Decision for dispute CAC-UDRP-103613

Case number	**CAC-UDRP-103613**
Time of filing	**2021-03-02 09:43:54**
Domain names	**intesa-sanpaolo.email**

Case administrator

Organization	**Denisa Bilík (CAC) (Case admin)**

Complainant

Organization	**Intesa Sanpaolo S.p.A.**

Complainant representative

Organization	**Intesa Sanpaolo S.p.A.**

Respondent

Name	**Salvatore Lumia**

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, among others, of the following registrations for the trademarks "INTESA SANPAOLO" and "INTESA":

- International trademark registration n. 920896 "INTESA SANPAOLO", granted on March 7, 2007, in classes 9, 16, 35, 36, 38, 41 and 42;
- EU trademark registration n. 5301999 "INTESA SANPAOLO", applied on September 8, 2006 and granted on June 18, 2007, in classes 35, 36 and 38;
- International trademark registration n. 793367 "INTESA", granted on September 4, 2002 and duly renewed, in connection with class 36;
- 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.

FACTUAL BACKGROUND

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

The Complainant is an Italian company, while the Respondent is French. The Complainant is the leading Italian banking group and also one of the protagonists 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. On July 8, 2020, the Respondent registered the domain name <INTESA-SANPAOLO.EMAIL>. The domain is only parked and in passive hold. On November 9, 2020 the Complainant's attorneys sent to the Respondent a cease and desist letter asking for the voluntary transfer of the domain name at issue. Despite such communication, the Respondent did not comply with the request.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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).
It is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant's trademarks "INTESA SANPAOLO" and "INTESA". As a matter of fact,<INTESA-SANPAOLO.EMAIL> exactly reproduces the well-known trademark "INTESA SANPAOLO".

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). 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. Nobody has been authorized or licensed by the above-mentioned banking group to use the domain name at issue.

The domain name at stake does not correspond to the name of the Respondent and, to the best of Complainant´s knowledge, the Respondent is not commonly known as "INTESA-SANPAOLO". Lastly, the Panel does not find any fair or non-commercial uses of the domain name at stake.

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).
The domain name <INTESA-SANPAOLO.EMAIL> was registered and is used in bad faith.

The Complainant's trademarks "INTESA SANPAOLO" and "INTESA" are distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name
Passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, panels have tended to make such findings in circumstances in which, for example, a complainant's mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the complainant's trademark rights (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, enclosed as Annex E, and also the panels' consensus view on this point, as reflected in the "WIPO Overview of WIPO Views on Selected UDRP Questions" at paragraph 3.2.).

As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademarks. For what concern the second circumstance, it must be underlined 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 trademarks and that result is so similar to the Complainant's domain names currently used by the latter to provide online banking services for enterprises.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain name has to be considered a use in bad faith: «The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests» (Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc., concerning just the case of a bank).

The risk of a wrongful use of the domain name at issue is even higher in the present case, since the Complainant has already been targeted by some cases of phishing in the past few years. Such a practice consists of attracting the customers of a bank to a web page which imitates the real page of the bank, with a view to having customers disclose confidential information like a credit card or bank account number, for the purpose of unlawfully charging such bank accounts or withdrawing money out of them. It happened that some clients of the Complainant have received e-mail messages asking, by the means of web pages which were very similar to the Complainant's ones, the sensitive data of the Clients, like user ID, password etc. Then, some of the Clients have been cheated of their savings.

Also, in the present case, the Complainant believes that the current owner registered the disputed domain name with the "phishing" purpose, in order to induce and divert the Complainant's legitimate customers to its website and steal their money and the above could be easily verified given the particular nature of the disputed domain name (typosquatting).

Even excluding any "phishing" purposes or other illicit use of the domain name in the present case, anyway we could find no other possible legitimate use of INTESA-SANPAOLO.EMAIL. The sole further aim of the owner of the domain name under consideration might be to resell it to the Complainant, which represents, in any case, an evidence of the registration and use in bad faith, according to par. 4(b)(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»).

Lastly, it shall be noted that on November 9, 2020 the Complainant's attorneys sent to the Respondent a cease and desist letter asking for the voluntary transfer of the domain name at issue. Despite such communication, the Respondent did not comply with the above request.

PROCEDURAL FACTORS

The Complainant can use English as the language of the proceeding.
First of all, the Complainant is an Italian company, while the Respondent is French. Given the above, the present Complaint was written in English, a third international language comprehensible to a wide range of Internet users worldwide, including the ones living in Italy and in France. Since the spirit of Paragraph 11 of the Rules seems to be to ensure fairness in the selection of language by giving full considerations to the parties' level of comfort with each language, English seemed to be the fair language in the present proceeding.
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

The passive holding of the domain in question amounts to a violation of the UDRP Rules as the Complainant's mark is well-known, and there was no conceivable use that could be made of the domain name that would not amount to an infringement of

the Complainant's trademark rights.

Accepted

1. **INTESA-SANPAOLO.EMAIL**: Transferred

PANELLISTS

Name   **Thomas Hoeren**

2021-03-25

Publish the Decision