Panel Decision for dispute CAC-ADREU-007582

Case number	CAC-ADREU-007582
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Domain names	onetoonecf.eu

Case administrator

Aneta Jelenová (Case admin)

Complainant

Organization

Respondent

Organization	ARCTOS PARTNERS ADVISORS Società Ditta

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 other legal proceedings, pending or decided, which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant Company was founded in Madrid, Spain, in 2004 and is represented by Enrique Quemada Clariana who has also signed in the name and on behalf of OnetoOne Corporate Finance the Contract between the Complainant and the Respondent.
The Complainant is a Spanish Company offering its financial services in several countries across the world such as in Mexico, Philippines, China, Colombia, India and Italy under the EUTM trademarks ONETOONE CP Reg. 9530205 of 17 November 2017 granted on 23 March 2011 and ONETOONE Corporate Finance Reg.015043656 of 26 January 2016 granted on 24 May 2016 . As far as the present case is concerned the EUTM covers Italy as the Jurisdiction of the Respondent as chosen by the Complainant.
The Complainant is the owner of trademark registrations for ONEtoONE Corporate Finance covering financial services in the European Union since 2016 for financial services under Reg.015043656.
The Complainant and the Respondent entered into an Agreement called UNIT Agreement as per enclosed Documents. This Contract was signed on September 24, 2015 and was about a sort of agency contract in which the Respondent would have developed OnetoOne activities in Italy. On May 18 2017 this contract was terminated. In this contract the Respondent was also obliged to pay an amount for the use of the trademark ONETOONE Corporate Finance and a portion of the outstanding trademark licensing royalties were also requested by the Complainant or its representative on May 18, 2017 in occasion of the termination of the contract.
The termination of the relationship was agreed by both the parties and was considered effective since 18 May 2017.
The disputed domain name <ONETOONECF.EU> was registered on 22 May 2017 and is currently not pointed to an active website.

A. COMPLAINANT

The Complainant underlined that the Respondent knew the clauses, and specially clause 7 of the contract, above mentioned, but just four days after the contractual relationship with Giovanni Sestili came to an end, on 22 May 2017 he registered the EU domain name of our company ONEtoONE Corporate Finance S.L: <onetoonecf.eu>.
Therefore, the Complainant underlines that there is a considerable risk that the public will perceive the disputed domain name either as a domain name owned by the Complainant or will infer that there is some kind of commercial relationship between the Respondent and the Complainant.
The Complainant asserts that the Respondent has no rights or legitimate interest in the disputed domain name since the Complainant has not found that the Respondent has any registered trademarks corresponding to the disputed domain name, is not aware of a Respondent’s use of the disputed domain name that would provide it a legitimate interest, and has granted no license or authorization of any other kind to the Respondent to use its trademark OnetoOne CF.
The Complainant also points out that the Respondent was certainly aware of the Complainant’s mark having signed a Contract with the Complainant (the so called UNIT) in which the Registrant accepted to work for the Complainant and develop the business for OneToONe

company and brand. The circumstances that the Respondent registered the domain name at issue just few days after the contract between the parties was voluntary terminated is a blatant prove that the Respondent has no legitimate rights whatsoever and that this domain name was registered without any right and in bad faith.
In fact the Complainant submits that the Respondent's use of the disputed domain name does not amount to a bona fide offering of goods or services, or a legitimate non-commercial or fair use, since the disputed domain name has been used by the Respondent to try to pass itself off as an entity associated with the Complainant in order to disrupt the Complainant's services.
Finally the Complainant contends that the Respondent registered and used the disputed domain name in bad faith since: i) the Complainant's trademark in respect of financial services belonging to the Complainant and the Registrant knew very well this circumstances given that he had signed a contract in order to work for the Complainant;
ii) the failure of the Respondent to respond to a cease and desist letter, or a similar attempt of contact, has been considered relevant in a finding of bad faith; iii) the Respondent has not been using the disputed domain name, the disputed domain name is, in fact, currently not pointed to an active website since it was taken down following a Complainant's request to the hosting provider.
The Registrant cannot use lack of knowledge as his defense because the domain name is identical to the company for which Mr. Sestili should have worked with.

B. RESPONDENT

The Respondent did not submit any Response.

DISCUSSION AND FINDINGS

Article 22(10) of Commission Regulation No. 874/2004 (hereinafter "the Regulation") provides that the Respondent's failure to respond to a Complaint may be considered by the Panel as grounds to accept the claims of the Complainant. However, as stated in ADR Case No. 05665 (OANDA), this does not mean that a Complaint will automatically be upheld whenever a Respondent fails to respond, since the Complainant is required to demonstrate that the provisions of Article 21(1) of the Regulation are satisfied.

According to article 22 of the Regulation, an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21. Article 21 (1) provides that a registered domain name shall be subject to revocation where the 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, and where:
(a) it has been registered by its holder without rights or legitimate interests in the name; or
(b) it has been registered or is being used in bad faith.
First Element
With reference to the first element, the Panel finds that the Complainant has proved its rights in the trademark ONEtoONE Corporate Finance within the meaning of the Article 10 (1) of the Regulation. Both the EUTMs 015043656 and 9530205 are very simple and descriptive or evocative and for this reason it might be challenged their validity before the appropriate Courts and Institutions. However up to that moment, for this Panel, the trademark is fully valid and enforceable. As the European Court of Justice clearly stated in its Decision F1 in Case C-196/11 of 24 May 2012, the validity of a national or an European Trademark cannot be decided by the Opposition Divisions but as to be assessed and decided by the Competent Bodies. To this end is not up to this Panelist to decide about the Complainant's trademark validity but the said registration is a prima facie right and until its registration is valid has to be considered enforceable and to be protected against third parties's confusingly similar later trademarks.
The Complainant contends that the disputed domain name is confusingly similar to its trademark ONEtoOne Corporate Finance as it encompasses the trademark in its entirety with the addition of the descriptive acronym "CF" that clearly stands for Corporate Finance.

The Panel finds that the addition to the Complainant's trademark of the acronym CF clearly stands for Corporate Finance is not sufficient to exclude confusingly similarity but rather increase the intention to link the disputed domain name to the Complainant's Company and trademark.
As to the top level domain ".eu", it is well established that it may be excluded from consideration as being merely functional component of a domain name.
Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a name in respect of which it has rights, according to the first requirement of Article 21 (1) of the Regulation.
Second Element
With reference to right or legitimate interest, the Article 21 (2) of the Regulation states that "a legitimate interest may be demonstrated where:
(a) prior to any notice of an ADR procedure, the holder of the domain name has used the domain name or a name corresponding to it in connection with the offering of goods or services or has made demonstrable preparation to do so;
(b) it has been commonly known by the domain name;
(c) it is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the

reputation of a name in which a right is recognised or established by national and/or community law.
The Panel finds that the Complainant has proven the Respondent's lack of any rights or legitimate interests in the disputed domain name. The Respondent, by not submitting a Response, has failed to rebut the Complainant's contentions. As stated in CAC Case N. 04040, "In the absence of a Response or any evidence showing a legitimate interest or fair use of the Domain Name by the Respondent, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name".
There is no actual relation, disclosed to the Panel, between the Respondent and the Complainant and Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks under any circumstance. In addition, there is no evidence that the Respondent might be commonly known by the mark OnetoOne or the disputed domain name.

Third Element
The disputed domain name is not pointed to any active website at the time of the drafting of the decision.
Based on this evidence, the Panel finds that the Respondent's use of the disputed domain name does not amount to a good faith offer of goods or services or to a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of the Complainant's trademark.
As to the use of the disputed domain name, the Panel notes that it is not pointed to an active website as a result of the Complainant's take down request to the web hosting provider. However, based on the documents submitted by the Complainant, the Panel is satisfied that the disputed domain name was used to attempt to attract potential customers to a website offering financial services without authorization, pretending to act as an affiliated company of a Complainant's subsidiary, as such substantially increasing the risk of consumer deception.
Moreover, in view of the circumstances of the case and in accordance with Paragraph B10 of the ADR Rules, the Panel considers the failure of the Respondent to comply with its obligation under the ADR Rules as grounds to accept the claims of the Complainant.
Since the Complainant is an entity eligible to be the holder of .eu domain name in accordance with the Paragraph 4(2) (b) of Regulation 733/2002, the Panel orders that the disputed domain name be transferred to the Complainant.
Decision
For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the disputed domain name be transferred to the Complainant OnetoOne Corporate Finance S.L. A company established under the Spanish Law.

DECISION

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

the domain name ONETOONECF.EU be transferred to the Complainant

PANELISTS

Name	MASSIMO CIMOLI

DATE OF PANEL DECISION 2018-03-16

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: ONETOONECF.EU

II. Country of the Complainant: SPAIN, country of the Respondent: ITALY

III. Date of registration of the domain name: 18 May 2017

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

- word mark EUTM, reg. No. 09530205, for the term ONEtoONE CP, filed on 17 November 2010, registered on 20 March 2011 in respect of goods and services in classes of class 36
- word mark EUTM, reg. No. 015043656, for the term ONEtoONE Corporate Finance, filed on 26 January 2016, registered on 24 May 2016 in respect of goods and services in classes of class 36

company name: ONEtoONe Corporate Finance S.L.

V. Response submitted: No

VI. Domain name is confusingly similar 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 was not authorised to use the trademark comprised in the domain name and, secondly , is not known to operate under OnetoOneCF

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: The Respondent did know very well the Complainant's trademark because he signed a contract to develop the Complainant's OnetoOne Finance Corporate in Italy. The contested domain name was in passive holding and no reply to the Complainant's warnign letter was ever sent by the Respondent

IX. Other substantial facts the Panel considers relevant: -

X. Dispute Result: Transfer of the disputed domain name
XI. Procedural factors the Panel considers relevant: -

XII. Is Complainant eligible? Yes