Panel Decision for dispute CAC-ADREU-003467

Case number	**CAC-ADREU-003467**
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Domain names	**wsbk.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**FGSPORT S.r.l., Gianluca Pastori**

Respondent

Organization / Name	**EURid**

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

None

FACTUAL BACKGROUND

On 13 March 2006, the Complainant, FGSPORT S.r.l., represented by a legal practitioner, Mr. Massimo Cimoli, of De Simone & Partners S.p.A., submitted the Application for registration of the .eu domain name “wsbk” (hereinafter the “Application”).

The Complainant based its prior right on an unregistered trademark protected by Italian law for the name WSBK and provided the validation agent and EURid (hereinafter the “Respondent”) with the following documentary evidence:

- an affidavit undersigned by Mr. Massimo Cimoli, which states that unregistered trademarks are protected in Italy pursuant to Article 12 letter c) of the Italian Industrial Property Code and Article 2571 of the Italian Civil Code; condition for such protection being the non local use of a trademark;
- two documents showing that Mr. Massimo Cimoli is a legal practitioner;
- a copy of the provisions of Italian law referred to in the affidavit; and
- “Coverage Summary By Broadcaster”, “Coverage Summary By Round”, “Broadcast Summary” tables showing the logo of the Complainant in the bottom left corner.

By its decision, dated 15 September 2006 (hereinafter the “Decision”), the Respondent rejected the Application because the documentary evidence as provided by the Complainant was considered insufficient to establish the Prior Right of the Complainant to the Domain Name within the meaning of Article 10 (1) of EC Regulation No. 874/2004 (hereinafter the “Public Policy Rules”).

In its Complaint, filed on 13 November 2006, with the Czech Arbitration Court, the Complainant opposed the Decision issued by EURid, requesting the Decision to be annulled and the “wsbk.eu” domain name to be attributed to the Complainant.

A. COMPLAINANT

The Complainant contends that it is the holder of Italian unregistered trademark WSBK protected by Italian law:

- WSBK is an unregistered trademark referred to in TV programs, in particular SBK Superbike World Championship, which are made and organized by the Complainant. The Complainant is the owner of the Superbike World Championship as well as the copyright owner of the TV programs marketed under the trademark WSKB.

- The fact that the WSBK TV programs were watched by a large audience (with more than 6 million viewers per year) and that the use of

WSBK was in essence both national and “trans-national”, establishes sufficient ground for the WSBK name to become an unregistered trademark protected by Italian law.

- The WSBK TV programs and broadcasts are business products and activities.

B. RESPONDENT

The Respondent contends that the Complainant did not clearly and certainly demonstrate that it is the holder of the respective prior right for the following reasons:

a) The affidavit must state that the claimed prior right meets the requirements under local law

- The affidavit submitted to the validation agent used only general wording stating that unregistered trademarks are, in general, protected in Italy pursuant to Article 12 letter c) of the Italian Intellectual Property Code and Article 2571 of the Italian Civil Code; the condition for such protection being non local use of a trademark. The legal practitioner representing the Complainant did not indicate his assessment of the supporting documents and failed to demonstrate that the claimed name WSBK meets the conditions under Italian law to be declared an unregistered trademark. As a matter of fact, the affidavit does not contain either the name WSBK, or the name of the Complainant, being the holder of the unregistered trademark.

Such “generic” affidavits are not sufficient to clearly establish the protection of the claimed prior right.

- Based on the documentary evidence received, the validation agent was not able to certify that the affidavit relates to the submitted documentary evidence and that the conditions required by local law for protection were correctly fulfilled for the name WSBK.

b) The Complainant did not demonstrate that it was the holder of the claimed prior right

The Complainant’s name is not mentioned in the affidavit. Tables provided in the documentary evidence show the logo of the Complainant in the bottom left corner but also show the logo of TNSsport and numerous other names.

Based on the review of the documentary evidence received, the validation agent could not confirm that the Complainant is the holder of the claimed prior right and the validation agent is not permitted to take into consideration information which is not part of the documentary evidence submitted with the Application.

DISCUSSION AND FINDINGS

The Complainant based its Complaint on the fact that it is the holder of Italian unregistered trademark WSBK protected by Italian law.

Therefore, in accordance with Article 14 of the Public Policy Rules, the Complainant should have attached all necessary documentary evidence to its original Application proving that the Complainant is the holder of the prior right claimed on the domain name in question.

The Panel finds it important to investigate the following crucial points:

a) Proof of the existence of the claimed prior right

Article 10 of the Public Policy Rules recognizes unregistered trademarks, as far as they are protected under national law in the member states, as a prior right. In this case, pursuant to Section 15 (ii) and consequently Section 12 paragraph 3 (i) of the Sunrise Rules, the Complainant was requested to provide an affidavit signed by a legal practitioner, accompanied by documentation supporting the affidavit declaring that the name for which a prior right is claimed meets the conditions provided for in Italian law, in relation to the type of prior right concerned.

The Complainant submitted an affidavit stating that the unregistered trademarks are, in general, protected in Italy pursuant to Article 12 letter c) of the Italian Intellectual Property Code and Article 2571 of the Italian Civil Code; the condition for such protection being non local use of a trademark. However, the legal practitioner failed to specifically indicate whether the WSBK name meets these conditions as defined under Italian law.

The respective affidavit should have included a comprehensive statement provided by the legal practitioner confirming that the claimed name WSBK meets the conditions requested by Italian law to be recognized as an unregistered trademark protected by this law.

The Panel will not examine whether additional information submitted together with the Complaint would have been sufficient or not, as this speculation is irrelevant. Only the documentary evidence received within the deadline for the Application for registration of the domain name can be taken into consideration and the validation agent cannot and is not allowed to reflect any additional information provided later, i.e. after the Sunrise Period application deadline.

b) Proof that the Complainant is the holder of the claimed prior right

To support its Application and to prove that the Complainant is the holder of the WSBK unregistered trademark, the Complainant submitted tables of coverage and broadcast summaries related to the WSBK program and SBK Superbike World Championship. The only indication of any relationship between WSBK and the Complainant, FGSPORT S.r.l., is the Complainant's logo below the table which, nevertheless, is also accompanied by TNSsport's logo. There is no explanation and evidence clearly showing what the exact relationship is between the Complainant and the claimed name WSBK.

With regard to the foregoing, and based on the documentary evidence received, the validation agent could not have reached any other decision than that the Complainant failed to sufficiently prove that it is the holder of the claimed unregistered trademark.

In its Complaint, the Complainant explains that it is the producer and organizer of the SBK Superbike World Championships and the copyright owner of the TV programs marketed under the trademark WSBK. Such statement and the exact relationship between the Complainant and WSBK's name should have been supported by relevant and clear evidence and submitted with the original Application to the validation agent.

The Panel must stress that the validation agent examines whether the Complainant has a prior right to the name exclusively on the basis of a prima facie review of all documentary evidence received within the respective deadline from the Applicant. As such, the Complainant failed to provide, together with its Application for registration of the domain name, any clear proof that it is the holder of the unregistered trademark WSBK.

c) Conclusion

Given the foregoing, the Panel holds that the Complainant failed to provide the validation agent with sufficient documentary evidence showing that the Complainant is the holder of the prior right, in this particular case, of an unregistered trademark protected by Italian law. For all the reasons presented in the Discussion and Findings section, the Panel hereby denies the Complaint.

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	**Jiri Cermak**

DATE OF PANEL DECISION 2007-02-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, represented by a legal practitioner, submitted the Application for registration of the .eu domain name "wsbk" and based its prior right on an unregistered trademark protected by Italian law for the name WSBK. The Respondent rejected the Application due to insufficient documentary evidence declaring the prior right of the Complainant to the respective domain name.

The Complainant submitted an affidavit with the Application stating that unregistered trademarks are, in general, protected in Italy pursuant to Article 12 letter c) of the Italian Intellectual Property Code and Article 2571 of the Italian Civil Code; the condition for such protection being non local use of a trademark. However, the legal practitioner failed to indicate whether the respective WSBK name meets these conditions as defined under Italian law. Such "generic" affidavits are not sufficient to clearly establish the protection of a claimed prior right.

The Complainant also provided materials related to the WSBK program. Nevertheless, the only sign of any relationship between WSBK and the Complainant is the Complainant's logo, which appears on the sheet together with a logo of another company. There is no explanation and evidence clearly showing what the exact relationship is between the Complainant and the claimed name WSBK. In its Complaint, the Complainant tried to explain the relationship, however, such statement and the exact relationship between the

Complainant and the WSBK name should have been supported by relevant and clear evidence and submitted with the original Application to the validation agent.

Given the foregoing, the Panel held that the Complainant failed to provide the validation agent with sufficient documentary evidence showing that the Complainant is the holder of the prior right, in this particular case, of an unregistered trademark protected by Italian law, and therefore denied the Complaint.