

Decision for dispute CAC-UDRP-103494

Case number	CAC-UDRP-103494
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Time of filing	2021-01-05 13:02:28
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Domain names	INTESASANPAOLLO.WEBSITE, INTESASANPAOLLO.SPACE, INTESASANPAOLLO.SITE, INTESASANPAOLLO.HOST
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Case administrator

Organization	Denisa Bilík (CAC) (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

Name	Artem Pavlov
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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 is the owner of the following trademark registrations for the sign “INTESA SANPAOLO” (the “INTESA SANPAOLO trademark”):

- the International trademark INTESA SANPAOLO with registration No.920896, registered on 7 March 2007 for goods and services in International Classes 9, 16, 35, 36, 38, 41 and 42; and

- the European Union trademark INTESA SANPAOLO with registration No.5301999, registered on 18 June 2007 for goods and services in International Classes 35, 36 and 38.

FACTUAL BACKGROUND

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

The Complainant is the leading Italian banking group, formed as a result of the merger in 2007 between Banca Intesa S.p.A.

and Sanpaolo IMI S.p.A., two of the top Italian banking groups. The market capitalisation of the Complainant exceeds 37.4 billion Euro, and it has a network of 5360 branches and 14.6 million customers in Italy. The Complainant has a strong presence in Central and Eastern Europe with a network of approximately 1000 branches and over 7.2 million customers. The international network of the Complainant specialised in supporting corporate customers is present in 26 countries in the Mediterranean area, the United States, Russia, China and India.

The Complainant's official website is located at the domain name <intesasanpaolo.com>.

The Respondent registered the disputed domain names on 13 April 2020. Each of them currently resolves to a parking webpage of the Registrar.

The Complainant notes that on 28 May 2020 it sent to the Respondent a cease-and-desist letter, but the Respondent did not respond.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that the disputed domain names are confusingly similar to the Complainant's INTESA SANPAOLO trademark, as they exactly reproduce the trademark with the mere addition of the letter "L", which makes them a clear example of typosquatting.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant submits that it has never authorized the Respondent to use the INTESA SANPAOLO trademark, the Respondent is not commonly known by the disputed domain names and is not making any fair or non-commercial use of them.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. It maintains that the INTESA SANPAOLO trademark is distinctive and well known around the world, and the fact that the Respondent has registered four domain names that are confusingly similar to it, indicates that it had knowledge of the Complainant's trademark at the time of registration of the disputed domain names. The Complainant submits that they have not been used for any bona fide offerings. Rather, the circumstances of the case indicate that the Respondent has registered or acquired the domain names primarily for the purpose of selling, renting, or otherwise transferring them to the Complainant or to a competitor of the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain names.

The Complainant points out that the disputed domain names are connected to a website without particular active contents. According to it, there is no conceivable use that could be made of the disputed domain names that would not amount to an infringement of the Complainant's trademark rights, since the disputed domain names exactly correspond to the Complainant's well-known INTESA SANPAOLO trademark and the Complainant's domain names used by it to provide online banking services.

The Complainant submits that the risk of a wrongful use of the disputed domain names is even higher in the present case, since the Complainant has already been targeted by some cases of phishing in the past few years. Some clients of the Complainant have received e-mail messages asking for their sensitive data. In the present case, the Complainant believes that the Respondent registered the disputed domain names with a phishing purpose, in order to induce and divert the Complainant's legitimate customers to its website and steal their money since the disputed domain names are an example of typosquatting.

RESPONDENT:

The Respondent did not submit a Response in this proceeding.

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.

According to the information provided by the Registrar, the language of the Registration Agreements for the disputed domain names is Russian. Under paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, 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 Complainant requests English to be the language of the proceeding, with the arguments that the Complainant is an Italian company, while the Respondent is Russian, that the Complaint is in English, a third international language comprehensible to a wide range of Internet users worldwide, including the ones living in Italy and in Russia. The Complainant notes that the spirit of Paragraph 11 of the Rules is to ensure fairness in the selection of language, and English seems to be the fair language in the present proceeding. The Respondent has not objected to the Complainant's request on the language of the proceeding.

The above satisfies the Panel that the Respondent would not be disadvantaged if the language of the proceeding is English, and is satisfied that using this language in this proceeding would be fair and efficient. Therefore, in exercise of its powers under paragraph 11 of the Rules, the Panel decides that the language of this administrative proceeding will be English. At the same time, the Panel will take into account the evidence in the case file that is in the Russian language.

PRINCIPAL REASONS FOR THE DECISION

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 Provider 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.

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 ..."

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.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the INTESA SANPAOLO trademark. The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the “.website”, “.space”, “.site” and “.host” gTLD sections of the disputed domain names.

The relevant part of each of the disputed domain names is therefore the sequence “intesanpaollo”, which reproduces the INTESA SANPAOLO trademark with an additional letter “l”, which has a low effect on the overall impression made by the disputed domain name, in which the INTESA SANPAOLO trademark is easily distinguishable and dominating. Each of the disputed domain names appears as a misspelling of this trademark. As discussed in section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the “WIPO Overview 3.0”), a domain name that 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.

Taking all the above into account, the Panel finds that the disputed domain names are confusingly similar to the INTESA SANPAOLO trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that 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. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because the Respondent was not authorized to use the INTESA SANPAOLO trademark and is not commonly known under the disputed domain name. The Complainant also points out that the disputed domain names are an example of typosquatting and do not resolve to active websites. According to the Complainant, the Respondent has registered the disputed domain names for the purpose of phishing attacks against the Complainant’s legitimate customers. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not provided an explanation of the reasons why it has registered the disputed domain names.

In the Panel’s view, the circumstances of this case do not contradict the prima facie case made by the Complainant and do not support a finding that the Respondent has rights and legitimate interests in the disputed domain names. They represent a typosquatted version of the popular INTESA SANPAOLO trademark, which is easily distinguishable and dominates in them. In the lack of any arguments or evidence to the contrary, all the above leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant’s INTESA SANPAOLO trademark, has registered the disputed domain names targeting this trademark in an attempt to exploit its goodwill by confusing and attracting Internet users who may believe that the disputed domain names are affiliated to the Complainant.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain names.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

The registration of the distinctive INTESA SANPAOLO trademark significantly predates the registration date of the disputed domain names. They were all registered on the same date and reproduce the INTESA SANPAOLO trademark with the same spelling mistake, which may lead Internet users to believe that they are affiliated to the Complainant. The Panel is therefore of the view that the Respondent is more likely to have registered the disputed domain names with knowledge of the Complainants' trademark rights and with the intention of taking advantage of their goodwill.

The disputed domain names are inactive, but in the absence of an authorization by the Complainant, and in view of the fact that the Respondent has not provided any plausible explanation of its choice of domain names, the Panel is not aware of any good faith use to which the disputed domain names may be put. As submitted by the Complainant, their non-use would not prevent a finding of bad faith under the doctrine of passive holding, taking account of the degree of distinctiveness and reputation of the Complainant’s INTESA SANPAOLO trademark, the failure of the Respondent to submit a Response, and the implausibility of any good faith use to which the disputed domain names may be put. See section 3.3 of the WIPO Overview 3.0.

This satisfies the Panel that the disputed domain names have been registered and 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. **INTESASANPAOLLO.WEBSITE:** Transferred
2. **INTESASANPAOLLO.SPACE:** Transferred
3. **INTESASANPAOLLO.SITE:** Transferred
4. **INTESASANPAOLLO.HOST:** Transferred

PANELLISTS

Name	Assen Alexiev
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DATE OF PANEL DECISION	2021-02-16
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Publish the Decision
