

Decision for dispute CAC-UDRP-105474

Case number	CAC-UDRP-105474
Time of filing	2023-05-26 10:29:17
Domain names	INTESANAPOLO.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

Name	Jiri Capcuch
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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 registrations for the trademarks INTESA SANPAOLO and INTESA:

- International trademark registration #920896 "INTESA SANPAOLO", granted on March 7, 2007 and duly renewed, in connection with classes 9, 16, 35, 36, 41, 42;
- International trademark registration #793367 "INTESA", granted on September 4, 2002 and duly renewed, in connection with class 36;
- EU trademark registration #5301999 "INTESA SANPAOLO", granted on June 18, 2007 and duly renewed, in connection with classes 35, 36 and 38; and
- EU trademark registration #12247979 "INTESA", 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 a 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.

Intesa Sanpaolo is among the top banking groups in the euro zone, with a market capitalisation exceeding 45.3 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management). Thanks to a network of approximately 3,500 branches capillary and well distributed throughout the Country, with market shares of more than 16% in most Italian regions, the Group offers its services to approximately 13.6 million customers. Intesa Sanpaolo has a strong presence in Central-Eastern Europe with a network of approximately 950 branches and over 7.1 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 most active, such as the United States, Russia, China and India.

The Complainant is also the owner 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.intesasampaolo.com>.

The Respondent appears to be an individual who resides in Ostrava, Czech.

The disputed domain name was registered on January 26, 2023.

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).

The Complainant claims rights in the INTESA and INTESA SANPAOLO marks through its trademark registrations with the EUIPO and WIPO. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See *Avast Software s. r. o. v Milen Radumilo*, 102384, (CAC 2019-03-12).

The Complaint further alleges that the disputed domain name is a reproduction of Complainant's well-known trademark "INTESA SANPAOLO", with the mere omission of the letter "SA" in the mark's verbal portion "SAN" and the inversion of letters "P" and "A" in the term "PAOLO".

The Panel is of the view that it is commonly agreed that typosquatting constitutes confusion and the prominent part of the disputed domain name in the present case is at least visually confusingly similar to Complainant's INTESA SANPAOLO mark, see *Intesa Sanpaolo S.p.A. v Milen Radumilo*, 103410 (CAC 2020-12-17). In light of the ".com" generic top-level domain ("gTLD"), the Panel believes that it does not prevent the finding of confusingly similar. See *Belron International Limited v Andrea Paul*, 103381, (CAC 2020-12-09).

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of proof then shifts to the Respondent to show it does have rights or legitimate interests. See *PepsiCo, Inc. v Smith power production*, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name and the Respondent is not authorized or licensed to use of the trademarks INTESA SANPAOLO and INTESA as well as the disputed domain name. The Complainant could not find any fair or non-commercial use of the disputed domain name and the Respondent is not commonly known as "INTESANAPOLO".

Having reviewed the screenshot of the website, the Panel notes that the disputed domain name resolves to a pay-per-click site featuring some advertisements related to the banking industry which are highly related to the Complainant. It is agreed by previous panels that

resolving a domain name that is confusingly similar to a famous brand to a pay-per-click site to attract traffic for commercial gain does not constitute rights or legitimate interests, see Novartis AG vs Carolina Rodrigues (Fundacion Comercio Electronico), 105302 (CAC 2023-04-19). The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name but the assertion has not been within the required period of time.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

The Complainant claims that its trademarks “INTESA SANPAOLO” and “INTESA” are distinctive and well known globally and the Respondent should have actual knowledge of the trademarks due to its registration of the disputed domain name that is confusingly similar to the trademarks “INTESA SANPAOLO”. The Panel agrees that Complainant’s INTESA SANPAOLO and INTESA are well-known and notes that the trademarks were registered about 20 years before the registration date of the disputed domain name. It is well established that registering a domain name similar to a well-known brand with actual knowledge clearly constitutes to registration in bad faith, see ARCELORMITTAL (SA) v acero, 102399, (CAC 2019-04-22). On this basis, the Panel accepts that the disputed domain name was registered in bad faith.

The Complainant further asserts that the disputed domain name is not used for any bona fide offerings. The Respondent has had intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of his web site in accordance with para 4(b)(iv) of the Policy. The disputed domain name resolves to a website that allow accessing to websites of Complainant’s competitors in the banking industry. The Panel is of the view that resolving a domain name that is confusingly similar to a famous brand to a pay-per-click site constitutes use of bad faith due to intentionally attempted to diverse traffic and for commercial gain, see ARCELORMITTAL (SA) vs arcalormittel, 104715 (CAC 2022-08-04) and paragraph 3.1.4 of the WIPO Overview 3.0. In this circumstance, the Panel finds that Respondent’s use of the disputed domain name is in bad faith.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **INTESANAPOLO.COM**: Transferred

PANELLISTS

Name	Mr Paddy TAM
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DATE OF PANEL DECISION 2023-06-28

Publish the Decision