# Decision for dispute CAC-UDRP-106706

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| Case number | CAC-UDRP-106706 |
| Time of filing | 2024-07-18 08:43:25 |
| Domain names | INTESASANPAOLOPIN.COM |

## Case administrator

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| Organization | Iveta Špiclová (Czech Arbitration Court) (Case admin) |

## Complainant

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

## Complainant representative

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

## Respondent

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| Name | Christine Clement |

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 trademarks:

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

The Complainant also owns following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”:

<intesasanpaolo.com>, <intesasanpaolo.org>, <intesasanpaolo.eu>, <intesasanpaolo.info>, <intesasanpaolo.net>, <intesasanpaolo.biz>, <intesa-sanpaolo.com>, <intesa-sanpaolo.org>, <intesa-sanpaolo.eu>, <intesa-sanpaolo.info>, <intesa-sanpaolo.net>, <intesa-sanpaolo.biz>, <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>.

All of the above domain names are connected to the Complainant’s official website www.intesasanpaolo.com.

## FACTUAL BACKGROUND

The Complainant is the leading Italian banking group and also one of the protagonists in the European financial arena. The Complainant's company name is derived 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.

The Complainant is among the top banking groups in the euro zone, with a market capitalisation exceeding 63.5 billion euro. It claims to be the undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

It has 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. It offers its services to approximately 13,6 million customers.

The Complainant has a strong presence in Central-Eastern Europe with a network of approximately 900 branches and over 7.3 million customers.

Its international network specialises in supporting corporate customers and is present in 25 countries, especially in the Mediterranean area and those areas where Italian companies are most active, such as the United States, Russia, China and India.

The disputed domain name <INTESASANPAOLOPIN.COM> was registered on November 10, 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 that the disputed domain name is identical to 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.

The disputed domain name reproduces the Complainant's trademark "INTESA SANPAOLO" with the addition of the term "PIN".

The Complainant contends that the disputed domain name is identical, or at least, confusingly similar, to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA".

Whether a disputed domain name is identical or confusingly similar to a trademark can be determined by making a side-by-side comparison with the disputed domain name. See F. Hoffmann-La Roche AG v. P Martin, WIPO Case No. D2009-0323.

A disputed domain name is identical to the trademark when it is a character for character match. It is confusingly similar when it varies the trademark by, for example, adding generic terms to the dominant part of the trademark.

Here, the Complainant's trademark is reproduced in its entirety in the disputed domain name. The addition of the term "PIN", which the Complainant asserts, represents a sequence of numeric characters usually used to verify that the person using a device or a service, such as a debit card withdrawal, is authorised to make that operation as owner of the device.

The Complainant contends that this is confusing and misleading for internet users, who might think that the disputed domain name is somehow connected to the Complainant, which it denies.

The Panel considers the addition of the term "PIN" to the form the disputed domain name incorporating "INTESASANPAOLO" makes it confusingly similar to the Complainant's trademark. The dominant element of the disputed domain name is "INTESASANPAOLO". The addition of a pronounceable word "PIN" is likely to accentuate the risk of confusion.

It is also trite to state that the addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name and will be disregarded for the purposes of considering this ground.

Accordingly, the Panel considers that this ground is made out.

## 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.

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

The Complainant contends that the Respondent has no rights in the disputed domain name, and that it has not authorised or licensed the Respondent to use any of its trademarks "INTESA SANPAOLO" and "INTESA".

The Complainant also asserts that the disputed domain name does not correspond to the name of the Respondent and to the best of its knowledge is not commonly known as "INTESASANPAOLOPIN". The Complainant, however, did not adduce any direct evidence from the WHOIS database to support this additional assertion which, while not fatal, would have added further weight to the satisfaction of paragraph 4(a)(ii) of the Policy.

Finally, the Complainant contends that it has not found any fair or non-commercial uses of the disputed domain name. The Complainant's evidence shows that when using Google to access the disputed domain name website, it returned a security error with the message "Impossibile raggiungere il sito". While not conclusive, it shows the website cannot be reached. The strong inference is there is no fair or non-commercial use of the disputed domain name.

As the Respondent has not filed any administrative compliant response to the Complaint, the Panel accepts that the Complainant's contention that the Respondent has no rights or legitimate interests to the disputed domain name.

Accordingly, the Panel considers that this ground is made out.

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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.

There are two elements that must be satisfied – registration and use in bad faith.

The evidence shows, and the Panel accepts, that the Complainant's trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and well known all around the world. The Complainant's trademarks were clearly registered prior to the registration of the disputed domain name.

The Complainant contends that the registration of a confusingly similar domain name by the Respondent implies that the Respondent had knowledge of the Complainant's trademarks at the time of registration. A basic Google search for these terms would have clearly indicated their association with the Complainant, suggesting the Respondent's awareness of the Complainant's rights.

The Panel is prepared to draw the inference that the disputed domain name was registered by the Respondent with knowledge of the Complainant's trademarks, thereby constituting registration in bad faith.

The Complainant also contends that the passive holding of the domain name, especially given the notoriety of its trademarks, supports a finding of bad faith, referencing Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003 that establishes passive holding with knowledge of another's trademark as evidence of bad faith.

The evidence shows that the disputed domain name website cannot be reached. It is a clear example of passive holding. The Panel accepts that such conduct is evidence of use in bad faith given the notoriety of the Complainant's trademarks.

The Complainant further contends that despite a cease-and-desist letter sent to the Respondent on December 15, 2023, requesting the voluntary transfer of the disputed domain name, the Respondent did not respond or comply, further indicating bad faith.

While there is no obligation for the Respondent to respond to the Complainant's cease-and-desist letter, failing to do so has the consequence that it may infer bad faith registration and use.

Such silence can also support a contention of abusive registration. The inference is that if the Respondent has a right or legitimate interest in the disputed domain name, it would have responded.

Here, the Panel is prepared to draw the inference from the Respondent's conduct of omission to support the contention that the disputed domain name was registered and used in bad faith.

No challenge has been made by the Respondent to the Complainant's contentions and assertions as it has not filed any administrative compliant response.

As the Panel has already made the above finding, it is unnecessary to consider the Complainant's further assertions relating to potential "phishing" or resale of the disputed domain name to the Complainant due to the lack of any evidence to support these

assertions. A mere possibility is insufficient evidence.

Accordingly, the Panel accepts that the disputed domain name was registered by the Respondent and used in bad faith.

PROCEDURAL FACTORS

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On August 21, 2024 the CAC by its Nonstandard Communication stated as follows (omitting irrelevant parts):

- That neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court.
- As far as the e-mail notice is concerned, the CAC did not receive any confirmation about delivery if the e-mail sent to postmaster@intesasanpaolopin.com was delivered or not.
- The e-mail notice sent to zakariaback@hotmail.com was returned back undelivered as the e-mail address had permanent fatal errors.

No further e-mail address could be found on the disputed site. The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above Nonstandard Communication, 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 Complainant owns the international trademarks "INTESA SANPAOLO" and "INTESA" and the domain name <intesasanpaolo.com> which are used in connection with its goods or services.

The Respondent registered the disputed domain name <INTESASANPAOLOPIN.COM> on November 10, 2023. The website of the disputed domain name cannot be reached.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("Policy") and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent failed to file any administratively compliant response.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

(a) The disputed domain name is identical to (when ignoring the addition of the term "PIN") or confusingly similar to the Complainant's well-known trademarks "INTESA SANPAOLO" and "INTESA".

(b) The Respondent has no rights or legitimate interests in respect of the disputed domain name.

(c) The disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLOPIN.COM**: Transferred

## PANELLISTS

| Name | **William Lye OAM KC** |
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DATE OF PANEL DECISION 2024-09-02