

Decision for dispute CAC-UDRP-104763

Case number	CAC-UDRP-104763
Time of filing	2022-08-02 09:36:50
Domain names	INTESASANPAOLO-SPEDIZIONE.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
--------------	---

Complainant

Organization	Intesa Sanpaolo S.p.A.
--------------	------------------------

Complainant representative

Organization	Intesa Sanpaolo S.p.A.
--------------	------------------------

Respondent

Name	Bruno Brugnoli
------	----------------

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

Complainant owns rights in the “INTESA SANPAOLO” sign and shows valid trademark rights as follows:

- International trademark “INTESA SANPAOLO” No. 920896, dated of March 7, 2007 (renewed), for goods and services in classes 9, 16, 35, 36, 38, 41, 42;
- International trademark “INTESA” No. 793367, dated of September 4, 2002 (renewed); for services in class 36;
- European Union trademark “INTESA SANPAOLO” No. 005301999, dated of September 8, 2006 (renewed) for services in classes 35, 36 and 38;
- European Union trademark “INTESA” No. 012247979, dated of October 23, 2013 (renewed), for goods and services in classes 9, 16, 35, 38, 41 and 42.

Complainant also operates domain names including the same wording “INTESA” or “INTESA SANPAOLO”, namely: INTESASANPAOLO.COM, INTESASANPAOLO.ORG, INTESASANPAOLO.EU, INTESASANPAOLO.INFO, INTESASANPAOLO.NET, INTESASANPAOLO.BIZ, INTESA-SANPAOLO.COM, .ORG, INTESA-SANPAOLO.COM.EU, INTESA-SANPAOLO.COM.INFO, INTESA-SANPAOLO.COM.NET, INTESA-SANPAOLO.COM.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.

FACTUAL BACKGROUND

Complainant is an Italian banking group as well as one of the protagonists in the European financial area. Complainant introduces itself as one of the top banking groups in the euro zone and an undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

Respondent is Mr. Bruno Brugnoli, located in Italy.

On December 22, 2021, Respondent registered the disputed domain name <intesasanpaolo-spedizione.com> for which the redirection is currently blocked due to a security risk.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

- Complainant argues that the disputed name is confusingly similar to its trademark and its domain name associated

Complainant considers that the disputed domain name is identical, or at least confusingly similar to its "INTESA SANPAOLO" and "INTESA" registered trademarks.

As a matter of fact, Complainant states that the disputed domain name fully reproduces the words "INTESA SANPAOLO", which is identical to its well-known trademark "INTESA SANPAOLO".

Complainant then explains that the mere addition of the Italian term "SPEDIZIONE", meaning shipping in English, is merely descriptive and that is not enough to distinguish the disputed domain name from Complainant's trademarks, thus increasing the likelihood of confusion.

- Complainant argues that Respondent does not have any rights or legitimate interests in the disputed domain name

Complainant asserts that Respondent has no rights on the disputed domain name. Complainant indeed explains that it has not authorised nor licensed Respondent to use its trademarks and to register the disputed domain name.

What is more, Complainant explains that the disputed domain name does not correspond to Respondent since this latter is not commonly known as "INTESASANPAOLO-SPEDIZIONE".

At last, Complainant states that there is no proof of non-commercial use of the disputed domain name.

- Complainant further argues that the disputed domain name was registered and used in bad faith

Complainant asserts that when Respondent registered the disputed domain name, he was fully aware of Complainant's trademark due to the fact of its renown towards the world and in Italy, where Respondent is located.

To support its claim, Complainant shows a basic Google search of the words "INTESA" and "INTESA SANPAOLO" which both have yielded obvious references to Complainant. As such, it emphasises the knowledge Respondent must have had of

Complainant's trademarks while registering the disputed domain name. Therefore, it is a clear evidence that Respondent registered the disputed domain name in bad faith.

Complainant also states that the domain name is not used in good faith by Respondent as it is not used for a bona fide offering of goods.

Complainant argues that the domain name is not currently connected to a website and that it should be considered as passive holding and thus constitutes a finding of bad faith.

Further, Complainant indicates that it has sent a cease-and-desist letter to Respondent regarding the disputed domain name, but that Respondent never replied.

Finally, Complainant states that it believes Respondent proceeded with the registration of the disputed domain name for phishing purpose considering Complainant's field of activity and previous phishing cases.

RESPONDENT:

Respondent did not provide any response to the Complaint, and is therefore in default.

RIGHTS

Complainant demonstrates that it owns valid trademark rights in the "INTESA SANPAOLO" and "INTESA" signs. Furthermore, Complainant shows valid rights of various domain names bearing the signs "INTESA SANPAOLO" and "INTESA".

The Panel recognises that Complainant's trademark rights in the "INTESA SANPAOLO" and "INTESA" signs are established.

The Panel also agrees that the disputed domain name is confusingly similar to Complainant's "INTESA SANPAOLO" trademark. In fact, the addition of the term "spedizione" is not sufficient to avoid a likelihood of confusion with the "INTESA SANPAOLO" trademark (see WIPO Overview 3.0: "In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing").

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

Complainant shall provide a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name, under Policy 4 (a) (ii).

This standard has been recognised throughout continuous case law, such as in *LESAFFRE ET COMPAGNIE v. Tims Dozman*, Case No. 102430 (CAC, April 2, 2019) where it has been held that 'The 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 Respondent carries the burden of demonstrating rights or legitimate interest 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 UDRP (please see, for example, WIPO case No. D2003-0455, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*)'.

Complainant asserts that Respondent is not authorised nor licensed by Complainant to use the disputed domain name. In addition, Respondent is not commonly known under the disputed domain name.

Respondent did not provide a response to the Complaint. Previous panels have held that such lack of response from the

Respondent's part was proof that Complainant and Respondent had no relation and that Respondent is not commonly known under the disputed domain name (See FILEHIPPO S.R.O. v. whois agent, Case No. 102279 (CAC January 31, 2019), "In the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant's trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.").

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

Complainant argues that given the distinctiveness and the widely known of its trademark and domain name containing its trademarks "INTESA" and INTESA SANPAOLO", Respondent could not ignore Complainant's prior rights when registering the disputed domain name. This is supported by evidence provided by Complainant, showing an extract of a Google search of the words "INTESA SANPAOLO" and "INTESA" where the results referred to Complainant.

What is more, Complainant states that the disputed domain name is not used for any bona fide offering. To support this argument, Complainant explains that Respondent has registered or acquired the disputed domain name for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant. Furthermore, Complainant argues that the disputed domain name is not connected to any web site and states that passive holding should apply in the present case. However, the Panel notes that the redirection of the disputed domain name is currently blocked by a security alert. In addition, the disputed domain name seemed to previously redirects towards a parking page with commercial links targeting Complainant's activity.

The Panel considers that the current and previous use of the disputed domain name cannot be considered as a use in good faith of the domain name. It indeed seems that Respondent was using the domain name for commercial gain, by taking advantage of Complainant's renown, and diverting Internet users to lead them to its own website.

At last, Complainant proved that on June 1, 2022, Complainant's attorney sent to the Respondent a cease-and-desist letter, asking for the voluntary transfer of the disputed domain name to their client. Respondent never replied to such communication. Such behaviour here evidences a lack of interest and a finding of 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

Complainant holds trademark rights in the "INTESA SANPAOLO" and "INTESA" signs. The disputed domain name reproduces Complainant's trademarks and is therefore confusingly similar to Complainant's trademarks. The mere addition of the word "spedizione" is not sufficient to avoid a likelihood of confusion.

Respondent failed to establish legitimate rights or legitimate interest in the disputed domain name. Complainant established that Respondent registered and uses the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. INTESASANPAOLO-SPEDIZIONE.COM: Transferred

PANELLISTS

Name	Nathalie Dreyfus
------	------------------

DATE OF PANEL DECISION	2022-09-01
------------------------	------------

Publish the Decision
