Panel Decision for dispute CAC-ADREU-007548

Case number	CAC-ADREU-007548
Time of filing	2017-11-29 11:42:10
Domain names	sumat-project.eu

Case administrator

Aneta Jelenová (Case admin)

Complainant

Organization	VICOMTECH

Respondent

Name	Colleen Hester

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

There is no other legal proceedings the Panel is aware of which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a center specialized in the fields of multimedia, computer science and interactive technologies and headquartered in San Sebastian (Spain). It is named VICOMTECH.
The Complainant's "Human Speach and Language Technology" department is heading a project, founded by the European Commission and named SUMAT.
The goal of this project is to increase the efficiency of the translation of professional subtitles by introducing automatic statistical translation technology. To this end, an online subtitling translation service is being developed for nine European languages combined in 14 language pairs.
This initiative is funded by the EU's ICT policy support program and is run by a consortium of VSI and other subtitling companies with five technical partners. The goal is the construction of a large corpus of adjusted subtitles and the use of this corpus for teaching SMT systems in several language pairs.
One of the commitments undertaken in the project was to maintain the Sumat-Project website for a period of at least five years starting on March 31, 2014, that is until at least March 31, 2019.
As project partner, the company ATHENS TECHNOLOGY CENTER ABETE registered the domain name as of April 28, 2011.
After the first years of registration, however, it was agreed that the project coordinator - the Complainant - should be the owner of the registration and the formalities for the transfer were initiated.
However, as an error occurred during its transfer, the domain name was released and registered by a third party who transferred it to its current owner, i.e. to the Respondent.
The disputed domain name <sumat-project.eu> was last registered on July 20, 2017.
The Complainant has attempted to come to an amicable agreement and therefore sent several e-mails to the Respondent and tried to call him. No response was sent.
The domain does not resolve to any website.

A. COMPLAINANT

The Complainant is a Spanish entity, it relies on articles 21.1 and 10.1 of the 874/2004 regulation to claim prior rights on SUMAT, on the basis of Spanish national Law:
"'Prior rights' shall be understood to include, inter alia, 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".

It explains that the Laws on Brands of 2011 which provides that “the right and ownership of the mark and trade name is acquired by means of duly registered registration in accordance with the provisions of this Act”.
However, this provision has to be coordinated with the Act of 2001, and in this case, with:
- article 6.2 of the Act of 2001, which states that a notoriously known market prevents the registration of a subsequent or confusing trademark;
- article 34 of the Act of 2001 (5th section), which “equates the proprietor of the well-known mark in Spain to the proprietor of the registered trademark”.
The Complainant asserts that the name SUMAT is well-known on the Spanish and on the European market and therefore relies on several articles published on the internet

1. Confusing similarity. EC N°874/2004 Art 21 (1)
Complainant asserts that <sumat-project.eu> is identical to the domain name, which was originally registered by one of the SUMAT’s project participant. Its cancellation was a mistake.
2. Absence of rights or legitimate interests. EX N°874/2004 Art 21 (1)(a)
The Complainant states that the Respondent did not use the disputed domain name since its registration.
For these reasons, Complainant contends that Respondent has no right or legitimate interest in the domain name <sumat-project.eu>.
3. Registration or use in bad faith. EC N°874/2004 Art 21 (1)(b)
a. Registration in bad faith
The Complainant relies on internal reports on the SUMAT project and on several published articles on the SUMAT project to contend that the name SUMAT has a reputation and that the Respondent was very likely aware of this name.
The Complainant contends that the disputed domain name was registered in order to be sold by the registrant.
It considers that the Respondent wants to interrupt the Complainant’s business by deceiving potential customers and users, giving them the impression that there is no work and creation linked to the SUMAT project.
b. Use in bad faith
The Complainant argues that Respondent uses the domain in bad faith.
No website was created since the registration of the domain name and no sign of evolution is visible.
The Complainant contends that any potential use of the disputed domain name would create a confusion with the SUMAT project.

B. RESPONDENT

The Respondent did not reply to the Complaint.

DISCUSSION AND FINDINGS

The Complainant is required to satisfy with Article 21.1 of the EU Regulation 874/2004 on “Speculative and abusive registrations” according to which “A registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, where that name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it:
a) has 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 same regulation states that: “Holders of prior rights recognized or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of. eu domain starts.
‘Prior rights’ shall be understood to include, inter alia, 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”.
The first question to answer is to decide if the Complainant has a right in the meaning of Article 10.1 of the EU Regulation 874/2004.
The Complainant filed the Complaint from its position of coordinator of the European project called SUMAT.
The Complainant is as Spanish entity which relies on rights protected by the Spanish law, according to the Laws on Brands of 2011 and to the Act of 2001, including:
- article 6.2 of the Act of 2001, which states that “a notoriously known market is equated with a registered trademark”;
- article 34 of the Act of 2001, which “equates the proprietor of the well-known mark in Spain to the proprietor of the registered trademark”.
The Complainant briefly cites the Spanish legal provisions on which it relies to allege prior rights.
It does neither provide the copy of these laws, nor cite any decision that applied these provisions and that would comment and explain the required criteria to consider a name as well-known in Spain and protected as well-known non-registered trademark.

The SUMAT project is a European project, financed by the EU and aiming at facilitating the communication in different languages. This is a major issue for Europeans.
Given the submitted pieces of evidence, the Panel is not able to consider that the Complainant proved that it has a prior right according to Spanish national Law.
It does not preclude the Complainant from requesting again the transfer of the disputed domain name.
Therefore, the Panel is of the opinion that the Complainant does not prove its prior rights, in the meaning of articles 21.1 and 10.1 of the 874/2004 EU Regulation on “Speculative and abusive registrations”.
Therefore, there is no need to discuss the absence of rights or legitimate interests or the bad faith registration or use.
For all the foregoing reasons, in accordance with Paragraph B 12 of the Rules, the Panel orders that the complaint is denied.

DECISION

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

the Complaint is Denied

PANELISTS

Name	Marie Emmanuelle Haas

DATE OF PANEL DECISION 2017-11-29

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <sumat-project.eu>

II. Country of the Complainant: Spain, country of the Respondent: Germany

III. Date of registration of the domain name: 20/07/2017

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:

7. unregistered trademark: no proof of the alleged rights

V. Response submitted: No

VI. Domain name is neither identical nor confusingly similar to the protected right/s of the Complainant, as the Complainant offers no proof that it has rights in the word SUMAT incorporated in the disputed domain name.

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. [Yes/No]
2. Why: Not considered by the panel, as the Complainant did not prove that it has rights in the word SUMAT that is incorporated in the disputed domain name.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. [Yes/No]
2. Why: Not considered by the panel, as the Complainant did not prove that it has rights in the word SUMAT that is incorporated in the disputed domain name.

IX. Other substantial facts the Panel considers relevant: None.

X. Dispute Result: Complaint denied

XI. Procedural factors the Panel considers relevant: The Complainant did not prove that it has rights in the word SUMAT that is incorporated in the disputed domain name.