Decision for dispute CAC-UDRP-107693

Case number	CAC-UDRP-107693
Time of filing	2025-06-26 14:05:22
Domain names	INTESASANPAOLOUK.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

Organization	Cariplo SpA

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

According to the submitted evidence, the Complainant owns, among many others, the following Trademarks:

- International trademark for INTESA (word mark), Reg. No. 793367, registered on September 4, 2002, and in force until September 4, 2032, in International Class ("IC") 36;

- European Union trademark for INTESA SANPAOLO (word mark), Reg. No. 5301999, filed on September 8, 2006, registered on June 18, 2007, and in force until September 8, 2026, in ICs 35, 36, and 38;

- United Kingdom trademark for INTESA (word mark), Reg. No. UK00903105277, filed on March 21, 2003, granted on February 13, 2009, and in force until March 21, 2033, in ICs 35, 36, and 42;

- United Kingdom trademark for INTESA SANPAOLO (word mark), Reg. No. UK00905301999, filed on September 8, 2006, registered on June 18, 2007, and in force until September 8, 2026, in ICs 35, 36, and 38.

The disputed domain name <**intesasanpaolouk.com**> was registered on **January 8, 2007**, and resolves to an inactive website.

FACTUAL BACKGROUND

The Complainant is a relevant Italian banking group with a strong presence in the European financial arena. 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 capitalization exceeding 87.4 billion euros, and a presence in various business areas, including retail, corporate, and wealth management. The Complainant has a network of approximately 3,000 branches capillary, distributed throughout Italy, with market shares of more than 13% in most Italian regions. The Complainant offers its services to approximately 14 million customers.

The Complainant has a strategic international presence, with over 900 branches and 7.5 million customers, comprising subsidiaries operating in 12 countries in Central-Eastern Europe and Middle Eastern and North African areas and an international network of specialists in support of corporate customers across 25 countries, in particular in the Middle East and North Africa, including in the United States, Russia, China and India.

The Complainant also owns a domain name's portfolio, based on the trademarks: INTESA SANPAOLO and INTESA: <intesasanpaolo.com>, .org, .eu, .info, .net, .biz; <intesa-sanpaolo.com>, .org, .eu, .info, .net, .biz and <intesa.com>, .info, .biz, .org, .us, .eu, .cn, .in, .co.uk, .tel, .name, .xxx, .me, which are connected to the official website http://www.intesasanpaolo.com, registered on August 24, 2006.

The Complainant asserted -without providing the corresponding WhoIs [basic] evidence- that the disputed domain name **<intesasanpaolouk.com>** was registered on **January 8, 2007**. Therefore, the Panel, based on paragraph 10 of the Rules and section 4.8 of the WIPO Overview 3.0, has conducted very limited research on it and accepts the Complainant's assertion as true.

PARTIES CONTENTIONS

Respondent

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

Complainant Contentions:

- The Complainant contends that the disputed domain name is identical, or – at least – confusingly similar, to the Complainant's trademarks INTESA SANPAOLO and INTESA. That, as a matter of fact, the disputed domain name exactly reproduces the well-known trademark INTESA SANPAOLO, with the mere addition of the acronym "UK" (which represents the abbreviation of the geographical term "United Kingdom", a country in which Complainant's trademarks have been registered and are used); that it is confusing and misleading for Internet users, who might think that the disputed domain name is somehow connected to Intesa Sanpaolo S.p.A., which is not true.

- The Complainant contends 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. That nobody has been authorized or licensed by the above-mentioned banking group to use the disputed domain name. That the disputed domain name does not correspond to the name of the Respondent, and, to the best of Complainant's knowledge, the Respondent is not commonly known by "INTESASANPAOLOUK".

- The Complainant does not find any fair or non-commercial uses of the disputed domain name.

- That the Complainant's trademarks INTESA SANPAOLO and INTESA are distinctive and well-known worldwide. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent knew of the Complainant's trademark at the time of registration of the disputed domain name; if the Respondent had carried even a basic Google search in respect of the wordings "INTESA SANPAOLO" and "INTESA", the same would have yielded obvious references to the Complainant.

- The Complainant contends that the disputed domain name is not used for any bona fide offerings, including if it is not connected to any website, as is the case according to the Passive Holding Doctrine, confirmed by multiple UDRP panelists under section 3.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"); that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant's line of business, trademarks and even domain name portfolio, used to provide online banking services for enterprises.

- The Complainant also contends that it has been targeted by some cases of phishing in the past few years, and that as a result, its Clients have been cheated of their savings; that given the nature of the disputed domain name, it is possible to infer that, the Respondent registered it with "phishing" purposes, to induce and divert the Complainant's legitimate customers to its website and steal their money; and/or also to resell it to the Complainant as set out in paragraph 4.(b)(i) of the Policy.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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 the Policy were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

In accordance with Paragraph 4(a) of the Policy, the onus is on the Complainant to prove:

(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 is being used in bad faith.

The Panel will consider each of these requirements in turn.

Identical or Confusingly Similar

Concerning the First Element of the Policy, the Complainant has sufficiently proved before the Panel that it owns trademark Rights over the term INTESA and INTESA SANPAOLO.

The disputed domain name includes the trademark INTESA SANPAOLO, in addition to the acronym “UK” (which represents the abbreviation of the geographical term “United Kingdom”), an addition that does not avoid a finding of confusing similarity (see Intesa Sanpaolo S.p.A. v. Denis Emasin, CAC-UDRP Case No. 106533).

In relation to the use of a trademark in the disputed domain name plus other terms, Section 1.8 of the WIPO Overview 3.0 has stated:

> “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. The nature of such additional term(s) may, however, bear on assessment of the second and third elements.” (emphasis added).

Regarding the generic Top-Level Domain “.com”, it may be disregarded (see Section 1.11.1 of the WIPO Overview 3.0).

Therefore, this Panel concludes that the disputed domain name is confusingly similar to the Complainant’s INTESA SANPAOLO trademark.

Rights or Legitimate Interests

Concerning the Second Element of the Policy, to this Panel it is clear that:

(1) The Respondent is not associated or affiliated or hasn’t been authorized or licensed by the Complainant to register the disputed domain name.

(2) There is no favorable evidence towards the Respondent concerning the composition of the disputed domain name, by: a well-known trademark as INTESA SANPAOLO, the addition of the acronym "UK", which represents the abbreviation of the geographical term "United Kingdom", where the Complainant has active presence.

(3) There is no evidence that the Respondent corresponds or has become commonly known by the term "intesasanpaolouk.com".

(4) Nothing in the record suggests or infers any fair or non-commercial use of the disputed domain name, which it seems remained inactive, in particular given the Complainant's banking [highly data sensitive] activity.

According to the evidence submitted before this Panel, the Complainant has made out its prima facie case, and the Respondent did not submit any response or any communication during the entire proceeding rebutting the Complainant's arguments.

Therefore, this Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Registered and Used in Bad Faith

Registration in Bad Faith:

In this case, according to the evidence provided, by the time the Respondent registered the disputed domain name, the Complainant had already established its trademark Rights, including in the UK, e.g., INTESA, since September 2, 2002 (at international level); INTESA since March 21, 2003; INTESA SANPAOLO since September 8, 2006.

Furthermore, the Panel notes that "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" and that the Respondent registered the disputed domain name, seven (7) days after it, meaning on January 8, 2007.

The Panel, of course, also notes that the Complaint has been brought 18 years after the disputed domain name was registered, an ample period, where despite of it, given 1) the total absence of communication, claim and/or formal response from the Respondent; 2) the effective presence of a cybersquatting scenario on the Complainant's detriment; 3) the nature of the Complainant's business where innocent third parties may result ultimately damaged; 4) the Complainant's proof, where each of the UDRP Elements have been established and 5) the absence of it in the Policy, i.e.: Statute of Limitations; then based on paragraph 10 of the Rules, the Panel concludes, that such delay 'has not drawn a negative inference from the delay in the filing of the Complaint.' (see Billards Toulet v. Damon Nelson - Manager, Quantec LLC/Novo Point, LLC, WIPO Case No. D2016-2502, and Section 4.17 of the WIPO Overview 3.0).

To this Panel, the composition of the disputed domain name is not coincidental, in particular given the nature and worldwide presence of the Complainant's business activity, including by the time of its registration (see Section 3.2.2 of the WIPO Overview 3.0).

Use in Bad Faith:

In this case, according to the evidence provided by the Complainant, the disputed domain name has remained inactive. Concerning the Passive Holding Doctrine, among multiple panelists' Decisions, and in particular, under Section 3.3 of the WIPO Overview 3.0, which states that:

> "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.
>
> While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include:
>
> (i) the degree of distinctiveness or reputation of the complainant's mark,
>
> (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use,
>
> (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and
>
> (iv) the implausibility of any good faith use to which the domain name may be put."

In this case, the Complainant has proved that:

(i) INTESA and INTESA SANPAOLO are widely known trademarks that enjoy distinctiveness and a strong reputation, including in the UK market, across Europe, and many other jurisdictions.

(ii) the Respondent failed to submit any communication and/or a Response.

(iv) the disputed domain name has been passively held, resulting in an inactive website, and with it, raising "the specter of continuing bad faith abuse by the Respondent of Complainant's trademark" (see Comerica Inc. v. Horoshiy, Inc., WIPO Case No. D2004-0615).

Therefore, this Panel concludes that the disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPAOLOUK.COM**: Transferred

PANELLISTS

Name	**María Alejandra López García**

DATE OF PANEL DECISION 2025-07-30

Publish the Decision