Decision for dispute CAC-UDRP-107169

Case number	CAC-UDRP-107169
Time of filing	2024-12-17 18:35:50
Domain names	INTESASANPAO-VERIFICAZIONE.COM

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Intesa Sanpaolo S.p.A.

Respondent

Organization	web Company

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 registrations for the trademarks INTESA SANPAOLO and INTESA:

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

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

- EU trademark registration #5301999 “INTESA SANPAOLO”, granted on June 18, 2007 and duly renewed, in connection with lasses 35, 36 and 38; and

- EU trademark registration #12247979 “INTESA”, granted on March 5, 2014, in connection with classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

The Complainant is a leading Italian banking group and also one of the protagonists 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.

The Complainant is among the top banking groups in the euro zone, with a market capitalisation exceeding 64,6 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 and 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. The Complainant 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 particularly in the Mediterranean area and those areas where Italian companies are most active, such as the United States, Russia, China and India.

The Complainant is also the owner 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>. All of them are now connected to the official website http://www.intesasanpaolo.com.

The Respondent appears to be based in Miami, Florida, United States.

The disputed domain name was registered on 12 August, 2024.

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 Complainant claims rights in the INTESA and INTESA SANPAOLO marks through its trademark registrations with the EUIPO and WIPO. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

The Complaint further alleges that the disputed domain name exactly reproduces the well-known trademark "INTESA SANPAOLO", with the mere omission of letters "L" and "O" in the mark's verbal portion "PAOLO and the addition of the Italian term "VERIFICAZIONE" (meaning "VERIFICATION"), an expression used by the Complainant for the security of its clients' bank accounts. It follows that it is confusing and misleading for Internet users, who might think that INTESASANPAO-VERIFICAZIONE.COM is somehow connected to Intesa Sanpaolo S.p.A., which is not true.

- Complainant's trademark: INTESA SANPAOLO.
- Complainant's primary domain name: <intesasanpaolo.com> (INTESASANPAOLO.COM).
- The disputed domain name: <intesasan**pao**-verificazione.com> (INTESASAN**PAO**-VERIFICAZIONE.COM).

The Panel is of the view that it is commonly agreed that typosquatting constitutes confusion and the prominent part of the disputed domain name in the present case is at least visually confusingly similar to Complainant's INTESA SANPAOLO mark. The additional of the term "verificazione" further enhanced the similarity between the disputed domain name and Complaintnant's INTESA SANPAOLO mark as such term is closely linked and associated with Complainant's brand and services and the hyphen does not reduce the similarity. See Chocoladefabriken Lindt & Sprüngli AG v. Manoj Kumar, 106724 (CAC 2024-08-19) ("The deletion of the letter "d" in the disputed domain name is a typical case of typosquatting, and is insufficient to avoid a finding of confusing similarity as the LINDT trademark remains the dominant component of the disputed domain name. The addition in the disputed domain name of the geographical term "USA" adds to the confusing similarity especially as the disputed domain name redirects to Complainant's official USA website."). See also WIPO Jurisprudential Overview 3.0 at 1.8 "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element".

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of

prove then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name and nobody has been authorized or licensed by the Complainant to use the disputed domain name. The Complainant could not find any fair or non-commercial use of the disputed domain name.

Having reviewed the screenshot of the website, the Panel notes that the disputed domain name does not resolve to any active content. It is agreed by previous panels that resolving a domain name that is confusingly similar to a famous brand to a blank page does not constitute rights or legitimate interests, see Novartis AG v. freibert peter (Healthcare), 107098 (CAC 2024-12-27) (“Failing to resolve a confusingly similar domain name to any web content or resolving it to a static parking page is typically not considered to be a bona fide use... The Respondent has not offered any explanation for its use of the disputed domain name and the Panel notes the distinctiveness and global reputation of the Complainant’s trademark. Considering the available evidence, it is apparent to the Panel that the Respondent is not using the disputed domain name for a bona fide offering of goods or services or in connection with a legitimate non-commercial or fair use under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy.”).

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name but the assertion has not been rebutted within the required period of time.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

The Complainant claims that 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, the Complainant has submitted an extra of Google search in support of its allegation that the research results in respect of the wordings “INTESA SANPAOLO” and “INTESA” have yielded obvious references to the Complainant.

The Panel is of the view that the Complainant's INTESA SANPAOLO and INTESA are well-known and notes that the trademarks were registered more than 20 years before the disputed domain name was registered by the Respondent. It is well established that registering a domain name similar to a well-known brand with actual knowledge clearly constitutes to registration in bad faith, see ARCELORMITTAL (SA) v acero, 102399, (CAC 2019-04-22). On this basis, the Panel accepts that the disputed domain name was registered in bad faith.

The Complainant further asserts that the disputed domain name is not used for any bona fide offerings even if it is not connected to any web site. Even excluding any illicit use, there is no other possible legitimate use of the disputed domain name.

The Complainant also points out that the Complainant sent a cease and desist letter to the Respondent, asking for the voluntary transfer of the disputed domain name. Despite such communication, the Respondent did not comply with the above request.

The Panel agrees that the Respondent has no plausible reason to be passively holding a domain name that is confusingly similar to a famous brand and it is commonly agreed by the previous panels that passive holding of a domain name does not prevent the finding of bad faith, see Intesa Sanpaolo S.p.A. v. jette mellemgaard, 107170 (CAC 2025-01-09) (“Under the Telstra precedent and progeny, panels have tended to make such findings in circumstances in which 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. Here, the Complainant sufficiently alleges that its marks are well-known, at least in Europe where Respondent is purportedly located. Furthermore, given the nature of the disputed domain name which includes the Italian word for "verification" in connection with the trademarks of a well-known banking group, the Panel agrees that there is no conceivable good faith use of the disputed domain name. It is far more likely that the disputed domain has been registered and is being held with nefarious intention to commit fraud or crime. The Respondent has not appeared to offer any purported justification. Therefore, the Panel finds that Complainant has adequately established this element of the Policy.”) The ignorance of Complainant’s cease and desist letter and the present proceeding further prevents the Panel from drawing a conclusion that the registration and use of the disputed domain name by the Respondent are in good faith.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted and the disputed domain name shall be transferred from the Respondent to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAO-VERIFICAZIONE.COM**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2025-01-14

Publish the Decision