Decision for dispute CAC-UDRP-106532

Case number	CAC-UDRP-106532
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Domain names	IT-INTESA-SANPAOLO.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	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 the following trademark registrations:

- International trademark registration No. 920896 “INTESA SANPAOLO”, registered on 7 March 2007 in connection with classes 9, 16, 35, 36, 38, 41 and 42;
- International trademark registration No. 793367 “INTESA”, registered on 4 September 2002 in connection with class 36;
- EUTM No. 5301999 “INTESA SANPAOLO”, registered on 18 June 2007 in connection with the classes 35, 36 and 38;
- EUTM No. 12247979 “INTESA”, registered on 5 March 2014 in connection with classes 9, 16, 35, 36, 38, 41 and 42.

The Complainant proved its ownership of the listed trademark registrations by the submitted extract from the WIPO Madrid search and the EUIPO registration certificates.

FACTUAL BACKGROUND

Intesa Sanpaolo is among the top banking groups in the eurozone, with a market capitalization exceeding 64,5 billion euros, 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 the Country, with market shares of more than 15% in most Italian regions, 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. Moreover, 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, Russia, China and India (submitted Report about Intesa Sanpaolo).

The Complainant is the owner of numerous trademark registrations for “INTESA SANPOLO” or “INTESA” (see above). Moreover, the Complainant owns, among the others, the following domain names containing the “INTESA SANPAOLO” and “INTESA” signs: <INTESASANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ>, <INTESA-SANPAOLO.COM, .ORG, .EU, .INFO, .NET, .BIZ> and <INTESA.COM, .INFO, .BIZ, .ORG, .US, .EU, .CN, .IN, .CO.UK, .TEL, .NAME, .XXX, .ME>. All of them are connected to the Complainant’s official website under <INTESANPAOLO.COM> domain name.

The disputed domain name < IT-INTESA-SANPAOLO.COM> (hereinafter “disputed domain name”) was registered on 18 December 2023. According to the Registrar, the Respondent is ‘Denis Emasin’. The Respondent’s provided address as being at Nice, France.

PARTIES CONTENTIONS

COMPLAINANT:

A. The Complainant contends that the disputed domain name is confusingly similar to the Complainant’s trademarks.

The Complainant claims that it is more than obvious that the disputed domain name is identical, or – at least – confusingly similar, to the Complainant’s “INTESA SANPAOLO” and “INTESA” trademarks. The disputed domain name exactly reproduces the “INTESA SANPAOLO” well-known trademark, with the mere addition of the “IT” acronym (which represents the abbreviation of the geographical term "ITALY", the country in which Complainant’s headquarters is located).

B. The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant claims that the Respondent has no rights to the disputed domain name and that nobody has been authorized or licensed by the above-mentioned banking group to use the disputed domain name.

The Complainant states that the disputed domain name does not correspond to the name of the Respondent and the Respondent is not commonly known as “IT-INTESA-SANPAOLO”.

Lastly, the Complainant does not find any fair or non-commercial uses of the disputed domain name (furnished screenshot of the website under the disputed domain name).

C. The Complainant contends that the disputed domain name has been registered and is being used in bad faith.

According to the Complainant, the disputed domain name was registered and is used in bad faith.

The Complainant claims that its “INTESA SANPAOLO” and “INTESA” trademarks are distinctive and well-known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the “INTESA SANPAOLO” and “INTESA” verbal elements, the same would have yielded obvious references to the Complainant. The Complainant submits an extract of a Google search in support of its allegation. This raises a clear inference of knowledge of the Complainant’s trademark on the part of the Respondent. Therefore, it is more than likely that the disputed domain name would not have been registered if it were not for the Complainant’s trademark. This is a clear evidence of registration of the domain name in bad faith.

The Complainant adds that the disputed domain name is not used for any bone fide offerings. More particularly, there are circumstances indicating that, by using the domain name, 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 mark as to the source, sponsorship, affiliation, or endorsement of his website.

First of all, several services can be detected, but not in good faith: in fact, the domain name is connected to a website promoting banking and financial services for which the Complainant’s trademarks are registered and used (submitted screenshots of the Complainant’s official website).

Consequently, Internet users, while searching for information on the Complainant’s services, are confusingly led to the website of the Respondent.

Therefore, the Complainant deems that the Respondent has registered and is using the disputed domain name to intentionally divert traffic away from the Complainant’s website.

Past panels have stated that the registration and use of a domain name to re-direct Internet users to websites of competing organizations constitute bad faith registration and use under the UDRP.

The current use of the disputed domain name, which allows accessing to the website of the Respondent, also through the Complainant’s trademark, causes, as well, great damages to the latter, due to the misleading of their present clients and to the loss of potential new ones. So, the Respondent’s conduct is even worse.

The Complainant claims that the Respondent's commercial gain is evident since it is obvious that the Respondent's sponsoring activity is being remunerated. The Complainant adds that it is no coincidence that this speculation has involved a big financial institution such as Intesa Sanpaolo. In fact, the diversion practice in the banking realm is very frequent due to the high number of online banking users. In fact, it has also to be pointed out that the Complainant has already been part of other WIPO Cases where the panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations.

Lastly, on 5 January 2024, the Complainant's attorneys sent to the Respondent's Registrar a cease-and-desist letter, asking to forward the document to the domain name owner in order to require the voluntary transfer of the disputed domain name. Despite such communication, the Respondent did not comply with the above request.

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 UDRP).

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 UDRP).

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 UDRP).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. Therefore, the Panel proceeds to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them [Paragraph 5(f) of The Rules].

1. CONFUSING SIMILARITY

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks.

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter "The WIPO Overview 3.0") in Paragraph 1.2.1 states: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The WIPO Overview 3.0 in Paragraph 1.7 states: "[…] 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 WIPO Overview 3.0 in Paragraph 1.8. states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

In the WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., the panel stated that: "It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar".

In the present case, the Complainant has established that it owns numerous international trademark registrations and EUTMs consisting of the “INTESA” and “INTESA SANPAOLO” verbal elements, protected for the classes in connection with financial services (evidenced by the extract from the WIPO Madrid search and the EUIPO registration certificates).

The disputed domain name <IT-INTESA-SANPAOLO.COM> contains the Complainant’s trademark in its entirety and adds the “IT” general abbreviation in front of the Complainant’s trademark. No further adjustments were made to distinguish the disputed domain name from the Complainant’s trademarks. The “IT” abbreviation stands, among others, for the geographical term “Italy”. The addition of the gTLD <.com> does not change the overall impression of the disputed domain name either.

Past panels have declared that when the trademark is recognizable within the disputed domain name, the addition of a general (geographical) term (as “IT” in the present case) would not prevent a finding of confusing similarity.

Therefore, the disputed domain name is considered to be confusingly similar to the relevant trademark.

As a result, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the UDRP.

2. THE RESPONDENT´S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to Paragraph 4(a)(ii) of the UDRP, the Complainant shall make a case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfils this demand the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the UDRP (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman). Moreover, past panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, past panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the UDRP, once the complainant has made something credible (prima facie evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing concrete evidence.

In the CAC Case No. 102279, FileHippo s.r.o. v. whois agent, the panel stated that “[i]n the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under Paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of Paragraph 4(a)(ii) of the Policy.”

In the Forum Case No. FA 1781783, Skechers U.S.A. Inc. v. Chad Moston / Elite Media Group, the panel stated that: “where a response is lacking, WHOIS information can support a finding that the respondent is not commonly known by the disputed domain name”.

In the present case, the Complainant claims that the Respondent is not related in any way to the Complainant and that the Complainant has never granted any license nor authorization to the Respondent to use the Complainant’s trademark or apply for registration of the disputed domain name.

The Complainant proved its ownership of numerous international trademark registrations (see above).

From the submitted screenshot of the website under the disputed domain name, it becomes clear that the Respondent is not using the disputed domain name for any fair or non-commercial purpose.

There is no evidence that would lead to the conclusion that the Respondent is known by the disputed domain name.

The Respondent did not reply to the Complaint and so failed to demonstrate his rights or legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied the requirement under Paragraph 4(a)(ii) of the UDRP.

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

The Panel finds that the Respondent registered and used the disputed domain name in bad faith.

The WIPO Overview 3.0 in Paragraph 3.1.1 states: “If on the other hand circumstances indicate that the respondent’s intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant’s trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent’s likely knowledge of the complainant’s rights, (ii) the distinctiveness of the complainant’s mark, […], (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name, […].

The WIPO Overview 3.0 in Paragraph 3.1.4 states: “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

The WIPO Overview 3.0 in Paragraph 3.3 states: “From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding.”

In the WIPO Case No. D2006-1440, National Football League v. Thomas Trainer, the panel stated: “when a registrant, such as the Respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted.”

In the Forum Case No. FA 1773444, Ashley Furniture Industries, Inc. v. Joannet Macket / JM Consultants, the panel stated that: “The Panel finds that Respondent’s lack of content at the disputed domain shows the lack of a bona fide offering of goods or services or a legitimate noncommercial or fair use per Policy ¶¶ 4(c)(i) and (iii).”

In the present case, the Complainant has established that it owns numerous international trademark registrations and EUTMs consisting of the “INTESA” and “INTESA SANPAOLO” verbal elements, protected for the classes in connection with financial services, with the priority right since 2002 (evidenced by the extract from the WIPO Madrid search and the EUIPO registration certificates).

The disputed domain name consists of the Complainant’s trademark wording in its entirety. The addition of the “IT” abbreviation in front of the Complainant’s trademark does not change the overall impression. Besides, the addition of “IT” might confuse Internet users about the owner of the disputed domain name since the Complainant is seated in Italy. Therefore, the disputed domain name is confusingly similar to highly distinctive and well-known earlier trademarks of the Complainant.

Past panels have decided that the Complainant’s “INTESA” and “INTESA SANPAOLO” trademarks are well-known and have obtained a high degree of recognition [cf., e.g., the CAC Case No. CAC-UDRP-106371, Intesa Sanpaolo S.p.A. v. Termo Electrica].

A simple Google search for “INTESA SANPAOLO” leads Internet users mostly to the Complainant’s name and Its domain names as it is clear from the presented Google search results.

In addition to that, the Complainant’s business activities reach millions of customers (proved by the furnished Report about Intesa Sanpaolo).

Therefore, this Panel states that the Respondent must have been aware of the Complainant’s trademark and its reputation before the registration of the disputed domain name on 18 December 2023.

As was evidenced by the submitted screenshot of the website under the disputed domain name, the disputed domain name is leading Internet users to a blank website with signs as “Carte Visa” and “Conti Deposito”. These signs make a connection to financial services, which are the main part of the Complainant’s business activities and for which the Complainant has registered Its trademarks. By that, the disputed domain name might confuse and attract Internet users to the Respondent’s confusingly similar website for the Respondent’s own commercial gain.

Thus, it might be concluded that the Respondent is not using the disputed domain name in good faith.

The Respondent did not reply to the Complaint and so failed to demonstrate his rights or legitimate interests in the disputed domain name. Moreover, the Respondent did not reply to the cease-and-desist letter sent to him by the Complainant’s attorneys (proved by the submitted communication with the disputed domain name’s Registrar). Both support the finding of the Respondent’s bad faith.

Although there is no clear evidence that would lead to the conclusion that the Respondent is obtaining commercial gain by the “sponsoring activity” that “is being remunerated” (as it is claimed by the Complainant) it does not prevent the finding of the registration and use of the disputed domain name in bad faith by the Respondent.

Following the above-mentioned, the Panel finds that the Complainant has satisfied conditions pursuant to Paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Radim Charvát**

DATE OF PANEL DECISION 2024-06-26