPO INTESA SANPAOLO".

On January 7, 2022, the Respondent registered the disputed domain name <INTESASANPAOLOGRUPS.COM> (hereinafter, the "Disputed Domain Name").

According to Complainant's non-contested allegations, the Respondent has no rights or legitimate interest in respect of the Disputed Domain Name and Complainant has not granted any authorization or license to use the trademarks "INTESA SANPAOLO", "INTESA" and "GRUPPO INTESA SANPAOLO" within the Disputed Domain Name.

For the purpose of this case, the Registrar confirmed that the Respondent is the current registrant of the Disputed Domain Name and that the language of the registration agreement is English.

The facts asserted by the Complainant are not contested by the Respondent

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES CONTENTIONS

COMPLAINANT:

First element: Similarity

The Complainant states that the Disputed Domain Name is identical or at least, confusingly similar to its trademarks "INTESA SANPAOLO", "INTESA" and "GRUPPO INTESA SANPAOLO".

The Complainant asserts that the trademark "INTESA SANPAOLO"® is included in its entirety within the Disputed Domain Name with the mere addition of the term "GRUPS" which it has obvious references to the English term "GROUPS", meaning "GRUPPI" in Italian.

Second element: Rights or legitimate interest

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and any use of the trademarks "INTESA SANPAOLO", "INTESA" and "GRUPPO INTESA SANPAOLO" has to be authorized by the Complainant.

The Complainant also confirms that nobody has been authorized or licensed by Complainant to use the Disputed Domain Name at issue.

The Complainant also claims that they did not find any fair or non-commercial use of the Disputed Domain Name at stake.

Third element: Bad faith

The Complainant states that the Disputed Domain Name is confusingly similar to its trademarks "INTESA SANPAOLO", "INTESA" and "GRUPPO INTESA SANPAOLO".

The Complainant indicates that its trademarks “INTESA SANPAOLO”, “INTESA” and “GRUPPO INTESA SANPAOLO” are distinctive and well known around the world. The Complainant indicated that the fact that Respondent has registered a Disputed Domain Name that is confusingly similar to the Complainant indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the Disputed Domain Name.

The Complainant contends that the Disputed Domain Name is not used for any bone fide offerings and therefore, there are circumstances indicating that the Respondent has registered or acquired the Disputed 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 the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy).

The Complainant indicates that the Disputed Domain Name is not used for any bone fide offerings, even if it is connected to a web site without particular active contents, by now. In the light of the elements presented by the Complainant, the Complainant is of the opinion that the passive holding of the Disputed Domain Name has to be considered a use in bad faith

Finally, the Complainant believes that the current owner 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 (typosquatting).

RESPONDENT

Respondent did not reply to the Complaint.

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

According to Paragraph 4(a) of the Policy, a complainant is required to prove each of the following three elements to obtain an order that a 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 are being used in bad faith.

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

(A) THE COMPLAINANT’S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE

COMPLAINANT'S RIGHTS.

Paragraph 4(a)(i) of the Policy establishes the obligation of Complainant to demonstrate that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant submitted copies of different trademarks registrations pertaining the terms "INTESA SANPAOLO", "INTESA" and "GRUPPO INTESA SANPAOLO" for insurance; financial affairs; monetary affairs and real estate affairs, among many others.

The Complainant's trademarks were registered prior to 2022, the year of the creation date of the Disputed Domain Name.

In the current case, the Disputed Domain Name is composed of the trademark "INTESA SANPAOLO®" with the addition of the term "GRUPS" which can be referred either to the English term GROUP or to the English term GRUP.

The term GROUP is normally used in Business to indicate a business that contains several different companies. In Italian language the term GROUP can be translated as "GRUPPI" in Italian. Regarding the term GRUP, it is an informal term used in British English which refer to a person aged over 30 whose interest and lifestyle are similar to those of people in their early 20s. Taking into account the circumstances surrounding this case, the Panel concludes that term GROUP should be the reference used for the purpose of this case.

In assessing confusing similarity, the Panel finds the Disputed Domain Name is confusingly similar to the Complainant's trademark, as it incorporates the entirety of the

"INTESA SANPAOLO®", "INTESA®" trademarks plus term GRUPS. In this regard, UDRP panels agree that 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. See paragraph 1.8. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0 ("WIPO Jurisprudential Overview 3.0").

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration. See paragraph 1.11.1 of WIPO Jurisprudential Overview 3.0.

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the Disputed Domain Name is confusingly similar to Complainant's "INTESA SANPAOLO®", "INTESA®" & "GRUPPO INTESA SANPAOLO" trademarks.

(B) RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME.

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it with relevant evidence demonstrating rights or legitimate interests in the domain name; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. 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.).

In this regard, Paragraph 4 (c) provides with circumstances which could prove rights or legitimate interest in the disputed domain name on behalf of the Respondent such as:

- (i) before any notice to Respondent of the dispute, Respondent is using or provides with 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) The Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate noncommercial 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.

For the present case, the Complainant has confirmed in the Complaint that the Disputed Domain Name is not connected with or authorized by the Complainant in any way.

From the information provided by the Complainant, there is no evidence or reason to believe that the Respondent (as individual, business or other organization) has been commonly known by the Disputed Domain Name.

The Respondent's name "Carolina Rodrigues / Fundacion Comercio Electronico" is all what it links the Disputed Domain Name with the Respondent. Absent of any other evidence such as a personal name, nickname or corporate identifier, the Panel is of the opinion that the Respondent is not commonly known by the Disputed Domain Name.

The Complainant indicates that they have not granted authorization to the Respondent to use their "INTESA SANPAOLO®" & "INTESA®" trademarks.

The website associated with the Disputed Domain Name resolves to an inactive website. Different Panels have confirmed that the lack of content at the Disputed Domain Name can be considered as a finding that Respondent does not have bona fide offering of goods and services (see, for example, Forum Case No. FA 1773444, Ashley Furniture Industries, Inc v. Joannet Macket/JM Consultants).

The fact that Respondent did not reply to the Complaint gives an additional indication that the Respondent lacks rights or legitimate interest since the Respondent did not provide with evidence of the types specified in paragraph 4 (c) of the Policy, or of any circumstances, giving rise to rights or legitimate interests in the disputed domain name.

Therefore, the Panel concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest to the disputed domain name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME.

Paragraph 4(a)(iii) of the Policy indicates that the Complainant must assert that the Respondent registered and is using the Disputed Domain Name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- 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
- 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 Respondent has engaged in a pattern of such conduct; or
- The Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- 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.

In accordance with the evidence, the Disputed Domain Name is currently not in use. It is well established at different UDRP panel resolutions that the lack of use of a domain name does not prevent from finding bad faith (e.g. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. 2000-0003).

In this vein, WIPO Jurisprudential Overview, version 3.0. at paragraph 3.3. provides some factors that have been considered relevant in applying the passive holding doctrine such as: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

For the current case, the evidence at hand confirms that Complainant's "INTESA SANPAOLO®" & "INTESA®" trademarks are distinctive and the Complainant has a strong reputation in the financial industry, at least in Europe. Furthermore, the Complainant has provided evidence that the Respondent should have found information over the internet about Complainant's trademarks rights over "INTESA SANPAOLO®" & "INTESA®" before registering the Disputed Domain Name.

In addition to the above described and from the Panel perspective, the following circumstances also confirm Respondent's bad faith in the registration of the Disputed Domain Name:

(a) By conducting a search over the Internet, the Respondent should have been made aware of Complainant's trademarks "INTESA SANPAOLO®" & "INTESA®" trademarks as well as their reputation in the financial industry in Europe;

(b) The Disputed Domain Name is composed with the term GRUPS. Absent of Respondent's reply, this combination is only a confirmation of Respondent's knowledge of Complainant's trademark "INTESA SANPAOLO®" prior to the registration of the Disputed Domain Name;

(c) Complainant's trademark rights over "INTESA SANPAOLO®" & "INTESA®" predate the date of registration of the Disputed Domain Name.

(d) The website associated with the Disputed Domain Name is inactive.

These factors make the Panel believe that the Disputed Domain Name was registered with the intention 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.

At his Complaint, the Complainant claims that the current owner registered the Disputed Domain Name with the "phishing" purpose, 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. Here the Panel dissents with the Complaint since there was no evidence provided which could confirm the "phishing" purpose described by the Complaint. Nevertheless, this finding does not change the overall assessment of this case.

One additional argument presented by the Complaint relates to the possibility that the Respondent registered the Disputed Domain Name with the purpose to resell it, however, the Complaint did not provide evidence regarding this point. Nevertheless, the Panel decided to use its General Powers described at article 10 of the Rules for Uniform Domain Name Dispute Resolution Policy to confirm whether the Disputed Domain Name is for sale over the internet. In this sense, the Panel was able to identify that the Disputed Domain Name appears for sale at sedo.com for the minimum offer of 899USD. This confirms the Complainant's argument that the Disputed Domain Name was acquired 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 more than the documented out-of-pocket costs directly related to the domain name.

See paragraph 4.8 at WIPO Jurisprudential Overview 3.0 where it is indicated:

Noting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the Disputed Domain Name and the Complainant’s “INTESA SANPAOLO®” & “INTESA®” trademarks, b) the lack of reply to this Complaint by Respondent, c) the fact that the Disputed Domain Name is being passively held and iv) the fact that the Disputed Domain Name is listed for sale at sedo.com, the Panel draws the inference that the Disputed Domain Name was registered is being used in bad faith.

Therefore, the Panel concludes that Respondent registered and is using the Disputed Domain Name in bad faith and thus has 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. **INTESASANPAOLOGRUPS.COM**: Transferred

PANELLISTS

Name	Victor Garcia Padilla
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DATE OF PANEL DECISION	2022-12-02
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Publish the Decision