

Decision for dispute CAC-UDRP-104954

Case number	CAC-UDRP-104954
Time of filing	2022-10-31 10:04:02
Domain names	ALINTESANPAOLO.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	Transure Enterprise Ltd
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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 the following trademarks:

- INTESA SANPAOLO, international registration No. 920896, of March 7, 2007, duly renewed, for goods and services in class 9, 16, 35, 36, 41 and 42;
- INTESA, international registration No. 793367 of September 4, 2002, and duly renewed, for services in class 36;
- INTESA SANPAOLO, EU registration No. 5301999, filed on September 8, 2006 and granted on June 18, 2007. and duly renewed, for services in classes 35, 36 and 38; and
- INTESA, EU registration No. 12247979, filed on October 23, 2013 and granted on March 5, 2014, for goods and services in class 9, 16, 35, 36, 38, 41 and 42.

Moreover, the Complainant is the owner of various domain names containing the trademarks INTESASANPOLO and INTESA, all of which redirect to the Complainant's official website at www.intesasanpaolo.com.

FACTUAL BACKGROUND

The Complainant is the company resulting from the merger, effective as of the 1st of January 2007, between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups at the time. The Complainant is now the leading Italian banking group,

operating 3,700 branches throughout the Italian territory, with a market share of more than 16% in several Italian regions, providing its services to approximately 13,5 million customers. The Complainant is also among the top leading banking groups in the Euro zone, with a market capitalisation of more than 32,8 billion Euro. The Complainant has a strong presence in Central Eastern Europe, with a network of approximately 1000 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 those areas where Italian companies are most active, such as the United States, Russia, China and India.

The disputed domain name was registered on March 25, 2022 and leads to a website containing pay-per-click links.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

According to the Complainant, the disputed domain name is confusingly similar to its trademarks INTESA SANPAOLO and INTESA, as it reproduces the well-known trademark INTESA SANPAOLO, with the omission of the letters "SA" of the word INTESA, and the addition of the letters "AL", which is a clear example of typosquatting.

The Complainant further maintains that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has no rights in the disputed domain name and any use of the trademarks INTESA and INTESA SANPAOLO has to be authorised by the Complainant. Furthermore, the disputed domain name does not correspond to the Respondent's name and, to the best of the Complainant's knowledge, the Respondent is not commonly known as "alintesanpaolo.com". Lastly, the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a noncommercial fair use, as further discussed below.

In respect of registration and use of the disputed domain name in bad faith, the Complainant contends that its trademarks INTESA and INTESA SANPAOLO are distinctive and well known and the fact that the Respondent has registered a disputed domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant's trademarks at the time of the registration of the disputed domain name. Had the Complainant carried out even a basic Google search, in relation to the Complainant's marks, the same would have yielded obvious references to the Complainant. Therefore, it is more than likely that the disputed domain name would not have been registered, hadn't it been for the Complainant's trademarks. This is a clear evidence of the registration of the disputed domain name in bad faith.

In addition, the disputed domain name is connected to a website sponsoring, amongst others, banking and financial services, which are protected by the Complainant's trademarks. Consequently, Internet users while searching for the Complainant are confusingly led to the websites of the Complainant's competitors, sponsored on the website connected to the domain name at issue. Therefore, the Complainant maintains that the Respondent has registered and is using the disputed domain name in order to intentionally divert traffic away from the Complainant's website. Such use of the disputed domain name also causes great damages to the Complainant due to the misleading of their present clients and the loss of potential new ones. The Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated.

Lastly, the Complainant points out that on June 1, 2022, the Complainant sent to the Respondent a cease and desist letter asking for the voluntary transfer of the disputed domain name. Despite this letter, the Respondent did not comply with the Complainant's request.

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

I. Domain name confusingly similar to the Complainant's trademarks

The Panel notes that the Complainant has proved that it owns earlier rights in the trademarks INTESA and INTESA SANPAOLO. In the Panel's view, the disputed domain name <alintesanpaolo.com> is confusingly similar to both these trademarks, as the trademark INTESA is fully reproduced in the disputed domain name, and the wording "intesanpaolo", part of the disputed domain name, is almost identical to the Complainant's trademark INTESA SANPAOLO, differing only by the deletion of the letters "sa" from the word "sanpaolo". However, this deletion is likely to go unnoticed, as the Internet user will read the disputed domain name altogether, and the pronunciation of the portion "intesanpaolo" is practically identical to the pronunciation of the Complainant's mark INTESA SANPAOLO. Likewise, from a visual point of view the two signs are almost identical. As to the addition of the two letters "al" at the beginning of the disputed domain name, they are not sufficient to avoid a confusing similarity. It is in fact steadily recognized, that whenever a third party's trademark is recognizable within a domain name, the addition of other elements, including two-letter elements such as in the case at issue, cannot prevent a finding of confusing similarity.

Thus, the Panel is satisfied that the first condition under the Policy is met.

II. Respondent's lack of rights or legitimate interests in the disputed domain name

The second condition to be proved in order to succeed in a UDRP proceeding is that the Respondent lacks rights or legitimate interests in the disputed domain name.

While the overall burden of proof rests with the complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.

The Complainant contends that the Respondent is not its licensee and that it has never been authorised to use its trademarks as part of a domain name. Furthermore, nothing in the case file shows that the Respondent is commonly known by the name "alintesanpaolo".

The disputed domain name is associated with a website containing sponsored links relating to services identical to those offered by the Complainant. The Respondent is probably deriving a revenue from each click on these sponsored links. Such use can amount neither to a bona fide offering of goods or services, nor to a legitimate noncommercial or fair use of the disputed domain name.

The Respondent had the chance to explain why, in his view, it owns rights or legitimate interests in the disputed domain name, but decided not to do so.

In view of the above, the Panel is satisfied that also the second condition under the Policy is met.

III. Registration and use of the disputed domain name in bad faith

In the Panel's view, the Complainant is right when it argues that its trademarks are distinctive and well known and that the Respondent has registered the disputed domain name with full knowledge of them. Indeed, both INTESA and INTESA SANPAOLO are well known trademarks in the financial field (especially the banking field), and as they both are quite distinctive, it is not credible that the Respondent registered a domain name almost identical to these marks by coincidence. This is even more so, considering the type of sponsored links appearing on the website associated with the disputed domain name, which all refer to the same activity of the Complainant. The registration of a disputed domain name in breach of the Complainant's earlier trademark rights, being aware of such rights, and in the absence of any right or legitimate interest in the disputed domain name, is clear evidence of registration in bad faith.

As to use in bad faith, as mentioned above, the disputed domain name leads to a website containing sponsored links referring to the Complainant's activity, from which the Respondent probably derives an income. The use of the disputed domain name as described above shows that the Respondent has deliberately decided to target the Complainant and its trademark and to mislead the Internet users looking for the Complainant, for its own advantage. The Panel therefore concludes that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web page, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site.

Moreover, the Complainant sent a cease and desist letter to the Respondent, pointing out its rights and requesting the voluntary assignment of the disputed domain name. However, said letter remained unanswered, which demonstrates the Respondent's total lack of interest in solving the matter amicably. Given the overall circumstances of this case, also this circumstance is an evidence of the Respondent's bad faith.

In view of the foregoing, the Panel is satisfied that the third condition under the Policy is met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALINTESANPAOLO.COM**: Transferred
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PANELLISTS

Name	Angelica Lodigiani
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DATE OF PANEL DECISION **2022-12-13**

Publish the Decision
