Decision for dispute CAC-UDRP-106472

Case number	CAC-UDRP-106472
Time of filing	2024-04-23 09:18:38
Domain names	AREACLIENTEINTESA.COM

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	Giuseppe Fiengo

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":

(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" wording.

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

The Complainant has also registered several domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term „INTESA" such as <INTESASANPAOLO.COM> (official website), <INTESA.COM>, <INTESA.EU>, <INTESA.ORG> and others.

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 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 27 January 2024 and is held by the Respondent.

The disputed domain name website (i.e. website available under the internet address containing the disputed domain name) is inactive and merely reads “that domain has been suspended”.

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

PARTIES CONTENTIONS

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 disputed domain name contains the well-known trademark “INTESA” and a descriptive Italian expression “AREA CLIENTE” (meaning “customer area”), which refers to a service offered, among others, by the Complainant to its customers.
- Thus, according to the Complainant, the confusing similarity between the 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 the 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 the 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.
- The disputed domain name represents a clear case of so-called “phishing” which means that the disputed domain name is intended to defraud the Complainant’s customers.
- Google promptly stopped the illicit activity carried out by the Respondent by blocking access to the disputed domain name website.

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

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 the 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. Addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity tests under the UDRP typically involve 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 "INTESA" element of Complainant’s trademarks (which standalone enjoys a high level of distinctiveness) into the disputed domain name constitutes a confusing similarity between the Complainant’s trademark and the disputed domain name.

The addition of a non-distinctive element – a descriptive term ““AREA CLIENTE” (meaning “customer area” in 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 the 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 authorized 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 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).

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

All of the activities above are considered malicious activities.

It is well-founded that registration of the disputed domain name that is confusingly similar to the complainant's trademarks which enjoys a 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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AREACLIENTEINTESA.COM**: Transferred

PANELLISTS

Name	**Jiří Čermák**

DATE OF PANEL DECISION 2024-05-29

Publish the Decision