

Decision for dispute CAC-UDRP-104544

| | |
|----------------|----------------------------|
| Case number | CAC-UDRP-104544 |
| Time of filing | 2022-05-03 08:54:44 |
| Domain names | INTESASANPAOLO.LIVE |

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 | johnson clinton |
|------|------------------------|

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 and duly renewed, in connection with classes 9, 16, 35, 36, 41 and 42;
- International trademark registration n. 793367 “INTESA”, granted on September 4, 2002 and duly renewed, in connection with class 36;
- EU trademark registration n. 5301999 “INTESA SANPAOLO”, filed on September 8, 2006 granted on June 18, 2007 and duly renewed, in connection with the classes 35, 36 and 38; and
- 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:

Intesa Sanpaolo S.p.A. (“Intesa Sanpaolo” or “Complainant”) is the owner of various registrations for the trademark INTESA SANPAOLO on a worldwide basis. One of them, the EU trademark Reg. No. 5301999 “INTESA SANPAOLO” was filed on September 8, 2006, granted on June 18, 2007 and duly renewed, in connection with the classes 35, 36 and 38. Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the signs “INTESA SANPAOLO” and “INTESA”: <INTESASANPAOLO.COM>, .ORG, .EU, .INFO, .NET, .BIZ, <INTESA-SANPAOLO.COM>, .ORG, .EU, .INFO, .NET, .BIZ and <INTESA.COM>, <INTESA.INFO>, <INTESA.BIZ>, <INTESA.ORG>, <INTESA.US>, <INTESA.EU>, <INTESA.CN>, <INTESA.IN>, <INTESA.CO.UK>, <INTESA.TEL>, <INTESA.NAME>, <INTESA.XXX>, <INTESA.ME>. All of them are now connected to the official website <http://www.intesasanpaolo.com>.

Intesa Sanpaolo is the leading Italian banking group and is very well known among the top banking groups in the euro zone, with a market capitalisation exceeding 40,5 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Intesa Sanpaolo offers its services to approximately 13,5 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 1.000 branches and over 7,1 million customers. Moreover, the international network specialised in supporting corporate customers is present in 25 countries.

The disputed domain name <intesasanpalo.live> was registered on May 23, 2021 by Italian resident Johnson Clinton.

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, <INTESASANPALO.LIVE> is almost identical to Complainant’s well-known trademark “INTESA SANPAOLO”, with the mere omission of the first letter “O” in the mark’s verbal portion “SANPAOLO” (a clear example of typosquatting).

The Complainant underlined that nobody has been authorized or licensed by the Complainant to use the trademark at issue, including in the domain names.

Several services can be detected, but not in good faith: the domain name is connected to a website sponsoring, among others, banking and financial services, for whom the Complainant’s trademarks are registered and used. Consequently, Internet users, while searching for information on the Complainant’s services, are confusingly led to the websites of the Complainant’s competitors, sponsored on the websites connected to the domain name at issue. Therefore, the Complainant deems that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant’s web site. The Respondent’s commercial gain is evident, since it is obvious that the Respondent’s sponsoring activity is being remunerated.

On April 13, 2022, 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.

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).

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

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

1. The Panel agrees with the Complainant that the disputed domain name is confusingly similar to the Complainant's trademark INTESA SANPAOLO. The disputed domain name consists under the generic TLD ".live". However, the TLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element of the confusing similarity test (see WIPO Overview 3.0, para. 1.11.1). Therefore, considering the renown of the Complainant and its trademark INTESA SANPAOLO, it becomes evident that omission of the letter "O" in the disputed domain name, does not set aside the confusing similarity between the disputed domain name and the Complainant's trademark.
2. The Panel acknowledges that the Complainant presented prima facie evidence that the Complainant has not licensed, authorized, or permitted Respondent to use Complainant's trademarks in any manner, including in domain names. The Respondent's name "Johnson Clinton" does not resemble the disputed domain name in any manner. Respondent's use of the disputed domain names does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use.
3. As no administratively compliant response has been provided to the Panel and the prima facie evidence was not challenged by the Respondent, the Panel concludes that the Respondent meant Complainant's trademark INTESA SANPAOLO when he registered the disputed domain name <intesasanolive> (see WIPO Overview 3.0, para. 3.1.1). Previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Accordingly, the Panel finds that the disputed domain name was registered in bad faith.
4. The evidence in this case also show that the disputed domain name has been used to intentionally divert traffic away from the Complainant's web site. The Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated. This qualifies as bad faith use under paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INTESASANPALO.LIVE**: Transferred

PANELLISTS

| | |
|------|-----------------------------|
| Name | dr. Darius Sauliūnas |
|------|-----------------------------|

DATE OF PANEL DECISION 2022-06-08

Publish the Decision