Decision for dispute CAC-UDRP-107008

Case number	CAC-UDRP-107008
Time of filing	2024-10-30 09:43:44
Domain names	INTESANSA-SANPAOLO.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	Karl Grarar

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, conducting business under the company name INTESA SANPAOLO, is owner of the following registered trademarks:

- International trademark no. 793367 “INTESA”, registered since 4 September 2002, in class 36;
- EU trademark no. 12247979 “INTESA”, filed on 23 October 2013 and registered since 5 March 2014, in classes 9, 16, 35, 36 38, 41 and 42;
- EU trademark no. 5301999 “INTESA SANPAOLO”, filed on 8 September 2006 and registered since 18 June 2007, in classes 35, 36 and 38; and
- International trademark registration n. 920896 “INTESA SANPAOLO”, registered since 7 March 2007, in classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

THE COMPLAINANT

The Complainant is a leading Italian banking group, born from the merger of Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., effective as of 1 January 2007.

The Complainant is among the largest financial institutions in the Euro zone, with a market capitalisation exceeding 52,3 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,300 branches capillary and well distributed throughout Italy, with market shares of more than 15% in most Italian regions, the Complainant offers its services to approximately 13,6 million customers.

The Complainant has a strong presence in Central-Eastern Europe as well, with a network of approximately 900 branches and over 7,2 million customers.

Moreover, the Complainant's 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 in the United States, Russia, China and India.

The Complainant owns several trademarks and domain names, all of them characterised by the presence of the distinctive terms "INTESA" and "INTESA SANPAOLO".

THE DISPUTED DOMAIN NAME AND THE RESPONDENT

The disputed domain name was registered on 30 December 2023, well after the registration of the Complainant's trademarks. Further to CAC's request for registrar verification, the Registrar identified the underlying registrant (the Respondent) as Grarar Karl, an individual residing in Switzerland.

The disputed domain name resolves to Cloudflare's error page.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

The Complainant contends that the disputed domain name is identical or at least confusingly similar to the Complainant’s trademarks, because it reproduces the well-known trademark “INTESA SANPAOLO” with the mere addition of letters “NSA” between the mark’s verbal components “INTESA” and “SANPAOLO”, representing a clear example of typosquatting.

The Complainant contends that the Respondent has nothing to do with the Complainant, nor has been authorised or licensed to use the Complainant's trademarks or to register or use the disputed domain name. The disputed domain name does not correspond to the Respondent's name, nor is this latter commonly known by the disputed domain name. Lastly, there is no good faith, or legitimate noncommercial or fair use of the disputed domain name.

Finally, the Complainant contends that, given the distinctiveness and reputation of its trademarks, it is unlikely that the Respondent had no knowledge of the Complainant's trademarks when he had registered the disputed domain name. The Complainant has submitted the results of a Google search and alleges that, had the Respondent performed a basic search on Google, he should have yielded obvious references to the Complainant. Hence, it is most likely that the Respondent registered the disputed domain name having in mind the Complainant and its trademarks. According to the Complainant, the Respondent has registered the disputed domain name primarily for the purpose of selling it to the Complainant or a competitor of the Complainant for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the disputed domain name. The Complainant contends that the passive holding of the disputed domain name also shows the Respondent’s bad faith, since there is no possible legitimate use of the disputed domain name.

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

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:
(i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used by the Respondent in bad faith.

I. IDENTITY OR CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARKS

In UDRP disputes, the test for identity or confusing similarity requires a straightforward comparison between the complainant's trademark and the disputed domain name. This usually involves a side-by-side assessment of the domain name and the textual elements of the relevant trademark to determine whether the mark is recognizable within the domain name. When a domain name fully incorporates a trademark, or contains its dominant feature, it is generally deemed confusingly similar to the mark for purposes of the first element test. Adding other terms—whether descriptive, geographical, derogatory, or otherwise—does not prevent a finding of confusing similarity. UDRP panels have found domain names that intentionally include a common or obvious misspelling of a trademark confusingly similar to the relevant trademark under the first element, because they retain sufficiently recognizable aspects of the mark (so-called typosquatting). Common typosquatting techniques include using adjacent keyboard letters, substituting similar-looking characters (e.g., numbers for letters), employing visually similar letters in different fonts, using non-Latin, accented, or internationalized characters, reversing letters or numbers, adding or embedding unrelated terms or numbers. Furthermore, the TLD is usually disregarded in determining identity or similarity, as it is simply a technical aspect of registration.

In this case, the Complainant has established that it has rights in the INTESA trademark since 2002. The Complainant has also shown to have rights in the INTESA SANPAOLO trademark since 2006.

In assessing identity or confusing similarity, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, because it incorporates the entirety or at least the distinctive parts of the Complainant's trademarks with the addition of the letters "NSA" and a hyphen between the distinctive terms "INTESA" and "SANPAOLO". These additional letters and the hyphen neither affect the attractive power of the Complainant's trademarks, nor are sufficient to distinguish the disputed domain name from the Complainant's marks. Therefore, the Internet users might be misled into error and believe that that the disputed domain name and any related web service (website, email, etc.,) is related to, owned by or under the control of the Complainant.

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's marks.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

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 names. If the 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.

The Complainant contends to have no relationship whatsoever with the Respondent. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademarks or to register and use the disputed domain name.

No evidence is available that the Respondent, identified by the Registrar as Grarar Karl, has been commonly known by the disputed domain name or has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The Respondent registered the disputed domain name, which is a mispelled version of the Complainant's trademarks and, thus confusingly similar to the Complainant's trademarks. UDRP panels have found that domain names identical or confusingly similar to a complainant's trademark carry a high risk of implied affiliation.

Moreover, the disputed domain name is inactive, resolving to an error page (error code 522).

Therefore, the Panel is unconvinced that, before any notice of the dispute, the Respondent used or prepared to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services or is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademarks.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

III. REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

As mentioned under the first element, the Complainant has sufficiently demonstrated to own rights in the INTESA and INTESA SANPAOLO trademarks. The Complainant's trademarks were registered prior to the registration of the disputed domain name and are well-known.

The disputed domain name is a typosquatted version of the Complainant's trademarks. The addition of the letters "NSA" and a hyphen between the dominant features of the relevant marks (namely the terms "INTESA" and "SANPAOLO"), as well as the TLD ".COM" (a technical requirement of the registration) are not sufficient elements to escape the finding of confusing similarity between the disputed domain name and the Complainant's trademarks.

Given the distinctiveness and reputation of the Complainant's prior marks, the Panel finds 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. The Complainant has submitted the results of a Google search carried out regarding the terms "INTESA SANPAOLO", all of them related to the Complainant. Should the Respondent have performed a similar search on the Internet before registering the disputed domain name, he would have easily learnt about the Complainant's activities and trademarks registered and used worldwide. Even assuming that the Respondent had no knowledge of the Complainant's prior marks at the time of registration of the disputed domain name (which is quite unlikely), he omitted to verify that the disputed domain name would have infringed the Complainant's earlier rights or, even worse, he verified it and deliberately proceeded with the infringing registration. The Panel emphasises that, under paragraph 2 of the Policy, it is the Respondent's responsibility to determine whether the domain name registration infringes or violates third party's rights. By registering the disputed domain name confusingly similar with the Complainant's well-known mark, the Respondent has violated, inter alia, the cited provision of the Policy.

In absence of evidence provided by the Complainant, the Panel does not find that there are circumstances showing that the disputed domain name has been registered or acquired by the Respondent primarily with the intent to sell it to the Complainant or a competitor of the Complainant for a valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name (paragraph 4(b)(i) of the Policy).

As for the use of the disputed domain name, the Complainant has submitted evidence and the Panel has verified that the disputed domain name does not resolve to any active website.

UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows and WIPO Case No. D2000-0400 CBS Broadcasting, Inc. v. Dennis Toeppen).

The following factors were considered by this Panel when applying the passive holding doctrine in the present case:

- the degree of distinctiveness and/or reputation of the Complainant's trademark;
- the failure of the Respondent(s) to submit a response or to provide any evidence of actual or contemplated good faith use;
- the implausibility of any good faith use to which the disputed domain name may be put.

In view of all circumstances of this case, the Panel is dissuaded that it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being an infringement of the Complainant's marks under trademark law and/or an infringement of consumer protection legislation.

The Complainant has, therefore, discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

The disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESANSA-SANPAOLO.COM**: Transferred

PANELLISTS

Name	**Ivett Paulovics**

DATE OF PANEL DECISION 2024-12-03

Publish the Decision