

Decision for dispute CAC-UDRP-104163

Case number CAC-UDRP-104163

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Domain names GRAZIA.NET

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization Mondadori Media S.p.a.

Complainant representative

Organization Dragotti & Associati S.r.l.

Respondent

Name Grazia Visconti

OTHER LEGAL PROCEEDINGS

The Complainant has made contentions and provided documentary evidence concerning legal proceedings which had been decided by Italian courts and which relate to the disputed domain name, namely:

- proceeding no. 30264/2010 before the Court of Milan decided with judgement no. 8953/2012 (11107/2012) issued on 31 May 2012 and published on 18 June 2012;
- proceeding before the Court of Appeal of Milan decided with judgement no. 4725/2015 published on 10 December 2015; and
- proceeding no. 15245/2016 before the Italian Court of Cassation decided with judgement no. 4721/2020 issued on 25 November 2019 and published on 21 February 2020.

By virtue of the judgement of the Court of Cassation, the judgements rendered in first and second instances are final.

These judgements and their ruling are particularly relevant in the present administrative proceeding and will be analysed in the reasoning below.

The Panel is aware of the above-mentioned legal proceedings which are decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is owner of the following registered trademarks:

- Italian trademark registration GRAZIA (word) no. 0001540355 filed on 27 June 1963 and registered since 21 October 1963 in class 16; and
- international trademark GRAZIA (word) no. 276829 registered since 28 November 1963 in class 16.

The trademarks mentioned above are hereinafter referred to as GRAZIA Trademark.

FACTUAL BACKGROUND

The Complainant is a well-known Italian company leader in the field of publishing, books, magazines, media production and distribution.

The disputed domain name was registered on 27 August 1998 by an Italian individual identified by the Registrar as Grazia Visconti. As confirmed by the Respondent itself, Grazia Visconti is a pen-name used by Graziella Solaroli.

In 2010 the Complainant initiated legal proceedings against the Respondent concerning the disputed domain name, prevailing in all court instances available. Notwithstanding the court order to transfer the disputed domain name to the Complainant, which became final and enforceable in 2020, and the warning letter sent by this latter in 2021, requiring the so-called Auth Code necessary to obtain the transfer of the disputed domain name at the Registrar, the Respondent has not transferred the domain name in question to the Complainant.

The disputed domain name does not resolve to any active website.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is identical or at least confusingly similar to the GRAZIA Trademark in which it has rights, because the disputed domain name contains in its entirety such mark.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Contrary to the ruling of the judgements rendered by the Italian courts and the warning letter sent by the Complainant, the Respondent has not transferred the disputed domain name to the Complainant. Moreover, the Complainant contends that the disputed domain name is currently inactive.

The Complainant finally contends that, as confirmed by the judgements, its GRAZIA Trademark is well-known and the disputed domain name has been registered and is being used in bad faith by the Respondent.

RESPONDENT:

The Respondent contends that the present administrative proceeding has been brought by the Complainant to obtain the "forced transfer" of the disputed domain name based on the final judgement which ended the legal proceedings brought before the Italian courts of first and second instances and the Court of Cassation.

The Respondent claims that one out of three judgements (the one issued by the Court of Appeal of Milan) has not been submitted by the Complainant. According to the Respondent such judgement is essential for the complete review of the present case and, therefore, should be "acquired".

The Respondent also claims that the Complainant has submitted the Complaint and the documents in Italian with a "raw" and unreliable translation in English which should be replaced by an accurate and certified translation.

Therefore, the Respondent requests that, as a preliminary step, a sworn translation of all the documents be ordered, without which "the application appears to be clearly inadmissible", reserving the right to submit any further documents and pleadings that might be useful for dealing with the case at hand.

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

Before the reviewing the case on the merits, the Panel addresses the procedural objections raised by the Respondent concerning:

1. the necessity to "acquire" the judgement issued by the Court of Appeal of Milan, because it is essential for the complete review of the case;
2. the necessity to provide a certified and sworn translation of the Complaint and the documents annexed thereto.

With reference to such objections, the Panel notes as follows:

1. The UDRP Rules in principle provide only for a single round of pleadings, and do not contemplate discovery as such. Accordingly, the Panel's assessment will normally be made on the basis of the evidence presented in the Complaint and any filed Response. Paragraph 12 of the UDRP Rules makes clear that it is for the Panel to request, in its sole discretion, any further statements or documents from the parties that it deems necessary. Paragraph 10 of the UDRP Rules similarly vests the Panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition. While relatively infrequent, where the Panel believes it would benefit from additional information or arguments from the parties concerning contentions made in the pleadings or otherwise, it may issue a procedural order to the parties requesting such information or arguments.

In the present case the Complainant relies on three judgements rendered by Italian courts. By virtue of the judgement of the Court of Cassation, which dismissed the Respondent's appeal in cassation, the judgments of the Court of Appeal of Milan (second instance) and the Court of Milan (first instance) became final (*res iudicata*) starting from the date of publication (21 February 2020). The fact that the judgements are final has also been confirmed by the Respondent in its Response ("These proceedings were commenced [...] on the basis of a final judgment that had ended legal proceedings brought before courts of first and second instance and before the Supreme Court of Cassation").

While the judgements of the Court of Milan and the Court of Cassation have been submitted by the Complainant, the judgement of the Court of Appeal of Milan has not been annexed to the Complaint. However, the Court of Cassation's judgement has sufficiently described Court of Appeal's reasoning and ruling. Whilst the Respondent considers the appeal judgement "essential" for the complete review of this case, and had been party (appellant) in the legal proceeding before the Court of Appeal of Milan, and, thus, had such judgement in its hands or, however, easy access to it, it has not submitted the judgement in question with its Response. Under paragraph 5, letter c, of the UDRP Rules the Response should respond specifically to the statements and allegations contained in the Complaint, include any and all bases for the Respondent to retain registration and use of the disputed domain name, and annex any documentary or other evidence upon which the Respondent relies, together with a schedule indexing such documents. Although the Respondent has had the possibility to do so, has neither replied to the statements and allegations of the Complainant, nor included any bases to retain the

registration and use of the disputed domain name, nor annexed any documentary evidence it considers "essential" to decide the present dispute. Under paragraph 14 of the UDRP Rules, if a Party, in the absence of exceptional circumstances, does not comply with any provision of the UDRP Rules, the Panel shall draw such inferences therefrom as it considers appropriate.

According to this Panel, the Complaint and its documents and the Response are sufficient to decide this dispute.

2. Paragraph 11 of the UDRP Rules provides that the language of the administrative proceeding shall be the language of the registration agreement of the disputed domain name (in the present case English), subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding (e.g., nationality of the parties). The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding. However, neither the UDRP Rules, nor the Supplemental Rules of the CAC require the parties to meet certain formalities, such as providing certified or sworn translation of the documents.

The Complaint was submitted in English and two out of six annexes of the Complaint are in English. The remaining four annexes (the extract of the database of the Italian Trademark Office, the judgement of the Italian Court of Cassation, the warning letter sent to the Respondent, and the judgement of the Court of Milan) are in Italian accompanied by English translation, defined by the Complainant as raw translations.

This Panel is composed of a Panelist who is also an Italian qualified lawyer and, therefore, well understands the Italian language, including legal terminology used by the above-mentioned judgements and the original warning letter.

Moreover, the Panel finds that the English translation of the Italian documents provided by the Complainant are sufficiently reliable.

Therefore, the Respondent's right to defend itself in this proceeding and the ability of the Panel to review this case have not been compromised or affected.

The procedural objections raised by the Respondent are to be considered manifestly ill-founded and a delaying tactic.

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

To succeed in the administrative proceeding, paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (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 by the Respondent in bad faith.

Under paragraph 15(a) of the UDRP Rules, the Panel shall decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The Complainant relies upon judgements rendered under Italian laws and which have become final and enforceable since 21 February 2020.

The Panel has analysed such judgments as far as they are relevant for the purpose of the present proceeding. The final findings and ruling of such judgements can be briefly summarised as follows:

- the Respondent had registered marks, including the trademark (expired before the introduction of the legal proceedings before the courts by the Complainant), the journal and the domain name <grazia.net>, partially identical and, however,

confusingly similar to the earlier GRAZIA Trademark of the Complainant;

- the GRAZIA Trademark of the Complainant are well-known;
- the Respondent had registered and used its marks, including the domain name <grazia.net>, in bad faith with the intent to exploit the GRAZIA Trademark of the Complainant;
- the Respondent's marks, including the domain name <grazia.net>, infringe the trademark rights of the Complainant;
- the Respondent should cease the use, in every possible form and manner, of the mark GRAZIA;
- the domain name <grazia.net> should be transferred to the Complainant.

1. THE COMPLAINANT'S RIGHTS AND IDENTITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S TRADEMARK

The Complainant has established in this administrative proceeding to have rights in the GRAZIA Trademark since 1963.

In assessing identity or confusing similarity, the Panel finds that the disputed domain name is identical to the Complainant's trademark, because it incorporates the entirety of such mark, and differs from this latter by merely adding the TLD .net.

UDRP panels agree that the TLD is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant's trademark, as it is a technical requirement of the registration (see paragraph 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is identical to the Complainant's mark.

2. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent (see paragraph 2.1 of the WIPO Overview 3.0: "where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element").

Based on the evaluation of all evidence presented, the Panel neither finds that the Respondent has used or has demonstrable prepared 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 before any notice of this dispute; nor that the Respondent (identified as Grazia Visconti used as pen-name by Graziella Visconti) have been commonly known by the disputed domain name; nor 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 or to tarnish the trademark or service mark at issue.

To the contrary, by virtue of the ruling contained in the judgements of the Italian courts (order to cease the use of the GRAZIA Trademark in every possible form and manner and to transfer the infringing domain name to the Complainant), which are not discussed and rather confirmed to be final by the Respondent, the Respondent lacks rights or legitimate interests to the disputed domain name.

While the Complainant has established its prima facie case, the Respondent, instead of coming forward with substantial defence and relevant evidence demonstrating its rights and legitimate interests to the disputed domain name, has objected the lack of submission of the Court of Appeal's judgement by the Complainant and of a sworn and certified translation of the Complaint and its documents. Objections which are completely ill-founded for the reasons mentioned above, and has been raised by the Respondent for the only purpose to delay the transfer of the disputed domain name to the Complainant ordered by the courts. Such conduct is relevant also for the assessment of the third element (see below).

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

3. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Respondent registered the disputed domain name which is identical to the Complainant's trademark, since it incorporates the GRAZIA Trademark. The addition of the TLD .net (technical requirement of the registration) is not a sufficient element to escape the finding of identity between the disputed domain name and the Complainant's trademark.

Given the distinctiveness and reputation of the Complainant's prior mark, confirmed in legal proceedings before the Italian courts, it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant's rights in such well-known mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

The disputed domain name does not currently resolve to any active website.

With reference to the non-use of domain names, UDRP panels consider the following factors when applying the passive holding doctrine:

- the degree of distinctiveness and/or reputation of the Complainant's trademark;
- the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use;
- the Respondent's concealing its identity (privacy or proxy service) or use of false contact details;
- the implausibility of any good faith use to which the disputed domain name may be put.

Contrary to the final judgements rendered in the legal proceedings initiated by the Complainant and lasted 10 years, and to the warning letter sent by the Complainant requiring the transfer of the disputed domain name, the Respondent has failed to adhere to such court orders (conduct which might also have criminal consequences under Italian laws but this is out of the scope of the UDRP) and to the request of the Complainant. It has also failed to provide in its Response any evidence of actual or contemplated good faith use, raising only unfounded procedural objections.

Taken into account all circumstances of this case, the Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(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. GRAZIA.NET: Transferred

PANELLISTS

Name **Avv. Ivett Paulovics**

DATE OF PANEL DECISION **2021-12-27**

Publish the Decision