

Decision for dispute CAC-UDRP-105156

Case number	CAC-UDRP-105156
Time of filing	2023-02-01 09:05:41
Domain names	IONTESASANPAOLO.COM

Case administrator

Name	Olga Dvořáková (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	lin yanfei
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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

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

- International trademark registration n. 920896 "INTESA SANPAOLO", dated of March 7, 2007, duly renewed, for goods and services in classes 9, 16, 35, 36, 41 and 42;
- International trademark registration No. 793367 "INTESA", dated of September 4, 2002, duly renewed, for goods and services in class 36;
- EU trademark registration No. 5301999 "INTESA SANPAOLO", dated of June 18, 2007, duly renewed, for goods and services in classes 35, 36 and 38;
- EU trademark registration No. 12247979 "INTESA", dated of October 23, 2013, dated of March 5, 2014, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42.

In addition, Complainant owns a large number of domain names, including <intesasanpaolo.com>, <intesa-sanpaolo.com> and <intesa.com>. All of these are connected to the official website <http://www.intesasanpaolo.com>.

FACTUAL BACKGROUND

Complainant is the leading Italian banking group and also one of the central figures in the European financial area. Intesa Sanpaolo

was founded in 2007 by the merger of Banca Intesa and Sanpaolo IMI, two top Italian banking groups.

Complainant is one of the euro zone's top banking groups and the Italian leader of all business areas (retail, corporate and wealth management). Complainant has a strong presence in Central-Eastern Europe with a network of approximately 950 branches.

Complainant has an international network specialized in supporting business in 25 countries, in particular in the Mediterranean area and the areas in which Italian companies are most active, such as United States, Russia, China and India.

The Disputed Domain Name <iontesasanpaolo.com> was registered by Respondent on October 20, 2022, in China.

PARTIES CONTENTIONS

1. Complainant

Firstly, Complainant argues that the Disputed Domain Name is identical or, at least, confusingly similar to its trademark "INTESA SANPAOLO", as it includes the Complainant's trademark in its entirety, based on Respondent's typosquatting practice.

Complainant states that the misspelling of the trademark "INTESA SANPAOLO", i.e. the addition of the letter "O" in the trademark's verbal term "INTENSA", is characteristic of a typosquatting practice intended to create confusing similarities between Complainant's trademark and the Disputed Domain Name.

Complainant further affirms that Respondent has no rights or legitimate interests in the Disputed Domain Name. Complainant states that it has not granted any license nor any form of authorization to anybody in order to register the Disputed Domain Name.

Complainant contends that Respondent is not commonly recognized by the Disputed Domain Name and argues that Respondent has no legitimate or non-commercial reasons for using it.

Finally, Complainant alleges that Respondent registered and used the Disputed Domain Name in bad faith. Complainant contends that Respondent was aware of Complainant's trademark at the time of registration and deliberately registered the Disputed Domain Name to create confusion among internet users and divert traffic away from Complainant's website.

2. Respondent

Respondent did not reply to Complainant's contentions and is therefore in default.

RIGHTS

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).

Complainant must prove that the Disputed Domain Name is confusingly similar to the registered trademark in which the Complainant has rights.

The possession of an international registered trademark is considered as initial proof that the complainant holds trademark rights. According to Annex, this trademark is notably protected in China where Respondent is based.

The Disputed Domain Name wholly incorporates Complainant's "INTESA SANPAOLO" trademark, having added an "O" between the letters "I" and "N". It is well-established that the addition of other letters to Complainant's trademark does not prevent a finding of confusing similarity between a domain name and said trademark. This alteration constitutes an act of typosquatting.

Moreover, the extension ".com" is not to be taken into consideration when examining the identity or similarity between Complainant's registered trademark and the Disputed Domain Name, as it is viewed as a standard registration requirement. Indeed, it is well known that the gTLD is insufficient to avoid a finding of confusing similarity.

For the aforementioned reasons, the Panel finds that the Disputed Domain Name is confusingly similar to Complainant's trademark and therefore the condition of paragraph 4(a)(i) is fulfilled.

NO RIGHTS OR LEGITIMATE INTERESTS

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).

Complainant must first make out a prima facie case showing that Respondent lacks rights and legitimate interests in respect of the Disputed Domain Name and then the burden of proof shifts to Respondent to come forward with evidence of rights or legitimate interests. If Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. In the present case,

Respondent did not submit arguments in response to the complaint.

Respondent has no association with Complainant and has not received permission to use the registered trademark or to register any domain name that includes the trademark "INTESA SANPAOLO". Additionally, Respondent cannot claim prior rights or legitimate interest in the Disputed Domain Name as the registered trademark precedes the registration of the Disputed Domain Name.

In addition, Respondent's use of the Disputed Domain Name to redirect users to its website, displaying competing content from Complainant's website, does not support the possibility to foresee rights or legitimate interests (See Section 2.5.3 WIPO Jurisprudential Overview 3.0).

Finally, there is no evidence that Respondent has become commonly known by the term "Intensa Sanpaolo", in accordance with paragraph 4(c)(ii) of the Policy. As the Disputed Domain Name is confusingly similar to Complainant's well-known registered trademark, Respondent cannot plausibly pretend he was intending to develop a legitimate activity through the Disputed Domain Name.

Having considered the above circumstances, the Panel finds that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

BAD FAITH

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).

1) Registration in bad faith

Bad faith can be found where Respondent "knew or should have known" of Complainant's trademark rights and, nevertheless registered a domain name in which they had no rights or legitimate interests (see for instance *Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*, WIPO Case No. D2009-0320 and *The Gap, Inc. v. Deng Youqian*, WIPO Case No. D2009-0113).

Given Complainant's worldwide presence and its trademark registrations all around the world, the Panel finds it strongly unlikely that Respondent was not aware of Complainant's rights in said trademark. The Panel considers that the trademark is well known and that with a simple Google search, Respondent could have known the existence of Complainant.

Previous UDRP panels have also found that "the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith" (See section 3.1.4 of the WIPO Overview 3.0). The Disputed Domain Name corresponds with typosquatting as it incorporates Complainant's trademarks and adding the letter "O" between "I" and "N".

The Panel finds it implausible that Respondent was unaware of Complainant when it registered the disputed domain name.

Therefore, the Panel finds that Respondent has registered the Disputed Domain Name in bad faith.

2) Use in bad faith

The Disputed Domain Name is not used for any bona fide offerings. Specifically, there are current circumstances that suggest that Respondent has deliberately tried to lure Internet users to their website for commercial gain by utilizing the Disputed Domain Name, creating a high probability of confusion with Complainant's trademark regarding the source, sponsorship, affiliation, or endorsement of their website (as per paragraph 4(b)(iv) of the Policy).

The website affiliated to the Disputed Domain Name offered, among others, banking and financial services which are the services provided by Complainant. When Internet users search for information about the services offered by Complainant they come across the website of Complainant's competitor.

Several WIPO decisions have maintained that using the Disputed Domain Name to intentionally divert traffic away from Complainant's website is evidence of bad faith (See *YAHOO! INC. v. David Murray*, Case No. D2000-1013).

Complainant considers that this may create significant damage to these businesses due to the misleading of current customers and the loss of potential new ones (see WIPO Decisions n. D2000-1500, *Microsoft Corporation v. StepWeb*, and D2001-1335, *The Vanguard Group, Inc v. Venta*). It seems that Respondent used the notoriety of Complainant's trademark to increase its commercial gain; it seems clear that the sponsoring is being remunerated.

According to Complainant, it is common for banks to be targeted by this type of practice because of the large number of online banking users. This is not the first time that Complainant has found itself in the situation where WIPO has ordered the transfer or cancellation of the domain name for bad faith registration (see *Intesa Sanpaolo S.p.A v. Kara Turner*, WIPO Case No. D2018-0639 and *Intesa Sanpaolo S.p.A v. Above.com Domain Privacy*, WIPO Case No. D2015-2289).

In light of the above, the Panel finds that Respondent registered and uses the Disputed Domain Name in bad faith under paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

Complaint was filed with the Forum on January 30, 2023. On the same day, the CAC transmitted a request for registrar verification to the Registrar by email. The CAC sent an email communication to Complainant, on February 1, 2023, providing information disclosed by the Registrar. Complainant filed an amendment to the Complaint within the appointed deadline.

In accordance with the rules, the CAC formally notified Respondent of Complaint, and the proceedings commenced on February 1, 2022. Respondent did not submit any response. Respondent's default was notified on February 23, 2023.

The Forum appointed Nathalie Dreyfus as the sole panelist in this matter on February 23, 2023. The Panel found that it was properly constituted and submitted the Statement of Acceptance and Declaration of Impartiality and Independence.

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

1/ The Panel finds that the Disputed Domain Name is confusingly similar to Complainant's "INTESA SANPAOLO" trademark and the construction of the Disputed Domain Name shows typosquatting.

2/ The Panel finds that Complainant has succeeded in proving that Respondent has not used the Disputed Domain Name in good faith, that Respondent is not making fair use of the Disputed Domain Name, and that Respondent is not commonly known by the Disputed Domain Name. Rather, the Disputed Domain Name has been used for misleading the Complainant's customers, which therefore, cannot constitute a right or legitimate interest in the Disputed Domain Name.

3/ Finally, the Panel recognizes that the Disputed Domain Name was registered in bad faith, as Respondent must have been aware of the existence of the trademark while offering similar services. Moreover, the Disputed Domain Name is used in bad faith because it deliberately diverts traffic from Complainant's website, with the risk that this may cause damage to Complainant.

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name <iontesasanpaolo.com> be transferred to Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **IONTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	Nathalie Dreyfus
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DATE OF PANEL DECISION **2023-03-15**

Publish the Decision
