Decision for dispute CAC-UDRP-107090

Case number	CAC-UDRP-107090
Time of filing	2024-12-02 08:48:18
Domain names	INTESASANPAOLOIT.COM

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	WILLIAM LAMERA

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

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007, in connection with classes 9, 16, 35, 36, 38, 41 and 42;
- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002, in connection with class 36;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, filed on September 8, 2006, granted on June 18, 2007, in connection with the classes 35, 36 and 38;
- EU trademark registration n. 12247979 “INTESA”, filed on October 23, 2013, granted on March 5, 2014, in connection with classes 9, 16, 35, 36, 38, 41 and 42.

The Complainant is also the owner of the several domain names bearing the signs “INTESA” and “INTESA SANPAOLO”.

The disputed domain name <intesasanpaoloit.com> was registered on April 14, 2024.

PARTIES CONTENTIONS

The Complainant contends the following:

The Complainant is among the top banking groups in the euro zone, with a market capitalization exceeding 70,1 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). It has a network of approximately 3,300 branches capillary, with market shares of more than 15% in most Italian regions, the Group offers its services to approximately 13,7 million customers. The Complainant has a strong presence in Central-Eastern Europe with a network of approximately 900 branches and over 7,5 million customers. The Complainant is the owner of the several trademarks “INTESA SANPAOLO” and “INTESA” and several domain names bearing the signs “INTESA SANPAOLO” and “INTESA”.

On April 14, 2024, the Respondent registered the disputed domain name <intesasanpaoloit.com> that is identical, or at least confusingly similar, to the Complainant’s trademarks as exactly reproduces the Complainant’s trademark “INTESA SANPAOLO”, with the mere addition of the acronym “IT” (which represents the abbreviation of the geographical term “ITALY”, the country in which is located Complainant’s headquarters).

The Respondent has no rights on the disputed domain name, and any use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the disputed domain name. The disputed domain does not correspond to the name of the Respondent and, to the best of Complainant’s knowledge, the Respondent is not commonly known as “INTESASANPAOLOIT” and no fair or non-commercial use of the disputed domain name has been found.

The disputed domain name was registered and is used in bad faith. The Complainant’s trademarks “INTESA SANPAOLO” and “INTESA” are distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name.

In addition, if the Respondent had carried even a basic Google search in respect of the wordings “INTESA SANPAOLO” and “INTESA”, the same would have yielded obvious references to the Complainant. This raises a clear inference of knowledge of the Complainant’s trademark on the part of the Respondent. Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant’s trademark. This is a clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bone fide offerings. More particularly, there are circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy).

The disputed domain name is not used for any bona fide offerings, even if it is connected to a Registrar’s web page without particular active contents, by now. The passive holding of a domain name with knowledge that the domain name infringes another party’s trademark rights is evidence of bad faith registration and use.

In particular, the consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, panels have tended to make such findings in circumstances in which, for example, a complainant’s mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the complainant’s trade mark rights.

As regards to the first aspect, the Complainant has proved the notoriety of its trademarks. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant’s trademarks and that results so similar to the Complainant’s domain names currently used by the latter to provide online banking services for enterprises.

The risk of a wrongful use of the domain name at issue is even higher in the present case, since the Complainant has already been targeted by some cases of phishing in the past few years. Even excluding any “phishing” purposes or other illicit use of the disputed domain name, it is not possible to find any other possible legitimate use of the disputed domain name.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:
(i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
(ii) The respondent has no rights or legitimate interests in respect of the domain name; and
(iii) The domain name has been registered and is being used in bad faith.

I. Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the trademarks specified in paragraph “Identification of rights” above whereas the trademark “INTESA SANPAOLO” (n. 920896) has been granted on March 7, 2007, and trademark “INTESA” (n. 793367) on September 4, 2002.
The disputed domain name has been registered on April 14, 2024, i.e. more than 22 years after the “INTESA” trademark registration and 17 years after the “INTESA SANPAOLO” trademark registration.

The disputed domain name consists of three parts: INTESA and SANPAOLO. The first part of the disputed domain name is identical to the international and EU trademarks “INTESA”, and both parts are identical to the international and EU trademarks “INTESA SANPAOLO”.

The term “IT” added to the end of the disputed domain name seems to be an abbreviation or country code for the Italy where the Complainant primarily resides and where is also the residence of the Respondent. The addition of the geographical term “IT” does not change the overall impression of the designation as being connected to the Complainant or its trademarks and more likely could strengthen the connection between the disputed domain name and the Complainant.

The generic top-level domain “.COM” does not change the overall impression of the designation as being connected to Complainant’s trademarks.

Therefore, the Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the Complainant’s trademarks “INTESA” and “INTESA SANPAOLO” in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

II. Rights or Legitimate Interests

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (ii) the respondent has no rights or legitimate interests in respect of the domain name.

The Complainant has established a prima facie case (not challenged by the Respondent who did not filed any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant and there is no indication that the Respondent is commonly known by the term “INTESASANPAOLOIT” or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. There is also no evidence, that the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel therefore considers that 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).

III. Registered and Used in Bad Faith

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (iii) the domain name has been registered and is being used in bad faith.

The Respondent has registered the disputed domain name which consists of the Complainant's trademarks "INTESA" and "INTESA SANPAOLO". There are no doubts that the Complainant's trademarks are distinctive and well-known. It could be therefore concluded that the disputed domain name has been registered in bad faith as the Respondent had or should have had the Complainant and its prior trademark rights in mind when registering the disputed domain name. Moreover, the addition of the geographical term "IT" strengthens the connection between the Complainant and the disputed domain name as the Complainant resides in Italy where is its core business.

Use of such disputed domain name could, therefore, attract the internet users to the corresponding web page by creating a likelihood of confusion with the Complainant's trademarks (paragraph 4(b)(iv) of the Policy). Although there is no evidence that the disputed domain name has been used for phishing or other illegal activities, the use of the disputed domain name visually and alphabetically almost identical to the Complainant's trademarks could lead to the confusion of the web page visitors.

Considering the (i) similarity between the Complainant's trademarks and the disputed domain name, (ii) obviously intentional addition of the geographical indication that leads directly to the Complainant again, (iii) distinctiveness of the Complainant's trademarks, (iv) passive holding of the disputed domain name without any reference to the real active website and (v) the failure of the Respondent to submit a response or to provide any evidence of good faith use, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

Thus, 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).

The Panel considers that the Complainant has shown that the disputed domain name <intesasanpaoloit.com> is confusingly similar to trademarks in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLOIT.COM**: Transferred

PANELLISTS

Name	**Petr Hostaš**

DATE OF PANEL DECISION 2025-01-06

Publish the Decision