Decision for dispute CAC-UDRP-107315

Case number	CAC-UDRP-107315
Time of filing	2025-02-20 10:09:13
Domain names	BANCAINTESA.ONLINE

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	Domain Name Privacy Inc.

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 the following registrations for the trademarks “INTESA” and “BANCA INTESA”:

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

- International trademark registration n. 1032908 “BANCA INTESA”, applied on December 18, 2009 and duly renewed, in classes 9, 16, 35, 36, 41, 42 and 45;

- EU trademark registration n. 12247979 “INTESA”, applied on October 23, 2013 and granted on March 5, 2014, in classes 9, 16, 35, 36, 38, 41 and 42;

- EU trademark registration n. 779793 “BANCA INTESA”, applied on March 24, 2006, granted on November 15, 1999 and duly renewed, in classes 9, 16, 36, 41 and 42.

FACTUAL BACKGROUND

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

The Complainant alleges it 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.

Further, Banca Intesa 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.

On December 5, 2024, the Respondent registered the domain name BANCAINTESA.ONLINE. Complainant notes that on June 19, 2020 its attorneys sent to the Respondent a cease-and-desist letter asking for the voluntary transfer of the domain names at issue. Despite such communication, the Respondent did not comply with the above request.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant submits that <bancaintesa.online> is identical to its INTESA and BANCA INTESA trademarks in that it contains in whole the word “Banca Intesa.” According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain names, because it has not been authorized by the Complainant to use the BANCA INTESA trademark, and the disputed domain name does not correspond to the name of the Respondent. The Complainant adds that the Respondent does not carry out a fair or non-commercial use of the disputed domain name as it currently does not resolve to an active website.

The Complainant contends further that the disputed domain name was registered and is being used in bad faith. According to the Complainant, the BANCO INTESA trademark is distinctive and well-known around the world, and that it is evident that the Respondent registered the disputed domain name with knowledge of Complainant’s trademark. The disputed domain name is not used for any bona fide purpose as it resolves to a website containing pay-per-click links to banking services.

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

RESPONDENT:

The Respondent did not reply to the Complainant's contentions and did not submit any arguments or evidence in its defence. In such event, UDRP Rule 14 provides (a) that the “Panel shall proceed to a decision on the complaint” and (b) that “the Panel shall draw such inferences therefrom as it considers appropriate.”

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

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it. Nevertheless, Complainant has the burden of proof on its contention that Respondent's registration of <bancaintesa.online> constitutes an abusive registration.

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
(ii) the respondent has no rights or legitimate interests in respect of the domain name; and
(iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Czech Arbitration Court has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case and defend its registration of the subject domain name <bancaintesa.online>.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name …"

Notwithstanding Respondent's default Complainant is not relieved from the burden of establishing its claim. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0, paragraph 4.3: "Noting the burden of proof on the complainant, a respondent's default (i.e., failure to submit a formal response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true.

A. Identical or confusingly similar, paragraph 4(a)(i).

The Complainant has demonstrated that it has trademark registrations for the terms INTESA and BANCA INTESA in several jurisdictions thus has a right to maintain this proceeding. The next question is whether the disputed domain name is identical or confusingly similar to the Complainant's trademark. At the threshold it is necessary only to consider "whether a domain name is similar enough in light of the purpose of the Policy to justify moving on to the other elements of a claim for cancellation or transfer of a domain name." The Panel in Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party, WIPO Claim No. D2000-1415 explains that "numerous prior panels have held [the purposes of the Policy are satisfied] when a domain name wholly incorporates a complainant's registered mark." Similarly, Magnum Piering, Inc. v The Mudjackers and Garwood S. Wilson, Sr., WIPO Claim No. D2000-1525. Panelists generally disregard the top-level suffixes as functional necessities; thus, the top-level extension is irrelevant in determining the issue under the first requirement of the Policy.The Panel has made a side-by-side comparison of <bancaintesa.online> and the BANCA INTESA trademark and concludes that it is identical to the mark because it incorporates the mark in its the entirety.

Having demonstrated that <intesaonpaolo.com> is identical to Complainant's BANCA INTESA trademark the Panel finds Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights and legitimate interests, paragraph 4(a)(ii)

Under paragraph 4(a)(ii) of the Policy, a complainant has the burden of establishing that a respondent lacks rights or legitimate interests in respect of the disputed domain name, but this burden is light. It is sufficient in the first instance for Complainant to allege a prima facie case, and if the evidence presented is conclusive or yields an inference that Respondent lacks rights or legitimate interests, the burden shifts to Respondent to rebut the allegations. Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Claim No, D2003-0455 (holding that "[s]ince it is difficult to prove a negative ... especially where the Respondent, rather than complainant, would be best placed to have specific knowledge of such rights or interests–and since Paragraph 4(c) describes how a Respondent can demonstrate rights and legitimate interests, a Complainant's burden of proof on this element is light.") See also Euromarket Designs, Inc. v. Domain For Sale VMI, WIPO Claim No. D2000-1195 ("[I]n the absence of direct evidence, complainant and the panel must resort to reasonable inferences from whatever evidence is in the record."

Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because the Complainant has not granted Respondent permission to use the BANCA INTESA trademark. The evidence in the records is conclusive that Respondent is not commonly known under the disputed domain name. See Amazon Technologies, Inc. v. Suzen Khan / Nancy Jain / Andrew Stanzy, FA 1741129 (Forum Aug. 16, 2017) (finding that respondent had no rights or legitimate

interests in the disputed domain names when the identifying information provided by WHOIS was unrelated to the domain names or respondent's use of the same).

The Complainant also points out that the disputed domain name resolves to a website of PPC links to banking services. The Panel finds that the use of the disputed domain name for a parking page with pay-per-click links does not represent a bona fide offering, having in mind that links in this case are related to banking services and therefore they compete with and capitalize on the reputation and goodwill of the Complainant's trademark and mislead Internet users. WIPO Overview 3.0, section 2.9.

Accordingly, the Panel finds that Complainant has satisfied its prima facie burden. See Malayan Banking Berhad v. Beauty, Success & Truth International, WIPO Claim No. D2008-1393 (holding that once a complainant makes such a prima facie showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant.). Once the burden shifts, Respondent may demonstrate its right or legitimate interest by showing the existence of any of the following nonexclusive circumstances:

(i) before any notice to you [respondent] of the dispute, your use of, or 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) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [respondent] are 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.

If a respondent proves any of these circumstances or indeed anything else that shows it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail. However, where respondent fails to respond the Panel must assess the record before it. Here, the Respondent has a case to answer and has not done so. See Deutsche Telekom AG v. Britt Cordon, WIPO Claim No. D2004-0487 (holding that "once a complainant establishes a prima facie case that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondent. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP"); also, Malayan Banking Berhad, supra. (holding that If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.).

Here, the Respondent has not appeared to rebut Complainant's offer of proof. Its choice of the domain name is confusingly similar to the trademark. Complainant has shown that Respondent is not authorized to register the disputed domain name, does not have any business relationship with the Complainant that would support a defense under para. 4(c)(i) of the Policy, and is not making a "legitimate noncommercial or fair use of the domain name."

Further, the evidence in the record is conclusive that Respondent cannot claim that it has been commonly known by the domain name as it appears through a privacy service without disclosure of the respondent's name. See Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group, Forum Case Number FA1781783 ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy 114(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy para. 4(c)(ii)"); Amazon Technologies, Inc. v. Suzen Khan / Nancy Jain / Andrew Stanzy, Forum Case Number FA 1741129 (finding that respondent had no rights or legitimate interests in the disputed domain names when the identifying information provided by WHOIS was unrelated to the domain names or respondent's use of the same).

Since there is no proof otherwise, the record supports the conclusion that Respondent lacks any right or legitimate interest as measured by the three circumstances of paragraph 4(c). See Deutsche Telekom AG v. Britt Cordon, WIPO Case No. D2004 -0487 (holding that "once a complainant establishes a prima facie case that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondent. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP"). Similarly in Malayan Banking Berhad, supra. (holding that " [i]f the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.").

Accordingly, as the Panel finds that Complainant has demonstrated that Respondent lacks rights or legitimate interests in the disputed domain name it has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith, paragraph 4(a)(iii)

Having determined that Respondent lacks rights or legitimate interests, the Complainant must then prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith. See WIPO Overview 3.0,_section 3.1.4. is that "the mere registration of a domain name that is identical or confusingly similar [. . .] to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

Paragraph 4(b) of the Policy sets out four nonexclusive circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(i) 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
(ii) 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
(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) 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 or service on the site or location.

For the following reasons, the Panel finds that it is more likely than not that the Respondent registered and has used the disputed domain name to take advantage of likelihood of confusion with the Complainant's mark for the Respondent's commercial gain, falling squarely within paragraph 4(b)(iv) of the Policy. The presumption is further strengthened by the strong inference of actual knowledge of Complainant and the BANCA INTESA trademark.

In this case, the BANCA INTESA trademark has a long history of use in commerce predating the registration of the domain names, and in its niche, it cannot be considered otherwise than as a famous mark. As the evidence demonstrates bad faith use, so the priority of the trademark establishes bad faith registration. The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b)(iv) as well as within the larger notion of abusive conduct.

The domain name in this case resolves to a PPC link page that displays links to banking services. Use of a domain name to host PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation of the complainant's mark, as in this case. WIPO Overview 3.0, section 2.9. Use of a domain name to redirect Internet users to a complainant's own website cannot confer any rights or legitimate interests. See Skyscanner Limited v. Domain Administrator, WIPO Case No. D2025-0392.

Accordingly, the Panel finds that Respondent has registered and used the disputed domain name in bad faith and that its conduct firmly supports the conclusion that the registration of <bancaintesa.online> was abusive.

Having thus demonstrated that Respondent registered and is using the disputed domain name in bad faith, Complainant has also satisfied 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. **BANCAINTESA.ONLINE**: Transferred

PANELLISTS

Name	**Gerald Levine Ph.D, Esq.**

DATE OF PANEL DECISION 2025-04-22

Publish the Decision