

Decision for dispute CAC-UDRP-105473

Case number	CAC-UDRP-105473
Time of filing	2023-05-31 12:56:33
Domain names	INTESASANPAOLOL.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	Jiri Capcuch
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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 has established by evidence that the Panel accepts that it is the owner the following registered trademarks for INTESA SANPAOLO:

- International trademark registration n. 920896 for INTESA SANPAOLO, granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration n. 5301999 for INTESA SANPAOLO, filed on September 8, 2006, granted on June 18, 2007 and duly renewed, in connection with the classes 35, 36 and 38.

FACTUAL BACKGROUND

The Complainant is a leading Italian banking group and a prominent member of the European financial community that has an extensive network of branches and millions of customers and is very active internationally.

It owns a series of registered trademarks for INTESA SANPAOLO and a series of domain names that it uses in its business. It has come to the notice of the Complainant that the Respondent has registered the domain name <intesasanpaolol.com> ("the disputed domain name") which is clearly a copy of the Complainant's trademark, to which the Respondent has added the letter "l" and caused it to resolve to a website sponsoring banking and financial services, for which the Complainant's INTESA SANPAOLO trademark is

registered and used and to the websites of the Complainant's competitors. This is clearly confusing to the Complainant's customers and potential customers and disruptive of the Complainant business. Accordingly, it has brought this proceeding to have the domain transferred to itself. The Respondent has not filed a Response.

PARTIES CONTENTIONS

A. COMPLAINANT

The Complainant made the following contentions.

1. The Complainant is a leading Italian banking group and a prominent member of the European financial community.
2. It has an extensive network of branches and millions of customers and is very active internationally.
3. The Complainant also owns many domain names that reflect the INTESA SANPAOLO trademarks, such as <intesasanpaolo.com>, which it uses in its business.
4. The Respondent registered the domain name <intesasanpaolol.com> ("the disputed domain name") on January 26, 2023.
5. The disputed domain name is virtually identical, or at least confusingly similar, to the Complainant's INTESA SANPAOLO trademarks, as the only difference between the domain name and the trademarks is the addition of the letter "l" to the trademarks. Thus, in registering the domain name, the Respondent has engaged in typosquatting, a practice that has been demonstrated in many prior UDRP decisions.
6. The Respondent has no right or legitimate interest in the disputed domain name. That is because the Complainant has not authorized the Respondent to make any use of nor granted any licence to it to use the INTESA SANPAOLO trademarks and to register a domain name incorporating the INTESA SANPAOLO trademarks.
7. Moreover, it is apparent that the Respondent is not commonly known by the disputed domain name.
8. Further, the Respondent has not made any fair or non-commercial use of the disputed domain name.
9. The Respondent has registered and used the disputed domain name in bad faith.
10. The INTESA SANPAOLO trademarks are distinctive and well known all around the world. Therefore, the Respondent must have had actual knowledge of the trademarks at the time of registration of the disputed domain name.
11. If the Respondent had carried a basic Google search in respect of the wordings INTESA SANPAOLO the same would have yielded obvious references to the Complainant and its mark. 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 which is clear evidence of registration of the domain name in bad faith.
12. In addition, the disputed domain name is not used for any *bona fide* offerings. Thus, it must be concluded that the Respondent intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its web site (par. 4(b)(iv) of the Policy) which amounts to registration and use of the domain name in bad faith.
13. Moreover, the domain name is linked to a website sponsoring banking and financial services, for which the Complainant's INTESA SANPAOLO trademarks are registered and used.
14. Likewise, 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.
15. Therefore, the Complainant submits that the Respondent has registered and is using the domain name to divert traffic away from the Complainant's web site and is doing so intentionally.
16. The validity of those contentions is supported by numerous prior UDRP decisions in many in which the Complainant has been a complainant.
17. The current use of the disputed domain name, which allows access to the web sites of the Complainant's competitors, also causes great damage to the Complainant, due to misleading its present clients and the loss of potential new customers.
18. The Respondent's commercial gain in that regard is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated.
19. This practice of diversion is now very frequent due to the high number of online banking users and there is a public interest in stopping it by the order the Complainant now seeks, namely transfer of the domain name to the Complainant.

B. RESPONDENT

The Respondent did not file a Response in this proceeding.

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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy ("the Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules"), and the CAC Supplemental Rules.

A. Administrative compliance

By notification dated May 31, 2023 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint did not sufficiently identify the Respondent. The notification invited the Complainant to have regard to the Registrar's verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder. Also on May 31, 2023, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

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.

The Panel will therefore deal with each of these requirements in turn.

Identical or Confusingly Similar.

The Complainant has adduced evidence that the Panel accepts that it is the registered owner of the INTESA SANPAOLO trademarks and as such has rights in those trademarks.

The Panel next finds that the Respondent registered the disputed domain name <intesasanpaolol.com> ("the disputed domain name") on January 26, 2023.

The disputed domain name is virtually identical or at least confusingly similar, to the Complainant's INTESA SANPAOLO trademarks for the following reasons.

First, the domain name includes the entirety of the trademarks and does not include any wording other than the trademarks, except that the letter "l" has been added to the trademarks which is a minor alteration. Accordingly, the domain name would inculcate in the mind of any internet user who saw it that it was in fact the well-known INTESA SANPAOLO trademark and hence an official domain name of the Complainant that would lead to an equally official website of the Complainant.

Secondly, taken as a whole, the domain name would convey to the objective bystander that it related to the activities of the Complainant, giving rise to inevitable confusion.

It is also now well established that the addition of a generic top level domain, such as ".com" in the present case, cannot negate the confusing similarity that is otherwise present, as it is in this case.

Accordingly, the Panel finds that the domain name is confusingly similar to the Complainant's INTESA SANPAOLO trademark. The Complainant has thus shown the first of the three elements that it must establish.

Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate noncommercial 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests and that when such a *prima facie* case is made out, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent cannot do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name .

That *prima facie* case is made out from the following considerations.

The evidence of the Complainant is that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant nor authorized by it in any way to use the INTESA SANPAOLO trademarks and does not carry out any activity for, nor has any business with, the Complainant.

It is also clear from the evidence that the Respondent is not commonly known by the domain name under Policy ¶ 4(c)(ii).

Moreover, the essence of this proceeding is that the Respondent has engaged in typosquatting, which means that it has deliberately altered the spelling of the trademark to deceive and trick internet users into thinking that the domain name is an official domain name of the Complainant and that it will lead to an official website of the Complainant, neither of which is true. Clearly, such conduct cannot give rise to a right or legitimate interest in the domain name.

Also, the domain name is linked to a website sponsoring banking and financial services, for which the Complainant's INTESA SANPAOLO trademarks is registered and used.

Likewise, 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.

Therefore, the Complainant submits that the Respondent has registered and is using the domain name to divert traffic away from the Complainant's web site and is doing so intentionally. The Panel agrees and notes that such conduct could never give rise to a right or

legitimate interest in the disputed domain name and the Panel finds that it does not do so in the present case.

Those propositions are supported by many prior UDRP decisions.

These facts give rise to the *prima facie* case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the *prima facie* case has not been rebutted and the Complainant has therefore made out the second of the three elements that it must establish.

Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (i) 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 that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b) (iv) of the Policy and probably within other provisions of paragraph 4 (b) as well.

That is so for the following reasons.

The Complainant first submits that it is reasonable to infer that Respondent was aware of Complainant and its well-known trademark at the time of registration of the disputed domain name. The Panel agrees. Because of the fame and strong reputation of the INTESA SANPAOLO trademarks, the Respondent must have been aware of the existence of the Complainant and its reputation when it registered the disputed domain name. The Panel finds that it is highly likely that the Respondent chose the trademark to invoke the concept of the Complainant, its fame and its activities. By that means the Respondent, in registering the domain name deceptively and without any authority to do so, must be taken to have created a likelihood of confusion, with the intention of attracting current and potential customers of the Complainant looking for its services and doing so in this misleading manner. Accordingly, the domain name was registered in bad faith.

Secondly, and as already noted, the Complainant submits that the disputed domain name is linked to a website sponsoring banking and financial services, for which the Complainant's INTESA SANPAOLO trademark is registered and used. Likewise as the Complainant also submits, internet users, while searching for information on the Complainant's services, may well be confusingly led to the websites of the Complainant's competitors, sponsored on the websites connected to the disputed domain name. The Panel accepts the Complainant's evidence to that effect. Thus, the Complainant contends that the Respondent registered the disputed domain name primarily for the purpose of deceptively attracting internet users to its own website, whether existing or potentially new customers of the Complainant and for commercial gain. That conduct is clearly in bad faith and the Panel so holds. The Panel also notes that there are many UDRP decisions to that effect.

Thirdly, all of this evidence brings the case squarely within paragraph 4(b)(iv) of the UDRP, i.e. "by using the domain name, (the Respondent) ... intentionally attempted to attract, for commercial gain, Internet users to (its) web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of (its) web site or location or of a product or service on (its) web site or location".

Fourthly, the conduct of the Respondent also amounts to a probable intention to try to sell the domain name within the meaning of paragraph 4(b)(i), intending to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name within the meaning of paragraph 4(b) (ii) and intending to disrupt the business of the Complainant within the meaning of paragraph 4(b)(iii).

Fifthly, in addition and having regard to the totality of the evidence, the Panel finds that, in view of the Respondent's registration of the disputed domain name using the INTESA SANPAOLO mark and in view of the conduct that Respondent has engaged in when using the domain name, the Respondent registered and used it in bad faith within the generally accepted meaning of that expression. Such conduct has been held by previous UDRP panels to constitute bad faith registration and use.

Finally, as the Complainant points out, the rise of internet banking means that financial institutions are particularly prone to the type of attack demonstrated by this proceeding. There is therefore a definite public interest in stamping it out.

Accordingly, the Complainant has shown the third of the three elements that it must establish, has established all such elements and is entitled to the relief that it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **INTESASANPAOLOL.COM**: Transferred

PANELLISTS

Name	Neil Brown
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DATE OF PANEL DECISION	2023-06-26
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Publish the Decision