Panel Decision for dispute CAC-ADREU-008357

Case number	CAC-ADREU-008357
Time of filing	2022-08-09 14:32:55
Domain names	valentini

Case administrator

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

Complainant

Organization	valentini.eu

Respondent

Organization	Azienda Agricola Valentini s.s. società agricola

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

Decision in CAC case no. 8276

FACTUAL BACKGROUND

The Complainant, a Danish company "valentini.eu", informs to have lost control over the domain name <valentini.eu> and the correspondent website. The domain name <valentini.eu> was registered by Mr. Stig Valentini, owner of the above Danish company, on August 29, 2006, and was assigned to the Respondent, an Italian company "Azienda Agricola Valentini s.s. società agricola", as per the effect of a previous decision of the CAC (between the Respondent and Mr. Stig Valentini) of March 30, 2022 in case no. 8276.
The Complainant has filed a Complaint with the CAC asking that the disputed domain name <valentini.eu> is definitively transferred to the Complainant or to Mr. Stig Valentini and requesting the Panel to declare the illegality of the use of the <valentini.eu> domain name by the Respondent.

A. COMPLAINANT

According to the Complainant, Mr. Stig Valentini was subjected to a sort of "identity theft" on May 25, 2022. In particular, the Complainant believes that the actual owner of the domain name in dispute has acted in bad faith also in consideration of a previous communication (received by Mr. Stig Valentini on December 22, 2021) in which Mr. Gabriele Valentini, as legal representative of the company "Azienda Agricola Valentini s.s. società agricola", has showed a concrete interest in buying the domain name in dispute.
The Complainant also informs that the decision in case no. 08276 is entirely based on a false narrative from the Respondent. In particular the Complainant insists that, differently from the Respondent's assertion, "valentini.eu" has been regularly in use to communicate with customers with e-mails and through the company website. Actually, the Complainant has submitted evidence demonstrating that a website has been effectively connected to the dispute domain name and therefore that an <external use> of <valentini.eu> has been done. The Complainant also states that, during its ownership on the disputed domain name, the use of <valentini.eu> was never contested by other parties.
In addition, the Complainant believes that the Respondent does not enjoy any right on the disputed domain name since its name is not VALENTINI but AZIENDA AGRICOLA VALENTINI (the Complainant registered trademarks include the entire wording AZIENDA AGRICOLA VALENTINI) and therefore, the Respondent should have rights only on the longer entire name. This even in consideration of the fact that there are registered marks VALENTINI owned by third parties. Therefore, it is the Complainant's view that Respondent should have right on a domain name like <agricolavalentini.eu> which is available.
Finally, the Complainant considers that a commercial private company is always represented by the person and therefore associated with Stig Valentini born on 1966). In consideration of the above it is the Complainant's view that it has prior rights on <valentini.eu> with respect to the Respondent.

B. RESPONDENT

According to the Respondent, the Complainant is simply trying to challenge the previous decision in CAC case no. 8276 which is in clear contrast with Art. 12 (a) of ADR Rules: "The decisions of the panelists will be final, not subject to appeal, and compulsory for the Parties, without detriment to the right of the Parties to initiate a court proceeding in a Mutual Jurisdiction which will have consequences to the implementation of the decision as described in the Terms and Conditions".
In particular, the Respondent contends to be the owner of rights on the term VALENTINI, already demonstrated and recognized in case no. 8276, which clearly predate the registration of the disputed domain name and that the domain name <valentini.eu> reproduces in its entirety the most distinctive part of the Respondent trademarks (VALENTINI).
In addition, the Respondent considers that it has prior rights on <valentini.eu> with respect to the Complainant especially in consideration of an Italian trademark registration filed in 1968, while the Complainant is known as "valentini.eu" only from October 23, 2020

DISCUSSION AND FINDINGS

First of all, the Panel deems it is necessary to remind to the parties the function of the Alternative Dispute Resolutions for .EU Domain Name (hereinafter ADR). Said technical disputes are characterized by a very limited field of investigation and have the only purpose of contesting speculative and abusive registrations of .eu domain names where a complaint is filed in accordance with the applicable rules. Therefore, this Panel cannot consider the request of the Complainant to declare the illegality of the use of the <valentini.eu> domain name by the Respondent since ADR only serve to verify if a domain name registration is abusive or not (and in the affirmative case to transfer the contested domain name to a complainant) according to the ADR Rules. The Panel may only evaluate if the disputed domain name was registered and has been used in bad faith where the concept of bad faith is strictly linked to the content of the ADR Rules.
In addition, it is important to remind that this Panel is not requested to elect the party who enjoys most ancient rights on the term "VALENTINI". Moreover, this Panel is not entitled to review the decision in case no. 8726 which is in contrast with art. 12 (a) of ADR Rules: "The decisions of the panelists will be final, not subject to appeal, and compulsory for the Parties, without detriment to the right of the Parties to initiate a court proceeding in a Mutual Jurisdiction which will have consequences to the implementation of the decision as described in the Terms and Conditions". Anyway, for this Panel it was necessary to examine the above decision being it related to the same domain name here considered. In this respect, it must be noted that Mr. Stig Valentini has not actively participated to the proceedings and this circumstance is crucial. Actually, as stated by the Panel in the decision related to case no. 8726: "The Complainant has further asserted that the Respondent is not known by the VALENTINI name and has no legitimate rights to or interests in the disputed domain name. These assertions are not contradicted by the Respondent. Should the Respondent have rights or legitimate interests to the disputed domain name, the Panel assumes that it would have advised the Panel of the same. As no response was filed, the Panel therefore accepts that the Respondent does not have rights or legitimate interests to the disputed domain name. The Panel here notes that the Respondent's name Stig Valentini appears to partially coincide with the disputed domain name. The disputed domain name may have been chosen for this reason. If this was indeed the reason, given the circumstances of the present case, the Respondent could have easily shown that he has at the very least a competing right to the disputed domain name. In fact, it would have been sufficient for him to participate in this proceeding and document his rights by showing his identity card or passport". It clearly means that, if Mr. Stig Valentini had filed in that proceedings the same evidence here presented, the outcome of the case no. 8726 would have been completely different. Anyway, as per the above Art. 12 (a) of ADR Rules, the decision of the Panel is final and not subject to appeal unequivocally meaning that, if one is not satisfied with the decision, the only possible remedy is to initiate a court proceeding in a jurisdiction according to Art. 12 (a) of ADR Rules. In other words, it must be duly considered that in case no. 8726 Mr. Stig Valentini had an appropriate procedural space to rebut the counterparty assertions, but he failed to do so and, as a consequence, the decision was taken on a legal framework including only the Complainant arguments and evidence. This Panel, as already explained, is prohibited from taking a position regarding the scenario of the case no. 8726 by the ADR Rules and may only take a decision considering the scenario of the present case which is obviously different.

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 the company name "valentini.eu" and the unregistered trademark VALENTINI.EU both identical to the disputed domain name and therefore the Panel finds that the first condition considered by article 21.1 of the Commission Regulation 874/2004 has been established.

On the contrary, the second and third conditions considered by article 21.1 of the Commission Regulation 874/2004 have not been

established. In particular, the Respondent has clearly demonstrated to have rights on the name VALENTINI being it the main identifier of the Respondent company name and registered trademarks. In this perspective the Panel wishes to clarify that AZIENDA AGRICOLA is a totally non-distinctive wording being a mere indicator requested by the Italian law to companies operating exclusively in the agricultural field. Coming to the bad faith it appears more than clear that, in contrast with the Complainant assertions, the Respondent owns the domain name in dispute as the result of a previous decision of the CAC. This unequivocally means that it was not acquired (with the same meaning of registered) in bad faith. Finally, from the legal framework of the present case, it appears obvious to the Panel that Respondent is willing to use the disputed domain name in connection with its business (wine sector) and this avoid any possible likelihood of use in bad faith. In this perspective the Panel wishes also to clarify that the communication sent by the Respondent to Mr. Stig Valentini on December 22, 2021 was a mere request of information regarding the possible sale of the domain name in dispute and, as such, in the Panel's view, it is not an indication of bad faith as per the Complainant assertions.

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	**Guido Maffei**

DATE OF PANEL DECISION 2022-08-08

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <valentini.eu>

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

III. Date of registration of the domain name: 29 August 2006

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

- unregistered trademark
- company name

V. Response submitted: Yes

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

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
Yes
Why: registered trademarks and company name including the term VALENTINI

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. No
2. Why: domain name transferred to the Respondent as effect of a previous CAC decision (case no. 8726). The Respondent will use the domain name in its business activity (wine sector).

IX. Other substantial facts the Panel considers relevant: previous decision no. 8726 related to the domain name in dispute

X. Dispute Result: Complaint denied

XI. Procedural factors the Panel considers relevant: the Panel may not review a previous CAC decision according to art.12 of ADR Rules