

Decision for dispute CAC-UDRP-104775

Case number	CAC-UDRP-104775
Time of filing	2022-08-10 09:37:22
Domain names	INTESSASANPAOLO.TOP

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	Vito Aloisio
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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 (Intesa Sanpaolo S.p.A.) is the owner of the (i) international trademark registration n. 920896 "INTESA SANPAOLO"; (ii) international trademark registration n. 793367 "INTESA"; (iii) EU trademark registration n. 5301999 "INTESA SANPAOLO"; (iv) EU trademark registration n. 12247979 "INTESA". Moreover, the Complainant is also the owner of the several domain names bearing the signs "INTESA" and "BANCA INTESA".

The disputed domain name <intessasanpaolo.top> was registered on January 27, 2022.

FACTUAL BACKGROUND

The Complainant is the Italian banking group resulting from the merger between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups. The market capitalization of the Complainant exceeds 35,6 billion euro. The Complainant has a network of 3,700 branches with market shares of more than 16% in most Italian regions and offers its services to approximately 13,5 million customers. The Complainant 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 specialised in supporting corporate customers is present in 25 countries, in particular in the Mediterranean area, United States, Russia, China and India.

The Complainant is the owner of the 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>. All of them are now connected to the official website <http://www.intesasanpaolo.com>.

The disputed domain name <intessasanpaolo.top> registered on January 27, 2022, is identical, or at least confusingly similar, to the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”. The disputed domain name exactly reproduces the well-known trademark “INTESA SANPAOLO”, with the mere doubling of the letter “S” in the mark’s verbal portion “INTESA”, representing a clear example of typosquatting.

According to the WIPO decision *Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc*, Case n. D2001-1314, the domain name is 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. WIPO jurisprudence offers many examples of confusing similarity brought about through easily made typing errors by an Internet user.

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 disputed domain name.

The disputed domain name at stake does not correspond to the name of the Respondent and the Respondent is not commonly known as “INTESSASANPAOLO”. The disputed domain name is not fair or non-commercially used.

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. Therefore, it is more than likely that the disputed domain name 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.

The disputed domain name is not used for any bona fide offerings. 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. In fact, countless UDRP decisions confirmed that 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.

In particular, the consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, panels have tended to make such findings in circumstances in which, for example, a complainant's mark is well-known, and there is no conceivable use that could be made of the domain name that would not 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 risk of a wrongful use of the disputed domain name 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 disputed domain name in the present case, anyway we could find no other possible legitimate use of the disputed domain name. The sole further aim of the owner of the disputed domain name 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).

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).

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

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.

I. Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the

- (i) international trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007;
- (ii) international trademark registration n. 793367 “INTESA”, granted on September 4, 2002;
- (iii) EU trademark registration n. 5301999 “INTESA SANPAOLO”, filed on September 8, 2006, granted on June 18, 2007; and
- (iv) EU trademark registration n. 12247979 “INTESA”, filed on October 23, 2013 and granted on March 5, 2014.

The disputed domain name has been registered on January 27, 2022, i.e. almost 20 years after the “INTESA” trademark registration and 15 years after the “INTESA SANPAOLO” trademark registration.

The disputed domain name consists of two parts: INTESA and SANPAOLO. The first part of the disputed domain name is identical to the international and EU trademarks “INTESA”, and both parts are identical to the international and EU trademarks “INTESA SANPAOLO”. The only difference is the letter “S” in the word “INTESA” which is doubled in the disputed domain name. The adding of the second letter “S” to word “INTESA” does not change the overall impression of the designation as being connected to Complainant’s trademarks as the words INTESA and INTESSA are visually similar, and this could cause confusion with the Complainant’s trademarks. The duplication of the letters is the typical example of typosquatting.

The addition of the generic top level domain “.TOP” does not change the overall impression of the designation as being connected to Complainant’s trademarks.

Therefore, the Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the Complainant’s trademarks “INTESA” and “INTESA SANPAOLO” in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

II. Rights or Legitimate Interests

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (ii) the respondent has no rights or legitimate interests in respect of the domain name.

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant and there is no indication that the Respondent is commonly known by the term “INTESSASANPAOLO” or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. There is also no evidence, that the Respondent is making a legitimate non-commercial 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.

The Panel therefore considers that 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).

III. Registered and Used in Bad Faith

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (iii) the domain name has been registered and is being used in bad faith.

The Respondent has registered the disputed domain name which consists of the Complainant’s trademarks “INTESA” and “INTESA SANPAOLO”. There are no doubts that the Complainant’s trademarks are distinctive and well-known. It could be therefore concluded that the domain name has been registered in bad faith as the Respondent had or should have the Complainant and its prior trademark rights in mind when registering the disputed domain name. Moreover, it is clear that the duplication of one letter “S” has been made intentionally by the Respondent as there is no good reason for such duplication within the disputed domain name.

It is clear, that the disputed domain name is a typosquatting variant of the Complainant's trademarks. Use of the disputed domain name could, therefore, attract the internet users to the corresponding web page by creating a likelihood of confusion with the Complainant's trademark (paragraph 4(b)(iv) of the Policy). Although there is no evidence that the disputed domain name has been used for phishing or other illegal activities, the use of the disputed domain name visually and alphabetically almost identical to the Complainant's trademarks could lead to the confusion of the web page visitors.

Considering the (i) similarity between the Complainant's trademarks and the disputed domain name, (ii) obviously intentional duplication of one letter, (iii) distinctiveness of the Complainant's trademarks, (iv) passive holding of the disputed domain name without any reference to the active website and (v) the failure of the Respondent to submit a response or to provide any evidence of good faith use, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

Thus, 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).

The Panel considers that the Complainant has shown that the disputed domain name <intessasanpaolo.top> is confusingly similar to trademarks in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESSASANPAOLO.TOP**: Transferred
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PANELLISTS

Name	JUDr. Petr Hostaš
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DATE OF PANEL DECISION	2022-09-15
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Publish the Decision
