

Decision for dispute CAC-UDRP-107092

Case number **CAC-UDRP-107092**

Time of filing **2024-12-02 08:47:34**

Domain names **METAINTESASANPAOLO.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 **guchunmo**

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 following trademarks:

- International trademark registration no. 920896 “INTESA SANPAOLO”, granted on March 7, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;
- International trademark registration no. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in connection with class 36;
- EU trademark registration no. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006 and granted on June 18, 2007, in classes 35, 36 and 38;
- EU trademark registration no. 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.

The Complainant also owns following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”:

<INTESA.COM>, <INTESASANPAOLO.ORG>, <INTESASANPAOLO.EU>, <INTESASANPAOLO.INFO>, <INTESASANPAOLO.NET>, <INTESASANPAOLO.BIZ>, <INTESA-SANPAOLO.COM>, <INTESA-SANPAOLO.ORG>, <INTESA-SANPAOLO.EU>, <INTESA-SANPAOLO.INFO>, <INTESA-SANPAOLO.NET>, <INTESA-SANPAOLO.BIZ>, <INTESA-SANPAOLO.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>.

All of the above domain names are connected to the Complainant's official website www.intesasanpaolo.com.

FACTUAL BACKGROUND

The Complainant is the leading Italian banking group, and also one of the protagonists in the European financial arena. The Complainant's company name is derived 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.

The Complainant is among the top banking groups in the euro zone, with a market capitalisation exceeding 70.1 billion euro. It claims to be the undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

It has 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. It 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.

Its international network specialises in supporting corporate customers and is present in 25 countries, especially in the Mediterranean area and those areas where Italian companies are most active, such as the United States, Russia, China, and India.

The disputed domain name <METAINTESASANPAOLO.COM> was registered on December 4, 2021.

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).

The disputed domain name reproduces the Complainant's trademark "INTESA SANPAOLO" with the addition of the term "META".

The Complainant contends that the disputed domain name is identical, or at least, confusingly similar, to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA".

Whether a disputed domain name is identical or confusingly similar to a trademark can be determined by making a side-by-side comparison with the disputed domain name. See *F. Hoffmann-La Roche AG v. P Martin*, WIPO Case No. D2009-0323.

A disputed domain name is identical to the trademark when it is a character for character match. It is confusingly similar when it varies the trademark by, for example, adding generic terms to the dominant part of the trademark.

Here, the Complainant's trademark is reproduced in its entirety in the disputed domain name. The addition of the term "META" preceding the Complainant's trademark, which the Complainant asserts can be associated with different meanings depending on the context used.

The Panel surmise that the word "META" can also have a more technical meaning in the context of computers and the internet. "META" can refer to data about data, or information that provides context about something else. In this sense, "METAINTESASANPAOLO" could be a domain name that is intended to provide some kind of metadata about the website of Intesa Sanpaolo bank.

The Panel considers the addition of the term "META" to the form the disputed domain name incorporating "METAINTESASANPAOLO" makes it confusingly similar to the Complainant's trademark. The dominant element of the disputed domain name is "INTESASANPAOLO". The addition of a pronounceable term "META" is likely to accentuate the risk of confusion.

It is also trite to state that the addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name and will be disregarded for the purposes of considering this ground.

Accordingly, the Panel considers that this ground is made out.

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).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

The Complainant contends that the Respondent has no rights in the disputed domain name, and that it has not authorised or licensed the Respondent to use any of its trademarks “INTESA SANPAOLO” and “INTESA”.

The Complainant also asserts that the disputed domain name does not correspond to the name of the Respondent and to the best of its knowledge is not commonly known as “METAINTESASANPAOLO”.

Finally, the Complainant contends that it has not found any fair or non-commercial uses of the disputed domain name.

The disputed domain name webpage returned a notice (as translated into English from the Korean language) stating “The website is being prepared. Please wait for a moment.”

As the Respondent has not filed any administrative compliant response to the Amended Complaint, the Panel accepts that the Complainant’s contention that the Respondent has no rights or legitimate interests to the disputed domain name.

Accordingly, the Panel considers that this ground is made out.

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).

There are two elements that must be satisfied – registration and use in bad faith.

The evidence shows, and the Panel accepts, that the Complainant’s trademarks “INTESA SANPAOLO” and “INTESA” are distinctive and well known all around the world. The Complainant’s trademarks were clearly registered prior to the registration of the disputed domain name.

The Complainant contends that the registration of a confusingly similar domain name by the Respondent implies that the Respondent had knowledge of the Complainant’s trademarks at the time of registration.

A basic Google search for these terms would have clearly indicated their association with the Complainant, suggesting the Respondent’s awareness of the Complainant’s rights.

The Panel is prepared to draw the inference that the disputed domain name was registered by the Respondent with knowledge of the Complainant’s trademarks, thereby constituting registration in bad faith.

The Complainant also contends that the domain name is not used for any bona fide offerings. The evidence shows that it is connected to a webpage without active content, suggesting passive holding, which is considered evidence of bad faith.

The Complainant further contends that despite a cease-and-desist letter sent to the Respondent on June 1, 2022, requesting the voluntary transfer of the disputed domain name, the Respondent did not respond or comply, further indicating bad faith.

While there is no obligation for the Respondent to respond to the Complainant’s cease-and-desist letter, failing to do so has the consequence that it may infer bad faith registration and use.

Such silence can also support a contention of abusive registration. The inference is that if the Respondent has a right or legitimate interest in the disputed domain name, it would have responded.

Here, the Panel is prepared to draw the inference from the Respondent’s conduct of omission to support the contention that the disputed domain name was registered and used in bad faith.

The Panel notes that the disputed domain name was registered on December 4, 2021. The Complaint was filed on November 28, 2024. This is about 35 months after the disputed domain name was registered, and approximately 29 months after the Complainant’s cease-and-desist letter was sent to the Respondent. The Complainant has led no evidence as to the delay in bringing its case nor explained the delay in its Amended Complaint.

On the other hand, the Respondent has not challenged the Complainant’s contentions and assertions as it has not filed any administrative compliant response.

Despite the unexplained delay in bringing its case promptly, the Panel is prepared to consider the following matters in favour of the Complainant:

- The long-standing rights of the Complainant to its trademark INTESSA SANPAOLO and its famous reputation worldwide.
- The lack of any administratively compliant response from the Respondent.
- The lack of evidence of any legitimate use of the disputed domain name.
- The available evidence that the disputed domain name website is being held passively for reasons other than any fair or non-commercial use.

As the Panel has already made the above finding, it is unnecessary to consider the Complainant's further assertions relating to potential "phishing" or resale of the disputed domain name to the Complainant due to the lack of any evidence to support these assertions. A mere possibility is insufficient evidence.

Accordingly, the Panel accepts that the disputed domain name was registered by the Respondent and used in bad faith.

PROCEDURAL FACTORS

Language of proceedings

The Complainant wishes to keep English as the language of the proceeding despite the Registration Agreement for the disputed domain name is in Korean.

Rule 11 provides that unless otherwise agreed to by the Parties or specified otherwise in the Registration Agreement, the language of the administrative proceedings shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise having regard to the circumstances of the administrative proceedings.

While there is no agreement between the parties on using English as the language of the proceeding, the dispute concerns the Respondent's registration of a domain name identical to the Complainant's well-known trademark, suggesting the Respondent likely had awareness of the Complainant and its language us. Despite the Complainant being an Italian company where the Italian language is likely to be dominant, the Complainant asserts that English is proposed as a fair choice for both parties to ensure fairness.

The Panel notes that on June 1, 2022 the Complainant, by its attorney, sent a cease-and-desist letter to the Respondent in English seeking for the voluntary transfer of the disputed domain name. The Respondent did not comply with the Complainant's request, nor has it chosen to participate in this proceeding.

Taking into account the Complainant's contentions, the evidence adduced, the lack of any response from the Respondent, and the nature of UDRP disputes which are designed to be resolved efficiently and cost-effectively, providing a streamlined mechanism to address domain name disputes without the need for prolonged litigation or excessive expense, the Panel is prepared to draw the inference that the Respondent has apparent familiarity with the English language.

Further, the CAC has also notified the Respondent on January 1, 2025 of the administrative proceedings in the Korean language, to which there has been no administrative compliant response received from the Respondent.

Accordingly, the Panel will proceed to determine this proceeding in the English language.

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On January 1, 2025 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

- That neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court.
- No other address for correspondence was found on the disputed domain name.
- As far as the e-mail notice is concerned, CAC received a notification that the e-mail sent (both in English and Korean) to postmaster@metaintesasanpaolo.com was returned back as undelivered.
- The e-mail notice CAC sent to heel@naver.com was returned back, with no receipt of any proof of delivery or notification of undelivery.

No further e-mail address could be found on the disputed site. The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, 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 Complainant owns the international trademarks “INTESA SANPAOLO” and “INTESA” and the domain name <intesianpaolo.com> which are used in connection with its goods or services.

The Respondent registered the disputed domain name <METAINTESASANPAOLO.COM> on December 4, 2021. The disputed domain name website appears to be connected to a webpage without active content, suggesting passive holding

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("Policy") and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent failed to file any administratively compliant response.

The Panel notes that the disputed domain name, registered on December 4, 2021, was the subject of a Complaint filed nearly 35 months later on November 28, 2024, with no explanation provided for the delay, including the 29 months following the Complainant's cease-and-desist letter dated June 1, 2022.

While the Respondent has not contested the Complainant's claims or filed an administratively compliant response, the Panel considers several factors favouring the Complainant: the longstanding global trademark rights and reputation of its trademark "INTESSA SANPAOLO", the Respondent's failure to respond, the absence of evidence of legitimate use of the domain, and indications of its passive holding for purposes other than fair or non-commercial use.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

- (a) The disputed domain name is identical to (when ignoring the term META) or confusingly similar to the Complainant's well-known trademarks “INTESA SANPAOLO” and “INTESA”.
- (b) The Respondent has no rights or legitimate interests in respect of the disputed domain name.
- (c) The disputed domain name has been 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. **METAINTESASANPAOLO.COM**: Transferred

PANELLISTS

Name	William Lye OAM KC
------	--------------------

DATE OF PANEL DECISION 2025-01-11

Publish the Decision