Decision for dispute CAC-UDRP-106783

Case number	CAC-UDRP-106783
Time of filing	2024-08-12 09:33:04
Domain names	INTESASANPAOLO-VERIFICA.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

Organization	Sahari Muti Inc

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 has demonstrated ownership of rights in the trademark INTESA SANPAOLO for the purposes of standing to file a UDRP complaint.

In particular, the Complainant is the owner of trademark registrations for INTESA SANPAOLO, including the following:

- International trademark registration No. 920896 for INTESA SANPAOLO, registered on 7 March 2007, duly renewed and covering goods and services in classes 9, 16, 35, 36, 38, 41 and 42; and

- European Union trademark registration No. 5301999 for INTESA SANPAOLO, registered on 18 June 2007, duly renewed and covering services in classes 35, 36 and 38.

The Complainant also refers to ownership over the number of domain names that incorporate its INTESA SANPAOLO trademark, such as <intesasanpaolo.com>, registered on August 24, 2006, <intesasanpaolo.org>, registered on September 8, 2006 and <intesasanpaolo.eu>, registered on August 26, 2006.

FACTUAL BACKGROUND

The Complainant is an Italian banking group formed from the merger of Banca Intesa S.p.A and Sanpaolo IMI S.p.A on 1 January 1, 2007. The Complainant's market capitalization exceeds 64,5 billion euro and Its network has approximately 3,300 branches in Italy alone where its services are offered to approximately 13,6 million customers. The Complainant also 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.

The disputed domain name was registered on June 9, 2024 and it currently resolves to a webpage that is blocked due to a suspected phishing activity.

PARTIES CONTENTIONS

The Complainant

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it. In particular, the Complainant argues that the disputed domain name is confusingly similar to its INTESA SANPAOLO and INTESA trademarks as both of these trademarks are contained in their entirety within the disputed domain name. The only difference between the disputed domain name and the Complainant’s trademark is the addition of the Italian term “VERIFICA”, meaning “verification”, which is an expression widely used by the Complainant for the security of its clients’ bank accounts.

Regarding the second UDRP element, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Neither license nor authorization has been granted to the Respondent (or any other person to that matter) to make any use of the Complainant’s trademark within the disputed domain name. The Respondent is also not commonly known by the disputed domain name and the use of the disputed domain name for a website blocked due to suspected phishing activities cannot be considered as a fair or non-commercial use.

With respect to the third UDRP element, the Complainant holds that its INTESA SANPAOLO and INTESA trademarks are distinctive and well-known all around the world and 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. Furthermore, a simple internet search for these trademarks would have yielded obvious references to the Complainant. Therefore, the Complainant holds that the disputed domain name is registered in bad faith. Additionally, 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 trademark as to the source, sponsorship, affiliation, or endorsement of his website. The fact that the website to which the disputed domain name resolves is blocked due to a suspected phishing activity indicates that the Respondent was to use this website for phishing financial information in an attempt to defraud the Complainant’s customers. This illicit activity was promptly stopped by Google who has blocked the webpage which makes it clear that the disputed domain name was also used in bad faith.

The 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 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

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy stipulates that the complainant must prove each of the following:

1. that the disputed domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
2. that the respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name, as stipulated in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“WIPO Overview 3.0”).

The Complainant has shown rights in respect of the INTESA SANPAOLO trademark for the purposes of the Policy (WIPO Overview 3.0, section 1.2.1). Although the Complainant has based its complaint on both INTESA SANPAOLO and INTESA trademarks, and although both trademarks are contained in their entirety within the disputed domain name, the Panel holds that for the purposes of analysis of the first UDRP element, it is sufficient to take into account only INTESA SANPAOLO trademark. Having in mind that INTESA SANPAOLO trademark consists of 2 verbal elements that are both contained within the disputed domain name and since INTESA trademark is already contained within INTESA SANPAOLO trademark, the Panel deems that analysis of both trademarks would be redundant and, as such, would not make any impact on the Panel's conclusions regarding the first UDRP element. The Panel will also use the same approach in assessment of the second and the third UDRP element.

The entirety of the Complainant's trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy (WIPO Overview 3.0, section 1.7).

Although the addition of other terms, here “verifica”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark for the purposes of the Policy (WIPO Overview 3.0, section 1.8). Similarly, the presence of hyphen between the Complainant's trademark and the additional word “verifica” also does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark.

In addition, it is well established that “.com”, as a generic Top-Level Domain, can be disregarded in the assessment of the confusing similarity between the disputed domain name and the Complainant’s trademark (WIPO Overview 3.0, section 1.11.1).

The Panel, therefore, finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

In particular, the Panel notes that there appears to be no relationship between the Respondent and the Complainant and that the Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s INTESA SANPAOLO trademark. There appears to be no element from which the Panel could infer the Respondent’s rights and legitimate interests in the disputed domain name, or that the Respondent might be commonly known by the disputed

domain name.

The Panel also finds that the structure of the disputed domain name, which contains the Complainant's INTESA SANPAOLO trademark in combination with the Italian word "verifica" (meaning "verification"), carries a high risk of implied affiliation (see WIPO Overview 3.0, section 2.5.1). This additional word closely corresponds to the Complainant's field of business and as such is inherently connected to the Complainant and its trademark and may imply sponsorship or endorsement by the Complainant.

Having in mind the above, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith (WIPO Overview 3.0, section 3.2.1).

In the present case, the Panel notes that the Respondent must have been aware of the Complainant and its INTESA SANPAOLO trademark, especially having in mind the distinctiveness of the Complainant's trademark. It is, therefore, highly unlikely that the Respondent decided to register a domain name containing this trademark in its entirety without having the Complainant in mind when doing so. It should be also borne in mind that that the first registration and use of INTESA SANPAOLO trademark predates the registration of the disputed domain name for more than 15 years, making it unlikely that the Respondent was not aware of the Complainant's trademark at the time of registration of the disputed domain name. Also, the choice of additional word "verifica" (meaning "verification" in Italian that can be understood as the reference to the process by which a consumer can verify its bank account or a bank transaction) further indicates that the Respondent was well-aware of the Complainant and its activities and had the Complainant and its INTESA SANPAOLO trademark in mind when registering the disputed domain name.

Due to the above, the Panel finds that the disputed domain name has been registered in bad faith.

As indicated above, the disputed domain name currently resolves to a webpage that is blocked due to a suspected phishing activity. Clearly, a use of a domain name for illegal activity (such as phishing) constitutes bad faith (see WIPO Overview 3.0, section 3.4). However, the Panel has some doubts whether mere blocking of the webpage due to suspected phishing activity can be indeed used as evidence of illegal activity by the Respondent. For that reason, the Panel has performed limited factual research in accordance with general powers granted to the Panel under paragraphs 10 and 12 of the Rules (see, in particular, section 4.8 of WIPO Overview 3.0) in order to access to website to which the disputed domain name resolves. Based on the findings of the Panel, once the user proceeds to the blocked website (by clicking on "Only visit this unsafe site if you're sure you understand the risks"), it ends up on an inactive page. There are no records in the internet archive that would shed a light on previous use of the disputed domain name and whether it was actually used for a phishing website. The Panel understands that limitations of internet archive and also takes into account that the disputed domain name was recently registered and therefore finds that lack of records in the internet archive should not be taken as conclusive evidence that the disputed domain name was not previously used for phishing purposes.

Nonetheless, even in the case that the disputed domain name was never used for a phishing website, the Panel holds that the particular circumstances of this case would still lead to establishment of the bad faith on the Respondent's side under the doctrine of passive holding. Previous panels have already considered that passive holding of a disputed domain name can satisfy the requirements of paragraph 4(a)(iii) of the Policy, and that in such cases the panel must give close attention to all the circumstances of Respondents' behaviour (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). The principles established in Telstra Corporation Limited v. Nuclear Marshmallows, had been widely adopted by UDRP panels and have found its place in WIPO Overview 3.0. In accordance with Section 3.3. of WIPO overview 3.0, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. It should be emphasized that it is not required that all the above-listed factors be present in order to establish bad faith use of the disputed domain name (see, for example, Compagnie Générale des Etablissements Michelin v. K Nandalal, BlueHost, WIPO Case No. D2021-3990). Having in mind the distinctiveness of the Complainant's INTESA SANPAOLO trademark and the structure of the disputed domain name (that clearly indicates targeting of the Complainant), it is rather difficult to imagine that such a domain name could be put into any good faith use.

The Panel finds that the disputed domain name has been both registered and is being used in bad faith, and consequently that the Complainant has established the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO-VERIFICA.COM**: Transferred

PANELLISTS

Name	**Stefan Bojovic**

DATE OF PANEL DECISION 2024-09-17

Publish the Decision