

Decision for dispute CAC-UDRP-105008

Case number	CAC-UDRP-105008
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Time of filing	2022-11-29 09:55:19
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Domain names	INTESASANPAOLO-LOGINS.COM
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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	Alberto Formosa
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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 International trademark registration n. 920896 "INTESA SANPAOLO", granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42 and a series of other registered trademarks for INTESA SANPAOLO and INTESA more particularly set out hereunder.

FACTUAL BACKGROUND

The Complainant is an Italian company engaged in the banking industry. It is one of the most prominent banking groups in the Euro Zone. It is also the owner of a series of registered trademarks for INTESA SANPAOLO and INTESA and related domain names that are used in its business. It has come to the notice of the Complainant that on December 19, 2021, the Respondent registered the domain name <intesasanpaolo-logins.com> without the permission of the Complainant and without any right to do so. The only discernible use to which the domain name has been put is that the website to which it resolves has been blocked by Google Safe Browsing through a warning page. As a result, the Complainant has filed this Complaint and has requested that the disputed domain name be transferred from the Respondent to the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED. PARTIES' CONTENTIONS: COMPLAINANT

The disputed domain name is identical or confusingly similar to the Complainant's INTESA SANPAOLO and INTESA trademarks more particularly described hereunder.

The Complainant is an Italian company engaged in the banking industry. It is one of the most prominent banking groups in the Euro Zone. It is also the owner of the following series of registered trademarks for INTESA SANPAOLO and INTESA, namely:

- International trademark registration n. 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 n. 793367 "INTESA", granted on September 4, 2002 and duly renewed, in connection with class 36;
- EU trademark registration n. 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 n. 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 is also the owner of a series of domain names that it uses in its business including the domain name <intesasampaolo.com>.

On December 19, 2021, the Respondent registered the disputed domain name <intesasampaolo-logins.com> which consists of the Complainant's INTESA SANPAOLO trademark in its entirety, to which has been added a hyphen and the descriptive word "logins". The domain name is therefore confusingly similar to the INTESA SANPAOLO trademark.

The Respondent has no rights or legitimate interests in the disputed domain name as the Respondent was not authorized by the Complainant to register it; the Respondent is not commonly known by the domain name and the Respondent had not used it for a fair or non-commercial purpose.

The disputed domain name was registered and is used in bad faith. That is so because it has been passively held by the Respondent, the Respondent must have had actual knowledge of the Complainant's INTESA SANPAOLO trademark at the time of registering the domain name, which fact could have been ascertained by a basic Google search. Moreover, the domain name has not been used for a bona fide offering and the Respondent has attempted to use in breach of paragraph 4(b) (iv) of the Policy. The registration and use of the domain name in bad faith is evidenced by the fact that the website to which it resolves has been blocked by Google Safe Browsing through a warning page. The necessary inference from that situation is that the main purpose for the Respondent having registered the domain name was to use its website for phishing for financial information in an attempt to defraud the Complainant's customers, which has prompted Google to stop this illegal activity and also with the intention to try to sell the domain name to the Complainant.

These contentions are supported by numerous prior UDRP decisions.

The Respondent has not complied with a cease and desist letter sent by the Complainant's attorney on June 16, 2022 requesting the transfer of the domain name to the Complainant.

RESPONDENT

The Respondent did not file 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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the CAC Supplemental Rules.

A. Administrative deficiency

By notification dated November 29, 2022 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint had not sufficiently identified the Respondent.

The notification requested the Complainant to correct the above-mentioned deficiency and submit an amended Complaint within five (5) days of receiving the notification and to submit the amended Complaint using the Form "Amend Complaint" available on the CAC's on-line platform. On December 1, 2022, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiency has been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The 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 domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts that it is the registered owner of the International trademark registration n. 920896 for INTESA SANPAOLO, granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42 and as such has rights in that trademark. The evidence is that the Complainant is also the registered owner of other trademarks for both INTESA SANPAOLO and INTESA.

The evidence then shows, and the Panel finds, that on December 19, 2021, the Respondent registered the disputed domain name <intesasampaolo-logins.com>

The Panel next finds that the disputed domain name is confusingly similar to the INTESA SANPAOLO trademark for the following reasons.

First, the domain name includes the entirety of the INTESA SANPAOLO trademark and that word is by far the dominant part of the domain name as, apart from the trademark, nothing else is included in it other than a hyphen, the generic word "logins" and the top level domain ".com". Accordingly, the attention of the internet user would naturally be drawn to the term INTESA SANPAOLO in the domain name and would inculcate in the mind of the user the idea that the domain name was an official domain name of the Complainant.

Secondly, as the Complainant submits, the change made to the trademark at the time of registering the domain name so that the domain name reads <intesasampaolo-logins.com> would be seen by internet users as indicating that it could be used to login to the Complainant's website. Moreover, the hyphen and the word "logins" are merely descriptive and cannot negate a finding of confusing

similarity that is otherwise open, as it is in the present case.

Thirdly, it is also accepted in this jurisdiction that the presence of a top-level domain such as “.com” cannot negate confusing similarity that is otherwise present as it is in this case.

Fourthly, the domain name would convey to the objective bystander that it related to the activities of the Complainant, giving rise to inevitable confusion.

Accordingly, and for all of those reasons, the domain name is confusingly similar to the Complainant's INTESA SANPAOLO trademark and the Complainant has thus shown the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] of the dispute, your use of, or 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) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail. However, in the present case, the Respondent has not filed a Response or advanced by any other means anything to show that it has a right or legitimate interest in the domain name.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations. The Respondent has no rights or legitimate interests in the disputed domain name as the evidence shows that Respondent was not authorized by the Complainant to register it; the Respondent is not commonly known by the domain name and the Respondent has not used it for a fair or non-commercial purpose.

Indeed, it is inconceivable that the Respondent could show a right or legitimate interest in the domain name in the light of the brazen nature of the registration and the fact that Google has determined that the Respondent's conduct merits the blocking of the resolving website by Google Safe Browsing through a warning page. In that regard the Panel agrees with the submission of the Complainant that the necessary inference from that situation is that the main purpose for the Respondent having registered the domain name was to use its website for phishing for financial information in an attempt to defraud the Complainant's customers, which has prompted Google to stop this illegal activity. The Panel also agrees with the Complainant that the intention of the Respondent was to try to sell the domain name to the Complainant.

These facts give rise to the prima facie case made out by the Complainant.

The Panel also note that the Complainant's submissions are supported by prior UDRP decisions.

As noted, the Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (i) 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
- (ii) 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) 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 or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraphs 4(b)(i), (iii) and (iv) of the Policy as the Complainant submits. The Panel finds that Respondent's intention in registering and using the domain name was clearly to try to sell it to the Complainant, disrupt its business and create confusion among internet users.

The Panel has reached those conclusions for the following reasons.

First, the Complainant's trademark is well known as is the Complainant itself and the disputed domain name is confusingly similar to that trademark. The conclusion must be that the domain name was registered with the intention of confusing internet users, which amounts to bad faith registration and use.

Secondly, it must also follow that the Respondent had actual notice of the Complainant's trademark. It has regularly been held in prior UDRP decisions that to copy a trademark in a domain name, knowing that it is the trademark of another party constitutes bad faith registration and use of the domain name. The Panel makes that finding in the present case.

Thirdly, the domain name does not resolve to an active website. This mean that the Respondent is not using the domain name for a legitimate purpose and, indeed, it is impossible to contemplate how the Respondent could use such a prominent name for any purpose other than an illegitimate one.

The conduct of the Respondent brings the case within paragraph 4(b) (i) of the Policy as the probable intention of the Respondent was to try to sell the domain name to the Complainant and within paragraph 4 (b) (iii) because the effect of the Respondent's conduct was to disrupt the Complainant's business.

The evidence also shows that Respondent's conduct puts the case within paragraph 4(b) (iv) of the Policy, as the Complainant submits. That is so because if the domain name remains registered to the Respondent, there is a very real danger that it will be used for an illegal purpose, namely phishing. The Respondent must have intended to hack financial details of the Complainant's clients so as to defraud probably the clients as well as the Complainant itself.

As the Complainant also submits, the foregoing activities have been held in previous UDRP decisions cited by the Complainant to constitute bad faith. Accordingly, the Complainant has shown the third of the three elements that it must establish and is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO-LOGINS.COM**: Transferred

PANELLISTS

Name	Neil Brown
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DATE OF PANEL DECISION	2023-01-03
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Publish the Decision