

Decision for dispute CAC-UDRP-107256

Case number	CAC-UDRP-107256
Time of filing	2025-01-27 08:56:52
Domain names	INTEISANPAOLO.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	Intesa Sanpaolo S.p.A.
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Complainant representative

Organization	Intesa Sanpaolo S.p.A.
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Respondent

Organization	Njalla Okta LLC
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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 states that it is the owner of the following trademark registrations:

- International trademark registration No. 920896 "INTESA SANPAOLO", registered on 7 March 2007 for goods and services in classes 9, 16, 35, 36, 38, 41 and 42;
- International trademark registration No. 793367 "INTESA", registered on 4 September 2002 for services in class 36;
- EUTM No. 5301999 "INTESA SANPAOLO", registered on 18 June 2007 for services in the classes 35, 36 and 38;
- EUTM No. 12247979 "INTESA", registered on 5 March 2014 for goods and services in classes 9, 16, 35, 36, 38, 41 and 42.

The Complainant proved its ownership of the listed trademark registrations by the submitted extract from the WIPO Madrid database and the EUIPO registration certificates.

FACTUAL BACKGROUND

The Complainant is the leading Italian banking group and one of the protagonists in the European financial area.

Intesa Sanpaolo is among the top banking groups in the eurozone, with a market capitalization exceeding 73,8 billion euro, 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 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 (submitted Report about Intesa Sanpaolo).

The Complainant owns, among others, the following domain names bearing the signs "INTESA SANPAOLO" and "INTESA": <intesaspaolo.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 the named domain names are connected to the Complainant's official website intesaspaolo.com.

The disputed domain name <intesisanpaolo.com> (hereinafter "disputed domain name") was registered on 15 November 2024. According to the Registrar, the Respondent is 'Host Master'. The Respondent's provided address as being at Saint Kitts and Nevis.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the requirements of the UDRP have been met and that the disputed domain name should be transferred to it.

RESPONDENT:

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 UDRP).

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 UDRP).

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 UDRP).

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

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. Therefore, the Panel proceeds to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them [Paragraph 5(f) of The Rules].

1. CONFUSING SIMILARITY

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks.

The WIPO Overview 3.0 in Paragraph 1.2.1 states: "Where the complainant holds a nationally or regionally registered trademark or

service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”.

The WIPO Overview 3.0 in Paragraph 1.7 states: “[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

The WIPO Overview 3.0 in Paragraph 1.9 states: “A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element [...] Examples of such typos include [...] (vi) the addition or interspersing of other terms or numbers.”

In the present case, the Complainant has established that it owns numerous international and EUTM trademark registrations consisting of the “INTESA SANPAOLO” or “INTESA” verbal element, protected for the classes in connection with financial services (evidenced by the extract from the WIPO Search and the EUIPO registration certificates).

The disputed domain name <inteisanpaolo.com> contains the Complainant’s trademark “INTESA SANPAOLO” in its entirety with the mere addition of the letter “I” in the “INTESA” verbal element of the marks (between letters “E” and “S”).

The disputed domain name in part of “INTEISA” differs from the Complainant’s “INTESA” verbal element by a single letter. According to the Panel, this is a clear example of typosquatting.

Therefore, the disputed domain name is considered to be confusingly similar to the relevant trademarks.

The “.com” element of the disputed domain names does not affect the finding of confusing similarity.

As a result, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the UDRP.

2. THE RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interest in the disputed domain name.

According to Paragraph 4(a)(ii) of the UDRP, the Complainant shall make a case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfils this demand the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the UDRP (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman). Moreover, past panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, past panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the UDRP, once the complainant has made something credible (prima facie evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing concrete evidence.

The WIPO Overview 3.0 in Paragraph 2.5.1 states: “Generally speaking, UDRP panels have found that domain names identical to a complainant’s trademark carry a high risk of implied affiliation.”

In the present case, the Complainant claims that the Respondent has no rights on the disputed domain name, and any use of the trademarks “INTESA SANPAOLO” and “INTESA” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned banking group to use the disputed domain name.

The Complainant adds that the disputed domain name does not correspond to the name of the Respondent and the Respondent is not commonly known under the disputed domain name.

To the satisfaction of the Panel, the Complainant made a prima facie case that there is no connection between the Complainant and the Respondent and that the Respondent does not have authorization in the disputed domain name from the Complainant.

The Respondent did not file any Response to the Complaint. Thus, the Respondent failed to demonstrate rights or legitimate interest in the disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied the requirement under Paragraph 4(a)(ii) of the UDRP.

3. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel finds that the Respondent registered and used the disputed domain name in bad faith.

The WIPO Overview 3.0 in Paragraph 3.1.4 states: “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith [...]”

The WIPO Overview 3.0 in Paragraph 3.3 states: "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding."

In the present case, the Complainant has established that it owns numerous international and EUTM trademark registrations consisting of the "INTESA SANPAOLO" or "INTESA" element, protected for the classes in connection with financial services (proved by the extract from the WIPO Madrid database and the EUIPO registration certificates).

The disputed domain name contains the Complainant's trademark in its entirety. By adding a single letter "I" to the Complainant's mark, the Respondent committed obvious typosquatting.

From the submitted Report about Intesa Sanpaolo, it is clear that the Complainant and Its trademarks have a certain reputation worldwide.

A simple Google search for "INTESA SANPAOLO" and "INTESA" leads Internet users primarily to the Complainant's website and websites connected to the Complainant's products and services (evidenced by the submitted screenshots of a Google search).

Therefore, the disputed domain name is confusingly similar to the highly distinctive and widely recognized earlier trademarks of the Complainant.

It is undisputed that the Respondent was aware of the Complainant's trademarks and Its reputation before the registration of the disputed domain names on 15 November 2024.

As was proved by the furnished screenshot of the website, the disputed domain name leads Internet users to a blanket page. This might indicate the intention of the Respondent to sell, rent or otherwise transfer the domain name registration to the Complainant. At the same time, it is clear that the Respondent is passively holding the disputed domain name and there exists a risk that the Respondent is not using and will not use it for any good faith purpose.

This conclusion is supported by the following facts of the case:

- (i) The Complainant's trademarks are widely known because of the Complainant's international business network and activities, as evidenced by the submitted Report about Intesa Sanpaolo,
- (ii) the Respondent has provided no Response to the Complaint and so failed to prove any actual or contemplated good faith use of the disputed domain name,
- (iii) the Respondent is operating and registered the disputed domain name under a name that is not a registered business name,
- (iv) the disputed domain name leads Internet users to a blank webpage,
- (v) taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

Moreover, past panels have declared that "[t]he very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests." (see WIPO Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc.).

Thus, it might be concluded that the Respondent did not register and is not using the disputed domain name in good faith.

Following the above-mentioned, the Panel finds that the Complainant has satisfied conditions pursuant to Paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. INTEISASANPAOLO.COM: Transferred

PANELLISTS

Name Radim Charvát

DATE OF PANEL DECISION 2025-02-25

Publish the Decision
