Panel Decision for dispute CAC-ADREU-008053

Case number	CAC-ADREU-008053
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Domain names	efsma.eu

Case administrator

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

Complainant

Organization	EUROPEAN FEDERATION OF SPORTS MEDICINE ASSOCIATIONS

Respondent

Organization	Up Provider

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 unaware of any other legal proceeding pending or decided relating the disputed domain name.

FACTUAL BACKGROUND

The Complainant, the European Federation of Sports Medicine Associations (EFSMA), among other things, carries out a very important official anti-doping activity in the European professional sports. The disputed domain name <efsma.eu> has been linked to the Complainant's official website and has been managed by the Complainant through the Respondent (Up Provider) as Provider.

The Complainant has recently discovered that the disputed domain name appears now to be registered in the name of the Respondent as effective owner and that there is no mention of the real owner (the Complainant) in the domain name's whois.

This change in the ownership, according to the Complainant, occurred during the 2018, when the Respondent decided to use Key-Systems GmbH as Registrar.

The Complainant, having discovered that situation, has immediately requested to the Respondent, on July 20, 2020, the auth-codes of the disputed domain name and of other domain names related to the Complainant's business.

On July 27, 2020, the Respondent confirmed its availability to send the requested auth-codes to the Complainant but, although a formal remainder was sent by the Complainant on August 5, 2020, the auth-codes were never made available before the commencement of the present proceedings.

After then, as per the Nonstandard Communication sent by the Complainant on October 14, 2020, the Respondent has finally transmitted the requested auth-codes to the Complainant. However, since the disputed domain name results "on hold" the auth-code sent for the disputed domain name does not work. In addition, the website is still unavailable, and the e-mail service is interrupted.

In consideration of the fact that the Respondent is not implementing a proper procedure for allowing the Complainant to regularly manage the domain name in dispute, the Complainant prefers to continue this ADR proceedings.

A. COMPLAINANT

Although the Complaint is structured in a very informal way it is possible for the Panel to ascertain that the European Federation of Sports Medicine Associations carries out an important antidoping activity in the European professional sports. This activity, according to the Complainant, is largely shown and promoted through websites linked to different domain names including the one in dispute <efsma.eu> which corresponds to the acronym of European Federation of Sports Medicine Associations. This should imply that the

Complainant has acquired rights on its acronym.

Furthermore, it is possible to note for the Panel that since the Complainant assumes that the Respondent is merely the Provider and not the real owner of the disputed domain name, the same Respondent, in the Complainant's view, has no rights in the disputed domain name.

Finally, it appears to the Panel that the Complainant considers the Respondent's bad-faith in having registered the disputed domain name in its own name and not in the name of the real owner and also in having made available the requested auth-code only after the commencement of the present proceedings, notwithstanding previous agreements between the parties.

B. RESPONDENT

The Respondent has not submitted a formal Response but has communicated with the Complainant during the proceedings.

DISCUSSION AND FINDINGS

Paragraph 21.1 of the European Regulation n°874/2004 states that “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 recognised 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.

By virtue of paragraph 10.1 2) of the Regulation, “‘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 Complainant based the complaint upon an unregistered trademark EFSMA. The Panel, after having conduct further investigations according to paragraph B7(a) of the Rules has clearly verified that actually EFSMA is an acronym for European Federation of Sports Medicine Associations which was founded in Portugal in 1998 and that during the years, has become a well-organized and structured international association, committed to the promotion and development of Sports Medicine in the whole Europe. Therefore, the Panel totally agrees with a previous decision related to the Complainant (EUROPEAN FEDERATION OF SPORTS MEDICINE ASSOCIATIONS, Aldo Rosso v. Maxim Filippov, CAC case no. 08015) and according to which: "The Complainant does not assert a registered trademark for EFSMA. An institution of such critical importance has, however, at the very least the right to protection against impersonation and passing off. Given the high, European-wide profile of the Federation, and the duration and extent of its activities since 1998, both its full name and the acronym EFSMA project key qualities of an unregistered trademark with its attendant rights. In the absence of any contest of the point by the Respondent, the Panel accepts that the Complainant is much in the public eye and is well known by, and has the requisite rights in, the acronym EFSMA to the extent required under the Rules". The Panel finds that the disputed domain name <efsma.eu> is identical to the Complainant’s previous sign as EFSMA is incorporated in its entirety in the disputed domain name and it is a well-established principle that suffixes (TLDs) such as “.com”, “org” or, in this case, “.eu”, may be disregarded when determining if there is identity or confusing similarity (see e.g. Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006-0561; Burberry Limited v. Carlos Lim, WIPO Case No. D2011-0344; Magnum Piercing, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525). The Panel therefore finds that the first condition considered by article 21.1 of the Commission Regulation 874/2004 has been established.

In addition, the Panel has duly considered the Nonstandard Communication filed by the Complainant on October 14, 2020 and including the letter from the Respondent with the auth-code related to the disputed domain name. The Panel believes that this letter, which actually appears as an implicit renunciation of the disputed domain name, clearly shows Respondent's lack of interest in contesting Complainant contentions, which suggests that Respondent does not have any rights or legitimate interests in the disputed domain name (see Lardini S.r.l. v. Andrea Soldano, Esamatic srl, WIPO Case No. D2016-1401). The Panel therefore finds that also the second condition considered by article 21.1 a) of the Commission Regulation 874/2004 has been established.

As the Complainant has proved that the Respondent has no rights or legitimate interest in the disputed domain name, there is no need to prove the alternative ground of bad faith, but for completeness the Panel will consider this point. In particular it is the Panel's view that the arguments raised by the Complainant are not sufficient for a finding of registration and/or use in bad faith of the disputed domain name. Actually, the Panel believes that much more details are needed in order to evaluate the possible bad faith of the Respondent. In addition, it is the Panel's opinion that the fact that the Respondent has furnished the requested auth-code, even if after the commencement of the present proceedings, is the evidence of the Respondent's lack of interest in the domain name in dispute but, at the same time, it is also an indication of the Respondent's lack of bad faith.

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 <EFSMA.EU> be transferred to the Complainant

PANELISTS

Name	**Guido Maffei**

DATE OF PANEL DECISION 2020-12-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <efsma.eu>

II. Country of the Complainant: Italy, country of the Respondent: Italy.

III. Date of registration of the disputed domain name: 7 December 2006.

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

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:implicit renunciation of the disputed domain name during the proceedings

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. No
2. Why: Lack of sufficient arguments by the Complainant

IX. Other substantial facts the Panel considers relevant: none

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: none

XII. If transfer to Complainant, is Complainant eligible? Yes