

Decision for dispute CAC-UDRP-105102

Case number	CAC-UDRP-105102
Time of filing	2022-12-29 10:11:54
Domain names	IT-INTESANPAOLO.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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	Noah Bando
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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 a number of trade marks for INTESA SANPAULO including, by way of example only, European Union trade mark registration number 530199 for INTESA SANPAULO in classes 35, 36 and 38, applied for on September 8, 2006 and registered on June 18, 2007.

FACTUAL BACKGROUND

The Complainant is an Italian banking group which was formed in 2007 following the merger of Banca Intesa S.p.A. and Sanpaulo IMI S.p.A. It has a market capitalisation exceeding EUR 40.3 billion and approximately 3,700 branches in Italy as well as many branches in other countries. The Complainant trades as INTESA SANPAULO and owns many trade marks to protect this trading style including the mark in respect of which full details are given above. It also owns a large number of domain names which comprise or include its trade marks, including <intesasanpaulo.com>, which resolves to its principal website.

The disputed domain name was registered on October 31, 2022. Attempts to access the website to which the disputed domain name resolves generate a warning that it is a deceptive website which may seek to trick Internet users into carrying out dangerous operations such as installing software or revealing personal information.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant says that the disputed domain name is identical or at least confusingly similar to its INTESA SANPAULO trade mark as it exactly reproduces it and simply adds the prefix "IT", followed by a hyphen. This comprises a clear example of typosquatting.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Any use of the Complainant's INTESA SANPAULO mark has to be authorised by it and it has not authorised or licensed the Respondent to use the disputed domain name. The Respondent is not known as "IT-INTESASANPAULA", nor is it making any fair or non-commercial uses of the disputed domain name.

Lastly, the Complainant says that the Respondent has registered and is using the disputed domain name in bad faith. The Complainant's INTESA and INTESA SANPAULO trade marks are distinctive and well-known. The fact that the disputed domain name is confusingly similar to the Complaint's INTESA SANPAULO trade mark suggests that the Respondent was aware, should have been aware, of the Complainant's mark as at the date it registered the disputed domain name and would not have been registered were it not for the Complainant's trade mark.

The disputed domain name is not being used for any bona fide offering. Moreover, the circumstances indicate that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its website. Considering that the disputed domain name resolves to a website which generates a warning that it is likely to be deceptive, it is clear that the respondent intended to use it for phishing and thereby to defraud the complainant's customers. Even if the Respondent is not engaged in phishing, there cannot be any possible legitimate use of the disputed domain name by the Respondent, other than to resell it to the Complainant.

RESPONDENT:

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).

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

Paragraph 4(a) of the Policy requires that the Complainant prove each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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 is being used in bad faith.

Identical or confusingly similar

So far as the first element is concerned, the Complainant's trade mark registrations for INTESA SANPAULO, including the trade mark in respect of which full details are provided above, establish its rights in this mark.

For the purpose of comparing the disputed domain name with the Complainant's mark, it is established practice to disregard the generic Top Level Domain, that is ".com" in the case of the disputed domain name, as this is a technical requirement of registration. The remaining element of the disputed domain name comprises the Complainant's trade mark, in full and without alteration, but adds the prefix "IT" and a hyphen. The hyphen is of no significance in this context and the word "IT", which is an acronym for Italy, the country where the Complainant has its head office, does not serve to differentiate the disputed domain name from the Complainant's trade mark.

Where a domain name wholly incorporates a complainant's registered trade mark that is sufficient to establish confusing similarity for purposes of first element of the Policy; see, for example, CAC Case No. 102382, *MAJE v enchong lin*. The Panel accordingly finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

Rights and legitimate interests

Paragraph 4(c) of the Policy sets out circumstances, without limitation, by which a respondent might demonstrate that it has rights or a legitimate interest in a domain name. These are, summarised briefly: (i) if the respondent has been using the domain name in connection with a *bona fide* offering of goods and services; (ii) if the respondent has been commonly known by the domain name; or (iii) if the respondent has been making a legitimate noncommercial or fair use of the domain name.

The use of the disputed domain name to resolve to a website which, according to the Internet browser warning, is likely to be used for deceptive purposes, does not comprise a *bona fide* offering of goods and services. See, for example, The Commissioners for *HM Revenue and Customs v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Red Man*, WIPO Case No. D2021-1997.

There is no evidence that the Respondent has been commonly known by the disputed domain name, nor does the Respondent's use of the domain name to resolve to a website with the characteristics described above amount to making a legitimate noncommercial or fair use of it. The second and third circumstances set out at paragraph 4(c) of the Policy are therefore also inapplicable.

The Complainant having made out a *prima facie* case in relation to the second element, the burden of proof shifts to the Respondent to rebut it; see, for example, CAC Case No. 102333, *Amedei S.r.l. v sun xin*. In the absence of any response by it to the Complaint, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Bad faith

The Panel accepts the Complainant's submission that the distinctive nature of its mark and its reputation means that it is highly improbable that the Respondent registered the disputed domain name without an awareness of the Complainant and its trade mark rights. In these circumstances, the registration by the Respondent of the disputed domain name, which is confusingly similar to the Complainant's mark, leads to a presumption of bad faith; see for example CAC Case No 102157, *FEDERATION FRANCAISE DE TENNIS (FFT) v Biswas, Jyotirmoy*. The Panel therefore finds that the disputed domain name was registered in bad faith.

The fact that the disputed domain name does not resolve to a website which is active in any real sense does not preclude a finding of bad faith use under the doctrine of passive holding. The material factors in this respect were first set out in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 and see also, by way of example, CAC Case No. 102333, *Amedei S.r.l. v sun xin*. The relevant factors are fulfilled in the circumstances of these proceedings, namely that (i) the Complainant has established that its rights in its INTESA SANPAULO mark are both extensive and established, (ii) the Respondent has not provided any evidence of actual or contemplated good faith use by it of the disputed domain name, (iii) the Respondent has taken active steps to conceal its true identity by use of a privacy service and (iv) it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate or infringe the Complainant's trade mark rights.

For these reasons the Panel finds that the disputed domain name was both registered and 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. **IT-INTESANPAOLO.COM**: Transferred

PANELLISTS

Name	Antony Gold
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DATE OF PANEL DECISION	2023-02-04
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Publish the Decision	
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