

Decision for dispute CAC-UDRP-104761

Case number	CAC-UDRP-104761
Time of filing	2022-08-02 09:26:27
Domain names	INTESASANPAOLO-CHECK.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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

Organization	IceNetworks Ltd.
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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 (the "Domain Name").

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following trade mark registrations that comprise or incorporate the terms "INTESA SANPAOLO" or "INTESA":

- International trade mark registration n. 920896 "INTESA SANPAOLO" as a word mark, dated 7 March 2007, in classes 9, 16, 35, 36, 38, 41 and 42 and proceeding to registration in multiple territories;
- International trade mark registration n. 793367 "INTESA" as a word mark, dated 4 September 2002 in class 36 and proceeding to registration in multiple territories;
- EU trade mark registration n. 5301999 "INTESA SANPAOLO" as a word mark, applied for on 8 September 2006 and granted on 18 June 2007, in classes 35, 36 and 38;
- EU trade mark registration n. 12247979 "INTESA" as a word mark, filed on 23 October 2013 and granted on 5 March 2014, in classes 9, 16, 35, 36 38, 41 and 42.

FACTUAL BACKGROUND

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The Complainant forms part of a leading Italian and euro zone banking group. It results from the merger (effective as of 1 January 2007) between Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., two Italian banking groups.

The Complainant's group has a market capitalisation exceeding 35.6 billion euro and operates in the retail, corporate and wealth management business areas. It has 3,700 branches and a market share of more than 16% in most Italian regions, offering 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 7.0 million customers. Moreover, the international network specialised in supporting corporate customers is present in 25 countries, in particular in the Mediterranean area and those areas where Italian companies are particularly active; such as the United States, Russia, China and India.

The Complainant is also the owner, among 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>.

On 3 March 2022, the Respondent registered the Domain Name.

The Domain Name is currently blocked by Google Safe Browsing because of a suspected phishing activity.

On May 18, 2022 the Complainant's attorneys sent to the Respondent a cease and desist letter asking for the voluntary transfer of the Domain Name. 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 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 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 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

The Panel is satisfied that the Complainant is the owner of a number of registered trade marks for the term "INTESA SANPAOLO".

In order to satisfy the first element of the Policy it is usually sufficient for a complainant to show that the relevant mark is “recognizable within the disputed domain name”; see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "WIPO Overview 3.0"). The Domain Name can only be sensibly understood as the term “INTESA SANPAOLO” in combination with the word "Check" and the ".com “ generic Top-Level Domain. The mark relied upon by the Complainant is, therefore, clearly recognisable in the Domain Name.

The Complainant has, therefore, satisfied the Panel that the Domain Name is confusingly similar to trade marks in which it has rights and has thereby made out the requirements of paragraph 4(a)(i) of the Policy.

The Panel also accepts that it is clear from the form of the Domain Name alone that the Domain Name has been deliberately chosen as involving a reference to the Complainant's business and marks.

Otherwise, it is not entirely clear why the Domain Name has been registered. The Complainant contends that this has been for unlawful phishing activities. It is a plausible allegation, particularly since the term "Check", might be understood as a synonym for "verification", or as the US spelling of the English word "cheque". It is also an allegation that gains some support from the fact that the website to which the Domain Name points has been blocked by Google Safe Browsing. However, at the same time this seems to be at odds with the Complaint's allegation in the Complaint that the Domain Name "is being passively held".

Nevertheless, regardless of what the exact intentions of the Respondent were or are, the Panel accepts that the Domain Name has been registered and held with the intention of using it to take some form of unfair advantage of the Complainant's marks. It is difficult to conceive of any use of the Domain Name that would not do so. This is sufficient for the Panel to conclude that the Domain Name was registered and is being held in bad faith (see 3.1 of the "WIPO Overview 3.0"). There is also no right or legitimate interest in holding a Domain Name for the purpose of taking unfair advantage of the mark of another and such a finding, is also positive evidence that no right or legitimate interest exists (see section 2.15 of the WIPO Overview 3.0).

In the circumstances, the Complainant has made out the requirements of paragraph 4(a)(ii) and (iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. INTESASANPAOLO-CHECK.COM: Transferred

PANELLISTS

Name	Matthew Harris
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DATE OF PANEL DECISION 2022-09-08

Publish the Decision