Panel Decision for dispute CAC-ADREU-003641

Case number	CAC-ADREU-003641
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Domain names	esade.eu

Case administrator

Name	Tomáš Paulík

Complainant

Organization / Name	Fundació Esade

Respondent

Organization / Name	Zheng Qingying

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

No other legal proceedings concerning the disputed domain name are currently pending.

FACTUAL BACKGROUND

- The domain name esade.eu was registered by the Respondent on 25 July 2006, the first day on which that domain name became free for any interested party to register following the applications which the complainant had unsuccessfully submitted during the sunrise period.

- Barring error, the domain name at issue, esade.eu, does not currently correspond to any active website.

- A first complaint filed by the Complainant on 13 December 2006 met with a notification of deficiencies. The Complainant then filed, on 27 December 2006, a fresh amended complaint which was found to be admissible. In it the Complainant, Fundació Esade, invoked its rights in the name ESADE in its capacity as the owner of various trademarks and as a Spanish academic organization with international prestige. It maintained that the Respondent had no rights or legitimate interest in the domain name at issue and had acted in bad faith in registering it, being fully aware of the Complainant's previous attempts to register it.

- The Respondent submitted a reply on 19 January 2007 in which he rejected the Complainant's claims, arguing that the rights of the latter had not been suitably evidenced. He maintained that he had a legitimate interest in the domain name at issue, contended that it had been legitimately registered under Article 3 of Regulation (f) no. 874/2004 and denied any bad faith in the registration or use thereof.

A. COMPLAINANT

- The Complainant, Fundació Esade, is an educational organization of acknowledged prestige. Fundació Esade (ESADE being the acronym of Escola Superior d'Administració i Direcció d'Empreses) was founded in Barcelona (Spain) in 1958 with the idea of establishing an educational complex on the subjects of business management and administration. From 1964 Esade expanded and created the Esade's MBA and Language School. In 1993 the Law School was created. Esade's expansion ended in 1998 with the creation of the Sant Ignasi School of Tourism.

- Since its foundation Esade has attained great prestige in the financial sector and is well known worldwide for the quality of the educational services it provides It is regarded as a frame of reference in research and as a forum for debate, reflection and opinion. It has campuses in Barcelona, Madrid and Buenos Aires (Argentina).

- Fundació Esade is the owner of many Spanish and European trademarks comprising the word ESADE. The following are mentioned by way of example:

1. Spanish Trademark number M 0413640 ESADE (fig.) in Class 41.

2. Spanish Trademark number M 0413539 ESADE (fig.) in Class 41.

3. Spanish Trademark number M 0413604 ESADE (fig.) in Class 41.

4. Spanish Trademark number M 1632368 ESADE (fig.) in Class 42.

5. CTM Registration number 002822716 ESADE, Escuela Superior de Administración y Dirección de Empresas (fig.) in Classes 16, 41 and 42.

- The Complainant also states that it is the holder of the domain names esade.com, esade.net, esade.edu, esade.org, esade.info, esade.biz, esade.es and esade.cat.

- The domain name esade.eu is identical to the trademarks in which the Complainant has rights.

- The registrant has no rights or legitimate interest in respect of the domain esade.eu, in the absence of any of the circumstances provided for in the ADR Rules which would allow the respondent to prove such a right or legitimate interest. Further, Respondent has not used the domain name, nor demonstrated preparations for building any website.

- The domain name has been registered and is being used in bad faith. At the time of registration the Respondent was fully aware of the existence of the Complainant and knew of the applications that Fundació Esade had filed for the domain name esade.eu during the sunrise period. The Respondent has, indeed, similarly been called to account in other proceedings for having registered other domain names in the same circumstances as the disputed domain name (that is, domain names rejected in the Sunrise Period) in order to sell them to the legitimate owners of the trademarks for high prices.

- There is also bad faith on the part of the Respondent in the use of the domain name at issue, given that the Complainant had sent the Respondent a warning letter in order to have the domain voluntarily restored by claiming its prior rights therein. In reply the Respondent said that he was planning to develop his site on the domain but also offered to sell it for € 1,500. After that the Complainant investigated the Respondent and ascertained that the latter had acquired a large number of domain names corresponding to trademarks of third parties and was consequently involved in various dispute resolution proceedings.

- Lastly, the Complainant notes that there were no changes or demonstrable facts denoting preparatory work on a website prior to the presentation of the complaint and thus maintains that the Respondent is engaging in what the OMPI has termed passive holding, thereby preventing Fundació Esade, the rightful owner of the trademark, from using a domain name in which it has a legitimate interest.

For all these reasons the Complainant requests that the disputed domain name be transferred to it.

B. RESPONDENT

- The Respondent submits that the Complainant has not proved its rights in the name ESADE and that neither “Fundació Esade” nor “ESADE” are names recognized or established by national and/or Community law.

- The Respondent disputes the trademark rights invoked by the Complainant on the ground that the copies of the marks have not been submitted in the language of the ADR proceeding (English) and therefore may not be taken into account according to Paragraph A(3)(c) of the ADR Rules and to Paragraph B(1)(d) of the ADR Supplemental Rules.

- The CTM invoked by the Complainant is a figurative trademark which contains the expression “ESADE Escuela Superior de Administración y Dirección de Empresas”.

- The Complainant claims that the domain name esade.eu is identical to its trademarks. However, it is obvious that the domain name esade and the Complainant’s CTM “ESADE Escuela Superior de Administración y Dirección de Empresas” are not identical.

- The Respondent submits that he does have legitimate rights and interests in the name esade.eu, pointing out in this regard that ESADE is the combination of “e” and “sade”. For the public, “e” is a common abbreviation of “electronic”, while “sade” is a common dictionary word, especially as a female name. So the word esade belongs to the public, anyone can use it and the Respondent has a right to the word esade.

- The mere act of registering a free domain name –if only minutes after it was released by the Register- does not constitute an action in bad faith. This is because anyone resident in the European Union may request registration of a free domain name at any time through accredited registrars after the phased registration (see Article 3 of Regulation (EC) No. 874/2004). Furthermore, no circumstances have been presented, or are self-evident, which indicate that the Respondent registered the domain name with the intention of preventing the holder name from using the domain name.

- The registration of the Respondent is intended solely for the Respondent's project and there is no intention to enter into conflict with the right of any third party.

- The fact that the Respondent may have registered other domain names is irrelevant because there is no proof that the Complainant might have rights relating to them.

For all these reasons the Respondent requests that the Complainant's claims be dismissed.

DISCUSSION AND FINDINGS

Pursuant to article 11, paragraph (d)(1), of the .eu Alternative Dispute Resolution Rules, the Panel shall grant the remedies requested if the Complainant proves "in ADR Proceedings where the Respondent is the holder of a .eu domain name registration 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 the national law of a Member State 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."

1. Domain name identical or confusingly similar to a name in respect of which a right is recognized.-

The Complainant, Fundació Esade, has submitted various press articles and other documentation showing that it is well known and has an established presence under the name ESADE in the circle of the most prestigious Spanish and European educational institutions.

As to the trademark registrations invoked by the Complainant, it is true that, as the Respondent point out, the documentation corresponding to the Spanish trademark registrations has not been translated into English, the language of the proceedings. However, it is no less true that the Complainant has submitted documentation in English evidencing its rights in Community trademark No. 002822716 ESADE, Escuela Superior de Administración y Dirección de Empresas (fig.). The fundamental distinctive element of that mark is precisely ESADE, which has much greater relevance and is displayed in much larger letters than the expression "Escuela Superior de Administración y Dirección de Empresas". It is to be noted, furthermore, that this Community trademark claims the seniority of Spanish trademark No. 1632368, which the Complainant also invokes.

The Panel therefore considers that the Complainant has adequately evidenced its registered rights in the term ESADE and the rights it has acquired through extensive use of that name. The first of the requirements for the Complaint to be accepted is therefore met.

2. Absence of Rights or Legitimate Interest

The Complainant submits that none of the circumstances which could, under Paragraph 11(e) of the ADR Rules, show that the Respondent might have rights or a legitimate interest in the disputed domain name is present in this case, given that to date the Respondent has neither made use of the domain name nor shown that preparations for the construction of a website might have been commenced.

The Respondent claims that he indeed has a legitimate interest in the name ESADE and states in this regard that the name is formed from a combination of "e" (for electronic) and "sade".

The Panel finds the argument put forward by the Respondent in that regard contrived. It appears to be nothing more than the result of an attempt to find some minimally plausible explanation to support the use of the name. The Respondent has not, however, provided any further explanation or anything that might indicate that he indeed intends to develop some website on the basis of the concept "electronic sade" or the like. Nor has he submitted any other argument or item of evidence that could point to the existence of even a

semblance of a right or legitimate interest in the disputed domain name.

The Panel therefore concludes that the Respondent has not shown any rights or legitimate interest in the domain name at issue and the second of the requirements for the Complaint to be accepted is therefore in turn met.

3. Bad Faith

The Respondent states that the act of registering a domain name only minutes after it was released does not constitute bad faith, in that it is expressly authorized under Article 3 of Regulation (EC) No. 874/2004). While the Panel does not dispute this assertion, it should be valued in conjunction with the rest of the circumstances surrounding the case.

The Panel has ascertained that, as the Complainant claimed, the Respondent has indeed been involved, in that same role, in other ADR proceedings relating to (alleged) cybersquatting. In various cases those proceedings ended with a decision upholding the complaint and observing bad faith on the part of the Respondent. Thus, in Case No. 03773 MONOT the Panel held that:

For reasons of procedural economy, as the Complaint is already well-founded, this Panel does not need to assess a possible bad faith of the Respondent in the registration or use of the contested domain name.

Nonetheless, the Panel will merely mention that the Respondent has manifestly engaged in a pattern of registering domain names consisting of third parties' trademarks. In this respect, the Panel refers to the following ADR decisions issued against the Respondent: Decision No. 3588 concerning the domain names XIRONA and LEVOTHYROX, which were transferred to Merk KGaA, the mother company of Merk Santé; Decision No. 3510 concerning the domain name BIGDUTCHMAN; Decision No. 2986 concerning the domain name TERXON; and Decision No. 3444 concerning the domain name OCUNET.

This conduct amounts to bad faith and is mentioned as such in the non exhaustive list contained in Article 21.3 of the Regulation.

Similarly, in Case No. 03885 WORLDSBK it was held that:

In addition, it must be noted that the registration of a domain name would be abusive if the Respondent only registered the domain name to prevent the holder of such a name from registering the domain for himself provided that a pattern of such conduct can be demonstrated, Art. 21(3)(b)(i) Regulation (EC) No. 874/2004.

In this respect, the Complainant pointed out that the Respondent already registered domain names which refer to existing trademarks and names without using them for his own business. This behaviour has not been disputed by the Respondent.

The Panel, after a prima facie examination of previous decisions rendered in ADR disputes, verified that the registration of domain names in the name of Respondent referring to existing trademarks occurred in at least seven cases (XIRONA, LEVOTHYROX, MONOT, OCUNET, GLENDIMPLEX, BIGDUTCHMAN and TERXON) as already ascertained during the ADR proceedings. In the Panel's view this circumstance is sufficient to establish a pattern of conduct according to Art. 21(3)(b)(i) Regulation (EC) No. 874/2004.

From the foregoing it may be gathered that the Respondent has engaged in a pattern of conduct which may without doubt be regarded as amounting to bad faith and is, indeed, specifically included among the circumstances denoting bad faith listed in Paragraph 11(f)(2)(i) of the ADR Rules.

Furthermore, the Complainant has shown that in the course of an exchange of emails between the parties the Respondent asked the price of € 1,500 for the transfer of the disputed domain name. That would appear a high price for a domain name which was not in use.

Through a global assessment of all the circumstances – namely, 1. that the domain name at issue was registered immediately upon its release and following an unsuccessful application on the part of the Complainant during the sunrise period; 2. that the Respondent has engaged in the same pattern of conduct in other cases in which the Court has already upheld the complaints against him and found him to have acted in bad faith; 3. that he has tried to sell a domain name not in use for a high price – the Panel arrives at the conclusion that the alternative condition of bad faith required for the acceptance of the complaint is likewise met.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name ESADE be transferred to the Complainant

PANELISTS

Name	Luis de Larramendi

DATE OF PANEL DECISION 2007-02-13

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant in the proceedings is the educational institution Fundació Esade. The Complainant has won international recognition in its field under the name ESADE, as it has shown by means of various articles and publications. It is also the owner of various Spanish trademarks and a Community trademark whose principal distinctive element is ESADE.

Notwithstanding the Respondent's claim that the documentation pertaining to the Spanish trademarks has not been translated into the language of the proceedings, the Panel considers that the Complainant has adequately proved that it is in the public eye under the name ESADE and also notes that it has submitted documentation in the language of the proceedings relating to its Community trademark.

The Panel further considers that the Respondent has not provided any plausible account of possible rights or legitimate interests in the domain name at issue and also deems it proved that the Respondent acted in bad faith, given that he was previously in turn the Respondent in other ADR proceedings addressing similar circumstances which concluded with decisions upholding the complaints. Consequently, although to register a domain name just after it has been released, when applications to register it during the sunrise period were dismissed, is not an act of bad faith in itself, bad faith may indeed be perceived when the Respondent makes a pattern of conduct out of that practice and thus seeks to obtain financial benefit from the rightful owners of the names affected.

As a result, the Panel rules that the domain name esade.eu must be transferred to the Complainant.