

Decision for dispute CAC-UDRP-105660

Case number	CAC-UDRP-105660
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Time of filing	2023-07-25 10:22:30
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Domain names	INTESSABANCA.COM
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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	Privacy service provided by Withheld for Privacy ehf
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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” and “BANCA INTESA”:

- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in connection with class 36;
- International trademark registration n. 831572 “BANCA INTESA (logo)”, granted on June 24, 2004 and duly renewed, in connection with class 36;
- 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;
- EU trademark registration n. 2987220 “BANCA INTESA (logo)”, filed on December 23, 2002 and granted on January 26, 2004, and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42.

The Complainant is also the owner, among the others, of the following domain names bearing the signs “INTESA” and “BANCA INTESA”: <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, BANCAINTESA.COM, BANCAINTESA.INFO, BANCAINTESA.BIZ, BANCAINTESA.ORG, BANCAINTESA.US, BANCAINTESA.EU, BANCAINTESA.CN, BANCAINTESA.IN, BANCAINTESA.CO.UK, INTESABANCA.COM, INTESABANCA.INFO, INTESABANCA.NET, INTESABANCA.IT>.

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

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.

The Complainant is among the top banking groups in the euro zone, with a market capitalisation exceeding 43,9 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). It has 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 13,5 million customers and has a strong presence in Central-Eastern Europe with a network of approximately 950 branches and over 7,1 million customers. The Complainant's 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 July 2, 2023, the Respondent registered the disputed domain name <INTESSABANCA.COM>.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("Policy") and seeks relief that the disputed domain name be transferred to the Complainant.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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).

The Panel accepts that the Complainant has rights by reason of its ownership of the registered trademarks "INTESA" and "BANCA INTESA". The question is whether the disputed domain name is identical or confusingly similar to the Complainant's trademarks.

Whether a disputed domain name is identical or confusingly similar to a trademark can be determined by making a side-by-side comparison with the disputed domain name. A disputed domain name is identical to the trademark when it is a character for character match. It is confusingly similar when it varies the trademark by, for example, adding generic terms to the dominant part of the trademark.

When part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner. It is, therefore, sufficient to establish identity or confusing similarity for the purposes of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0902; *Dr. Ing. h.c. F. Porsche AG v Vasily Terkin*, WIPO Case No D2003-003-0888.

The Complainant contends that 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" and "BANCA INTESA". It further contends that "INTESSABANCA" exactly reproduces the well-known trademark "BANCA INTESA", with the mere inversion of the terms "BANCA" and "INTESA" and the doubling of the letter "S" in the mark's verbal portion "INTESA", representing a clear example of typosquatting. See WIPO decision *Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc*, Case n. D2001-1314.

The Panel considers the use of the terms "BANCA" and "INTESA" by the inversion or by interchanging the order is a clear example of typosquatting. The slight variation here is the additional of the letter "S" to the trademark "INTESA". Accordingly, the Panel accepts the Complainant's contention

It is also trite to state that the addition of the gTLD ".COM" does not add any distinctiveness to the disputed domain name and will be disregarded for the purposes of considering this ground.

Accordingly, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademarks "INTESA" and "BANCA" and this ground is made out.

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).

The Complainant contends that it has not authorised or licensed the Respondent to use any of the trademarks “INTESA” and “BANCA INTESA”, and has no rights in the disputed domain name. The Panel accepts this uncontradicted contention.

The Complainant also asserts that the disputed domain name does not correspond to the name of the Respondent and, to the best of its knowledge, the Respondent is not commonly known as “INTESSABANCA”. It also asserts that it could not find any fair or non-commercial uses of the disputed domain name.

No challenge has been made by the Respondent to the Complainant’s contentions and assertions as it has not filed any administrative compliant response.

Given the evidence adduced by the Complainant of its portfolio of trademarks and wide reputation which the Panel accepts as evidencing the strength of its reputation, the Panel accepts and finds that the Respondent has no rights or legitimate interests to the disputed domain name.

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).

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The Complainant’s contends that trademarks “INTESA” and “BANCA INTESA” are distinctive and well known all around the world. The Panel accepts this assertion based on the evidence adduced.

As for registration of the disputed domain name, the Complainant contends that the Respondent registered a domain name that is confusingly similar to their trademarks which indicates that the Respondent had knowledge of the Complainant’s trademarks at the time of registration of the disputed domain name.

The Complainant asserts that if the Respondent had carried even a basic Google search in respect of the wordings “INTESA” and “BANCA INTESA”, the same would have yielded obvious references to the Complainant.

The Panel considers that this evidence raises a clear inference of knowledge of the Complainant’s trademarks on the part of the Respondent.

Accordingly, the Panel accepts that the uncontradicted evidence that supports the contention that the registration of the disputed domain name was made in bad faith.

Use in bad faith

The Complainant asserts that the disputed domain name is not used for any bona fide offerings, but it is connected to a website that reproduced a page from “Corriere della Sera” (an historical Italian newspaper). The main topic of the article is a false relationship between Intesa Sanpaolo Bank and the trading software “Bitcoin Bank”.

The Complainant further asserts that in the landing page there are numerous links to another page where it is possible to finalize the hypothetical investment. The evidence adduced suggests that the site linked to <INTESSABANCA.COM> was changed into a web page with no active contents, following the Complainant’s request to remove the abusive content sent to the disputed domain name’s Registrar and Hosting Provider.

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, particularly when 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. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

The Panel is prepared to draw the inference from the evidence adduced that the disputed domain name is or was not used for any bona fide offerings, even if it is not connected to any web site. This is further bolstered by the evidence showing the Respondent’s passive holding of the disputed domain name with no active content after a complaint was made.

As the Panel has already made the above finding, it is unnecessary to consider the Complainant’s further assertions relating to potential “phishing” or resale of the disputed domain name to the Complainant due to the lack of any evidence to support these assertions. A mere possibility is insufficient evidence.

No challenge has been made by the Respondent to the Complainant’s contentions and assertions as it has not filed any administrative

compliant response.

Accordingly, the Panel accepts that the disputed domain name was registered by the Respondent and used in bad faith.

PROCEDURAL FACTORS

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On August 15, 2023 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

That neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court. The CAC is therefore unaware whether the written notice was received by the Respondent or not.

As far as the e-mail notice is concerned, CAC received a notification that the e-mail notices sent to <postmaster@intessabanca.com> was returned back undelivered as the e-mail address had permanent fatal errors. The e-mail notice was also sent to <borisovgalaktion@gmail.com>, but we never received any proof of delivery or notification of undelivery.

No further e-mail address could be found on the disputed site.

The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, 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

The disputed domain name is confusingly similar to the Complainant's well-known trademarks by incorporating wholly the Complainant's trademarks by the inversion of the terms or by interchanging the order of the terms. This approach is a clear example of typosquatting. The slight variation with the additional doubling of an identical alphabet does not change the analysis of a side-by-side comparison.

The disputed domain name does not resolve to any active websites and is, therefore, a classic case of passive holding or non-use of the disputed domain name. That fact alone does not make it improper but coupled with other cumulative circumstances, in particular after the Complainant made a request to the disputed domain name's Registrar and Hosting Provider to remove abusive content, it can only be inferred that the Respondent does not have any rights or legitimate interests in the disputed domain name.

The Complainant trademarks are well-known around the world. By incorporating the Complainant's trademarks into the disputed domain name without any authorisation from the Complainant, the Respondent is likely seeking to capitalise on the Complainant's business reputation and trademarks. Such registration and use can only be inferred to have been done in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESSABANCA.COM**: Transferred

PANELLISTS

Name	William Lye OAM KC
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DATE OF PANEL DECISION	2023-08-27
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Publish the Decision
