

Decision for dispute CAC-UDRP-105219

Case number	CAC-UDRP-105219
Time of filing	2023-02-23 10:51:17
Domain names	SANPAOLO-INTESA-IT.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

Organization	Netlify Inc
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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 bases its Complaint on the following trademark registrations:

- International trademark registration "INTESA SANPAOLO", no. 920896, registered on 07.03.2007, for goods and services in classes 9, 16, 35, 36, 41, 42, designating several countries for protection;
- International trademark registration "INTESA", no. 793367, registered on 04.09.2002, for services in class 36, designating several countries for protection;
- EU trademark registration "INTESA SANPAOLO", no. 5301999, filed on 08.09.2006, registered on 18.06.2007, for services in classes 35, 36 and 38;
- EU trademark registration "INTESA", no. 12247979, filed on 23.10.2013, registered on 05.03.2014, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42.

In addition, the Complainant holds the following domain names which include the denominations "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 connected to the official website

FACTUAL BACKGROUND

The Complainant is Intesa Sanpaolo S.p.A., a 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 capitalisation exceeding 45,8 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,600 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 13,6 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 950 branches and over 7,1 million customers. Moreover, the international network specialised 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 owns trademarks „INTESA SANPAOLO” and „INTESA” as well as a portfolio of domain names „INTESA SANPAOLO” and „INTESA”.

The disputed domain name was registered on 30.05.2022.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT'S CONTENTIONS:

The Complainant's contentions are the following:

The disputed domain name SANPAOLO-INTESA-IT.COM is identical, or – at least – confusingly similar, to the Complainant's trademarks “INTESA SANPAOLO” and “INTESA”. The Complainant sustains that the disputed domain name reproduces exactly the well-known trademark “INTESA SANPAOLO”, with the mere inversion of the mark's verbal elements “INTESA” and “SANPAOLO” and the addition of the acronym “IT” (which represents the abbreviation of the geographical term "ITALY", the country in which is located Intesa Sanpaolo's headquarters).

Further, the Complainant considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

To this end, the Complainant asserts that the Respondent has no rights on the disputed domain name and any use of the trademarks “INTESA SANPAOLO” and “INTESA” has not been authorized or licensed by the Complainant.

Further, the Complainant asserts that the domain name at stake does not correspond to the name of the Respondent and, to the best of its knowledge, the Respondent is not commonly known as “SANPAOLO-INTESA-IT.COM”.

Lastly, the Complainant asserts that it does not find any fair or non-commercial uses of the domain name at stake.

The Complainant further argues that the disputed domain name has been registered and is used in bad faith.

The Complainant's asserts that that its “INTESA” and “INTESA SANPAOLO” trademarks are distinctive and well known and therefore, that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks.

In the Complainant's view, the fact that the Respondent has registered a domain name that is confusingly similar to “INTESA” and “INTESA SANPAOLO” trademarks indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name.

In addition, the Complainant asserts that, if the Respondent had carried a basic Google search in respect of the denominations “INTESA SANPAOLO” and “INTESA”, obvious references to the Complainant were to be found.

The Complainant further contends that, the disputed domain name is not used for any *bona fide* offerings and that there are circumstances indicating that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site.

The Complainant asserts that several services can be detected in relation to the disputed domain name, but none in good faith, the disputed domain name being connected to a website sponsoring, among others, banking and financial services, for whom the Complainant's trademarks are registered and used.

Therefore, the Complainant contends that Internet users, while searching for information on the Complainant's services, are confusingly led to the websites of the Complainant's competitors, sponsored on the websites connected to the disputed domain name, which the Competitor mentions that it causes great damages to such, due to the misleading of their present clients and to the loss of potential new ones.

Consequently, the Complainant considers that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant's web site.

In the light of the above, the Complainant considers that the Respondent has engaged in abusive domain name registration and use.

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

I. Confusing Similarity

The Panel agrees that the disputed domain name incorporates the Complainant's earlier "INTESA SANPAOLO" and "INTESA" trademarks and the reversal of the mark's verbal elements "INTESA" and "SANPAOLO" as well as the addition of the acronym "IT" (which represents the abbreviation of the geographical term "ITALY", the country in which the Complainant's headquarters is located) is insufficient to avoid a finding of confusing similarity.

Moreover, the extension ".com" is not to be taken into consideration when examining the similarity between the Complainant's trademarks and the disputed domain name (WIPO Case No. D2005-0016, *Accor v. Noldc Inc.*). The mere adjunction of a gTLD such as ".com" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, *L'Oréal v Tina Smith*, WIPO Case No. D2008-0820 *Titoni AG v Runxin Wang* and WIPO Case No. D2009-0877, *Alstom v. Itete Peru S.A.*).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

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 burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its trademarks, nor of a confusingly similar trademark in the disputed domain name.

No bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name was proven.

The Panel notes that the Respondent had an opportunity to comment on the Complaint's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

Based on the provided proofs, the Complainant's trademark "INTESA SANPAOLO" is a well known one and the disputed domain name is incorporating in its entirety the Complainant's trademark even if reversed to which it was added the acronym "IT" (which represents the abbreviation of the geographical term "ITALY", the country in which the Complainant's headquarters is located). Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark and has intentionally registered one in order to benefit from the reputation of the Complainant's trademark.

The disputed domain name appears to be connected to a website sponsoring, among others, for banking and financial services, for whom the Complainant's trademarks are registered and used.

Therefore, Internet users, while searching for information on the Complainant's services, could be confusingly led to the websites of the Complainant's competitors, sponsored on the websites connected to the disputed domain name, which supports a finding of bad faith.

In the present case, the following factors should be considered:

(i) the Complainant's trademark is a well-known one;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;

(iii) the Respondent registered the disputed domain name by incorporating in its entirety the Complainant's trademark even if reversed to which it was added the acronym "IT" (which represents the abbreviation of the geographical term "ITALY", the country in which the Complainant's headquarters is located); and

(iv) any good faith use of the disputed domain name would be implausible, as the trademark INTESA SANPAOLO is univocally linked to the Complainant and the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name confusingly similar to the Complainant's trademark.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SANPAOLO-INTESA-IT.COM**: Transferred

PANELLISTS

Name	Delia-Mihaela Belciu
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DATE OF PANEL DECISION 2023-04-03

Publish the Decision
