

Decision for dispute CAC-UDRP-105007

Case number	CAC-UDRP-105007
Time of filing	2022-11-29 09:55:33
Domain names	INETSASANPAOLO.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

Name	Mathiou Mertsant
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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" and "INTESA" registered as follows:

- International trademark registration no. 920896 "INTESA SANPAOLO", granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42;
- International trademark registration no. 793367 "INTESA", granted on September 4, 2002 and duly renewed, in connection with class 36;
- EU trademark registration no. 5301999 "INTESA SANPAOLO", filed on September 8, 2006, granted on June 18, 2007 and duly renewed, in connection with the classes 35, 36 and 38;
- EU trademark registration no. 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.

The Complainant also owns a portfolio of domain names, including 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.

The Complainant's domain names are connected to the official website WWW.INTESASANPAOLO.COM.

FACTUAL BACKGROUND

The Complainant is the leading Italian banking group and one of the protagonists in the European financial area. 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 36.6 billion euro, and it is asserted to be the undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

The Complainant has a network of approximately 3,700 branches and is well distributed throughout the country, with market share of more than 16% in most Italian regions. It offers its services to approximately 13.6 million customers. It has a strong presence in Central-Eastern Europe with a network of approximately 950 branches and over 7 million customers. Its international network specialised in supporting corporate customers who are 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 August 10, 2022, the Respondent registered the domain name <INETSASANPAOLO.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).

The Complainant contends that the disputed domain name is confusingly similar to its trademarks “INTESA SANPAOLO” and “INTESA” as the disputed domain name reproduces its trademarks with the mere inversion of letters “T” and “E” in the mark’s verbal portion “INTESA” to “INETSA”.

When part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner. It is, therefore, sufficient to establish identity or confusing similarity for the purposes of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0902; *Dr. Ing. h.c. F. Porsche AG v Vasily Terkin*, WIPO Case No D2003-003-0888.

While the term “INETSA” on its own is arguably different to the term “INTESA” but when combined with the exact term “SANPAOLO” to form the disputed domain name it is likely to create confusion as it uses the exact term “SANPAOLO” that is part of the Complainant’s trademark “INTESA SANPAOLO”. The Panel considers that this is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark. It does not change the overall impression of the designation as being connected to the Complainant’s trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademark.

Accordingly, the Panel considers that the mere inversion of the letters “T” and “E” in the trademark “INTESA” to “INETSA” when combined with the term “SANPAOLO” give the overall impression that the disputed domain name is connected with the Complainant’s trademarks and accordingly there is the likelihood of confusion occurring amongst customers who use the Complainant’s services.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark and that paragraph 4(a)(i) of the Policy is satisfied.

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).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a 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 *Croatia Airlines d.d. v. Modern Empire Internet Ltd*, WIPO Case No. D2003-0455.

The Complainant makes the following brief contentions:

First, the Complainant has not authorized or licensed the Respondent to use its trademarks “INTESA SANPAOLO” and “INTESA”. The Respondent has not filed any administrative compliant response to the Amended Complaint. The Panel accepts this uncontradicted contention.

Secondly, the disputed domain name does not correspond to the name of the Respondent. The Complainant asserts that to the best of its knowledge, the Respondent is not commonly known as “INETSASANPAOLO”.

By e-mail dated November 29, 2022 the Registrar of the disputed domain name informed the CAC that the Respondent is the registrant and provided his contact information as follows:

Mathiou Mertsant

12 York Road

Douglas, Douglas IM23BW, IM

+44:IM.7624427100

petersmithwebs@gmail.com

The Complainant has not adduced any evidence of information in the WHOIS database to support its assertion based on its knowledge. Where information in the WHOIS database is provided and a respondent is not similar to the disputed domain name, the Panel can accept such evidence as prima facie showing that a respondent is not commonly known by the disputed domain name. See, for example, Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>; Forum Case No. FA 699652, The Braun Corporation v. Wayne Loney.

Here, the Panel considers that the Complainant’s assertion based on its knowledge is not evidence of anything. Accordingly, the Panel will ignore the Complainant’s assertion based on its knowledge. As the Respondent has not filed any administrative compliant response to the Amended Complaint, the Panel will accept the uncontradicted notification from the registrar of the disputed domain name that the Respondent is the registrant which prima facie suggests that he is not known as the disputed domain name.

Thirdly, the Complainant contends that it does not find any fair or non-commercial uses of the domain name at stake. The Complainant adduced evidence that the disputed domain name is connected to a website that has been blocked by google Safe Browsing through a warning page. The Respondent has not filed any administrative compliant response to the Amended Complaint. The Panel accepts this uncontradicted contention.

Accordingly, the Panel finds the Respondent has no right or legitimate interests in the disputed domain name.

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).

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The Complainant’s principal address and business are in Italy. The Respondent’s address is in the Isle of Man. The disputed domain name is currently held passively.

The evidence also shows that the Complainant’s trademarks “INTESA” and “INTESA SANPAOLO” are distinctive and well-known all around the world. The Complainant contends the fact that the Respondent has registered a domain name that is confusingly similar to its trademarks indicates that the Respondent has knowledge of the Complainant’s trademarks at the time of registration of the disputed domain name. The Complainant asserts that if the Respondent had carried even a basic Google search in respect of the words “INTESA SANPAOLO” and “INTESA”, the same would have yielded obvious references to the Complainant.

The Panel considers that given the distinctiveness of the Complainant’s trademarks and reputation and the Respondent’s failure to respond to the proceedings, the Panel accepts the uncontradicted evidence of the Complainant’s well-known trademarks. The Panel considers that it is reasonable to infer that the Respondent registered the disputed domain name with full knowledge of the Complainant’s trademarks.

Accordingly, it is inconceivable that the Respondent might have registered the disputed domain name similar to or incorporating the Complainant’s trademarks without knowing of them.

Use in bad faith

The Complainant asserts that the disputed domain name is not used for any bona fide offerings and contends that the main purpose of the Respondent is to use the disputed domain name for “phishing” financial information in an attempt to defraud the Complainant’s

customers and that Google promptly stopped the illicit activity carried out by the Respondent. See *Halifax Plc. v. Sontaja Sanduci*, WIPO Case No. D2004-0237 and also *CarrerBuilder LLC v. Stephen Baker*, WIPO Case No. D2005-0251.

Use of a disputed domain name for the purpose of defrauding internet users by operation of a “phishing” website is clear evidence of registration and amounts to use of a domain name in bad faith. See *Royal Bank of Scotland Group plc v. Secret Registration Customer ID 232883 / Lauren Terrado*, WIPO Case No. D2012-2093; *Grupo Financiero Inbursa, S.A. de C.V. v. inbuirsa*, WIPO Case No. D2006-0614; *Finter Bank Zürich v. N/A, Charles Osabor*, WIPO Case No. D2005-0871 and *Banca Intesa S.p.A. v. Moshe Tal*, WIPO Case No. D2006-0228.

The Panel has already referred to the uncontradicted facts set out in the Amended Complaint and accepts the evidence and contention that the disputed domain name is held passively.

The Complainant’s evidence also points to a possible “phishing” activity using the disputed domain name, which is prima facie confirmed by Google Safe Browsing with a warning page. The Respondent has not filed any administrative compliant response to the Amended Complaint.

As the Complainant is well-known in the financial services sector, the Panel is prepared to infer that the Respondent registered the disputed domain name because in all probability he knew of the Complainant and its financial services offering and by using the disputed domain name in the manner asserted by the Complainant it is likely to attract internet users to the website. The inversion of the letters “T” and “E” in the trademark’s verbal portion “INTESA” to “INETSA” combined with the use of “SANPAOLO” is a clear example of typosquatting that can be used to direct consumers to a “phishing” website, as is contended by the Complainant.

Accordingly, the Panel considers that it is opened to conclude that there is no plausible, actual, or contemplated active use of the disputed domain name by the Respondent that would be lawful and legitimate.

The Panel, therefore, finds that the Respondent’s holding of the disputed domain name in this case satisfies the requirement that the disputed domain name is being used in bad faith by the Respondent.

Accordingly, the Panel finds that the registration of the disputed domain name and its use was in bad faith.

PROCEDURAL FACTORS

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieved actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC’s responsibility to achieve actual notice to the Respondent.

On December 18, 2022 the CAC by its non-standard communication notified the Respondent that the deadline for filing his response on the on-line platform will expire on December 22, 2022.

On December 23, 2022 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

Neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court. The CAC is therefore unaware whether the written notice was received by the Respondent or not. The e-mail notice sent to postmaster@inetsasanpaolo.com was returned back undelivered as the e-mail address had permanent fatal errors. The e-mail notice was also sent to petersmithwebs@gmail.com, but we never received any proof of delivery or notification of undelivery. No further e-mail address could be found on the disputed site – the site was redirected. The Respondent never accessed the online platform.

Given the reasonable measures employed by the CAC as set out in the above non-standard communications, and that the Respondent has not provided any administrative compliant, 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

The Complainant owns the registered trademarks “INTESA” and “INTESA SANPAOLO” and several domain names that includes its trademarks which are used in connection with its goods or services for a considerable time. The Complainant’s trademarks are well-known globally.

The Respondent registered the disputed domain name on August 10, 2022. The disputed domain name combines, in its entirety, the second term “SANPAOLO” of the Complainant’s well-known trademark “INTESA SANPAOLO” with the term “INETSA” which is the inversion of the letters “T” and “E” in the trademark “INTESA” to form “INETSA”.

The Complainant asserts that the disputed domain name is used as a “phishing” website.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent has failed to file any administratively compliant response.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

- (a) The disputed domain name is confusingly similar to the Complainant's well-known trademarks "INTESA" and "INTESA SANPAOLO".
- (b) The Respondent has no rights or legitimate interests in respect of the disputed domain name.
- (c) The disputed domain name has been registered and is being 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. **INETSASANPAOLO.COM**: Transferred

PANELLISTS

Name	William Lye OAM KC
DATE OF PANEL DECISION	2022-12-25
Publish the Decision	