Decision for dispute CAC-UDRP-107010

Case number	CAC-UDRP-107010
Time of filing	2024-10-30 09:45:08
Domain names	INTESA-CLIENT.ORG

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.

Respondent

Name	David Vozilkin

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

In these proceedings, the Complainant relies on its following trademarks:
- International trademark registration no. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in class 36, also covering Switzerland, where the Respondent is apparently located;

- International trademark registration no. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42, also covering Switzerland, where the Respondent is apparently located;
- EU trademark registration no. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006, granted on June 18, 2007 and duly renewed, in classes 35, 36 and 38;
- EU trademark registration no. 12247979 “INTESA”, filed on October 23, 2013, granted on March 5, 2014, and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42.

It is worth noting that, the Complainant also owns multiple registrations for the same trademarks in many countries around the world, which have not been cited in these proceedings.

Further, the Complainant is also the owner, among others, of the following domain names bearing the signs <INTESA SANPAOLO> and “INTESA”: <INTESASANPAOLO.COM>,.ORG, .EU, .INFO, .NET, .BIZ, <INTESA-SANPAOLO.COM>, .ORG, .EU, .INFO, .NET, .BIZ and <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>, <CLIENTE-INTESASANPAOLO.COM>, <CLIENTE-INTESASANPAOLO.ONLINE>, <CLIENTI-INTESASANPAOLO.COM>, <CLIENTIINTESASANPAOLO.IT>, <INTESASANPAOLO-

CLIENTI.COM>, <INTESASANPAOLO-CLIENTI.NET> and <CLIENTIWEBINTESASANPAOLO.IT>. All of them are now connected to the official website http://www.intesasanpaolo.com.

FACTUAL BACKGROUND

The Complainant is a large Italian banking group of companies, which emerged in 2007 from two other large Italian banking groups, Banca Intesa S.p.A. and Sanpaolo IMI S.p.A.

According to the evidence filed by the Complainant and not disputed by the Respondent, the Complainant has thousands of branches and millions of customers in Europe, where it figures in the top banking groups, as well as in other large countries of the world. It is especially well active in its home country Italy, but is also present in Switzerland, where the Respondent is based.

The Complainant owns a significant portfolio of trademarks including the wording “INTESA” and "INTESA SANPAOLO", among which notably two international registrations dating back to 2002 and 2007, as well as a couple of EU trademark registrations from 2006 and 2013. It also owns a multitude of related domain names, including quite a few that combine its trademark “INTESA” with the word element “CLIENT-”.

The disputed domain name <INTESA-CLIENT.ORG> was registered on June 17, 2024 by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name is confusingly similar to its “INTESA” and “INTESA SANPAOLO” trademarks; that the Respondent lacks rights or legitimate interests in the disputed domain name, and; that the Respondent registered and used the disputed domain name 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).

More precisely, the disputed domain name <INTESA-CLIENT.ORG> wholly incorporates the Complainant’s International and EU Trademark Registrations for “INTESA” to which it is identical, as well as to its highly similar domain names. Indeed, the mere addition of the generic word “CLIENT” to the Complainant’s trademark in the disputed domain name is not sufficient to escape the finding of confusing similarity, as the other word element has been kept intact by the Respondent (INTESA).

As far as the gTLD ".org" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the INTESA trademark in a domain name, and that it had never licensed its trademark to the Respondent, who is not affiliated or doing any business with the Complainant.

Furthermore, and finally, there is neither any evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name, nor is there any non-commercial or fair use of the disputed domain name by the Respondent.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defence. However, the Respondent has chosen not to file a Response.

Therefore the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark, especially in Europe where the Respondent is also based and the fact that the disputed domain name fully incorporates the said trademark, it is rather clear to this Panel that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name resolves – according to the Complainant, not refuted by the Respondent – to an active website promoting services of a competitor company to the Complainant, which are in fact passed off for services of the Complainant. Such fraudulent use of a domain name shows bad faith under some circumstances, such as when the complainant’s trademark has such a strong reputation that it is widely known, and when it is impossible to conceive any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate. This fact is to be combined with the full incorporation of the Complainant’s reputable trademark in the disputed domain name. These are exactly the circumstances that apply in the case at issue. The trademarks INTESA SANPAOLO and INTESA enjoy wide and extensive reputation in their field of business. Thus, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate. This conclusion is further reinforced by the intentional use of the generic word “CLIENT” by the Respondent, as this term relates and points to the Complainant’s clientele, a usual practice in the banking and financial industry.

Therefore, the Panel finds it clear that the disputed domain name was used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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

The disputed domain name wholly incorporates the Complainant's trademark. The disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademark in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's well-known trademark. His use of the disputed domain name is in bad faith, as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESA-CLIENT.ORG**: Transferred

PANELLISTS

Name	Sozos-Christos Theodoulou

DATE OF PANEL DECISION 2024-11-25

Publish the Decision