Decision for dispute CAC-UDRP-105693

Case number	**CAC-UDRP-105693**
Time of filing	**2023-08-09 10:05:36**
Domain names	**INTESASANPALOL.COM**

Case administrator

Name	**Olga Dvořáková (Case admin)**

Complainant

Organization	**Intesa Sanpaolo S.p.A.**

Complainant representative

Organization	**Intesa Sanpaolo S.p.A.**

Respondent

Name	**lin yanfei**

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 submitted evidence, which the Panel accepts, showing that it is the registered owner of the following:

- the IR trademark INTESA SANPAOLO (registration n°920896) dated March 7, 2007;

- the IR trademark INTESA (registration n°793367) dated September 4, 2002;

- the EU trademark INTESA SANPAOLO (registration n°5301999) dated June 18, 2007;

- the EU trademark INTESA (registration n°12247979) dated October 23, 2013.

Moreover, the Complainant is also the owner of the domain names bearing the signs “INTESA SANPAOLO” and “INTESA” such as the domain names <intesasanpaolo.com> and <intesa.com>.

FACTUAL BACKGROUND

The Complainant, Intesa Sanpaolo S.p.A. is an Italian banking group, which is also among the top banking groups in the euro zone. The Complainant has approximately 3400 branches serving approximately 13,6 million customers in Italy and approximately 950 branches and over 7,2 million customers in Central Eastern Europe.

The Complainant holds several trademark registrations for “INTESA SANPAOLO” and “INTESA” and the Complainant also holds the domain names bearing “INTESA SAN PAOLO” and “INTESA”.

On October 20,2022; the Respondent registered the disputed domain name <intesasanpalol.com>. The disputed domain name redirects to a website with a security warning at the time of this decision.

PARTIES CONTENTIONS

COMPLAINANT:

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The Complainant contends that the disputed domain name is identical or at least confusingly similar to the Complainant’s well-known and distinctive trademarks “INTESA SANPAOLO” and “INTESA” as it represents a typo-squatting version of the Complainant’s well-known trademark “INTESA SANPAOLO”.

The Complainant states that the disputed domain name only lacks the letter “O” and is with an additional letter “L”, which is to be considered as a typing error.

NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant states that the Respondent has no rights on the disputed domain name and the Respondent is not known as the disputed domain name.

The Complainant also alleges that neither license nor authorization has been granted to the Respondent to use the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA”.

The Complainant argues that the Respondent is not using the disputed domain name in connection with non-commercial or fair use.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant indicates that the disputed domain name <intesasanpalol.com> has been registered and is being used in bad faith and that the Respondent registered the disputed domain name confusingly similar to the Complainant’s well-known prior trademarks. The Complainant claims that given the distinctiveness and reputation of the Complainant’s business and trademarks worldwide, the Respondent could not have registered the disputed domain name without actual knowledge of the Complainant and its trademarks.

The Complainant also states that the disputed domain name is not used for any *bone fide* offerings. More particularly, it was claimed that there are present 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 website.

The Complainant asserts that several services that are not in good faith can be detected, as the domain name is connected to a website sponsoring, banking and financial services, for which the Complainant’s trademarks are registered and used. Therefore, the Internet users may be confusingly led to the Respondent’s website while searching for Complainant’s service, and the Complainant claims that the Respondent has registered and is using the disputed domain name in order to intentionally divert traffic away from the Complainant’s website, which constitutes bad faith.

The Complainant also states that the Respondent’s commercial gain is evident, since it is obvious that the Respondent’s sponsoring activity is remunerated.

The Complainant further asserts that the diversion practice in banking realm is very frequent due to the high number of online banking users and that the Complainant has already been part of other WIPO UDRP Cases where the panellists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations.

Accordingly, the Complainant alleges that the disputed domain name was registered and is being used in bad faith.

RESPONDENT:

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).

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

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 this context, the Panel also notes that the burden of proof 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 to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

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

1. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of “INTESA SANPAOLO” and “INTESA” trademarks.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s “INTESA SANPAOLO” trademark and the addition of the letter “L” with the omission of the letter “O” at the end is not sufficient to vanish the similarity.

In particular, this case represents a clear example of typo-squatting, where the disputed domain name is one letter less and/or more than the Complainant's mark.

Moreover, the addition of the gTLD “.COM” is not enough to abolish the similarity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain name is a domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar

with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

2. NO 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 domain name.

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 the respondent of the dispute, the use or making 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) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the 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 burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the domain name.

The Complainant contends that the Respondent has nothing to do with the Complainant and any use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name.

In the absence of a response, the Panel accepts the Complainant’s allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain name.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

3. BAD FAITH

The Panel concludes that the Complainant's “INTESA SANPAOLO” and “INTESA” trademarks are of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the “INTESA SANPAOLO” and “INTESA” trademarks, the Respondent, was aware of the Complainant and its trademarks at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant’s trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover, the disputed domain name is also redirected to a website where there is a warning for safety and security at the date of this decision, which also clearly indicates use in bad faith.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPALOL.COM**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2023-09-12

Publish the Decision