

Decision for dispute CAC-UDRP-105923

Case number	CAC-UDRP-105923
Time of filing	2023-10-30 09:49:35
Domain names	LNTESASANPAOLO-ACCEDI.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	marco not available (Privacy Protect, LLC (PrivacyProtect.org))
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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, inter alia, a registered owner of the following trademarks containing word elements "INTESA" or "SANPAOLO":

(i) INTESA (word), International Trademark, filing (priority) date 4 September 2002, registration no. 793367, registered for services in class 36;

(ii) INTESA (word), EU Trademark, filing (priority) date 23 October 2013, registration no. 12247979, registered for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;

(iii) INTESA SANPAOLO, International Trademark, filing (priority) date 7 March 2007, registration no. 920896, registered for goods and services in classes 36;

(iv) INTESA SANPAOLO, EU trademark, filing (priority) date 8 September 2006, registration no. 5301999, registered for goods and services in classes 35, 36, 38,

besides other national and international trademarks consisting of or containing the "INTESA" or "SANPAOLO" wording.

(Collectively referred to as "**Complainant's trademarks**").

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term „INTESA" or "SAN PAOLO" such as INTESASANPAOLO.COM (official website),

FACTUAL BACKGROUND

The Complainant (Intesa Sanpaolo S.p.A.) is a leading Italian banking group and also one of the protagonists in the European financial arena. The Complainant is the company resulting from the merger (effective as of 1 January 2007) between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups.

The disputed domain name was registered on 7 May 2023 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) resolves to a website with links (likely generated automatically) to various financial services, as for example services offering credits or loans.

The Complainant seeks transfer of the disputed domain name to the Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

- CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain name contains the "SAN PAOLO" word elements of the Complainant's trademarks in its entirety.
- In addition, the dispute domain name represents a typosquatting version of the well-known trademark "INTESA", exactly reproducing the mentioned trademark with the mere substitution of the letter "I" with an "L" and adding a descriptive expression "ACCEDI" which can be roughly translated as "log in"
- Thus, according to the Complainant the confusing similarity between Complainant's trademarks and the disputed domain name is clearly established.

- NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain name.
- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant's trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name.
- Furthermore, the domain name website has not been used for any legitimate or fair purposes.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain name's registration and such trademarks are well known in relevant business circles. The Respondent can be considered aware of the Complainant's trademarks when registering the disputed domain name due to well-known character thereof, which should have been checked by the Respondent by performing a simple internet search.
- The disputed domain name (at the time of filing of the complaint) is not used for any bona fide offerings. More particularly, there are present circumstances indicating that, by using the domain name, the Respondent has registered the disputed domain name primarily for creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site.

- iii. The disputed domain name is connected to a website sponsoring, banking and financial services, for whom the Complainant's trademarks are registered and used.
- iv. The disputed domain name represents a clear case of so called "typosquatting" which means that the disputed domain name is based on an obvious misspelling of the Complainant's trademark: substitution of the letter "I" with an "L".

RESPONDENT:

The Respondent has not provided any response to the complaint.

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

RIGHTS

Since the disputed domain name and the Complainant's trademarks are not identical. Therefore, the key element investigated and considered by the Panel is whether the disputed domain name is confusingly similar to the Complainant's trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the disputed domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name. An addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name in question.

Applying the principles described above, the Panel contends that incorporation of a dominant "SAN PAOLO" elements of Complainant's trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitutes confusing similarity between the Complainant's trademark and the disputed domain name.

The other element of the Complainant's trademarks (INTESA) differs only in one character from the disputed domain name - letter I is replaced by a letter L (INTESA vs. LINTESA), which cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant's trademarks and thus the likelihood of confusion still exists.

Addition of a non-distinctive element –descriptive term "ACCEDI" (which can be roughly translated as "log in" into English) cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant's trademarks and thus the likelihood of confusion still exists. On the contrary, it may mislead the internet users that the disputed domain name is somehow related to Complainant's business.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the

identity and confusing similarity tests, as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant's assertions that the Respondent is not commonly known by the disputed domain names and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

Given the facts above and in the absence of the Respondent's response, the Panel concludes that there is no indication that the disputed domain names were intended to be used in connection with a bona fide offering of goods or services as required by UDRP.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant 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 Respondent has not used the disputed domain names in any manner, however, the Panel concludes (as it has been ruled in many similar cases, as for example *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, <telstra.org>, *Jupiters Limited v. Aaron Hall*, WIPO Case No. D2000-0574, <jupiterscasino.com>, *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. D2002-0131, <ladbrokespoker.com>) that the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name(s) without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.

Examples of what may be cumulative circumstances found to be indicative of bad faith include cases in which (i) the Complainant has a well-known trademark and (ii) there is no genuine use (e.g. a mere "parking") of the disputed domain name by the Respondent (irrespective of whether the latter should also result in the generation of incidental revenue from advertising referrals).

The use of misleading term ACCEDI indicates that the disputed domain name might be intended for "phishing" purposes. Such practice consists of attracting customers to a web page which imitates the real page of the Complainant (i.e. bank website) with an intention to mislead such users and have them disclosed confidential information.

In addition, it is clear that by replacing a single letter from the Complainant trademark (letter "I" is replaced by letter "L") while all other characters of the disputed domain name are identical to the Complainant trademark, it was Respondent's intention to target Internet users who incorrectly type a website address into their web browser, an illicit activity recognised as „typosquatting“. There are several different reasons for typosquatting, as for example:

- to try to sell the disputed domain back to the Complainant;
- to monetize the disputed domain through advertising revenues from direct navigation misspellings of the intended domain;
- to redirect the typo-traffic to Complainant's competitor;
- as a phishing scheme to mimic the Complainant's site, while intercepting passwords or other information which the visitor enters unsuspectingly;
- To install drive-by malware or revenue generating adware onto the visitors' devices;
- To harvest misaddressed e-mail messages mistakenly sent to the typo domain.

All of the activities above are considered as malicious activities.

It is well-founded that registration of the disputed domain names that are confusingly similar to the complainant's trademarks which enjoys strong reputation, plus other facts, such as above described unfair use of the disputed domain names, are sufficient to establish bad faith under the 4(a)(iii) of the Policy.

It is well-founded that registration of the domain names that are confusingly similar to the Complainant's trademarks which enjoys strong reputation, plus other facts, such as above described potential unfair use of the domain names, are sufficient to establish bad faith under the 4(a)(iii) of the Policy.

Thus, the Panel has taken a view that 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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LNTESASANPAOLO-ACCEDI.COM**: Transferred

PANELLISTS

Name **Jiří Čermák**

DATE OF PANEL DECISION **2023-12-05**

Publish the Decision