Decision for dispute CAC-UDRP-106050

Case number	CAC-UDRP-106050
Time of filing	2024-01-02 12:49:19
Domain names	INTESASPAOLO.ORG

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.

Respondent

Name	Alfred Beny

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 bases its Complaint on the following trademark:

- International trademark registration “INTESA SANPAOLO”, no. 920896, registered on 7 March, 2007, duly renewed, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42, in several jurisdictions;
- International trademark registration “INTESA”, no. 793367, registered on 4 September, 2002, duly renewed, for services class 36, in several jurisdictions;
- European Union trademark “INTESA SANPAOLO”, no. 5301999, filed on 8 September, 2006, registered on 18 June, 2007, duly renewed, for services in classes 35, 36 and 38;
- European Union trademark registration “INTESA”, no. 12247979, filed on 23 October, 2013, registered on 5 March, 2014, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

The Complainant is Intesa Sanpaolo S.p.A., a leading Italian banking group and also one of the protagonists in the European financial arena. 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 48,3 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,300 branches capillary and well distributed throughout Italy, with market shares of more than 15% 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 900 branches and over 7,2 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.

The Complainant is the owner of several trademarks INTESA and INTESA SANPAOLO, such as the International trademark registration “INTESA SANPAOLO”, no. 920896, the International trademark registration “INTESA”, no. 793367, the European Union trademark “INTESA SANPAOLO”, no. 5301999, the European Union trademark registration “INTESA”, no. 12247979, (all cited above).

The Complainant also owns a number of domain names which include its trademarks INTESA and INTESA SANPAOLO, such as the domain names <INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ>, <INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ>, <CLIENTI-INTESASANPAOLO.COM>, <SERVIZICLIENTI-INTESASANPAOLO.COM>, <INTESASANPAOLO-CLIENTI.COM>, <CLIENTE-INTESASANPAOLO.ONLINE>, <CLIENTE-INTESASANPAOLO.COM>, <ASSISTENZA-INTESASANPAOLO.COM>, <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 the above cited domain names of the Complainant were connected at the date of filing the Complaint with the official website of the Complainant, namely http://www.intesasanpaolo.com.

The disputed domain name <intesaspaolo.org> was registered on 4 August 2023 and is currently used in relation to a webpage blocked by Google Safe Browsing due to a suspected phishing activity.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED. PARTIES'

The Complainant's contentions are the following:

The disputed domain name <intesaspaolo.org> is identical or at least confusingly similar to the Complainant's earlier trademarks INTESA and INTESA SANPAOLO, that the Respondent lacks rights or legitimate interests in the disputed domain name for a number of reasons and that the disputed domain name was registered and is being used in bad faith.

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

1. Confusing Similarity

The Panel agrees that the disputed domain name <intesaspaolo.org> is confusingly similar to the Complainant's earlier trademarks INTESA and INTESA SANPAOLO. The disputed domain name <intesaspaolo.org> represents a typosquatting version of the earlier trademark INTESA SANPAOLO, reproducing this trademark with the omission of letters “A” and “N” from the mark’s verbal part “SAN”, which is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant’s earlier trademarks and it does not change the overall impression of the designation as being connected to the trademarks INTESA and INTESA SANPAOLO.

A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. This stems from the fact that the domain name contains sufficiently recognizable aspects of the relevant mark, as is this case. (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), point 1.9).

Moreover, the extension “.org” is not to be taken into consideration when examining the similarity between the Complainant’s trademark and the disputed domain name (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as “.org” is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L’Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

2. Lack of Respondent's rights or legitimate interests

The Complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name as such is not identified in the WHOIS database as the disputed domain name. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its trademark, nor of a confusingly similar trademark in the disputed domain name.

Based on the available evidence, the disputed domain is currently used in relation to a webpage blocked by Google Safe Browsing due to a suspected phishing activity. Such use does not amount to a bona fide offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name.

The Panel notes that the Respondent had an opportunity to comment on the Complaint’s allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

3. Bad Faith

Based on the available evidence, the Complainant's trademarks INTESA and INTESA SANPAOLO, which predate the registration date of the disputed domain name, are distinctive and well-known trademarks. Moreover, a basic Google search in respect of the wordings “INTESA SANPAOLO” and “INTESA”, show references to the Complainant. Thus, the Respondent has chosen to register the disputed domain name representing a typosquatting version of the Complainant’s INTESA SANPAOLO trademark in order to create a confusion with such trademark. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant’s earlier trademarks and has intentionally registered one in order to create confusion with such trademarks.

In the present case, the following factors should be considered:

(i) the Complainant's trademarks predate the registration date of the disputed domain name;

(ii) the Complainant's trademarks INTESA and INTESA SANPAOLO are distinctive and well-known trademarks;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;

(iii) the Respondent registered the disputed domain name representing a typosquatting version of a registered trademark;

(iv) the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name similar to the Complainant's trademark;

(v) the Complainant’s attorneys sent on 16 August, 2023 to the Respondent’s Registrar a cease-and-desist letter, asking to forward the letter to the domain name owner in order to require the voluntary transfer of the domain name at issue. From the available evidence, no response was received;

(vi) the disputed domain is, at the date of the decision, used in relation to a webpage blocked by Google Safe Browsing due to a

suspected phishing activity. Considering the above, in the Panel's view, it is inconceivable that the Respondent will be able to make any good faith use of the disputed domain name.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASPAOLO.ORG**: Transferred

PANELLISTS

Name	**Delia-Mihaela Belciu**

DATE OF PANEL DECISION 2024-02-06

Publish the Decision