Decision for dispute CAC-UDRP-106775

Case number	CAC-UDRP-106775
Time of filing	2024-08-08 09:19:05
Domain names	AVVISOINTESASANPAOLO.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	Riccardo Marchi

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 trademarks INTESA SANPAOLO and INTESA, such as:

- International word mark INTESA SANPAOLO, registered on 7 March 2007 under no. 920896 for goods and services of classes 9, 16, 35, 36, 38, 41 and 42;
- International word mark INTESA, registered on 4 September 2002 under no. 793367 for services of classes 36;
- EU word mark INTESA SANPAOLO, registered on 18 June 2007 under no. 5301999 for goods and services of classes 35, 36 and 38;
- EU word mark INTESA, registered on 5 March 2014 under no. 12247979 for goods and services of classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

According to the Complainant, Intesa Sanpaolo is a leading Italian banking group, resulting from the merger (effective as of 1 January 2007) between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two of the top Italian banking groups.

The Complainant asserts that it is among the top banking groups in the euro zone, with a market capitalisation exceeding 63,5 billion euro, and a leader in Italy in all business areas (retail, corporate and wealth management). The Complainant states that the

group, with a well-distributed network of around 3,300 branches across Italy, holds market shares exceeding 15% in most Italian regions, serving approximately 13.6 million customers. Additionally, the Complainant highlights the group's strong presence in Central-Eastern Europe, where it operates around 900 branches and serves over 7.3 million customers.

The Complainant is the owner of a large domain name portfolio, which includes domain names with the wording INTESA or INTESA SANPAOLO, such as <intesasanpaolo.com> and <intesa.com>.

The disputed domain name <avvisointesasanpaolo.com> was registered on 29 November 2023.

PARTIES CONTENTIONS

The Complainant´s contentions are summed up below.

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. **The disputed domain name is confusingly similar to the Complainant's trademarks**

According to the Complainant, the disputed domain name is confusingly similar to its well-known trademark INTESA SANPAOLO. The disputed domain name incorporates in full the Complainant's INTESA SANPAOLO trademark, with the mere addition of the Italian term AVVISO, meaning "notice", which refers to the notification service offered by the Complainant to its customers.

The generic Top-Level Domain extension of the disputed domain name, in this case ".com", is typically disregarded under the confusing similarity test, as it is a standard requirement for registration.

Therefore, the Complainant concludes and the Panel agrees that the disputed domain name is confusingly similar to the Complainant's trademark.

2. **The Respondent has no rights or legitimate interests in respect of the disputed domain name**

The Complainant asserts that the Respondent is not commonly known by the disputed domain name.

The Complainant further states that the Respondent is not authorized or licensed by the Complainant to make any use the disputed domain name. In addition, the Complainant asserts that it has not found any fair or non-commercial use of the disputed domain name.

The Panel finds that the Complainant has shown that the Respondent is not commonly known by the disputed domain name and has not made legitimate use of the disputed domain name for a bona fide offering of goods or services. In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

3. **The disputed domain name was registered and is being used in bad faith**

The Complainant argues that the distinctiveness and global recognition of the Complainant's trademarks suggest that the Respondent registered the disputed domain name with knowledge of the Complainant's trademarks.

The Complainant demonstrates that an online search for the words INTESA, INTESA SANPAOLO and AVVISO INTESA SANPAOLO on popular search engines would have inevitably informed the Respondent about the Complainant.

The Complainant demonstrates that the disputed domain name is not connected to any website. The Complainant asserts that it is objectively not possible to understand what use the Respondent could make of the disputed domain name. The Complainant cites past panel decisions, confirming that passive holding of a domain name with knowledge that it infringes another party's trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

The Complainant believes that the disputed domain name was registered for „phishing" purposes, aiming to induce and divert the Complainant's legitimate customers to its website and steal money. The Complainant notes that it has been targeted by phishing attacks in the past few years.

The Complainant suggests that another possible intention of the Respondent in registering the disputed domain name might be to resell it to the Complainant.

Finally, the Complainant states that its attorneys have sent a cease-and-desist letter to the Respondent asking for a voluntary transfer of the disputed domain name, to which the Respondent did not reply.

In lack of any Response from the Respondent, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AVVISOINTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	**Tom Heremans**

DATE OF PANEL DECISION 2024-09-17

Publish the Decision