Decision for dispute CAC-UDRP-106533

Case number	CAC-UDRP-106533
Time of filing	2024-05-17 09:58:50
Domain names	E-INTESA-SANPAOLO-IT.COM

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.

Respondent

Name	Denis Emasin

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 the owner of several trademarks:

- International trademark INTESA SANPAOLO No. 920896, registered on March 7, 2007, in classes 9, 16, 35, 36, 38, 41 and 42, protected in the European Union, in the United States of America, as well as in other countries;

- European Union trademark INTESA SANPAOLO No. 5301999, filed on September 8, 2006 and registered on August 20, 2007 in classes 35, 36 and 38, the Panel could check that it has been renewed;

- European Union trademark INTESA No. 12247979, filed on October 23, 2013 and registered on March 10, 2014, in classes 9, 16, 35, 36, 38, 41 and 42, the Panel could check that it has been renewed.

The disputed domain name <e-intesa-sanpaolo-it.com> was created on December 18, 2023.

It resolved to a parking website, which was sponsoring banking and financial services.

FACTUAL BACKGROUND

The Complainant is the 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 capitalization exceeding 64,5 billion euro, and the undisputed leader in Italy, in all business areas. Its network has approximately 3,300 branches in Italy.

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 7.3 million customers. The international network specialized 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 of America, China and India.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

The Complainant asserts that the disputed domain name <e-intesa-sanpaolo-it.com> is confusingly similar to its INTESA SANPAOLO and INTESA trademarks. It also relies on its domain names.

The disputed domain name exactly reproduces the well-known INTESA SANPAOLO trademark, with the mere addition of the letter “E”(representing an example of typosquatting) and the acronym « IT », which is the abbreviation of the geographical term ITALY, the country where the Complainant is headquartered.

The Complainant affirms that the Respondent has no rights or legitimate interests in the disputed domain name. Indeed, the Complainant never authorized or licensed the Respondent to use the INTESA SANPAOLO or INTESA trademarks and never authorized him to create the disputed domain name and to use it.

Moreover, the Respondent is not commonly known as “INTESA SANPAOLO” and there is no evidence of any fair or noncommercial use of the disputed domain name by the Respondent.

According to the Complainant, the disputed domain name <e-intesa-sanpaolo-it.com> was registered and used in bad faith.

The Complainant’s trademarks are well-known around the world and the disputed domain name is confusingly similar with them. Even if the Respondent did not know the trademarks, a basic Google search of “intesa sanpaolo” was enough to know that.

The disputed domain name is not used for any bona fide offerings. More particularly, there are present circumstances indicating that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website.

The disputed domain name redirects to a website sponsoring banking and financial services, for whom the Complainant’s trademarks are registered and used.

Consequently, Internet users, while searching for information on the Complainant’s services, are confusingly led to the websites of the Complainant’s competitors which are sponsored on the websites connected to the domain name at issue. The Respondent has registered and used the disputed domain name at issue in order to intentionally divert traffic away from the Complainant’s website.

This practice causes great damages to the Complainant, due to the misleading of their present clients and to the loss of potential new ones.

According to the Complainant, the Respondent’s commercial gain is evident, since it is obvious that the Respondent’s sponsoring activity was being remunerated.

RIGHTS

To prevail in the proceedings under the Policy, the Complainant must show that the three requirements set forth in paragraph 4(a) of the Policy are met. Those requirements are:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

Likewise, under paragraph 4(c) of the Policy, the Respondent can demonstrate its rights and legitimate interests in the disputed domain name in its response to the Complaint by demonstrating, among others, the circumstances mentioned under this paragraph of the Policy.

The Complainant has clearly established its registered rights on the INTESA SANPAOLO and INTESA trademarks.

The disputed domain name <e-intesa-sanpaolo-it.com> entirely reproduces the Complainant's trademark INTESA SANPAOLO, with the mere adjunction of the letters "e" meaning « electronics » to start and « IT » designating « Italy » at the end.

Such addition does not avoid a finding of confusing similarity.

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.

Therefore, this condition is satisfied.

NO RIGHTS OR LEGITIMATE INTERESTS

As set forth by paragraph 4(c) of the Policy, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the Respondent's rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to the Respondent of the dispute, its use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent has not been licensed or authorized to use the INTESA SANPAOLO or INTESA trademarks or to register the disputed domain name.

The Respondent did not make a fair or noncommercial use of the disputed domain name. He used it to direct to a website with links sponsoring banking and financial services for Complainant's competitors. Those services are the business activities of the Complainant and its trademarks are registered for those services.

There is no fair or noncommercial use of the disputed domain name by the Respondent.

The Respondent did not respond to the Complaint. Consequently it did not provide any evidence or circumstances to establish that it has rights or legitimate interests in the disputed domain name, according to paragraph 4(c) of the Policy.

In the circumstances of this case, the Panel finds that the Complainant has established a prima facie case of the Respondent's absence of rights or legitimate interests in the disputed domain name.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by an Administrative Panel to be evidence of the bad faith registration and use of a domain name. It provides that:

"For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

The Complainant has demonstrated the well-known character of its trademarks. The Respondent could not ignore the Complainant's rights on the INTESA SANPAOLO and INTESA trademarks when he registered the disputed domain name <e-intesa-sanpaolo-it.com>, in order to use it in relation with financial activities.

The Panel finds that the disputed domain name was registered in bad faith with the Complainant in mind, to make a commercial gain and disrupting the Complainant's activity.

The Respondent used the disputed domain name to redirect to a parking website sponsoring bank and financial services, which is the Complainant's business activity, and sponsoring the Complainant's competitors.

The goal was to attract the Internet users on the website by creating a likelihood of confusion with the Complainant's trademarks in order to mislead the Internet users, the Complainant's clients or the new ones, for a commercial gain.

The Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location, in the meaning of paragraph 4(b)(iv) of the Policy.

Therefore, 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

The disputed domain name is composed with the well-known INTESA SANPAOLO trademark, the addition of the letter "E" and of the letters "IT" to designate "Italy" does not avoid that it is confusingly similar to this trademark.

The Respondent did not contest the Complaint and has never been authorized to register the disputed domain name, that it uses for commercial gain, taking advantage of the reputation of the well-known INTESA SAPAOLO trademark to attract the internet users to its parking website dedicated to banking services.

The commercial use of the disputed domain name to resolve to a parking website dedicated to banking services proves that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location, in the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **E-INTESA-SANPAOLO-IT.COM**: Transferred

PANELLISTS

Name	**Marie-Emmanuelle Haas Avocat**

DATE OF PANEL DECISION 2024-06-21

Publish the Decision