Decision for dispute CAC-UDRP-106531

Case number	CAC-UDRP-106531
Time of filing	2024-05-17 09:51:32
Domain names	INTESASP.NET

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	luca mapozzi

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 submitted evidence that it is the owner of the following trademarks:

- International trademark "**INTESA SANPAOLO**" (wordmark), registration n. 920896, registered on March 7, 2007, in classes 9, 16, 35, 36, 41 and 42;
- International trademark "**INTESA**", registration n. 793367, registered on September 4, 2002, in class 36;
- EU trademark "**INTESA SANPAOLO**" (wordmark), registration n. 5301999, registered on June 18, 2007, in classes 35, 36 and 38; and
- EU trademark "**INTESA**" (wordmark), registration n. 12247979, registered on March 5, 2014, in classes 9, 16, 35, 36 38, 41 and 42.

These international trademarks and EU-trademarks are hereafter referred to as the "**Trademarks**".

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant claims to be the leading Italian banking group and a major player in the European banking and financial area. The

Complainant is the result of a merger (as of January 1, 2007) between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two Italian banking groups. The Complainant is the leading banking group in Italy. The Complainant also claims to have a strong presence in Central-Eastern Europe, and to have an international network that supports corporate customers in 25 countries, in particular in the Mediterranean area and areas where Italian companies are most active such as the United States, Russia, China and India.

The Complainant claims to be the owner of several trademarks comprising the term “INTESA”. The Complainant submitted evidence that it is the owner of the various international and EU-trademarks that are listed above and referred to in this decision as the “Trademarks”.

The Complainant also states that it is the owner of multiple domain names which include the word “INTESA”. However, the Complainant did not submit evidence that it is indeed the owner of such domain names. The Complainant provided screenshots of the website available via the domain name <intesasanpaolo.com>, which confirm that the Complainant operates the website available via this domain name.

The disputed domain name <Intesasp.net> was registered on December 27, 2023.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.
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

1. **Confusing similarity**

The disputed domain name consists of the Complainant's Trademark “INTESA” with the addition of the letters “S” and “P”.

The Panel remarks that Section 1.7 of WIPO Overview 3.0, states that, "in cases where a domain name contains the whole of a trademark, or where at least one dominant feature of the relevant trademark is recognisable in the domain name, the domain name shall normally be considered confusingly similar to that trademark for the purposes of UDRP status".

The Panel is of the opinion that the sole addition of the letters “S” and “P” does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. It seems to the Panel that the letters “S” and “P” are an abbreviation of - or at least refer to - “SANPAOLO”, and are therefore solely descriptive.

This is supported by section 1.8 of WIPO Overview 3.0, which states: "Where the relevant mark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not preclude a finding of confusing similarity under the first element".

The gTLD ".net" may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. **Rights or legitimate interests**

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that 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, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the Panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant argues that:

- The Respondent is not authorized or licensed by the Complainant to use the Trademarks or to use the disputed domain name;
- The disputed domain name does not correspond to the name of the Respondent. The Respondent is not commonly known as “INTESASP”;
- There is no fair or non-commercial use of the disputed domain name.

The Respondent did not file an administratively compliant (or any) response. The Respondent did not provide evidence that it has rights or legitimate interests in the disputed domain name (the Respondent could, inter alia, have provided evidence of the factors mentioned in paragraph 4(c) of the Policy, but failed to do so).

The Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name from the following facts:

- There is no evidence at all that the Respondent is or has been commonly known by the disputed domain name or by the term(s) “INTESA” or “INTESASP”.
- There is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers. On the contrary, it appears that the Respondent is taking advantage (or at least intends to take advantage) of the Complainant's registered Trademarks to attract internet users to its own website.
- The Respondent did not show to have any trademark rights or other rights in the term(s) “INTESA” or “INTESASP”.
- The Respondent does not seem to have any consent or authorisation to use the Trademark(s) or variations thereof and does not seem to be related in any way to the Complainant.

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name.

3. **Bad faith**

The Complainant argues the following:

- The Respondent registered the disputed domain name with actual knowledge of the Complainant’s Trademarks. The Trademarks are well known all around the world. A Google search with the words “INTESA” and “INTESA SANPAOLO” clearly leads to the Complainant.
- The Respondent does not use the disputed domain name for a bone fide offering of goods or services. The disputed domain name is connected to a website promoting banking and financial services. The Complainant claims that the Respondent has registered and is using the disputed domain name to confuse consumers and intentionally divert traffic away from the website of the Complainant.
- Several WIPO decisions state that the registration and use of a domain name to re-direct internet users to websites of competing organisations constitutes bad faith.
- The Respondent’s commercial gain is evident, since the website available via the disputed domain name contains sponsored links.
- Several panellists in other domain name disputes have ordered the transfer or the cancellation of disputed domain names in similar WIPO cases where Intesa Sanpaolo was the complainant.

The Panel weighs these arguments and facts as follows:

The Panel accepts that the evidence submitted by the Complainant proves that the Respondent uses the disputed domain name to offer similar services as those of the Complainant or at least to publish links to such similar services. The website available via the disputed domain name mentions the following terms in Italian: “Simulazione Prestito” (“Loan Simulation”), “Conto Corrente Aziendale Online” (“Online Business Current Account”), and “Aprire Conto Corrente” (“Open Current Account”). Such services are covered by the Complainant’s Trademarks. The Respondent is using the disputed domain name either to offer competing services that are covered by the Complainant’s Trademarks or to re-direct consumers to competitors for such competing services.

At the very least, the offering of (or linking to) these services via the disputed domain name is considered as a way of intentionally confusing consumers and intentionally trying to divert traffic away from the website of the Complainant.

The Panel concludes that, on the balance of probabilities, it may be expected that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence of the Complainant's Trademarks and the scope of these Trademarks.

The Panel also took account of the following elements of fact:

- The Respondent is located in the same country as the Complainant (i.e., Italy). Given the widespread recognition of the Complainant and its Trademarks especially in Italy, it can be assumed that the Respondent was aware of the Complainant and its registered Trademarks.
- The Complainant has trademark rights to the terms “INTESA” for banking and financial services in various countries. The term selected by the Respondent (“INTESA”) seems to have no meaning in any language and seems only selected for its similarity to the Complainant’s registered Trademark(s).
- The registration of the Complainant’s Trademarks predates the registration of the disputed domain name.
- The disputed domain name is almost identical to the Complainant's Trademarks "INTESA", with the addition of the letters “S” and “P”. Taking the circumstances in account, it seems evident that the letters “S” and “P” refer to “SANPAOLO”. This confirms the existence of fad faith at the time of registration and use of the domain name.
- A Google search of the term "INTESA" clearly points to the Complainant. In light of this, it seems unlikely that the Respondent would not have been aware of the unlawful character of the disputed domain name at the time of its registration and use. The Panel concludes that the Respondent knew or at the very least should have known of the existence of the Complainant and its Trademarks.

In the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel believes from the facts in this case that the Respondent had the Trademark(s) of the Complainant in mind when registering and subsequently using the disputed domain name.

From these facts, the Panel concludes that the Respondent had actual knowledge of the Trademarks of the Complainant. The Respondent must have had the Trademark of the Complainant in mind when registering and using the disputed domain name. It appears that the Respondent tried to profit from the name and success of the Complainant with the disputed domain name.

For all the reasons stated above, the Panel concludes that the Complainant did prove that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(1)(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. **INTESASP.NET**: Transferred

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2024-06-12

Publish the Decision