Decision for dispute CAC-UDRP-106895

Case number	CAC-UDRP-106895
Time of filing	2024-09-26 13:16:59
Domain names	INTESAMIRSANPAOLO.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	Camelia Longo

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 a number of trademark registrations covering various jurisdictions including the following:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 41 and 42;

- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in connection with class 36;

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38; and

- EU trademark registration n. 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.

FACTUAL BACKGROUND

The Complainant is the leading Italian banking group and also one of the most prominent figures in the European financial arena.

Intesa Sanpaolo is the company resulting 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. Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 68,8 billion euro, and it is the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). With 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 also has a strong presence in Central-Eastern Europe with a network of approximately 900 branches and over 7.4 million customers. Moreover, the international network specialised 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. Moreover, the Complainant is also the owner, among others, of the following domain names: <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>; and <intesa.me>, all of which redirect users to the Complainant's official website at http://www.intesasanpaolo.com.

PARTIES CONTENTIONS

COMPLAINANT:

The disputed domain name, which was registered on March 6, 2024, is identical or at least confusingly similar to the Complainant's trademarks as it inserts the expression "Mir" between the mark's verbal portions "INTESA" and "SANPAOLO", with obvious references to "MIR CAPITAL", the Italian-Russian private equity fund, established as part of the partnership between Gazprombank and Intesa Sanpaolo. The disputed domain name also adds the ".com" TLD. Further, the disputed domain name has been blocked by Google Safe Browsing as connected to suspected phishing activity or other illicit use. The Respondent thus has no rights or legitimate interests in the disputed domain name, it is not authorised to use the Complainant's trademarks, it is not commonly known by the name, and it is not making a bona fide or fair use of the disputed domain name. Further, the addition of a descriptive word to the Complainant's trademark for a domain name whose website is blocked for illicit activity, indicates that the disputed domain name was registered and used in bad faith.

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

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at paragraph 4.3; see also GROUPE CANAL + v. Danny Sullivan, 102809 (CAC January 21, 2020) ("the Panel, based on the poorly supported and conclusory allegations of the Complainant, retains that the Complainant has not prevailed on all three elements of the paragraph 4(a) of the Policy and, therefore, rejects the Complaint.")

1. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrate its ownership of trademark rights and that the disputed domain name is confusingly similar to such trademark. Boehringer Ingelheim Animal Health France / Merial v. S Jon Grant, 103255 (CAC September 30, 2020) ("it is imperative that the Complainant provides evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark(s).").

The Complainant has submitted screenshots from the website of the World Intellectual Property Office (WIPO) and scans of its Certificates of Registration from the European Intellectual Property Office (EUIPO) as evidence that it owns registered rights to its asserted INTESA and INTESA SANPAOLO trademarks in multiple jurisdictions. Registration with such national and multi-national offices has been found sufficient to satisfy the threshold requirement of proving trademark rights under Paragraph 4(a)(i) of the Policy. Margaritaville Enterprises, LLC v. Neil Wein, FA 1916531 (FORUM November 9, 2020) ("It is well established by decisions under this Policy that a trademark registered with a national authority is evidence of trademark rights"). The disputed domain name adds the generic term "mir" and the .com gTLD to the INTESA SANPAOLO trademark and thus the second level of the disputed domain name is confusingly similar to the asserted trademark and will lead internet users to wrongly believe that the disputed domain name originates or is endorsed by the Complainant. Prior panels have found confusing similarity under similar fact situations. Migros-Genossenschafts-Bund v. Anonymized Respondent, UDRP-106814 (CAC October 9, 2024) ("The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark MIGROS since the mere addition of a descriptive word "gruppe" does not eliminate any confusing similarity.").

Also, the extension ".com" typically adds no meaning or distinctiveness to a disputed domain name and may most often be disregarded in the Paragraph 4(a)(i) analysis. Novartis AG v. Wei Zhang, 103365 (CAC December 9, 2020) ("it is generally accepted that the addition of the top-level suffix in the domain name (e.g., '.com') is to be disregarded under the confusing similarity test").

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the addition of two letters thereto in the disputed domain name is insufficient to avoid a finding that it is confusingly similar to the Complainant's trademarks. Thus, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

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

Pursuant to Paragraph 4(a)(ii) of the Policy, the Complainant has the burden of making a prima facie showing that the Respondent has no rights or legitimate interests in the disputed domain name. Cephalon, Inc. v. RiskIQ, Inc., 100834 (CAC September 12, 2014). Once this burden is met, it then shifts to the respondent to demonstrate that it does have rights or legitimate interests in the domain name. Paragraph 4(c) of the Policy offers the Respondent several examples of how to demonstrate its rights or legitimate interests in the disputed domain name.

Under Paragraph 4(c)(ii) of the Policy a defence is provided where the evidence shows that a respondent is commonly known by the disputed domain name. In considering this issue, relevant information can include the WHOIS record and any assertions by a complainant regarding the nature of its relationship with a respondent. See LABORATOIRE NUXE v. Domains For Sale, UDRP-106079 (CAC January 25, 2024) ("Past panels have held that a respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name."). See also Z&V v. Mecara Untech (Mecara Untech), UDRP-106222 (CAC February 27, 2024) (no rights or legitimate interests found where "[n]either license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark."). The WHOIS record for the disputed domain name, as verified by the concerned Registrar, identifies the registrant name as "Camelia Longo". The Complainant further asserts that "[n]obody has been

authorized or licensed by the above-mentioned banking group to use the domain name at issue.”. The Respondent has not participated in this case and so it does not offer any information or evidence to argue against the Complainant’s assertions. Accordingly, the Panel finds no ground upon which to conclude that the Respondent is commonly known by the disputed domain name under Policy paragraph 4(c)(ii).

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain name. The disputed domain name does not resolve to any website as it has been blocked by Google Safe Browsing as a suspected phishing site. Past decisions under the Policy have held that non-use of a disputed domain name is not a bona fide offering of goods or services. See, e.g., DIGITAL CLASSIFIEDS FRANCE v. Cralos [sic] Ramirez Fuentes, UDRP-105639 (CAC August 17, 2023) (no bona fide use found where "the Complainant has demonstrated that the disputed domain name did not in the past, and still does not, connect to any relevant content on the Internet, but is passively held by the Respondent instead."). Further, it should be obvious that the operation of a phishing or other nefarious scheme also does not constitute a bona fide offering of goods or services. See, e.g., The Manufacturers Life Insurance Company v. Thomas Kracklan, UDRP-104840 (CAC December 13, 2022) (“The disputed domain name has been used for phishing. This is designed to be deceptive and confusing and pass off the Respondent as a representative of the Complainant. As such it cannot amount to the bona fide offering of goods and services or a legitimate fair use.”). From the screenshot submitted by the Complainant, it is shown that the disputed domain name resolves to a page that contains only a message in Italian which translates to “Dangerous site. Attackers on the site you are trying to visit may be tricking you into installing software or revealing information such as your password, phone number, or credit card.“. The Respondent has not filed a Response or made any other submission in this case to offer an alternative explanation for its actions. As the Complainant has made out a prima facie case that has not been rebutted by the Respondent, upon a preponderance of the evidence before it the Panel finds that the Respondent fails to make a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name per Paragraphs 4(c)(i) or (iii) of the Policy.

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

Under Paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate both that the disputed domain name was registered and is being used in bad faith. Further guidance on that requirement is found in Paragraph 4(b) of the Policy, which sets out four examples of possible actions by the Respondent that may satisfy this burden of proof.

The Complainant asserts that the Respondent was aware of and targeted the INTESA SANPAOLO trademark at the time it registered the disputed domain name. Actual knowledge of a complainant’s trademark, whether based on the trademark’s reputation or the respondent’s use of the disputed domain name, may form the foundation upon which to build a case for bad faith registration under Policy paragraph 4(a)(iii). See, Intesa Sanpaolo S.p.A. v. Ciro Lota, UDRP-106302 (CAC April 4, 2024) (“Given the distinctiveness and reputation of the Complainant's prior marks, it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant's rights in such well-known marks and the intention to exploit such reputation by diverting traffic away from the Complainant’s website.”). Based on the documents submitted by the Complainant which set out many of the facts about the INTESA SANPAOLO trademark (e.g., history, market capitalization, operating income, territory, number of bank branches and customers, etc.), the Panel accepts that the trademark is quite well-known. Further, the Complaint asserts that “Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name.”. The Panel finds this persuasive as the Respondent uses an identical copy of the distinctive and well-known trademark in the second level of the disputed domain name and adds only the word “mir” which the Complainant claims is an “obvious references to “MIR CAPITAL”, the Italian-Russian private equity fund…”. Based on the distinctiveness and widespread reputation of the Complainant’s trademark, the Panel concludes that it is more likely than not that the disputed domain name was registered with actual knowledge of the Complainant’s trademark rights.

As for use, the Complainant has submitted evidence that the disputed domain name resolves only to a warning page. The lack of activity has routinely been held to demonstrate bad faith use of a domain name that is confusingly similar to a complainant's trademark. BOURSORAMA v. Sahad Mohammed Riviera (Sahari Muti Inc), UDRP-105427 (CAC June 15, 2023) ("a passive holding of a disputed domain name may, in appropriate circumstances, be consistent with the finding of bad faith, in particular in circumstances in which, for example, (1) the Complainant's trademark is reputed and (2) there is no conceivable use that could be made of the disputed domain name and would not amount to an infringement of the complainant’s trademark’s rights."). It is also alleged that the website was engaged in phishing or other illicit activity which is also strong evidence of bad faith use. See, e.g., Deutsche Börse AG v. Minos Pitsillides (ompupits IT Services), UDRP-106654 (CAC July 27, 2024) (“Phishing is bad faith per se.”). The Respondent has not participated in this case to explain its actions and so, based upon a preponderance of the available evidence, the Panel finds that, in accordance with paragraph 4(b)(iv) of the Policy, the disputed domain name has been used to target Complainant in bad faith as it creates a likelihood of confusion with the INTESA SANPAOLO trademark and resolves to a website containing the warning “Dangerous site. Attackers on the site you are trying to visit may be tricking you into installing software or revealing information such as your password, phone number, or credit card.”.

Finally, the Complainant asserts that the Respondent failed to respond to a cease-and-desist letter sent through its Registrar. When viewed against all of the circumstances of a given case, a failure to respond to a cease-and-desist letter can provide additional supporting evidence of bad faith per Policy paragraph 4(a)(iii). See Arla Foods Amba v. James Moore, UDRP-105866 (CAC November 25, 2023) (finding that failing to respond to a cease-and-desist demand letter constitutes bad faith). On this basis the Panel finds further support for its above conclusion that the Respondent has acted in bad faith pursuant to Policy paragraph 4(a)(iii).

In light of the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) and that the disputed domain name has been registered and 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. **INTESAMIRSANPAOLO.COM**: Transferred

PANELLISTS

Name	**Steven Levy**

DATE OF PANEL DECISION 2024-10-29

Publish the Decision