

Decision for dispute CAC-UDRP-103538

Case number	CAC-UDRP-103538
Time of filing	2021-02-02 10:24:09
Domain names	INTESASANPOLOA.COM

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	lisa brgr
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OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks, amongst others:

- International trade mark registration no. 793367, dated 4 September 2002, for the word mark INTESA, in class 36 of the Nice Classification;
- International trade mark registration no. 920896, dated 7 March 2007, for the word mark INTESA SAOPAULO, in classes 9, 16, 35, 36, 41 and 42 of the Nice Classification;
- EU trade mark registration no. 12247979, dated 5 March 2014, for the word mark INTESA, in classes 9, 16, 35, 36, 38, 41 and 42 of the Nice Classification; and
- EU trade mark registration no. 5301999, dated 18 June 2007, for the word mark INTESA SAOPAULO, in classes 35, 36 and 38 of the Nice Classification.

FACTUAL BACKGROUND

The Complainant's contentions can be summarised as follows:

I. The disputed domain name is confusingly similar to trade marks in which the Complainant has rights

The Complainant states that it is the leading Italian banking group and one of the protagonists in the European financial arena. The Complainant informs that Intesa SaoPaolo resulted from the merger of the Italian banking groups Banca Intesa S.p.A. and SaoPaolo IMI S.p.A. in 2007.

The Complainant further states that it is amongst the top banking groups in the euro zone, with a market capitalisation exceeding EUR 37.4 billion, being the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). The Complainant has a strong presence in Central-Eastern Europe. It maintains an international network specialised in supporting corporate customers in 26 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.

In addition to the trade marks mentioned above, the Complainant informs that it is also the owner of numerous domain names which contain the words "INTESA SAOPAULO" and "INTESA", including <intesasaopaulo.com>.

The disputed domain name <intensasanpoloa.com> was registered on 29 May 2020. The website is currently inactive.

The Complainant avers that the disputed domain name is confusingly similar to the Complainant's trade marks INTESA SAOPAULO and INTESA, and that the disputed domain name is a mere typosquatting version of the Complainant's well-known trade mark INTESA SANPAULO.

In order to substantiate its claim, the Complainant relies on a previous WIPO UDRP decision (Deutsche Bank Aktiengesellschaft v. New York TV Tickets Inc., WIPO Case No. D2001-1314), where the panel found the domain names <duetschebank.com> and <duetsche-bank.com> as being confusingly similar and a clear example of a "case of typosquatting" where the domain name is a slight alphabetical variation from a famous mark. WIPO jurisprudence offers many examples of confusing similarity brought about through easily made typing errors by an Internet user - particularly when the mark is another language from that of the user's mother tongue".

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant asserts that the Respondent has no rights in the disputed domain name, and that any use of the trade marks INTESA SAOPAULO and INTESA has to be authorised by the Complainant. The Respondent has not been authorised or licensed by the Complainant to use the disputed domain name.

The Complainant also asserts that the Respondent is not known by the disputed domain name, nor is the dispute domain name being used for any fair or non-commercial use.

III. The Respondent registered and is using the disputed domain name in bad faith

The Complainant asserts that its trade marks INTESA and INTESA SAOPAULO are distinctive and well known around the world, and that the fact that the Respondent registered a domain name which is confusingly similar to the Complainant's trade marks indicates that the Respondent had knowledge of the Complainant's trade marks at the time of registering the disputed domain name. In this connection, the Complainant avers that, had the Respondent undertaken a basic Google search, it would have come across the Complainant's trade marks INTESA and INTESA SANPAULO. This is a clear indication of registration of the disputed domain name in bad faith.

Moreover, the disputed domain name is not being used for any bona fide offerings, nor does it connect to any website. There are present circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant, who is the owner of the trade marks to which the disputed domain name relate, or to a competitor of the Complainant, in either case for valuable consideration in excess of the

Respondent's out-of-pocket costs directly related to the disputed domain name (paragraph 4(b)(i) of the Policy).

The Complainant further alludes to the doctrine of passive holding to support its claim for a finding of bad faith. In doing so, the Complainant relies upon previous WIPO UDRP panels (most notably, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-003; and *Comerica Inc. v. Horoshiy, Inc.*, WIPO Case No. D2004-0615), as well as to paragraph 3.2 of the WIPO Panel Views on Selected UDRP Questions, Third Edition (WIPO Jurisprudential Overview 3.0).

Finally, the Complainant argues that the risk of a wrongful use of the disputed domain name is even higher in these proceedings given that the Complainant has already been targeted by some cases of phishing in the past few years. Furthermore, excluding any phishing purposes or other illicit use of the disputed domain name, the Complainant cannot find a possible legitimate use of the disputed domain name. The Respondent might have registered the disputed domain name in order to resell it to the Complainant, which evidences registration and use of the disputed domain name in bad faith.

In view of the above, the Complainant claims that the third and final element of the Policy has been established.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to trade marks 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

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy provides the following threshold for the Complainant to meet in order to divest the Respondent of the disputed domain name:

- i. The disputed 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 disputed domain name; and
- iii. The disputed domain name has been registered and is being used in bad faith.

It is therefore incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the

UDRP proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three Policy elements in turn.

I. Identical or Confusingly Similar

The UDRP test under the first element provides for a juxtaposing approach, according to which the textual components of the disputed domain name and the Complainant's trade marks are to be compared side by side.

In order to succeed under the first element of the Policy, the Complainant must provide evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark(s).

Upon review of the case file, the Panel is satisfied that the Complainant has trade mark rights in the terms INTESA and INTESA SAOPAOLLO, dating back to 2002 and 2007, respectively.

The disputed domain name is <intensasanpoloa.com>. The Complainant's trade mark INTESA is wholly incorporated in the disputed domain name.

In addition, the Complainant's trade mark INTESA SAOPAOLLO is nearly wholly incorporated in the disputed domain name, save for the fact that the letters "a" and "o" of the word "PAOLO" have been transposed in the disputed domain name so as to read "POLOA". Hence, the disputed domain name contains the term "INTESASANPOLOA" whilst the Complainant's trade mark is "INTESA SANPAOLO". The Panel takes the view that this transposition is rather immaterial to produce any distinctive character and, therefore, insufficient to dispel the visual and phonetic confusion between the disputed domain name and the Complainant's trade marks (see e.g. WIPO Jurisprudential Overview 3.0, paragraph 1.9; CAC Case No. 103188, Intesa Sanpaolo S.p.A. v tonkin katia sonia; CAC 102503, Intesa Sanpaolo S.p.A. v Coil services (Byron King); CAC 103452, ARCELORMITTAL (SA) v Frank).

The Panel further notes that TLD suffixes are typically disregarded in the assessment of the first element of the Policy. The reason for that is because a TLD is part of the anatomy of a domain name, being the last component positioned right after the final dot (e.g. ".com", ".org", ".net") (see WIPO Jurisprudential Overview 3.0, paragraph 1.11).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trade marks INTESA and INTESA SANPAOLO, the result of which being that the Complainant has succeeded under the requirement of paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The second element of the Policy provides that the Respondent shall demonstrate that it has rights or legitimate interests in the disputed domain name. It therefore falls on the Complainant the burden to refute any such allegations.

Paragraph 4(c) of the Policy sets out a non-exhaustive list of examples by which the Respondent can demonstrate its rights or legitimate interests in the disputed domain name, as follows:

- (i) before any notice of the dispute, the respondent's 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) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate non-commercial 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.

The evidentiary standard under the UDRP proceedings is such that, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to provide evidence to the contrary.

The Respondent did not submit a Response in these UDRP proceedings. Therefore, the Panel will make a determination on the basis of the available evidence.

Having reviewed the case file, the Panel notes that the Respondent does not carry out any activity for, or has any business or relationship of any nature with, the Complainant. There is no contractual arrangement between the parties to that effect, nor has the Complainant otherwise authorised the Respondent to make any use of the Complainant's trade marks, or to apply for registration of the disputed domain name on the Complainant's behalf. The Complainant has also not authorised the Respondent to make any use of the Complainant's trade marks INTESA and INTESA SANPAOLO, and there is no evidence on the record to suggest that the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain name.

The Panel is of the view that the evidence on the available record does not demonstrate that before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services. In addition, the available record does not demonstrate 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 Panel notes that there is also no evidence on record to suggest that the Respondent is affiliated with, or endorsed by, the Complainant (and, in any event, any affiliation or endorsement has been denied by the Complainant).

Furthermore, the choice of a domain name which incorporates a complainant's trade mark is further evidence of lack of rights or legitimate interests (WIPO Jurisprudential Overview 3.0, paragraph 2.4).

For the foregoing reasons, and noting that the Respondent has not provided a Response to refute any of the allegations and evidence produced by the Complainant in these proceedings, the Panel finds that the Complainant has made a prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

In order to meet the third requirement under the Policy, the Complainant must provide evidence that the disputed domain name was registered and is being used in bad faith.

The Policy enumerates non-exhaustive circumstances which would evidence bad faith registration and use of a domain name, as follows:

1. circumstances indicating that the respondent has registered or has 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
2. 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 you have engaged in a pattern of such conduct; or
3. the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
4. by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.

The Panel has considered the evidence put forward by the Complainant. The Panel takes the view that the circumstances in this case which are material to the assessment of bad faith registration and use are intertwined and, as such, will be dealt with by the Panel concurrently.

The Panel lists below a number of indicia which points in the direction of the Respondent's bad faith registration and use of the disputed domain name under the Policy:

- The disputed domain name wholly incorporates the Complainant's trade mark INTESA and nearly wholly incorporates the Complainant's trade mark INTESA SAOPAULO, save for an immaterial transposition of the letters "a" and "o" in the word "PAOLO", which is insufficient to dispel the overall visual and phonetic confusion between the disputed domain name and the Complainant's trade marks in the Panel's view;
- There is no credible explanation for the Respondent's choice of the disputed domain name, which was registered in May 2020, bearing in mind that the Complainant has been in operation for nearly 20 years across the globe, including in the United States, where the Respondent is based. The Panel also notes that the Complainant owns the almost identical domain name <intesanpaolo.com>, which was registered in 2014. Besides, the Complainant owns numerous other domain names bearing the terms "intesa" and "intesanpaolo", for example <gruppointesanpaolo.com>, which was registered in 2006. Therefore, the Panel does not look favourably upon the Respondent, and finds it highly unlikely that the Respondent was not aware of the Complainant's prior rights in the trade marks INTESA and INTESASANPAOLO at the time of registering the disputed domain name, given the Complainant's reputation, which the Panel accepts;
- The Respondent has not provided a Response within the time prescribed under the UDRP Rules, or at all, and has thus failed to offer any explanation of justification to the matters raised by the Complainant in the context of these proceedings. The Panel is empowered to draw adverse inferences by such failure (UDRP Rule 14 (b));
- There is nothing on the record suggesting that the Respondent is affiliated or otherwise connected with the Complainant and the Complainant denies any association;
- UDRP panels have found that a typo of a widely-known trade mark can by itself create a presumption of bad faith (WIPO Jurisprudential Overview 3.0, paragraph 3.14), and the Panel accepts the Complainant's trade marks are widely known; and
- The Panel considers that the case circumstances warrant a finding of bad faith under the passive holding doctrine (see e.g. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). Having considered the totality of the circumstances, the reasons for this include, most compellingly (i) the degree of reputation of the Complainant's trade marks; (ii) the Complainant's numerous domain names which were registered many years before the Respondent's registration of the disputed domain name; (iii) the failure of the Respondent to submit a Response or provide any evidence of actual or contemplated good faith use of the disputed domain name; and (iv) the overall unlikelihood of any good faith use of the disputed domain name.

The Complainant has raised the issue of a heightened risk that the disputed domain name may be used for phishing or fraudulent activities. The Panel has already found that that Complainant succeeds on the basis of the above. Nevertheless, the Panel notes that the Complainant's area of activity is regrettably more prone to activities of such nature. Panels should therefore be mindful of this enhanced risk while assessing a phishing claim in the banking and finance sector, and particular attention should be given to an inactive domain name that mirrors almost identically a complainant's official website, as there is every possibility that the domain name is connected with fraudulent activity.

The Panel is of the view that, taken together, the above are compelling indicia that the Respondent has registered and is using the disputed domain name in bad faith under the Policy.

Accordingly, the Panel finds that the Complainant has made a prima facie showing that the Respondent has registered and is

using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPOLOA.COM**: Transferred
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PANELLISTS

Name	Dr Gustavo Moser
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DATE OF PANEL DECISION 2021-03-01

Publish the Decision
