Decision for dispute CAC-UDRP-106773

Case number	CAC-UDRP-106773
Time of filing	2024-08-08 09:44:10
Domain names	INTESASANPAOLO-CLIENTI.NET

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	anza beni lanim

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 holder of several trademarks including:

- International word mark “INTESA SANPAOLO” registered under No. 920896 on March 7, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;
- International word mark “INTESA” registered under No. 793367 registered on September 4, 2002, in class 36.

FACTUAL BACKGROUND

The Complainant, Intesa Sanpaolo S.p.A., is an Italian banking group.

The Complainant is the owner of several INTESA and INTESA SANPAOLO trademarks, including the international word mark “INTESA SANPAOLO” registered under No. 920896 on March 7, 2007, covering goods and services in classes 9, 16, 35, 36, 38, 41 and 42.

The Complainant is also the owner of several domain names connected to its official website, including <intesasanpaolo.com>.

The disputed domain name has been registered on July 20, 2024. According to the Complainant’s evidence, the disputed domain

name appeared to resolve to a website displaying a login form to access a personal online bank account and reproducing the layout and colors of Complainant's official website as well as displaying the Complainant's INTESA SANPAOLO trademark and logo. The disputed domain name currently resolves to an inaccessible website.

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 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

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

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

The Panel has therefore dealt with each of these requirements in turn.

1. Identity of confusing similarity

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant shows to be the holder of several registered INTESA SANPAOLO trademarks, it is established that there is a trademark in which the

Complainant has rights.

The disputed domain name incorporates the Complainant's INTESA SANPAOLO trademark in its entirety, merely adding a hyphen and the term "clienti". In the Panel's view, this addition does not prevent the Complainant's trademark from being recognizable within the disputed domain name (see section 1.8 WIPO Overview 3.0; IM PRODUCTION v. Xue Han, CAC Case No. 104877 <isabel-marantus.com>).

Additionally, it is well established that the Top-Level Domains ("TLDs") such as ".net" may be disregarded when considering whether the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (see section 1.11 WIPO Overview 3.0).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No rights or legitimate interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of production to the Respondent (although the burden of proof always remains on the Complainant) (see section 2.1 WIPO Overview 3.0 and Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455; Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is known as "anza beni lanim". The Respondent's use and registration of the disputed domain name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Fundamentally, a respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner. The correlation between a domain name and the complainant's mark is often central to this inquiry. Generally speaking, UDRP panels have found that where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 WIPO Overview 3.0). The disputed domain name incorporates the Complainant's INTESA SANPAOLO trademark in its entirety, merely adding a hyphen and the term "clienti", which means "client" in Italian. In the Panel's view, this combination may even increase the risk of confusion with the Complainant as the Italian word "clienti" will likely be linked with the Complainant and its banking services. Therefore, the Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant and cannot constitute fair use.

Beyond looking at the domain name and the nature of any additional terms appended to it, panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the WIPO Overview 3.0).

According to the Complainant's evidence, the disputed domain name appeared to resolve to a website displaying a login form to access a personal online bank account and reproducing the layout and colors of Complainant's official website as well as displaying the Complainant's INTESA SANPAOLO trademark and logo. The Panel finds that this does not amount to a bona fide offering of goods or services, or a legitimate noncommercial or fair use of the disputed domain name. UDRP panels have categorically held that the use of a domain name for illegal activity (e.g. impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see section 1.13 of the WIPO Overview 3.0).

The Panel observes that the disputed domain name currently resolves to an inaccessible website. In the Panel's view, this does not amount to any legitimate noncommercial or fair use or use in connection with a bona fide offering of goods and services either.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name. In light of the above, the Complainant succeeds on the second element of the Policy.

3. Bad faith

The Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (see section 4.2 WIPO Overview 3.0 and e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

According to the Panel, a respondent's awareness of a complainant and/or a complainant's trademark rights at the time of

registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070).

In the instant case, the Panel finds that the Respondent must have had knowledge of the Complainant's rights in the INTESA SANPAOLO trademark when it registered the disputed domain name, as:

- the disputed domain name incorporates the Complainant's distinctive INTESA SANPAOLO trademark in its entirety and only adds a term which can be easily linked to the Complainant and its business;
- the disputed domain name appeared resolve to a website offering services similar to those of the Complainant (e.g. banking services) and displaying the logo and trademark of the Complainant;
- some of the Complainant's INTESA SANPAOLO trademarks were registered at least 15 years before the disputed domain name.

As established above, the disputed domain name resolved to a website appearing to offer services similar to those of the Complainant and displaying the Complainant's "INTESA SANPAOLO" mark and logo. In the Panel's view, the circumstances of this case indicate that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complaint and the Complainant's trademarks (see section 3.2.4, WIPO Overview 3.0).

Given the totality of the circumstances discussed above, the current state of the disputed domain name redirecting to an inaccessible webpage does not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3, WIPO Overview 3.0).

Finally, the Respondent did not formally take part in the administrative proceedings. According to the Panel, this serves as an additional indication of the Respondent's bad faith.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was 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. **INTESASANPAOLO-CLIENTI.NET**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2024-09-19

Publish the Decision