

## Decision for dispute CAC-UDRP-105566

Case number	CAC-UDRP-105566
Time of filing	2023-06-26 10:52:35
Domain names	INTESASANPAOLO-SICUREZZA-ONLINE.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	Statutory Masking Enabled
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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 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;
- 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>.

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## FACTUAL BACKGROUND

The Complainant is the leading Italian banking group and also one of the protagonists in the European financial area. 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 39,4 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,500 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.

On December 8, 2022, the Respondent registered the disputed domain name INTESASANPAOLO-SICUREZZA-ONLINE.COM.

The website behind the disputed domain name contained a contact form, to which the notification about the UDRP proceeding in case 105566 was sent. The CAC has received a response from the disputed site in which they stated: we are merely a domain name platform and do not account for the domain name owner.

In the view of Complainant, it is more than obvious that the disputed 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, INTESASANPAOLO-SICUREZZA-ONLINE.COM exactly reproduces the well-known trademark "INTESA SANPAOLO", with the mere addition of the terms "SICUREZZA" (the Italian translation of "security") and "ONLINE", that are merely descriptive.

The Complainant states that 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 at issue.

The disputed domain name does not correspond to the name of the Respondent and, to the best of Complainant's knowledge, the Respondent is not commonly known as "INTESASANPAOLO-SICUREZZA-ONLINE".

The disputed domain name was furthermore in the view of the Complainant registered and is used in bad faith.

The Complainant states that its trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and well-known 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. In the view of Complainant, 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 disputed domain name in bad faith.

In addition, the contested domain name is in the view of the Complainant not used for any bona fide offerings. More particularly, there are present circumstances indicating that the Respondent has registered or acquired the disputed 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 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 Complainant states that the disputed domain name redirects to a parking page in which the same is offered for sale.

In the view of Complainant it is no coincidence that this speculation has involved a big financial institution such as Intesa Sanpaolo. In fact, the diversion practice in banking realm is very frequent due to the high number of online banking users. In fact, it has also to be pointed out that the Complainant has already been part of other WIPO Cases where the Panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations.

On February 7, 2023, the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the disputed domain name at issue. Despite such communication, the Respondent did not comply with the above request.

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## PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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## 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).

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#### 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).

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#### 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).

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#### 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.

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#### PRINCIPAL REASONS FOR THE DECISION

##### 1. Identical or confusingly similar with Complainant's trademark

The Complainant owns "Intesa Sanpaolo" trademark registrations effective in various jurisdictions.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain name incorporates the entire Complainant's trademark "Intesa Sanpaolo", it is obvious that the disputed domain name at issue is confusingly similar, to the Complainant's trademarks "INTESA SANPAOLO". As a matter of fact, INTESASANPAOLO-SICUREZZA-ONLINE.COM exactly reproduces the well-known trademark "INTESA SANPAOLO", with the mere addition of the terms "SICUREZZA" (the Italian translation of "security") and "ONLINE", that are merely descriptive.

As stated in WIPO Overview 3.0 "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element" (see par. 1.8).

In the present case, the Complainant's trademark is clearly recognizable, because it is at the beginning of the disputed domain name. The addition of the generic word "SICUREZZA" and "ONLINE" does not lead to a different conclusion.

The .com domain zone shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

##### 2. Rights or Legitimate Interests

The Respondent did not respond.

When a respondent remains completely silent in the face of a prima facie case that it lacks any rights or legitimate interests in respect of a domain name, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. Here the Complainant has presented an abundance of evidence to show that the Respondent has no plausible right or legitimate interest in respect of the disputed domain name and the Panel so finds.

The disputed domain name redirects to a parking page and it is offered for sale and previous panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use (see e.g. CAC Case No. 102862 and WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe).

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

##### 3. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

The Panel believes that the Respondent registered the disputed domain name with full knowledge of Complainant's rights. The disputed domain name was registered more than ten years after the registration of the trademarks and the domain names of the Complainant and Complainant used it widely since then.

Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. If the Respondent had carried even a basic Google search in respect of the wording "INTESA SANPAOLO", the same would have yielded obvious references to the Complainant.

Besides, the evidence on record shows that the disputed domain name redirects to a parking page with commercial links. Respondent's use of the disputed domain name for a parking page is in itself sufficient to support a finding of bad faith use as Respondent is intentionally attempting to attract Internet users to its website for commercial gain, and is thus creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's website, in accordance with paragraph 4(b) (iv) of the Policy.

More particularly, there are present circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the Complainant who is the owner of the trademark or service mark or to a competitor of 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 offered for sale at a price of US \$ 699.00, which is more than out-of-pocket costs directly related to the disputed domain name.

First of all, it must be underlined that several WIPO decisions ascertained how "Although Respondent's offer of the disputed Domain Name for sale was not made specifically to Complainant or its competitor, offers for sale to the public may nevertheless constitute evidence of bad faith under the Policy" (United Artists Theatre Circuit Inc. v. Domains for Sale Inc., WIPO Case No. D2002-0005, March 27, 2002).

It is also true that "The sole fact that the disputed domain names have been registered by a person that does not use them but publicly offers them for rent or sale is the most perfect evidence of a bad faith activity in prejudice of Internet community and of the owner of the trademarks used as domain names" (TV Globo Ltda. v. Radio Morena, WIPO Case No. D2000-0245).

The Panel, therefore, accepts the Complainant's submissions that the disputed domain name was primarily registered for the purpose of selling, renting it to a third party 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).

Paragraph 4(b) of the Policy also provides a non-exhaustive list of circumstances that can constitute evidence of a Respondent's bad faith in registering and using a disputed domain name. In particular, the consensus view of WIPO UDRP panelists is that bad faith may in, some cases, be found in other conducts carried out by a domain name holder. 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 trademark rights.

In light of the above, the present case completely matches the above requirements: "The Panel accepts the Complainant's submissions that [...] it is not possible for the Respondent to have been unaware of the Complainant's [...] brand and associated trademarks prior to registering the Domain Name. As a consequence, the Panelist finds that in registering the Domain Name, the Respondent was aware of the Complainant's [...] brand and associated trademarks. Given the above information [...] the Panelist can find no plausible circumstances in which the Respondent could legitimately use the Domain Name" (see Microsoft Corporation v. Superkey Worldwide, Inc. - Case No. D2004-0071).

Lastly, on February 7, 2023, the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the disputed domain name at issue. Despite such communication, the Respondent did not comply with the above request. This can also in the proceeding at hand be seen as bad faith under the Policy.

In light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

**Accepted**

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

**1. INTESASANPAOLO-SICUREZZA-ONLINE.COM: Transferred**

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## PANELLISTS

Name **Jan Schnedler**

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DATE OF PANEL DECISION **2023-07-20**

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Publish the Decision

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