

Decision for dispute CAC-UDRP-104384

Case number CAC-UDRP-104384

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Domain names INTESANTFROD.COM

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 Mario Lobascio

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 registered trademarks (among others):

International registered trademarks:

- International registered trademark no. 793367 for the word mark INTESA, granted on September 4, 2002 in class 36 and designated in respect of over 40 territories; and
- International registered trademark no. 920896 for the word mark INTESA SANPAOLO, granted on March 7, 2007 in classes 9, 16, 35, 36, 38, 41 and 42 and designated in respect of over 60 territories.

European Union registered trademarks:

- European Union registered trademark no. 5301999 for the word mark INTESA SANPAOLO, granted on June 18, 2007 in classes 35, 36 and 38; and- European Union registered trademark no. 12247979 for the word mark INTESA, granted on March 5, 2014 in classes 9, 16, 35, 36, 38, 41 and 42.

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

The Complainant is an Italian banking group resulting from the merger between two of the top Italian banking groups, Banca Intesa S.p.A. and Sanpaolo IMI S.p.A., with effect from January 1, 2007.

The Complainant has approximately 13.5 million customers and a market capitalisation exceeding EUR 50.9 billion. It engages in retail, corporate and wealth management banking activities, and maintains approximately 3,700 branches throughout Italy. It has a market share of more than 17% in most Italian regions. The Complainant also has a strong presence in Central-Eastern Europe with a network of approximately 1,000 branches and over 7.1 million customers. The Complainant's international network, specialised in supporting corporate customers, is present in 25 countries, notably the Mediterranean area and the United States, Russia, China and India.

The Complainant is the owner of the INTESA and INTESA SANPAOLO registered trademarks. The Complainant is also the owner of multiple domain names bearing these marks, including for example, <intesasanpaolo.com> which is used for the Complainant's official website.

The disputed domain name was registered on August 31, 2021. It is identical or at least confusingly similar to the Complainant's INTESA and INTESA SANPAOLO trademarks, reproducing exactly the INTESA mark with the addition of the term "FROD", which is an expression widely used by the Complainant for the security of its clients' bank accounts, and the addition of letters "N" and "T" between "INTESA" and "FROD".

The Respondent has no rights in the disputed domain name. Any use of the INTESA and INTESA SANPAOLO trademarks has to be authorized by the Complainant. No-one has been authorized by the Complainant to use the disputed domain name. The disputed domain name does not correspond to the Respondent's name and it is not commonly known thereby. There are no fair or non-commercial uses of the disputed domain name.

The disputed domain name was registered and is used in bad faith. The Complainant's marks are distinctive and well-known worldwide. The Respondent's selection of a confusingly similar name in the disputed domain name indicates that it had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. Had the Respondent even carried out a basic Google search on the Complainant's marks the same would have yielded obvious references to the Complainant. It is more than likely that the disputed domain name would not have been registered if it were not for Complainant's trademark.

The disputed domain name is not used for any bona fide offering and is not connected to any website. Countless UDRP decisions confirm that the passive holding of a domain name with knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use. 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 concerned that would not amount to an infringement of the complainant's trade mark rights. The Complainant has proved the renown of its trademarks. It is objectively not possible to understand what kind of use the Respondent could make with a domain name which closely corresponds to the Complainant's trademarks and is similar to the domain names used by the Complainant to provide enterprise banking services.

The very act of having acquired the disputed domain name raises the probability of the Respondent using it in a manner that is contrary to the Complainant's legal rights and legitimate interests. 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. 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. The Complainant believes that the Respondent registered the disputed domain name with this phishing purpose in mind, especially considering that it is a typosquatted domain name. Equally, the Respondent may have registered the disputed domain name to sell it to the Complainant in terms of paragraph 4(b)(i) of the Policy.

PARTIES' CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

In addition to the contentions noted in the factual background section above, the Complainant requests that English be one of the languages of the administrative proceeding with the following contentions:

The Complainant wishes to keep English as the language of the proceeding, although the language of the registration agreement is Italian. The Complaint was drafted in English, an international language comprehensible to a wide range of Internet users worldwide, including those living in Italy. As the spirit of paragraph 11 of the Rules is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfort in each language, English seems to be the fair language in the present proceeding. Even if it is true that there is no evidence of an agreement between the Parties to the effect that the proceedings should be in English, it is not possible to ignore the fact that the present dispute was started because the Respondent deliberately registered a domain name which is identical to the Complainant's well-known registered trademark used in Italy and worldwide for several years. Since it is inconceivable that the Respondent was unaware of such circumstance when it registered the disputed domain name, the Complainant believes that a fair solution would be (1) to accept the Complaint as filed in English; (2) to accept a Response in either English or Italian (or the preferred language of the Respondent, if any); or (3) to appoint a panel familiar with such languages.

RIGHTS

The Panel has made no findings in respect of paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel has made no findings in respect of paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel has made no findings in respect of paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

This case falls to be rejected not on the merits but on the basis that the Panel is not prepared to accede to the Complainant's request that the language of the proceedings be English. Furthermore, the Panel is unable to determine a translated Complaint and issue a corresponding decision in Italian, even had it ordered translation into what is the default language for this case under the Policy.

Paragraph 11(a) of the Rules provides that unless otherwise agreed by the Parties, or specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. Here, the language of the registration agreement is Italian and therefore that is the default language of the proceeding. The Panel would have a discretion to determine that the language of the proceedings be English but, having carefully considered the substance of the Complainant's request, declines to exercise such discretion for the following reasons:

First, the Panel notes that the Parties have not agreed an alternative language. Some other reason would need to be identified indicating that it would be fair to both Parties to depart from the default. As outlined in section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), previous panels under the Policy have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. The section notes that such scenarios include (i) evidence showing that the respondent can understand the language of the complaint; (ii) the language/script of the domain name particularly where the same as that of the complainant's mark; (iii) any content on the webpage under the disputed domain name; (iv) prior cases involving the respondent in a particular

language; (v) prior correspondence between the parties; (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint; (vii) evidence of other respondent-controlled domain names registered, used, or corresponding to a particular language; (viii) in cases involving multiple domain names, the use of a particular language agreement for some (but not all) of the disputed domain names; (ix) currencies accepted on the webpage under the disputed domain name; or (x) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement.

Taking these scenarios in turn, (i) there is no evidence showing that the Respondent can understand the language of the Complaint. The Complaint was drafted in English. While formal notification was made by the provider to the Respondent in both the English and Italian languages, the Complaint itself was not translated into Italian. The Respondent has not filed any Response, nor has replied in any way which would suggest that it understands the substance of the Complaint. The fact that the Respondent has not responded despite having received notification of it in both English and Italian is not a sufficient justification on its own in the present Panel's view for the default language of the proceeding to be changed; (ii) the disputed domain name is not identifiably in any language. It does not, for example, contain any English words which the Panel recognizes. It reproduces one of the Complainant's trademarks but the Panel is not satisfied that just because the Complainant uses that mark internationally as well as in Italy it must necessarily mean that the Respondent understands English; (iii) there is no website associated with the disputed domain name and therefore there is no content available which would allow the Panel to make a reasonable inference that the Respondent has a working knowledge of English; (iv) the Complainant has cited no past cases involving the Respondent in its submissions. The Panel has been unable to identify any past cases involving the Respondent which might shed light on its proficiency in English; (v) there is no evidence of prior correspondence between the Parties from which the Respondent's working language(s) could be inferred; (vi) the Complainant was invited by the CAC to withdraw the Complaint if it required to proceed in Italian, or to provide submissions justifying its choice of language. The Complainant chose to take the latter course. The Panel does not consider that any delay arising from the complainant refiling the complaint in Italian (if the Complainant chooses to do so) outweighs the importance of the Respondent receiving fair notice of the Complaint, including being able to read and understand it. It should not be overlooked that the Complaint sets out the fact that the Complainant is one of the largest Italian banks. It has the capability to bring this Complaint in the language of the registration agreement. The Respondent's address as verified by the Registrar is in Italy. The administration contact of the disputed domain name is also in Italy. Even the Respondent's name, at least to this non-Italian speaker, has the appearance of being an Italian name. It is reasonable to infer that the Respondent is an Italian speaker and understands Italian. There are no facts from which it is reasonable to infer, in the circumstances of this particular case, that the Respondent is an English speaker and/or understands English; (vii) no evidence has been presented of any other Respondent-controlled domain names suggesting any proficiency on the Respondent's part in any particular language; (viii) this is not a multiple domain name case and there are no other domain names at issue with a registration agreement in a different language; (ix) as noted earlier, there is no website associated with the disputed domain name; and (x) there are no other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement.

The focal point of the Complainant's request is that the Complainant's mark has been used at an international level and that English is a lingua franca internationally (including in Italy) particularly among Internet users. The Panel does not understand the Complainant to be suggesting that all people living in Italy have a proficiency in the English language, whether they are Internet users or otherwise, far less that there is any evidence that the Respondent does. No corresponding evidence to that effect was submitted with the Complaint. Extending the Complainant's argument to its logical conclusion, any cases under the Policy involving a trademark used internationally could be brought in English notwithstanding the language of the registration agreement and in the absence of any other indicia of fairness to proceed in that language. That is plainly not the intent of the Policy, nor has that approach been typically applied by panels in previous cases.

In the circumstances of the present case, the Panel has reached the conclusion that absent any relevant indicia pointing to the contrary, the only language in which this Complaint could proceed which would be fair to both Parties is Italian. The fact that the Complaint was notified in both English and Italian by the provider (albeit that the Complaint itself was not translated into that language) and that no Response has been filed does not change the Panel's opinion on this matter. As the Panel understands it, this Complaint could proceed with the present provider in Italian, should the Complainant decide to re-file it in a suitably translated form.

PRINCIPAL REASONS FOR THE DECISION

In all of the circumstances outlined in the Procedural Factors section above, the Panel denies the Complaint, emphasising that its denial is for the procedural reasons outlined above and is not a ruling on the merits of the case. Accordingly, at least as far as the present Panel is concerned, said determination is issued without prejudice to any re-filing of the Complaint which the Complainant may decide to make in the language of the registration agreement, noting in particular that the provider in this case has the capability to notify a translated Complaint in Italian and to appoint an Italian-speaking panel to determine it.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **INTESANTFROD.COM**: Remaining with the Respondent

PANELLISTS

Name	Andrew Lothian
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DATE OF PANEL DECISION 2022-04-05

Publish the Decision