Panel Decision for dispute CAC-ADREU-007209

Case number	**CAC-ADREU-007209**
Time of filing	**2016-08-19 20:45:05**
Domain names	**smartling.eu**

Case administrator

Lada Válková (Case admin)

Complainant

Organization

Respondent

Organization	**smartling**

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other pending or decided legal proceeding which relate to the disputed domain name.

FACTUAL BACKGROUND

• Complainant is a representative of Smartling, Inc., a holder of several US registered trademarks, and among them word mark SMARTLING, No. 86/783,666 in class 42 for “non-downloadable software as a service (SAAS) namely, software for use by others for enabling multi-language translation of content”, filed on 9th October 2015, with first use in the US as of September 2009. For the purpose of this Decision hereinafter Smartling, Inc. will be understood by the name “Complainant”.
• US trademark SMARTLING, No. 86/783,666 has been registered on 31st May 2016.
• Complainant holds a domain name SMARTLING.com since 25th September 2009.
• The contested domain name „SMARTLING.eu“ has been registered by Remigiusz Kokot, on 29th December 2015.
• The Respondent did not submitted response to the Complaint.

A. COMPLAINANT

Complainant asserts that

• It has established trademark rights to the mark SMARTLING in the US and in various other countries around the world including but not limited to the United Kingdom, Brazil, Sweden, Germany and the Netherlands.

• Its trademark SMARTLING is identical to the disputed domain name if the suffix ".eu" is disregarded.

• The Respondent has no rights or legitimate interests in the SMARTLING.eu domain name as it was not commonly known by the disputed domain name before the trademark SMARTLING was adopted by Complainant or used by Complainant in the European Union, nor has Respondent been authorized by Complainant to register any variant of SMARTLING in any domain name.

• There is no evidence indicating that the Respondent would have rights in a mark identical to the disputed domain name, “which would serve to satisfy Policy 4(c)(i)”.

• The Respondent is not engaging in offering services at the SMARTLING.eu domain name, and any purported offering would be recent and done benefit and profit from Complainant's senior rights in and to the SMARTLING mark in the European Community.

• SMATRLING.eu has been registered and is being used in bad faith.

• The continued registration of the domain name at SMARTLING.eu will continue to result in damage to Complainant's reputation, through misrepresentation and damage.

• The Complainant requests revocation of the domain name.

B. RESPONDENT

The Respondent did not file any response within prescribed term.

DISCUSSION AND FINDINGS

Under Article 21(1) of the Regulation EC No. 874/2004, a speculative and abusive domain name registration may be subject to revocation if it is identical or confusingly similar to a name in respect of which a prior right is recognized or established by national and/or Community law, and if the domain name has either (a) been registered by its holder without rights or legitimate interest in the name, or (b) has been registered or is being used in bad faith.

Article 10(1) of the Regulation stipulates that "Prior rights" are including, among others, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.

In this particular case, the Complainant has submitted evidence that it owns rights in registered US trademark SMARTLING, No. 86/783,666 filed on 9th October 2015, which has in the meantime, after the submission of this Complaint, been registered on 31st May 2016. The Complainant has further proved that it is a holder of a domain name “SMARTLING.com” since 25th September 2009. The Complainant has also asserted that it has established trademark rights in several Member-States of the European Union; however the Complainant has not provided any evidence to support the claims of factual existence of such trademark rights, whether registered or unregistered.

Under Article 10 (1) of the Regulation, the necessary condition for a right to be considered prior is to be protected under either community regulations or national laws of a Member-State. Previous panels have taken different stands on the issue whether the trademarks registered outside EU and its Member-States can be considered as such “Prior Right” in the sense of Article 10 (1) of the Regulation (notably cases CAC 1580 “AuntMinnie” which confirms such “Prior Right”, and CAC 4478 “PICMG“ which states that no „Prior Right“ exists in the trademark registered outside of the EU.) Further, according to the stand point of number of Panels (CAC 7237, CAC 06616, CAC 1375), interpretation of „Prior Rights" does not stretch to other previously registered other TLDs only.

With regard to the Complainant's unsupported claims that it has established trademark rights in several Member-States of the European Union, the Panel is, on the grounds of Article B11 (a) of the ADR Rules, deciding a Complaint on the basis of the statements and documents submitted by the parties, and is not obliged to conduct its own investigations on the circumstances of the case (Article B 7 (a) of the ADR Rules).

However, given the specifics of this case, particularly (i) different standpoints of the previous Panels on the “Prior Right” issue, (ii) that the Complainant has the right in the registered US trademark, (iii) that it is since 2009 holder of a domain name with international reach and, arguably, target, (iv) that distinctive part of the domain name, trademark and company name of the Complainant, “SMARTLING”, is identical to here disputed domain name, and (v) that due to the poorly elaborated Complaint and lack of evidence in support its claims, the Complainant might unfairly lose its rights, in order to reach its decision, the Panel has decided to undertake own research of the online visibility, presence and mentions of the domain in the public before December 2015 when here disputed “SMARTLING.eu” was registered.

The online research showed that the Complainant translation software has indeed reached certain level of recognition globally before the Respondent registered disputable domain name; notably it has been covered by numerous internationally known media such as Forbes in December 2014; ZDNet in October 2014, The Wall Street Journal in October 2013, Techcrunch.com in October 2011, just to mention few. All available articles mention Complainant’s clients as well, which mostly consist of well-known companies and multinational companies located across the world (Apple, Twitter, British Airways, Spotify, etc.)

On the other hand, the Respondent’s email, as provided to the Registrar with domain name registration request, indicates that it is involved in translation activity as well. Indeed, online search showed that the Respondent is advertising translation from Polish to English

and vice versa, under the name „Resu Translations“ (http://www.e-tlumacze.net/resu or http://panoramafirm.pl/). As such, the Respondent clearly engages in activity competing to the Complainant.

From the conducted research the Panel undoubtedly concludes that the Complainant has become known worldwide by its innovative translation software, at least in its industry of translation, prior to December 2015 when the Respondent registered the disputable domain name, and that the Respondent could have been aware of its existence at the time of registering the domain name SMARTLING.eu. Respondent gave no reply to the Complaint.

Given all of the above, this Panel concludes, that in light of registered US trademark rights and „SMARTLING.com“ domain name, use since 2009 and the reputation the Complainant gained worldwide, that rights of the Complainant might be interpreted as Prior Right and that given significant media coverage with global reach and its involvement in the identical industry, the Respondent could have been aware that SMARTLING already indicates amongst consumers the Complainant as the origin of the services. In other words, by the stand of this Panel, the Respondent lacks legitimate interest in the name SMARTLING. However, as no evidence is submitted by the Complainant to support its bad faith claims, and that this exceeds extent of the research which can be undertaken by the Panel, this Panel does not consider it proved.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name “SMARTLING.eu” is revoked.

PANELISTS

Name	**Vanja Kovacevic**

DATE OF PANEL DECISION 2016-08-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: SMARTLING.eu

II. Country of the Complainant: United States of America, country of the Respondent: Poland

III. Date of registration of the domain name: 29 December 2015

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
None. The Complainant did not claim any valid Prior Rights.

V. Response submitted: No

VI. Domain name is identical to the protected right of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):

1. No

2. Why: The Respondent's website promotes health insurance plans, while the Complainant is a non-profit association that develops, publishes and exploits food composition information. Prima facie it is very unlikely that the Respondent could have any right or legitimate interest in the food business of the Complainant, let alone in his name and since the Respondent fails to show evidence thereof he is deemed to have none.

VIII. N/A

IX. Other substantial facts the Panel considers relevant: Trademarks rights registered outside the European Union, previous domain names and unsubstantiated claims on establishing trademark rights in the Member-States as claimed by the Complainant cannot be considered Prior Rights in the sense of Article 10 (1) Regulation (EC) No. 874/2004.

X. Dispute Result: Revoked

XI. Procedural factors the Panel considers relevant: None.

XII. N/A