Panel Decision for dispute CAC-ADREU-001456

Case number	**CAC-ADREU-001456**
Time of filing	**2006-06-26 15:53:45**
Domain names	**privacy.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Polytecna s.a.s. di Roberto Galbiati, dott. Roberto Galbiati**

Respondent

Organization / Name	**Drake Ventures Limited, David Kenny**

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

N/A

FACTUAL BACKGROUND

On February 9, 2006 the Claimant, Polytecna s.a.s. di Roberto Galbiati, filed a request for registration of the domain name “privacy.eu” claiming its prior right pursuant to Section 16 (3) of the Sunrise Rules. The domain name “privacy.eu” was, however, assigned to another applicant, Drake Ventures Limited, who has proven prior rights according to the Sunrise Rules.

Because the Complainant is of the opinion that the Applicant/the Respondent in this case violated Article 21 of Regulation (EC) No. 874/2004 by registering the domain name in bad faith, he claims that the domain name “privacy.eu” be awarded to Polytecna s.a.s. di Roberto Galbiati.

For that reason the Complainant has filed this complaint against the Respondent.

A. COMPLAINANT

On February 9, 2006 the Claimant, Polytecna s.a.s. di Roberto Galbiati, filed a request for registration of the domain name “privacy.eu” claiming its prior rights pursuant to Section 16 (3) of the Sunrise Rules. However, the domain name “privacy.eu” was assigned to another applicant, Drake Ventures Limited on March 13, 2006. The Complainant argued that the website “www.privacy.it” has been used by the company Polytecna for nine years. The website “www.privacy.it” has always and exclusively been used for the foregoing purposes ever since its registration.

The Complainant did not mention in the application the issue of trademark and did not prove that he has any prior rights. The Complainant only stated that in other words the denomination “www.privacy.it”, in addition to identifying an internet site of enormous fame, notoriety and authoritativeness in the field of expert advices on privacy at both national and European levels, may overall also be considered on a par with a trademark, not registered but constantly used over the last nine years to indicate the activities of the Complainant. Any use by other subject of the identical domain “privacy.eu” would, therefore, be in open contrast with not only the above mentioned European regulations but also Italian law on the right to a business name and on trademarks as well as on unfair competition.

The Complainant also discussed some of the decisions mainly of the Italian courts by which he justified his right to the disputed domain name.

The Complainant stated that Drake Ventures Limited/the Respondent has, with no doubt, registered the domain in question for purely speculative reasons, insofar that during the Sunrise Period such company cornered the market for along series of .eu domains, and

presumably for the sole purpose of reselling them to the interested parties.

The Complainant also stated that in addition to the above, according to the Italian law when a company uses a domain name such as to a engender confusion with names or distinctive signs legitimately used by other companies, it commits an act of unfair competition (which can be legally stopped) and is required compensate caused damage unless it can prove to have acted without fault.

For all the above reasons the Complainant asked that the domain “privacy.eu” be declared illegitimate insofar as it has violated Article 21 of the Regulation (EC) No. 874/2004 of the Commission and the domain “privacy.eu” be awarded to the Complainant. The Complainant also claimed the reimbursement of the charges of these proceedings.

B. RESPONDENT

The Respondent strongly refused the alleged breach of his rights and stated that the Complainant has not supported his arguments and that this complaint should be dismissed. He even stated that the Complainant is guilty of reverse domain name highjacking and that the Panel should find that these proceedings were brought in bad faith.

The Respondent presented different arguments according namely to Article 21 of Regulation (EC) No. 874/2004 using contra arguments based on its evidence and legal statements.

Among others, the Respondent stated that in order to be subject to revocation, the domain must fall under the status that either it has been registered by its holder without rights or legitimate interest or has been registered or is being used in bad faith. As the Respondent is the licensee of the Benelux trademark “PRIVACY” (registration No. 0775797), the Respondent clearly holds a right to the domain and cannot fall under the definition mentioned above; as a trademark licensee he has a good right to apply for a domain name under the Sunrise Rules.

The bad faith is demonstrated when circumstances indicate that the 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 Community law or to a public body. The disputed domain has never been offered for sale, for rent or otherwise. Furthermore, the Respondent had no knowledge of the Complainant prior to receiving notification of this complaint. Indeed, the Complainant has provided no evidence that the Respondent was aware of the existence of the Complainant prior to that date.

The Respondent also commented on the Complainant statements as to the Complainant’s goodwill throughout Europe. This has simply not been proven. The evidence provided by the Complainant to prove its reputation is limited to Italian sources besides one which is relating to Macedonia. Indeed, a search of the internet using the Google search engine and the search terms “Privacy Information” .eu Italy produced 37,600 results. As the domain is not and has never been offered for sale and the Respondent had no knowledge of the Complainant prior to the filing of the complaint, it must be clear that the Respondent did not acquire the domain name for any purpose to selling or renting the domain to the other person and/or the Complainant. Indeed, as stated above, the Respondent was unaware of the existence of the Complainant and therefore could not have had such an intention. The Respondent is also not a competitor of the Complainant.

On top of that, the Complainant’s domain name is a common dictionary word in the English language. Clearly, therefore, as the Respondent has not contravened any provision of Article 21 (3) of the Sunrise Rules, the Respondent cannot be found to have registered domain in bad faith.

To conclude, the Respondent stated that the Complainant is clearly trying to circumvent the well-established “first come – first served” principle which was used by EURid in registering the .eu domain names, including during the Sunrise Period. The Complainant therefore has not proven his claim of speculative and abusive registration under Article 21 of the Regulation (EC) No. 874/2004.

DISCUSSION AND FINDINGS

1. All procedure requirements for .eu dispute resolution (ADR) were met.

2. The main question for the decision is whether there is bad faith on the Respondent side when the Respondent properly applied in the Sunrise Period for the registration of the domain name, the Respondent at the same time having prior rights based on the license given by the third party.

3. The Sunrise Rules and related EU regulations clearly state the requirements and proceedings for the domain name application.

The most important issue in the Sunrise Period always was whether the Applicant has prior rights recognized by the Sunrise Rules.

4. The Sunrise Rules in Section 11 clearly defined what it does mean prior rights. It says that only domain name that correspond to i) registered Community or national trademarks or ii) geographical indications or designations of origin may be applied for by the holder and/or licensee (where applicable) of the prior right concerned.

Section 13 of the Sunrise Rules says that where the prior right claimed by an applicant is a registered trademark, the trademark must be registered by a trademark office in one of the member states, the Benelux Trademarks Office or the Office for Harmonization in the Internal Market (OHIM), or it must be internationally registered and protection must have been obtained in at least one of the member states of the European Union.

In case the Applicant is a licensee or transferee of a registered trademark referred to in Section 13 (1) above, Section 20 of the Sunrise Rules shall apply.

Section 20 of the Sunrise Rules defines what the Applicant – the licensee must do to obtain a protection and finally a domain name.

5. The Panel/the Panelist carefully reviewed all available evidence and data not only from the Complaint and the Response to Complaint but also from public sources.

6. The Panel/the Panelist also reviewed public sources as to the reputation of the Complainant, reputation of the Respondent and public sources as to the used domain names, website and trademarks.

7. The Panel/the Panelist therefore came to the following conclusions:

a) It was proven that the Complainant did not have any Prior Right as recognized by the Sunrise Rules.

b) On the other hand, the Respondent has proven that he had a proper license agreement and had therefore a Prior Right as recognized by the Sunrise Rules. The certificate of registered Benelux trademark and appropriate license declaration for a registered trademark was available to the Panel/the Panelist.

c) It was also proven from the above sources that the trademark was registered already in August 2005 and the license was given to the Applicant on December 1, 2005.

d) It was not proven by the Complainant that there was any speculative application and/or an application made in bad faith.

e) For all the above reasons the Panel/the Panelist came to the decision as defined below.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 of the ADR Rules, the Panel/the Panelist orders that the Complaint is denied.

PANELISTS

Name	**Vit Horacek**

DATE OF PANEL DECISION 2006-09-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Claimant, Polytecna s.a.s. di Roberto Galbiati, filed a request for registration of the domain name “privacy.eu” claiming its prior rights pursuant to Section 16 (3) of the Sunrise Rules. The domain name “privacy.eu” was, however, assigned to another applicant, Drake Ventures Limited who has proven prior rights according to the Sunrise Rules.

The Complainant argued that even it has no prior rights his word “privacy” is used and commonly known not only in Italy but also throughout Europe. The major argument of the Complainant was that the Respondent, Drake Ventures Limited, registered the domain name in bad faith and with speculative interest.

It was proven from the Complaint and the Response and also from public sources that the Complainant had no prior rights when applying for the domain name. On the other hand, it was proven that the Respondent had all prior rights according to the trademark registration in the European Union and based on the license given to the Respondent according to the Sunrise Rules.

Because no bad faith and speculative reasons of registration have been proven, the Panel/the Panelist decided to deny the complaint.