Decision for dispute CAC-UDRP-107417

Case number	CAC-UDRP-107417
Time of filing	2025-03-21 09:03:15
Domain names	INTESASPONLINE.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

Name	toni yee

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 numerous trademarks filed or registered worldwide, including but not limited to the following:

- International trademark registration no. 920896 “INTESA SANPAOLO”, registered on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 38, 41 and 42;
- International trademark registration no. 793367 “INTESA”, registered on September 4, 2002 and duly renewed, in connection with class 36;
- EU trademark registration no. 5301999 “INTESA SANPAOLO”, registered on June 18, 2007 and duly renewed, in connection with the 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.

The Complainant owns in particular the domain names <intesasanpaolo.com>, <intesasanpaolo.org>, <intesasanpaolo.eu>, <intesasanpaolo.info>, <intesasanpaolo.biz>, <intesa-sanpaolo.com>, <intesa-sanpaolo.org>, <intesa-sanpaolo.eu>, <intesa-sanpaolo.info>, <intesa-sanpaolo.biz> and <intesa.com>, <intesa.info>, <intesa.biz>, <intesa.org>, <intesa.eu>, etc.

The Respondent registered the disputed domain name on November 25, 2024. Currently, the disputed domain name does not

resolve at the time of the Complaint.

FACTUAL BACKGROUND

The Complainant is a leading Italian banking group 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.

It has a network of 3500 branches throughout Italy and has around 13.9 million customers. It also has a presence in Central-Eastern Europe with a network of 900 branches and over 7.5 million customers. Its international network specialised in supporting corporate customers has a presence in 25 countries, including the USA, Russia, China and India.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domains name should be transferred to it. The Complainant makes a number of legal arguments and also supplies a set of annexes providing evidence of its activities and of the Respondent's non-use or use (phishing pattern) of the disputed domain name.

No administratively compliant Response has been filed by the Respondent.

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

It ought to be indicated that the Centre was unable to send the written notice to the Respondent as the address provided by the Registrar in "Registrar verification" information does not exist. The Centre nevertheless sent the notice and the postal service provider was not able to deliver a written notice to such address.

No other address for correspondence was found on the disputed domain name.

The notice of the Commencement of the administrative proceeding was sent also by e-mail. Yet, the e-mail notices sent to postmaster@intesasponline.com was returned back undelivered. The e-mail notice was also sent to horltee@gmail.com, but the Centre never received any proof of delivery or notification of undelivery. No further e-mail addresses could be found on the disputed site.

The Respondent never accessed the online platform.

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

Notwithstanding the fact that no Response has been filed, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

- that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- that the disputed domain name was registered and is being used in bad faith.

A. Confusing similarity

The disputed domain name consists of the Complainant's Trademark “INTESA” with the addition of the letters "SP" and the generic and descriptive term "ONLINE".

The Panel remarks that Section 1.7 of WIPO Overview 3.0, states that, "in cases where a domain name contains the whole of a trademark, or where at least one dominant feature of the relevant trademark is recognisable in the domain name, the domain name shall normally be considered confusingly similar to that trademark for the purposes of UDRP status".

The adding of the "SP" that clearly stands for "SAN PAOLO" in connection with INTESA increases the reference to the Complainant's rights.

The Panel is of the opinion that the sole addition of the descriptive term “ONLINE”, to the combination pre-cited, does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. This is supported by section 1.8 of WIPO Overview 3.0, which states: "Where the relevant mark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not preclude a finding of confusing similarity under the first element".

The gTLD ".com" may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

B. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such a prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant argues that:

- the Respondent is not authorized or licensed by the Complainant;
- the disputed domain name does not correspond to the name of the Respondent. The Respondent is not commonly known as “INTESA SAN PAOLO” or even "INTESA";
- there is no fair or non-commercial use of the disputed domain name.

The Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name from the following facts:

- there is no evidence at all that the Respondent is or has been commonly known by the disputed domain name or by the term(s) “INTESA” or “INTESA SAN PAOLO” or even "INTESA SP";
- there is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers;
- the Respondent did not show to have any trademark rights or other rights in the term(s) “INTESA” or “INTESA SAN PAOLO” or even "INTESA SP";
- the Respondent does not seem to have any consent or authorization to use the Trademark(s) or variations thereof and does not seem to be related in any way to the Complainant; and
- the Respondent did not file an administratively compliant (or any) response. The Respondent did not provide evidence that it has rights or legitimate interests in the disputed domain name (the Respondent could, inter alia, have provided evidence of the factors mentioned in paragraph 4(c) of the Policy, but failed to do so).

In summary, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name.

C. Bad faith

The Complainant argues the following:

The Respondent registered the disputed domain name with actual knowledge of the Trademarks. The Trademarks are well known all around the world. A Google search with the words “INTESA” and “INTESA SANPAOLO” and "INTESA SP" clearly leads to the Complainant.

The Respondent does not use the disputed domain name for a bona fide offering of goods or services. Indeed, the disputed domain name is not used or does not resolve. Yet, the Complainant asserts that the Respondent may be using the domain for phishing activities. The Complainant claims that the Respondent has registered and is using the disputed domain name to confuse consumers and intentionally proceed with fraudulent activities.

Several panellists have ordered the transfer or the cancellation of disputed domain names in similar WIPO cases where Intesa Sanpaolo was the complainant.

The Panel weighs these arguments and facts as follows:

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.

The name INTESA or INTESA SAN PAOLO is distinctive and well known in numerous countries including the USA and Spain for the financial and banking activities of the Complainant.

The Respondent has copied the Complainant’s trademark “INTESA” and has combined it with the acronym "SP" for SAN PAOLO and a generic and descriptive term referring to the mere online access to activity of the Complainant. Therefore, this registration can only be viewed as an attempt to use the name highly confusingly similar to conduct phishing or other misconduct by e-mails.

Such making use of the disputed domain name, obviously in a potential fraudulent manner, neither qualifies as a bona fide nor as a legitimate noncommercial or fair use under the Policy and may not of itself confer rights or legitimate interests in the disputed domain name. The potential collection of personal data or passwords via phishing process being one possible fraudulent act (see CAC Case No. 104862).

The Respondent, for not responding to the complaint, has failed to demonstrate any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, by passing off, infringement of consumer protection legislation, or infringement of the Complainant’s rights under trademark law.

The Panel therefore 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. **INTESASPONLINE.COM**: Transferred

PANELLISTS

Name	**David-Irving Tayer**

DATE OF PANEL DECISION 2025-04-24

Publish the Decision