Decision for dispute CAC-UDRP-107167

Case number	CAC-UDRP-107167
Time of filing	2024-12-17 13:28:45
Domain names	INSESASANPAOLO-MANAGEMENT.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

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, among others, of the following registrations for the trademarks “INTESA SANPAOLO” and “INTESA”:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007 and duly renewed, in classes 9, 16, 35, 36, 38, 41 and 42;

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

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006 and granted on June 18, 2007, in classes 35, 36 and 38;

- EU trademark registration n. 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.

Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”: <INTESASANPAOLO.COM>, <INTESA-SANPAOLO.COM>, <INTESA.COM>, <INTESA.INFO>, and many others. All of them are now connected to the official website http://www.intesasanpaolo.com.

FACTUAL BACKGROUND

According to the Complainant, it is the 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.

Intesa Sanpaolo is among the top banking groups in the Euro zone, with a market capitalization exceeding 47,7 billion Euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 4,300 branches well distributed throughout the Country, with market shares of more than 19% in most Italian regions, the Group offers its services to approximately 13,5 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,2 million customers. Moreover, the international network specialized 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 the United States, Russia, China and India.

On October 8, 2024, the Respondent registered the domain name <INSESASANPAOLO-MANAGEMENT.COM>.

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).

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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(i) the disputed 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 disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

SIMILARITY TO THE EARLIER RIGHTS

The disputed domain name is confusingly similar to the Complainant’s Trademark, company name and domain names. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of

a) disregarding the top-level suffix in the domain name (i.e. “.com”), and

b) finding that amending a well-known mark such as "intesa sanpaolo" by changing one single letter in what could easily be considered a typographical error in combination with an obvious generic term referring to the Complainant's Services ("management") as a suffix to register the domain <INSESASANPAOLO-MANAGEMENT.COM> would be insufficient to distinguish a domain name from a trademark. Previous UDRP panels have consistently held that where the asserted trademark is recognizable within a disputed domain name, a minor misspelling does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy e.g. in CAC Case UDRP 107202, Compagnie de Saint-Gobain v. ygjwak1127 wak1127 (yangs LC), where the disputed domain name was <SIANT-GOBAIN.CAM> and CAC Case URDP 107169 Intesa Sanpaolo S.p.A. v. Renji Kuruvilla (web Company), which concerned the domain name <INTESASANPAO-VERIFICAZIONE.COM). In the latter decision, the Panel also held that the additional of the term “verificazione” further enhanced the similarity between the disputed domain name and Complaintnant’s "intesa sanpaolo" trademarks and company name as such term is closely linked and associated with Complainant’s brand and services and the hyphen does not reduce the similarity. This applies equally to the disputed domain in this case and the term "management" connected to the misspelt name by a hyphen in the disputed domain name.

The attempt to confuse internet users by creating a domain name purporting to be a landing page for interaction with the Complainant based on its use of a generic term for such a page and the trademarks and company name of the Complainant is unmistakable. The overall impression created by the domain name and in particular its dominant and distinctive elements must be seen as being confusingly similar to the earlier rights.

Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such 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 e.g. WIPO Case UDRP D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Complainant has put forward that the Respondent is not commonly known by the disputed domain name. Neither is the Respondent in any way related to the Complainant. Nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy). In fact, the Respondent appears to have simply ignored the communications regarding these proceedings as no reply was received.

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest in the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name. The Respondent is also in no way commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

However, on the website connected to the disputed domain name, several services can be detected, none of which are offered in good faith. The name is connected to a website promoting banking and financial services for which the Complainant’s trademarks are registered and in use but which are being offered by third parties on the website. Consequently, internet users, while searching

for information on the Complainant’s services, are confusingly led to the website of the Respondent. Therefore, the Panel finds that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant’s web site.

The reputation and associated well-known character of the Complainant's trademarks has been established in this case through the evidence provided and has previously been confirmed in other decisions such as CAC Case UDRP 106051 Intesa Sanpaolo S.p.A. ./. Ciro Molli or CAC Case UDRP-104884 Intesa Sanpaolo S.p.A. ./. A. Kinnek. The Panel is unable to find that there is a reasonable possibility of the Respondent making use of the disputed domain name which exactly corresponds to the Complainant’s trademarks in a way that would be in good faith.

In the absence of any response to the complaint and given the reputation of the Complainant and its trademarks, company name and domain names as supported by the Complainant’s evidence, the Panel can only conclude that the Respondent was fully aware of the Complainant's trademarks, domain names and company name at the time of registering the disputed domain name <INSESASANPAOLO-MANAGEMENT.COM>.

Therefore, it has been established to the satisfaction of the Panel that the disputed domain name was registered and is being used in bad faith, in order to prevent the Complainant from making proper use of the mark in the disputed domain name.

Therefore, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Udo Pfleghar B.A. (Melb.)**

DATE OF PANEL DECISION 2025-01-22

Publish the Decision