# Decision for dispute CAC-UDRP-107316

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| Case number | CAC-UDRP-107316 |
| Time of filing | 2025-02-21 10:01:56 |
| Domain names | THEINTESASANPAOLO.COM |

## Case administrator

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| Name | Olga Slanařová (Case admin) |

## Complainant

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| Organization | Intesa Sanpaolo S.p.A. |

## Complainant representative

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| Organization | Intesa Sanpaolo S.p.A. |

## Respondent

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| Name | qwe Q qwe |

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”, registered on March 7, 2007 for goods and services in classes 9, 16, 35, 36, 38, 41 and 42 ICGS, including Russian Federation;

- International trademark registration n. 793367 “INTESA”, registered on September 4, 2002 for services in class 36 ICGS, including Russian Federation;

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, filed on September 8, 2006, registered on June 18, 2007 for services in classes 35, 36 and 38 ICGS.

Moreover, the Complainant is also the owner, among others, of the following domain names bearing the Complainant’s trademark “INTESA SANPAOLO”:
<intesasanpaolo.com>, <intesasanpaolo.org>, <intesasanpaolo.eu>, <intesasanpaolo.info>, <intesasanpaolo.net>, <intesasanpaolo.biz>,
<intesa-sanpaolo.com>, <intesa-sanpaolo.org>, <intesa-sanpaolo.eu>, <intesa-sanpaolo.info>, <intesa-sanpaolo.net>, <intesa-sanpaolo.biz>,
<cliente-intesasanpaolo.com>, <cliente-intesasanpaolo.online>, <clienti-intesasanpaolo.com>, <clientiintesasanpaolo.it>, <intesasanpaolo-clienti.com>, <intesasanpaolo-clienti.net>, and <clientiwebintesasanpaolo.it>.

All of them are currently connected to the official Complainant's website: www.intesasanpaolo.com.

## FACTUAL BACKGROUND

The Complainant is the leading Italian banking group and also one of the protagonists in the European financial area. 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 capitalisation exceeding 74,7 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,000 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 13,9 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 disputed domain name was registered on October 14, 2024, and by the moment of submitting this complaint was redirecting to a low-quality website containing vague and generic references to financial services.

## PARTIES CONTENTIONS

**The Complainant**

The Complainant asserts that all elements of paragraph 4(a) of the Policy and the relevant Rules are satisfied:

1. **Identical or Confusingly Similar**: The disputed domain name is identical or at least confusingly similar to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA". The mere addition of the article "THE" does not eliminate confusion, especially given the strong global recognition of the Complainant's mark.
2. **No Rights or Legitimate Interests**: The Respondent is not affiliated with the Complainant and has not been authorized to use its trademarks. The Respondent is not commonly known by the disputed domain name, and no evidence of fair or non-commercial use has been found.
3. **Bad Faith**: The Complainant's marks are widely known. The Respondent's registration of a confusingly similar disputed domain name indicates prior knowledge of the Complainant's rights. The disputed domain name is used to host a website referencing banking and financial services (areas covered by the Complainant's trademarks) thereby misleading users and diverting traffic for commercial gain. This harms the Complainant's reputation and causes loss of potential clients.

On November 7, 2024, the Complainant's attorneys sent a cease-and-desist letter to the Registrar requesting that it be forwarded to the disputed domain name's owner. The Respondent failed to comply.

The Complainant requests transfer of the disputed domain name.

**The Respondent**

The Respondent did not reply to the Complainant's contentions.

## 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.

**Procedural Issue: Language of the Proceeding**

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

The language of the Registration Agreement for the disputed domain name is Russian. The Panel is proficient in both Russian and English.

The factors that the Panel should take into consideration include whether the Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without at the same time causing injustice to the Parties.

The Complaint was submitted in English. The Complainant, an Italian company, requests that the proceeding be conducted in English, citing the following:

- The Complainant is Italian, the Respondent is Russian, and English serves as a neutral international language.
- The Complaint is written in English, widely understood by users globally, including in Italy and Russia.

Given that the Respondent deliberately registered a domain name identical to the Complainant's well-known trademark, it is reasonable to presume awareness of the Complainant's rights.

The Respondent did not make any submissions with respect to the language of the proceeding. In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs.

While applying the provision on the language of the proceeding, the Panel considers that it should ensure that the parties are treated equally, that each party is given a fair opportunity to present its case, and that the proceeding takes place with due expedition.

While there is a language requirement in paragraph 11(a) of the Rules, the Panel must balance that against other considerations of ensuring that the proceeding takes place with due expedition and that the parties are treated fairly and given a fair opportunity to present their case. The Panel is of the view that the language requirement should not cause any undue burden on the parties or undue delay.

According to section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (WIPO Overview 3.0), this complaint falls under scenarios warranting proceeding in a language other than that of the registration agreement. For instance, (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name, particularly where it is the same as that of the complainant's mark.

It is well-known fact not requiring a proof that English is widely understood and is spoken throughout the world as an international language, including Russia. Therefore, it is highly likely that the relevant Respondent might understand English sufficiently to understand the content of the complaint and annexes.

Furthermore, it is a well-known fact that does not require proof that the Russian language uses the Cyrillic script. However, the disputed domain name is registered in Latin letters rather than their Cyrillic alternatives, suggesting that the Respondent has knowledge of languages other than Russian. In addition, the written notice sent by the Czech Arbitration Court was in both Russian and English. Furthermore, the fact that the disputed domain names incorporate the well-known brand of the Complainant, which consists of Latin characters only, indicates the Respondent's familiarity with brands that are not of Russian origin and at least some level of proficiency in English.

The Respondent raised no objection to the proceedings being conducted in English.

Based on the foregoing, the Panel concludes that it is not unfair to the Parties to proceed in English and finds it appropriate to exercise its discretion and allow the proceedings to be conducted in English.

PRINCIPAL REASONS FOR THE DECISION

The burden for the Complainant under paragraph 4(a) of the Policy is to prove:

1) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark in which the Complainant has rights;

2) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

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

The Panel will further analyze the potential concurrence of the above circumstances.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") and, where appropriate, will decide consistent with the consensus views captured therein.

**Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name.

Based on the evidence submitted by the Complainant, the Panel finds that the Complainant has shown rights in respect of its INTESA SANPAOLO mark for the purposes of the Policy. WIPO Overview 3.0, section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. WIPO Overview 3.0, section 1.7. The addition of the determinative article "THE" bears no distinctive character and is certainly not able to reduce the confusing similarity of the disputed domain name with the Complainant's trademark. WIPO Overview 3.0, section 1.8.

The Panel further notes that the gTLD ".com" is required only for technical reasons and is generally ignored for the purposes of comparison of the Complainant's mark to the disputed domain name. WIPO Overview 3.0, section 1.11.1.

For all of the above-mentioned reasons, the Panel is of the view that the disputed domain name is confusingly similar to the Complainant's mark, which means that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

**Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is well established that, as it is put in WIPO Overview 3.0, section 2.1, while the overall burden of proof in the proceedings is on the complainant, proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. Therefore, the Panel agrees with prior UDRP panels that the complainant is required to make out a prima facie case before the burden of production on this element shifts to the respondent to show that it has rights or legitimate interests in the disputed domain name.

The Complainant has made out a prima facie case showing that the Respondent has no rights or legitimate interests in the disputed domain name, notably by demonstrating rights in the INTESA SANPAOLO trademark, which precede the Respondent's registration of the disputed domain name for years, and confirming that the Respondent is neither affiliated with, nor has it been licensed or permitted to use the Complainant's INTESA SANPAOLO trademark or any domain names incorporating the INTESA SANPAOLO trademark.

Bearing in mind that the Panel has not found evidence that the Respondent has been commonly known by the disputed domain name, that the Complainant has not licensed, authorized, or permitted the Respondent to register the disputed domain name incorporating the Complainant's mark, and taking into account that the Respondent is not sponsored by or legitimately affiliated with the Complainant in any way, the Panel concludes that the Respondent has no rights or legitimate interests related to the disputed domain name.

With the evidence on file, the Panel therefore concludes that the Respondent has no rights or legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

**Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. WIPO Overview 3.0, section 4.2.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a

domain name is in bad faith. WIPO Overview 3.0, section 3.2.1.

In the present case, the Panel notes that the Complainant has submitted evidence that the Respondent registered the disputed domain name long after the Complainant registered its INTESA SANPAOLO trademark. Given that the Complainant's trademark has been registered for a long time, it is highly unlikely that the Respondent did not know of the Complainant and its INTESA SANPAOLO mark prior to the registration of the disputed domain name.

Furthermore, the Panel is also of the view that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online 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 in terms of paragraph 4(b)(iv) of the Policy. This false impression is increased by the incorporation of the Complainant's "INTESA SANPAOLO" trademark in the disputed domain name with the mere addition of the determinative article "THE", creating confusion for Internet users who might think that this domain name refers to "INTESA SANPAOLO" trademark owned by the Complainant and consequently is somehow connected to the Complainant, which is not true.

Furthermore, the disputed domain name redirected to a low-quality, misleading page – likely auto-generated or template-based – containing generic promotional content, vague references to financial services, and no actual functionality. This lack of substance strongly indicates that the site was not genuinely offering services, but rather serving as a placeholder or a deceptive tool aimed at confusing users or monetizing the domain through redirection, ads, or misleading associations.

Finally, the fact that the Respondent did not answer the cease and desist letter sent by the Complainant, is an additional evidence of bad faith. As it was decided by the Panel in Riemann Trading ApS v BUI QUANG PHUONG, CAC-UDRP-101403: "it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark PERSPIREX when registering the Disputed domain name. If the Respondent had legitimate purposes in registering and using the Disputed domain name it would have responded to the Complainant's "cease and desist" letter".

The Respondent did not submit a Response in this proceeding which is a further indication of the Respondent's bad faith, which was considered by the Panel.

Therefore, on the balance of probabilities, taking into consideration all cumulative circumstances of this case, the Panel considers that the disputed domain name was registered and is being used in bad faith. In light of the above, the third element under paragraph 4(a)(iii) of the Policy has been established.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **THEINTESASANPAOLO.COM**: Transferred

## PANELLISTS

| | |
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| Name | **Ganna Prokhorova** |

DATE OF PANEL DECISION 2025-03-30

Publish the Decision