

Decision for dispute CAC-UDRP-106302

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| Case number | CAC-UDRP-106302 |
| Time of filing | 2024-02-29 09:10:41 |
| Domain names | ACCESSOWEBINTESA.COM |

Case administrator

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| Name | Olga Dvořáková (Case admin) |
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Complainant

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| Organization | Intesa Sanpaolo S.p.A. |
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Complainant representative

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| Organization | Intesa Sanpaolo S.p.A. |
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Respondent

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| Name | Ciro Lota |
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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, conducting business under the company name INTESA SANPAOLO, is owner of the following registered trademarks:

- International trademark no. 793367 “INTESA”, registered since 4 September 2002, in class 36;
- EU trademark no. 12247979 “INTESA”, filed on 23 October 2013 and registered since 5 March 2014, in classes 9, 16, 35, 36 38, 41 and 42;
- EU trademark no. 5301999 “INTESA SANPAOLO”, filed on 8 September 2006 and registered since 18 June 2007, in classes 35, 36 and 38; and
- International trademark registration n. 920896 “INTESA SANPAOLO”, registered since 7 March 2007, in classes 9, 16, 35, 36, 38, 41 and 42.

The Complainant is also owner of numerous domain names registered in several TLDs including the terms “INTESA” and “INTESA SANPAOLO” (e.g., 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 and 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 etc.). All of them resolves to the official website of the Complainant (<https://www.intesasanpaolo.com>).

FACTUAL BACKGROUND

The Complainant is a leading Italian banking group, born from the merger of Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., effective as of 1 January 2007.

The Complainant is among the largest financial institutions in the Euro zone, with a market capitalisation exceeding 52,3 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 Complainant offers its services to approximately 13,6 million customers.

The Complainant has a strong presence in Central-Eastern Europe as well, with a network of approximately 900 branches and over 7,2 million customers.

Moreover, 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 in the United States, Russia, China and India.

The Complainant owns several trademarks and domain names, all of them characterised by the presence of the distinctive terms "INTESA" and "INTESA SANPAOLO".

The disputed domain name was registered on 16 June 2023, well after the registration of the Complainant's trademarks.

Further to CAC's request for registrar verification, the Registrar identified the underlying registrant as **Ciro Lota**, an individual residing in Italy.

Currently, the disputed domain name does not resolve to any active website, because it has been blocked by Google Safe Browsing as a "dangerous site". When Internet users attempt to navigate it, a warning is shown to them that it is unsafe and might be involved in illegal activities, like phishing or malware.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is identical or at least confusingly similar to the Complainant's trademarks, because it reproduces the term "INTESA" with the mere addition of the terms "ACCESSO" and "WEB" (meaning web access in Italian). According to the Complainant, considered the banking and financial context in which the Complainant operates, it is undeniable that the disputed domain name will result even more confusingly similar to the business carried out by the Complainant under its trademarks.

The Complainant contends that the Respondent has nothing to do with the Complainant, nor has been authorised or licensed to use the Complainant's trademarks or to register or use the disputed domain name. The disputed domain name does not correspond to the Respondent's name, nor is this latter commonly known by the disputed domain name. Since the disputed domain name is inactive, being the access to the related website blocked by Google Safe Browsing as unsafe, there is no good faith, or legitimate noncommercial or fair use of the disputed domain name.

Finally, the Complainant contends that, given the distinctiveness and reputation of its trademarks, it is unlikely that the Respondent had no knowledge of the Complainant's trademarks when he had registered the disputed domain name. The Complainant has submitted the results of a Google search and alleges that had the Respondent performed a basic search on Google, he should have yielded obvious references to the Complainant. Hence, it is most likely that the Respondent registered and has used the disputed domain name having in mind the Complainant and its trademarks and with the clear intention to take advantage of the reputation of the same by creating a likelihood of confusion between such marks and the disputed domain name. Moreover, according to the Complainant, the fact that Google Safe Browsing considered the website associated to the disputed domain name dangerous and being potentially involved in phishing is a clear indicia of bad faith use of the disputed domain name by the Respondent.

The Complainant, therefore, requests the transfer of the disputed domain name.

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

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:

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

I. THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARKS

The Complainant has established that it has rights in the INTESA trademark since 2002. The Complainant has also shown to have rights in the INTESA SANPAOLO trademark since 2006.

In UDRP disputes the test for identity or confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. The addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) to the complainant's trademark does not prevent a finding of confusing similarity under the first element. The TLD is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the complainant's trademark as it is a technical requirement of registration.

In assessing identity or confusing similarity, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, because it incorporates the entirety or at least the distinctive part of the Complainant's trademarks, namely the distinctive term "INTESA", combined with the generic and descriptive terms "ACCESSO" and "WEB" (meaning web access in Italian). These additional terms neither affect the attractive power of the Complainant's trademarks, nor are sufficient to distinguish the disputed domain name from the Complainant's marks. Rather, being related to the Complainant's business (online banking and financial services), they even increase the likelihood of confusion between the disputed domain name and the Complainant's trademarks. Therefore, the Internet users might erroneously believe that the disputed domain name and any related web services (website, email, etc.) is owned by or under the control of the Complainant.

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's marks.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

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 disputed domain names. If the Complainant makes out a prima facie case that the Respondent lacks rights or legitimate interests, the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.

The Complainant contends to have no relationship whatsoever with the Respondent. The Respondent has never received any approval

of the Complainant, expressed or implied, to use the Complainant's trademarks or to register and use the disputed domain name.

No evidence is available that the Respondent, identified by the Registrar as *Ciro Lota*, has been commonly known by the disputed domain name or has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The Respondent, apparently residing in Italy, registered the disputed domain name incorporating the Complainant's trademarks plus additional generic and descriptive terms in Italian, and, thus confusingly similar to the Complainant's trademarks.

UDRP panels have found that domain names identical or confusingly similar to a complainant's trademark carry a high risk of implied affiliation. A domain name consisting of a trademark plus an additional term at the second- or top-level is seen as tending to suggest sponsorship or endorsement by the trademark owner. Thus, UDRP panels have largely held that such composition cannot constitute fair use.

Currently, the disputed domain name does not resolve to any active website, because it has been flagged by Google Safe Browsing as a "dangerous site". When Internet users attempt to navigate it, a warning is shown to them that it is unsafe and might be involved in illegal activities, like phishing or malware.

Panels have categorically held that the use of a domain name for illegal activity (including unauthorised account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.

Therefore, the Panel is unconvinced that, before any notice of the dispute, the Respondent used or prepared to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services or is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademarks.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

III. REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

As mentioned under the first element, the Complainant has sufficiently demonstrated to own rights in the *INTESA* and *INTESA SANPAOLO* trademarks. The Complainant's trademarks were registered prior to the registration of the disputed domain name, and are valid and widely well-known, especially in Italy where the Respondent is residing.

The disputed domain name to be considered confusingly similar to the Complainant's trademarks, since it incorporates the entirety or at least the distinctive part of the Complainant's trademarks, namely the term "*INTESA*". The addition of the generic and descriptive terms "*ACCESSO*" and "*WEB*" (meaning web access in Italian) and the TLD ".COM" (technical requirement of the registration) are not sufficient elements to escape the finding of confusing similarity between the disputed domain name and the Complainant's trademarks. Considering that the Complainant provides banking and financial services (also online), the Respondent's choice to add generic and descriptive terms concerning such activities to the trademark of the Complainant shows the Respondent's clear intention to enhance such likeness of confusion for the Internet users who are seeking or expecting the Complainant.

Given the distinctiveness and reputation of the Complainant's prior marks, it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant's rights in such well-known marks and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

Even assuming that the Respondent had no knowledge of the Complainant's prior marks at the time of registration of the disputed domain name (which is quite unlikely), he omitted to verify that the disputed domain name would have infringed the Complainant's earlier rights or, even worse, it verified it and deliberately proceeded with the infringing registration and use.

The Complainant has submitted the results of a Google search carried out regarding the terms "*INTESA SANPAOLO*", all of them related to the Complainant. Should the Respondent have performed a similar search on the Internet before registering the disputed domain name, he would have easily learnt about the Complainant's activities and trademarks registered and used worldwide.

Under paragraph 2 of the Policy, it is the Respondent's responsibility to determine whether the domain name registration infringes or violates third party's rights. By registering the disputed domain name confusingly similar with the Complainant's well-known mark, the Respondent has violated, inter alia, the cited provision of the Policy.

In addition, the Panel observes that the registration data provided by the Respondent at the time of the registration of the disputed domain names seems to be inconsistent and/or fake, since there is no *Via Roma* in Milan, Italy. Providing fake registration data is certainly not an indicia of good faith registration.

Moreover, the disputed domain name does not resolve to any active website, since the access to it has been blocked by Google Safe Browsing, which considers such website unsafe likely being involved in illegal activities, such as phishing or malware.

In view of all circumstances of this case, the Panel is dissuaded that it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being an infringement of the Complainant's marks under trademark law and/or an infringement of consumer protection legislation.

Finally, the Panel finds that the Respondent, by registering and using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to his web site or other on-line location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of his web site or location or of a product or service on his web site or location (paragraph 4(b)(iv) of the Policy).

The Complainant has, therefore, discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

The disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **ACCESSOWEBINTESA.COM**: Transferred

PANELLISTS

| | |
|------|-----------------|
| Name | Ivett Paulovics |
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DATE OF PANEL DECISION 2024-04-04

Publish the Decision