Decision for dispute CAC-UDRP-107258

Case number	CAC-UDRP-107258
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Domain names	DIPARTIMENTOINTESA.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	CheapCloud Hosting Ltd

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 several trademarks consisting of the term “INTESA SANPAOLO®”, such as:

1. the International trademark registration “INTESA SANPAOLO®” n° 920896 registered since March 7, 2007 at classes 9, 16, 35, 36, 38, 41 & 42;
2. the International trademark registration “INTESA®” n° 793367 registered since September 4, 2002 at class 36;
3. EU trademark registration n. 5301999 “INTESA SANPAOLO®” registered since June 18, 2007 at classes 35, 36 & 38, and;
4. EU trademark registration n. 12247979 “INTESA®” registered since March 5, 2014 at classes 9, 16, 35, 36, 38, 41 & 42;

Different copies of the trademark certificates were included within the Complaint.

In addition, the Complainant claims to own domain names with the term “INTESA SANPAOLO” and “INTESA” such as: <INTESASANPAOLO.COM>, <INTESA-SANPAOLO.COM>, <INTESA.COM>, among many others. All of them are now connected to the official website http://www.intesasanpaolo.com.

Even though the Complainant did not include copies of the registration of the domains, the Panel was able to conduct a search and confirmed the validity of the registration of the domains <INTESASANPAOLO.COM>, <INTESA-SANPAOLO.COM> & <INTESA.COM>.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is the leading Italian banking group which 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.

The Complainant is among the top banking groups in the eurozone, with a market capitalisation exceeding 73,8 billion Euros, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to 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, the Group offers its services to approximately 13,7 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 900 branches and over 7,5 million customers. Moreover, the international network specialised 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.

The Complainant is the owner of different trademarks registrations for the terms “INTESA SANPAOLO”, “INTESA” and “GRUPPO INTESA SANPAOLO”.

On September 12, 2024, the Respondent registered the disputed domain name <DIPARTIMENTOINTESA .COM> (hereinafter, the “Disputed Domain Name”).

According to the Complainant’s non-contested allegations, the Respondent has no rights or legitimate interest in respect of the Disputed Domain Name and the Complainant has not granted any authorization or license to use the trademarks “INTESA SANPAOLO” and “INTESA” within the Disputed Domain Name.

For the purpose of this case, the Registrar confirmed that the Respondent is the current registrant of the Disputed Domain Name and that the language of the registration agreement is English.

The facts asserted by the Complainant are not contested by the Respondent.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES CONTENTIONS

COMPLAINANT:

First element: Similarity

The Complainant states that the Disputed Domain Name is identical or at least, confusingly similar to its trademarks “INTESA SANPAOLO” and “INTESA”. The Complainant asserts that the well-known trademark “INTESA”® is included in its entirety within the Disputed Domain Name with the mere addition of the Italian term “DIPARTIMENTO” (meaning “department”), with references to the operating departments of Intesa Sanpaolo, whose purpose is the management of resources for the performance of their respective institutional activities. It follows that it is confusing and misleading for Internet users, who might think that <DIPARTIMENTOINTESA.COM> is somehow connected to Intesa Sanpaolo S.p.A., which is not true.

Second element: Rights or legitimate interest

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and any use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant.

The Complainant also confirms that nobody has been authorized or licensed by the Complainant to use the Disputed Domain Name at issue.

The Complainant also claims that they did not find any fair or non-commercial use of the Disputed Domain Name.

Third element: Bad faith

The Complainant states that the Disputed Domain Name is confusingly similar to its trademarks “INTESA SANPAOLO” and “INTESA”.

The Complainant indicates that its trademarks “INTESA SANPAOLO” and “INTESA” are distinctive and well known around the world.

The Complainant indicated that the fact that the Respondent has registered a Disputed Domain Name that is confusingly similar to the Complainant indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the Disputed Domain Name.

The Complainant contends that the Disputed Domain Name is not used for any bona fide offerings and therefore, there are circumstances indicating that the Respondent has registered or acquired the Disputed 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 Complainant indicates that the Disputed Domain Name is not used for any bona fide offerings, even if it is not connected to any website by now. In fact, the Complainant indicates that there are countless UDRP decisions that confirm that the passive holding of a domain name with the knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use.

Lastly, it shall be noted that on October 4, 2024, the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the Disputed Domain Name at issue. Despite such communication, the Respondent did not comply with the above request.

RESPONDENT

The Respondent did not reply to the Complaint.

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 a 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 are being used in bad faith.

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

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S RIGHTS.

Paragraph 4(a)(i) of the Policy establishes the obligation of the Complainant to demonstrate that the Disputed Domain Names is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant submitted copies of different trademark registrations pertaining to the terms "INTESA SANPAOLO" and "INTESA" for insurance; financial affairs; monetary affairs and real estate affairs, among many others.

The Complainant's trademarks were registered prior to 2024, the year of the creation date of the Disputed Domain Name.

In the current case, the Disputed Domain Name is composed of the trademark "INTESA®" with the addition of the Italian term "DIPARTIMENTO", which can be translated into "DEPARTMENT" in English.

In assessing confusing similarity, the Panel finds the Disputed Domain Name is confusingly similar to the Complainant's trademark, as it incorporates the entirety of the trademark "INTESA®" plus the addition of the generic term "DIPARTIMENTO". In this regard, UDRP panels agree that 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. See paragraph 1.8. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0 ("WIPO Jurisprudential Overview 3.0.).

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is a technical requirement of registration. See paragraph 1.11.1 of WIPO Jurisprudential Overview 3.0.

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the Disputed Domain Name is confusingly similar to the Complainant's "INTESA SANPAOLO" and "INTESA" trademarks.

(B) RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME.

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it with relevant evidence demonstrating rights or legitimate interests in the domain name; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. 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 no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this regard, Paragraph 4 (c) provides with circumstances that could prove rights or legitimate interest in the disputed domain name on behalf of the Respondent such as:

(i) before any notice to Respondent of the dispute, Respondent is using or provides with demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) The Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or

(iii) 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.

For the present case, the Complainant has confirmed that the Disputed Domain Name is not connected with or authorized by the Complainant in any way. The Complainant indicates that they have not granted authorization to the Respondent to use their "INTESA SANPAOLO®" and "INTESA®" trademarks.

From the information provided by the Complainant, there is no evidence or reason to believe that the Respondent (as an individual, business, or other organization) has been commonly known by the Disputed Domain Name.

The Respondent's name "Dieter Pabst" is all what it links the Disputed Domain Name with the Respondent. Absent of any other evidence such as a personal name, nickname or corporate identifier, the Panel is of the opinion that the Respondent is not commonly known by the Disputed Domain Name.

The fact that the Respondent did not reply to the Complaint gives an additional indication that the Respondent lacks rights or legitimate interest since the Respondent did not provide with evidence of the types specified in paragraph 4 (c) of the Policy, or of any circumstances, giving rise to rights or legitimate interests in the Disputed Domain Name.

The website associated with the Disputed Domain Name resolves to an inactive website. Different Panels have confirmed that the lack of content at the Disputed Domain Name can be considered as a finding that Respondent does not have a bona fide offering of goods and services (see, for example, Forum Case No. FA 1773444, Ashley Furniture Industries, Inc v. Joannet Macket/JM

Consultants).

The Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests, which has not been rebutted by the Respondent. Therefore, the Panel concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest in the Disputed Domain Name.

The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME.

Paragraph 4(a)(iii) of the Policy indicates that the Complainant must assert that the Respondent registered and is using the Disputed Domain Name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- 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 that complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or
- the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

For the current case, the evidence at hand confirms that the Complainant's "INTESA SANPAOLO®" & "INTESA®" trademarks are distinctive and the Complainant has a strong reputation in the financial industry, at least in Europe. Furthermore, the Complainant has provided evidence that the Respondent should have found information over the internet about the Complainant's trademark rights over "INTESA SANPAOLO®" & "INTESA®" before registering the Disputed Domain Name. In fact, the Complainant has also been involved in different UDRP cases where the Complainant has been successful.

In addition to the above described and from the Panel perspective, the following circumstances also confirm the Respondent's bad faith in the registration of the Disputed Domain Name:

(a) By conducting a search over the Internet, the Respondent should have been made aware of the Complainant's trademarks "INTESA SANPAOLO®" & "INTESA®" trademarks as well as their reputation in the financial industry in Europe;

(b) The Disputed Domain Name is composed of the generic term "DIPARTIMENTO" which in English means "DEPARTMENT". Absent of Respondent's reply, this combination is only a confirmation of Respondent's knowledge of Complainant's trademark "INTESA®" prior to the registration of the Disputed Domain Name – in particular following Complainant's argument about the existence of the operating departments of Intesa Sanpaolo, whose purpose is the management of resources for the performance of their respective institutional activities (see for example the Research Department of Intesa Sanpaolo at the following link of Complainant's official website https://group.intesasanpaolo.com/it/research).

(c) Complainant's trademark rights over "INTESA SANPAOLO®" & "INTESA®" predate the date of registration of the Disputed Domain Name.

(d) The website associated with the Disputed Domain Name is inactive.

See WIPO Jurisprudential Overview, version 3.0. at paragraph 3.1.1. about circumstances indicating that the Respondent's intent in registering the Disputed Domain Name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark.

These factors make the Panel believe that the Disputed Domain Name was registered with the intention to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

The Complainant claims that the current owner registered the Disputed Domain Name with the "phishing" purpose, to induce and divert the Complainant's legitimate customers to its website and steal their money and the above could be easily verified given the particular nature of the Disputed Domain Name. Here the Panel dissents from the Complaint since there was no evidence provided which could confirm the "phishing" purpose described by the Complaint. Nevertheless, this finding does not change the overall assessment of this case.

Based on the evidence submitted by the Complainant, it is clear that the Respondent was registered with the intention to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

Last but not least, the Complaint provided with evidence about sending a Cease & Desist ("C&D") letter to Respondent on October 4th, 2024 without receiving any reply by Respondent.

The failure of the Respondent to answer the Complainant's Complaint and take any part in these proceedings as well as the C&D letter sent by the Complainant also suggests in combination with other factors bad faith on the part of the Respondent.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the Disputed Domain Name and the Complainant's "INTESA SANPAOLO®" & "INTESA®" & trademarks, b) the lack of reply to this Complaint by Respondent, c) the fact that the Disputed Domain Name is being passively held, the Panel draws the inference that the Disputed Domain Name was registered is being used in bad faith.

Therefore, the Panel concludes that the Respondent registered and is using the Disputed Domain Name in bad faith and thus has 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. **DIPARTIMENTOINTESA.COM**: Transferred

PANELLISTS

Name	**Victor Garcia Padilla**

DATE OF PANEL DECISION 2025-02-23

Publish the Decision