

Decision for dispute CAC-UDRP-106303

Case number CAC-UDRP-106303

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Domain names INTESASBANK.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 Bahari Host

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

In these proceedings, the Complainant relies on its following trademarks:

- International trademark registration no. 793367 "INTESA", granted on September 4, 2002 and duly renewed, in class 36;
- EU trademark registration no. 2987220 "BANCA INTESA" (logo), filed on December 13, 2002, granted on January 26, 2004, and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42;
- International trademark registration no. 831572 "BANCA INTESA" (logo), granted on June 24, 2004, and duly renewed, in class 36;
- EU trademark registration no. 6661672 "INTESA SANPAOLO BANK" & device, filed on February 12, 2008, granted on January 23, 2009, and duly renewed, in classes 9, 16, 35, 36, 41 and 42.
- EU trademark registration no. 12247979 "INTESA", filed on October 23, 2013, granted on March 5, 2014, and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42.

It is worth noting that, the Complainant also owns multiple registrations for the same or similar trademarks in many countries around the world, which have not been cited in these proceedings.

Further, the Complainant is also the owner, among others, of the following domain names bearing the sign "INTESA SANPAOLO

BANK", "INTESA" and "BANCA INTESA": INTESASANPAOLOBANK.COM, .EU, .NET, .MOBI, .IT, .RO, .CN, INTESABANK.COM, .EU, .NET, .ORG, .RU, .PL, .SK, .HU, .CN, INTESA.COM, .INFO, .BIZ, .ORG, .US, .EU, .CN, .IN, .CO.UK, .TEL, .NAME, .XXX, .ME, BANCAINTESA.COM, .INFO, .BIZ, .ORG, .US, .EU, .CN, .IN, .CO.UK, INTESABANCA.COM, .INFO, .NET, .IT. All of them are now connected to the official website <http://www.intesasanpaolo.com>.

FACTUAL BACKGROUND

The Complainant is a large Italian banking group of companies, which emerged in 2007 from two other large Italian banking groups, Banca Intesa S.p.A. and Sanpaolo IMI S.p.A.

According to the evidence filed by the Complainant and not disputed by the Respondent, the Complainant has hundreds of branches and millions of customers in Europe, where it figures in the top banking groups, as well as in other large countries of the world. It is also well active in the region of Asia, where the Respondent is based.

The Complainant owns a significant portfolio of trademarks including the wordings "INTESA", "BANCA INTESA" and "INTESA SANPAOLO BANK", among which notably two international registrations dating back to 2002 and 2004, as well as a couple of EU trademark registrations from 2002 and 2008. It also owns a multitude of related domain names, like <intesasanpaolo.com>, since August 24, 2006.

The disputed domain name <intesasbank.com> was registered on January 28, 2024, by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its "INTESA", "BANCA INTESA" and "INTESA SANPAOLO BANK" trademarks; that the Respondent lacks rights or legitimate interests in the disputed domain name, and; that the Respondent registered and used the disputed domain name 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).

More precisely, the disputed domain name <INTESASBANK.COM> substantially incorporates the Complainant's International and EU Trademark Registrations for "INTESA", "BANCA INTESA" and "INTESA SANPAOLO BANK" to which it is highly similar, as well as to its domain name <intesasanpaolo.com>. Indeed, the addition of the letter "S" (which happens to be the initial of the distinctive "SANPAOLO" trademark element) in the middle of the disputed domain name is not sufficient to escape the finding of confusing similarity, when following the well-established trademark theory of imperfect recollection, as the rest of the word elements have been kept intact by the Respondent (INTESA and BANK). It is a clear case of typosquatting, indeed.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the "INTESA", "BANCA INTESA" and/or "INTESA SANPAOLO BANK" trademarks in a domain name, and that it had never licensed its trademarks to the Respondent,

who is not affiliated or doing any business with the Complainant.

Furthermore and finally, there is neither any evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name, nor is there any non-commercial or fair use of the disputed domain name by the Respondent.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the worldwide reputation of the Complainant's trademarks, and the fact that the disputed domain name substantially incorporates the said trademarks, it is rather clear to this Panel that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademarks. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the mere appearance of a banking-related "application form" in local language on the landing page of the Respondent's website, which showcases the name of the Complainant on top and which asks for personal information of the users, clearly shows to this Panel that, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of his website. Further, as per the undisputed claims of the Complainant, the Respondent seems to be redirecting users to websites that belong to competitors of the Complainant, which is another strong indication of bad faith use.

Therefore, the Panel finds it clear that the disputed domain name was used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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

The disputed domain name substantially incorporates the Complainant's trademarks. The disputed domain name is therefore confusingly similar to the Complainant's trademarks.

The Respondent was not authorised to include the Complainant's trademarks in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's well-known trademarks. His use of the disputed domain name is in bad faith, as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASBANK.COM**: Transferred
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PANELLISTS

Name Sozos-Christos Theodoulou

DATE OF PANEL DECISION 2024-04-01

Publish the Decision
