Panel Decision for dispute CAC-ADREU-008195

Case number	CAC-ADREU-008195
Time of filing	2021-09-20 11:28:11
Domain names	itacademy.eu

Case administrator

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

Complainant

Organization	IT Professionals SRL

Respondent

Organization	SECOMMERCE GmbH

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 proceedings.

FACTUAL BACKGROUND

The Complainant is a company engaged in providing training and consultancy services since it was founded.

The Complainant has registered for Romania a combined trademark M 2006 07814 since 2006, with a dominant verbal element ITAcademy.

In 2011 the Complainant registered a figurative EU trademark 010282499, including the verbal element ITACADEMY.

The Complainant had registered the <itacademy.ro>, since 2006.

The Respondent registered the disputed domain name <itacademy.eu> on May 10, 2019.

The disputed domain name resolves to a website, on which it is offered for sale.

A. COMPLAINANT

The Complainant contends that:
- it has registered the trademark which includes the disputed domain name, since 2006, at a time Romania was not in EU so the Complainant could not legally get the domain or participate in sunrise period. In 2011, it expanded registration of the trademark at European level;
- the disputed domain name <itacademy.eu> was registered by the Respondent on May 10, 2019. It resolves to a website on which it is offered for sale, at a rate, on June 17, 2021 the rate, of 1.990.00 EUR.
- it contacted the Respondent and offered a fair price of 500.00 EUR.
- the Respondent rejected the offer and the sale price was hiked to 5.000.00 EUR.
- since 2006 the Complainant has monitored the registry for the expiration of the domain registration but this was always renewed;
- the Complainant is worried about misuse of this website in the future.

B. RESPONDENT

By its Response, the Respondent asserts:
- the Complaint is not containing any annexes or evidence, but is merely a list of unproven statements and allegations – which are incomplete and not accurate and therefore in breach of the Complainant's signed statement;

- the Complaint first mentions a “group of companies”, however does not specify the corporate structure, the name of the group, nor other members of the group, nor provides any proof that such services have been offered since 2000;
-the Complainant then refers to a European trademark it owns, however fails to specify the contents of this trademark;
- the Complainant´s trademark is not a word mark exactly matching the disputed domain name, but it is only a figurative mark, containing the text “ITAcademy professional learning solutions” along with a logo;
- the Complainant fails to explain why it should have rights to a domain name so different from its trademark;
- the Complainant “IT PROFESSIONALS SRL” is NOT the owner of the trademark, but a different company “SC ITPROFESSIONALS SRL”. The Complainant has failed to establish any relation between itself and trademark owner, so the Complainant has failed to demonstrate its rights on the domain <ITACADEMY.EU>;
- the allegations of the Complainant regarding to an IP dispute settled in its favor, does not specify what kind of settlement was reached, whether it was an out-of-court settlement, and what payments and arguments were exchanged an are, therefore irrelevant for the purpose of this proceeding;
- while the disputed domain name was previously indeed listed for sale at 1.990.00 EUR, the Complainant had contacted the Respondent with the intention to buy it. The Complainant was replied with a the offer of a fair price of 1.590.00 EUR;
- the Complainant fails to mention this counteroffer but only it had found 500 EUR to be a fair price;
- the Complainant has paid 1.300.00 EUR in official filing fees to file this Complaint, excluding its legal fees and time spent which can be explained only if the Complainant has valued the domain much closer to the Respondent fair offer of 1.590.00 EUR;
- the Respondent increased the price of the disputed domain name on SEDO with the view to prevent another party from buying this domain name instead and to reflect on the increased internal costs the Respondent has now invested and spent with this domain;
- the Complainant alleges that it had monitored the registration of the domain since 2006, “but it was always renewed” which is a clearly incorrect statement, as the disputed domain name was available for Respondent to newly register in 2019, and it could have easily registered before by the Complainant;
- the Complainant should register the domain <itacademy-professional-learning-solutions.eu>, which is still available for registration;
- the Complainant has not demonstrated why it should have the sole rights, or even any rights, on the domain <itacademy.eu> – which is neither matching its name, nor matching the trademark (which is not even owned by the Complainant);
-the term “it academy” is generis and used by hundreds of companies in Europe, and gives over 2.2 Million results in a Google Search – however no prominently mapped result at the Complainant’s location;
- the Respondent has registered the disputed domain name in 2019 in good faith, as the Respondent managing director and shareholder has received his diploma agree from the renowed “Technische Universität München” in Informatik (computer science) in 1998 and since the Respondent inception on 26.05.2009, the Respondent has been offering various IT services , which of course includes training and advice in Information Technology related matters;
- the Respondent managing director, also owns a travel business and has further considered to use the domain for travel related consulting and courses (itacademy meaning “international travel academy”).
- due to many ongoing projects, the disputed domain <itacademy.eu> has not been finally developed yet. In the meantime, the disputed domain has been temporary offered for sale on the SEDO marketplace - to compensate for estimated losses if the project with this domain, which was planned to be either an IT or international travel related one, cannot be completed in time, and to buy an adequate alternative domain name when the project is finally being developed;
- according to the letter from Eurid showing the whois-records, the disputed domain had been registered in 2019 for a whole 10 years until 2029, which shows that the Respondent has registered the disputed domain name with long term ambitions, and not for a short term speculation;
- the assertions above, indicate that the Respondent has a legitimate interest in the domain name, and has not registered it in bad faith.
In its Response, the Respondent requests to the Panel to find the Complaint is in bad faith and an abuse of ADR proceedings, according to Paragraph 12 (h).

DISCUSSION AND FINDINGS

According to Paragraph B11(d)(1) of the ADR Rules, the Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves in ADR proceeding where the Respondent is the holder of the domain name in respect of which the Complaint was initiated, that:
(i) the domain 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; either
(ii) the domain name has been registered by the Respondent without rights or legitimate interest in the name; or
(iii) the domain name has been registered or is being used in bad faith.
Article 21(1) of the Commission Regulation (EC) 874/2004 of 28 April 2004 contains similar provision to those of the ADR Rules.

In arriving to the findings in this case, the Panel has reviewed and considered both Complainant’s and Respondent’s submissions and appendixes in detail and has, based on article B7(a) of the ADR rules, further taken note of the decisions in ADR cases.

I. Condition according to Paragraph B11(d)(1)(i) of the ADR Rules

The disputed domain name includes the trademark - dominant verbal element "ITAcademy", which is protected under national Romanian and EU law for the Complainant by the registration of the trademarks: M 2006 07814 and EU trademark 010282499.
Although both registered trademarks are combined and figurative the "ITAcademy" words can be clearly separated and distinguished from the other elements. This Panel dismiss the submissions of the Respondent according to which the Complainant “IT PROFESSIONALS SRL” is not the owner of the trademark, but a different company “SC ITPROFESSIONALS SRL” as they are obviously ill intended.

The Complainant name ”IT PROFESSIONALS SRL” is identical with “SC ITPROFESSIONALS SRL”. Under Romanian law in 2006 and 2011 (the years of the two trademarks registration), the name of a company was always preceded by the acronyms SC coming from the ”Societate Comercială” which in English means ”Commercial Company”. After 2011, with the adoption of a new Romanian Civil Code, the acronyms SC were eliminated from the names of the companies.

Therefore, the Panel considers that the Complainant has demonstrates rights in the trademarks M2006 07814 and EU trademark 010282499 and accordingly finds that the disputed domain name is "identical and confusingly similar” to names in respect of which a right of the Complainant is recognized within the meaning of Paragraph B.11(d)(1) of the ADR Rules.

II. Condition according to Paragraph B11(d)(1)(iii) of the ADR Rules

Bad faith is defined in more detail in Paragraph B11(f) of the ADR Rules which contains an enumeration of the circumstances which may prove the registration or use of a domain name in bad faith. The Panel finds in this case applicable at least the circumstance provided at Paragraph B 11(f)(1) of the ADR Rules, as the circumstances of the case clearly indicate that the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name, in respect of which a right is recognized or established by national and/or European Union law.

It is the Respondent itself which admits that the domain name was primarily listed for sale at 1.990 EUR, and after the Complainant had contacted the Respondent with the intention to buy it, the Complainant was replied with an offer of 1.590 EUR. As the Complainant has not accepted the Respondent admits that it increased the price of the disputed domain name on SEDO.

The Panel is not persuaded by the construction of the Respondent according to which it registered the disputed domain in 2019 in good faith, with the view of offering various IT services, which of course includes training and advice in Information Technology related matters or for travel related consulting and courses (itacademy meaning “international travel academy”). Except for the submissions provided in the Response, the Respondent has not provided any evidence for the documentation of such submissions. Therefore it remains proven the obvious documented intent of the Respondent to register the disputed domain name for the purpose of selling, renting, or otherwise transferring the domain name to the holder a name, in respect of which a right is recognized or established by national and/or European Union law.

The Panel cannot also hold the submission of the Respondent that the Complainant should register the domain <itacademy-professional-learning-solutions.eu>, which is still available for registration, which it is not by itself a workable solutions.

In light of these findings, the Panel does not need to consider whether the Respondent has rights or legitimate interests in the disputed domain name as the conditions set in Paragraphs B11(d)(1)(i) and (iii) are satisfied.

In respect of the Respondent request to find the Complaint is in bad faith and an abuse of ADR proceedings, according to Paragraph 12 (h), this Panel for the findings above dismisses it.

Since the Complainant is a Romanian registered company and based in the Romania, the Complainant also satisfies the general eligibility criteria set out in article 4.2(b) of Regulation (EC) No 733/2002 and referred to in article 22.11 of the Commission Regulation (EC) 874/2004. The Complainant is therefore entitled to the transfer of the disputed domain name 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 domain name ITACADEMY.EU be transferred to the Complainant.

PANELISTS

Name	Beatrice Onica Jarka

DATE OF PANEL DECISION 2021-09-14

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: itacademy.ro

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

III. Date of registration of the domain name: May 10, 2019

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. combined individual trademark M 2006 07814 registered in Romania, reg. under No.082539 for the term 20 years, filed on 11/07/2006, registered on 27/08/2007 in respect of goods and services in classes 41 45 42 (Nice Classification) 290104 270501 200701 (Vienna Classification).
2. figurative trademark EUTM registered in, reg. no. 010282499, for the term 20 years, filed on 21/09/2011, registered on 02/02/2012 in respect of goods and services in classes 16, 41, 42 (Nice Classification) 20.07.02 (Vienna Classification)

V. Response submitted: Yes

VI. Domain name is confusingly similar to the protected right/s of the Complainant.

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. [Yes/No] Not analyzed.
2. Why: Not necessary.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes.
2. Why: The disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name, in respect of which a right is recognized or established by national and/or European Union law.

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