Decision for dispute CAC-UDRP-107168

Case number	CAC-UDRP-107168
Time of filing	2024-12-17 18:36:08
Domain names	INTESASANPAOLO-MANAGEMENT.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	NA

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 various registrations for the trademarks INTESA SANPAOLO and INTESA in many jurisdictions worldwide, including the following:

- INTESA SANPAOLO (word mark), International trademark registration No. 920896, registered on March 7, 2007, duly renewed, for goods and services in classes 9, 16, 35, 36, 38, 41 and 42, designating various jurisdictions worldwide;

- INTESA SANPAOLO (word mark), European Union trademark registration No. 5301999, registered on June 18, 2007, duly renewed, for goods and services in classes 35, 36 and 38.

Moreover, the Complainant is the owner of various domain names including the trademark INTESA SANPAOLO, among which <intesasanpaolo.com>, which resolves to the Complainant's main website.

FACTUAL BACKGROUND

The Complainant is a leading Italian banking group and one of the main financial operators in Europe. The Complainant 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 has a market capitalisation in the Euro zone exceeding 64,6 billion Euro and

operates in Italy through a network of approximately 3,300 branches distributed throughout the country, with a market share of more than 15% in most Italian regions. The Complainant offers its services to approximately 13,6 million customers in Italy. The Complainant also operates in Central-East Europe, with a network of approximately 900 branches and over 7,4 million customers, and its international network is present in 25 countries, mostly in the Mediterranean area, the United States, Russia, China and India.

The disputed domain name was registered on October 8, 2024 and is inactive.

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.

More specifically, the Complainant contends that the disputed domain name is confusingly similar to the Respondent's mark, as it fully reproduces such mark followed by the term "management", which merely refers to the organizational structure and the administration of the Complainant. Moreover, the Complainant contends that the Respondent lacks rights or legitimate interests in the disputed domain name as the Complainant did not authorize the Respondent to use the disputed domain and did not license its INTESA SANPAOLO and its other marks to the Complainant. Moreover, the Respondent does not appear to have been commonly known by the disputed domain name. The Complainant also argues that the Respondent is not making any fair or noncommercial use of the disputed domain name.

As far as registration and use of the disputed domain name in bad faith is concerned, the Complainant maintains that its INTESA SANPAOLO trademark is distinctive and well known. The fact that the Respondent registered the disputed domain name confusingly similar to this mark indicates that the Respondent had knowledge of the Complainant’s trademark at the time of the registration of the disputed domain name. In addition, had the Respondent carried a simple online search using the keyword "intesa sanpaolo", it would have only retrieved references connected to the Complainant. Therefore, it is more than likely that the disputed domain name would not have been registered if it were not for Complainant’s trademark.

Moreover, the disputed domain name is not used in connection with a bona fide offering of goods or services. More particularly, there
are circumstances indicating that the Respondent registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant or to one of the Complainant's competitors for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name. Albeit the disputed domain name does not resolve to an active website, passive holding of a domain name with knowledge that the domain name infringes another party’s trademark is evidence of bad faith registration and use. In particular, passive holding of a domain name may, in appropriate circumstances, be consistent with a finding of bad faith. This happens, for instance if 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. This applies to the case at issue, where the Complainant's INTESA SANPAOLO mark enjoys strong reputation and no legitimate or fair use of the disputed domain name by the Respondent is conceivable.

The risk of a wrongful use of the disputed domain name is even higher in the present case, since the Complainant operates in the banking field and is therefore strongly exposed to phishing attacks in order to steal the Complainant's customer sensitive information to distract their money or for some other illicit use. The only other reason why the Respondent could have registered the disputed domain name is to resell it to the Complainant for a valuable consideration exceeding the documented out-of-pocket costs directly related to the disputed domain name.

The Respondent did not reply to the Complainant's contentions as it did not file an administratively compliant Response.

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 Policy were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

I. Confusing similarity

The Panel agrees with the Complainant that the disputed domain name is confusingly similar to the Complainant's mark INTESA SANPAOLO. The disputed domain name incorporates this mark entirely followed by a hyphen and the descriptive term "management". The Complainant's mark is well recognizable within the disputed domain name, while the additional non-distinctive elements cannot prevent a finding of confusing similarity.

Accordingly, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Rights or Legitimate Interests

As also confirmed in the WIPO Overview, a complainant is required to make out a prima facie case that arespondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Based on the available evidence, the Respondent does not appear to have been commonly known by the disputed domain name. There is no evidence in the case file that the Respondent has any relationship with the Complainant. Moreover, the Complainant did not authorise the Respondent to include its INTESA SANPAOLO mark in the disputed domain name.

UDRP panels have largely held that the composition of a domain name consisting of a trademark plus an additional term cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. In the Panel's opinion, the addition of the descriptive term "management" suggests sponsorship or endorsement by the trademark owner as the disputed domain name could be intended as a website providing information on the Complainant's corporate structure, or on the activity of managing the financial assets of the Complainant's clients. Therefore, the disputed domain name is highly misleading.

Moreover, as the disputed domain name does not resolve to an active website and is highly misleading, the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services and is not making a legitimate noncommercial or fair use of the disputed domain name.

In light of the foregoing, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. As the Respondent failed to rebut the Complainant's arguments, the Panel considers that the Complainant has proved the second condition of the Policy.

III. Bad Faith

Under paragraph 4(a)(iii) of the Policy, to prevail in a UDRP dispute a complainant must prove that as domain name has been registered and used in bad faith.

With respect to registration in bad faith, the Panel notes that the disputed domain name incorporates the Complainant's INTESA SANPAOLO mark entirely. This mark is certainly distinctive and is also renown in the banking field. The reputation of the INTESA SANPAOLO mark has also been recognized in prior UDRP disputes (to mention only a few, see CAC-UDRP-107170, Intesa Sanpaolo S.p.A. vs. jette mellemgaard; LNBIZ-INTESASNAPAOLO.COM, Intesa Sanpaolo S.p.A. vs. alex rifores (sdfko034f43f); CAC-UDRP-107090, Intesa Sanpaolo S.p.A. vs. WILLIAM LAMERA). Accordingly, it is clear that the Respondent registered the disputed domain name being aware of the Complainant's mark and with the precise intention of targeting this mark. In such a circumstance and considering that the Respondent does not appear to have rights or legitimate interests in the disputed domain name, the Panel finds that the Respondent has registered the disputed domain name in bad faith,

With respect to use in bad faith, as mentioned above, the disputed domain name does not resolve to an active website but is passively held. From the inception of the 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. Factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put (see section 3.3. of the WIPO Overview 3.0.). In the case at issue, the Panel notes that the Complainant's mark is highly distinctive and enjoys reputation, and that the Respondent did not submit any Response or provided evidence in support of its actual or contemplated good-faith use of the disputed domain name. Moreover, the Respondent did not provide the Registrant's and Organization's names when it registered the disputed domain, as such violating its obligations under

the registration agreement in order to render more difficult the Complainant's defence of its trademark rights. Finally, as the Respondent's lacks rights or legitimate interests in the disputed domain name and the Complainant is an important and reliable banking institution, no plausible good faith use of the disputed domain name is possible.

Accordingly, the Panel finds that the Respondent has registered the disputed domain name in bad faith.

In view of the above, the Panel is satisfied that also the third and last condition of the Policy is met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLO-MANAGEMENT.COM**: Transferred

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2025-01-14

Publish the Decision