

Decision for dispute CAC-UDRP-104773

Case number CAC-UDRP-104773

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Domain names LNTESANPAOLB.COM

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Intesa Sanpaolo S.p.A.

Complainant representative

Organization Intesa Sanpaolo S.p.A.

Respondent

Organization O'Reilly, Hoppe and Collier Deja Zulauf

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 leading Italian banking group and also one of the protagonists in the European financial arena. 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.

Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalization exceeding 35,6 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,700 branches capillary and well distributed throughout the Country, with market shares of more than 16% in most Italian regions, the Group offers its services to approximately 13,5 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,0 million customers. Moreover, the international network specialized in supporting corporate customers is 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.

The Complainant is the owner, among others, of the following registrations for the trademarks "INTESA SANPAOLO" and

“INTESA”:

- 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; and
- 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.

Moreover, the Complainant is also the owner, among the others, of 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> and these all are connected to the Complainant’s website <http://www.intesasanpaolo.com>.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Respondent registered the domain name <LNTESANPAOLB.COM> on February 7, 2022.

The Complainant’s attorneys sent to the Respondent a cease and desist letter on June 1, 2022, asking for the voluntary transfer of the disputed domain name to their client. The Respondent’s never replied to such communication.

THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is the owner of the international and EU trademarks “INTESA SANPAOLO” and “INTESA”.

The Complainant is also the owner of the domain names bearing the signs “INTESA SANPAOLO” and “INTESA”. All of them are now connected to the official website <http://www.intesasanpaolo.com>.

The Respondent registered the domain name <LNTESANPAOLB.COM> on February 2022.

The Complainant states that it is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”. As a matter of fact, <LNTESANPAOLB.COM> represents a typosquatting version of the well-known trademark “INTESA SANPAOLO”, with the mere substitution of the letter “I” with an “L” in the word “INTESA”, the omission of the couple of the letters “S” and “A” from the mark “INTESA” and the merger of the verbal elements “INTESA” and “SANPAOLO” sharing, respectively, the same final and initial letters and the substitution of the final letter “O” with a “B” in the term “SANPAOLO”.

The Complainant recalled WIPO Case n. D2001-1314 in Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc, regarding the domain names <duetschebank.com> and <duetsche-bank.com>”. Such domain names are being confusingly similar and a clear example of a case of ‘typosquatting’ where the domain name is a slight alphabetical variation from a famous mark.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Respondent has no rights on the disputed domain name, and any use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue.

The domain name at stake does not correspond to the name of the Respondent and, to the best of our knowledge, the

Respondent is not commonly known as "LNTESANPAOLB".

Lastly, the Complainant does not find any fair or non-commercial uses of the domain name at stake by calling down the disputed domain name's home-page.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The domain name <LNTESANPAOLB.COM> was registered and is used in bad faith.

The Complainant's trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wordings "INTESA SANPAOLO" and "INTESA", the same would have yielded obvious references to the Complainant. The Complainant submits an extract of a Google search in support of its allegation. This raises a clear inference of knowledge of the Complainant's trademark on the part of the Respondent. Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant's trademark. This is a clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bona fide offerings. More particularly, there are 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 the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy).

The disputed domain name is not used for any bona fide offerings, even if it is not connected to any web site, by now.

The passive holding of a domain name with knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use.

The Complainant recalls:

- WIPO Case No. D2000-0003 in Telstra Corporation Limited v. Nuclear Marshmallows and
- Overview of WIPO on Selected UDRP Questions, para. 3.2.

The passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. The Complainant tends to find that if there is a Complainant's mark which is well-known and the Respondent makes no conceivable use of this mark then it would amount to an infringement of the Complainant's trade mark rights.

According to the Complainant it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant's trademarks and that results so similar to the Complainant's domain names currently used by the latter to provide online banking services for enterprises.

The Complainant quotes as follows: «The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests».

The Complainant recalls:

- WIPO Case No. D2004-0615 in Comerica Inc. v. Horoshiy, Inc., concerning a bank.

The risk of a wrongful use of the domain name at issue is even higher in the present case, since the Complainant has already been targeted by some cases of phishing in the past few years. Such a practice consists of attracting the customers of a bank to a web page which imitates the real page of the bank, with a view to having customers disclose confidential information like a credit card or bank account number, for the purpose of unlawfully charging such bank accounts or withdrawing money out of them. It happened that some clients of the Complainant have received e-mail messages asking, by the means of web pages which were very similar to the Complainant's ones, the sensitive data of the Clients, like user ID, password etc. Then, some of the Clients have been cheated of their savings.

Also in the present case, the Complainant believes that the current owner registered the disputed domain name with the "phishing" purpose, in order to induce and divert the Complainant's legitimate customers to its website and steal their money and the above could be easily verified given the particular nature of the disputed domain name (typosquatting).

Even excluding any "phishing" purposes or other illicit use of the domain name in the present case, anyway we could find no other possible legitimate use of <LNTESANPAOLB.COM>. The sole further aim of the owner of the domain name under consideration might be to resell it to the Complainant, which represents, in any case, an evidence of the registration and use in bad faith, according to par. 4(b)(i) («circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name»).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Panel shall draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules because of the Respondent's failure to submit a response.

The Panel shall decide this administrative proceeding pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules on the basis of the Complainant's as true and undisputed allegations.

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 15(a) of the Rules for the UDRP ('the Policy') instructs the Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it

deems applicable".

Paragraph 4(a) of the Policy requires that complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (i) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (ii) 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 finds that the Complainant has rights in the international trademarks "INTESA SANPAOLO" No. 920896 and EU trademark No. 5301999 and international trademark "INTESA" No. 793367 and EU trademark No. 12247979. The registration of a trademark with the WIPO sufficiently establishes the required rights in the mark for purposes of the Policy.

The Panel concludes that the Complainant has established its rights in the trademarks which are distinctive and well-known international trademarks. The notoriety and the actually distinctive nature of the trademarks "INTESA SANPAOLO" and "INTESA" is confirmed by their widespread and longstanding use and reputation in the field of the Complainant's business in banking areas since many decades. The Complainant is owner, among the others, of the many domain names bearing the signs "INTESA SANPAOLO" and "INTESA" which all are connected to the Complainant's website <http://www.intesasanpaolo.com>.

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The disputed domain name is <LNTE SANPAOLB.COM>. Where the relevant trademark is recognizable in the disputed domain name, the addition of other generic words cannot prevent a finding of the Panel that the disputed domain name is confusingly similar to the first and second part of the disputed domain name. The Panel finds that the disputed domain name LNTE SANPAOLB.COM represents a typosquatting version of the well-known trademark "INTESA SANPAOLO", with the mere substitution of the letter "I" with an "L" in the word "INTESA", the omission of the couple of the letters "S" and "A" from the mark "INTESA" and the merger of the verbal elements "INTESA" and "SANPAOLO" sharing, respectively, the same final and initial letters and the substitution of the final letter "O" with a "B" in the term "SANPAOLO". The Panel considers such domain names being confusingly similar and a clear example of "a case of 'typosquatting' where the domain name is a slight alphabetical variation from a famous mark.

The Panel therefore finds that the disputed domain name is 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).

B. THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Respondent O'Reilly, Hoppe and Collier Deja Zulauf does not correspond to the name of the Complainant nor it is commonly known as "LNTE SANPAOLB". The use of the trademarks "INTESA SANPAOLO" and "INTESA" has to be authorized by the Complainant. The Respondent did not evidence any such authorization or license accorded by the Complainant.

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant's trademarks are well known all around the world. The Panels finds in extract of a Google search a clear inference of knowledge of the Complainant's trademark on the part of the Respondent. Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant's trademark. This is an evidence of registration of the domain name in bad faith.

The Panel does not find that the disputed domain name is used for any bona fide offerings. The passive holding of a disputed domain name with knowledge that this domain name infringes another party's trademark rights is an evidence of use of the disputed domain name in bad faith.

The Panel concludes that passive holding of a disputed domain name amounts to an infringement of the Complainant's trade mark rights. Passive holding of the disputed domain name, even if there it is objectively not possible to understand what kind of use the Respondent could make with a domain name which correspond to the Complainant's trademarks, results in the likelihood of the accumulation and use of disputed domain names for the implicit purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. Therefore, the Respondent no effective use of the disputed domain name amounts to use in bad faith.

Moreover, the Respondent never replied a cease and desist letter, asking for the voluntary transfer of the disputed contested domain name to the Complainant, sent to the Respondent by the Complainant's attorneys on 1 June 2022. This behavior of the Respondent leads to the Panel's conclusion of the registration and use in bad faith.

The Panel does not find any fair or non-commercial uses of the domain name at stake on the disputed domain name's home-page and no other possible legitimate use of <LNTESANPAOLB.COM>.

The Panel therefore finds that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. LNTESANPAOLB.COM: Transferred

PANELLISTS

Name	JUDr. Vojtěch Trapl
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DATE OF PANEL DECISION 2022-09-10

Publish the Decision
