# Panel Decision for dispute CAC-ADREU-003885

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| Case number | CAC-ADREU-003885 |
| Time of filing | 2006-12-18 14:01:39 |
| Domain names | worldsbk.eu |

## Case administrator

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| Name | Josef Herian |

## Complainant

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

## Respondent

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| 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

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name. The Panel is aware of already decided ADR proceedings related to the Respondent and that will be mentioned in the decision.

FACTUAL BACKGROUND

The Complainant, FGSPORT S.r.l., is the holder of the following Community trademarks:
1- WORLDSBK (No. 004616157) applied for on September 27, 2005 (in classes 4, 9, 14, 16, 18, 25, 28, 32, 33, 35, 36, 37, 38, 39, 40, 41, 42 and 43) and registered on November 10, 2006;
2- WSBK (No. 004616413) applied for on September 27, 2005 (in classes 4, 9, 14, 16, 18, 25, 28, 32, 33, 35, 36, 37, 38, 39, 40, 41, 42 and 43) and registered on November 10, 2006.
The Complainant also owns the following Community trademark applications:
3 – SBK (No. 004615936) applied for on September 27, 2005 (in classes 4, 9, 14, 16, 18, 25, 28, 32, 33, 35, 36, 37, 38, 39, 40, 41, 42 and 43);
4- SBKTV (No. 004794418) applied for on December 20, 2005 (in classes 9, 35 and 41)
The Respondent, Zheng Qingying, applied for the disputed domain name <worldsbk.eu> on October 3, 2006.
On December 14, 2006 the Complainant filed the Complaint with the Czech Court of Arbitration (CAC); in the same day the Complainant send a nonstandard communication including further evidence related to the case. On December 21, 2006 the Respondent was notified by CAC that the Complaint was filed, that the time of commencement of ADR Proceeding was December 21, 2006 and that a Response would have to be filed within 30 working days. On December 22, 2006 the Respondent timely filed the Response.

A. COMPLAINANT

The Complainant contends, that the domain name <worldsbk.eu> is virtually identical to the trademarks SBK owned by the Complainant and identical to the CTM registration for WORLDSBK also owned by the Complainant. Furthermore, the Complainant stresses that its SBK trademark is quite renowned to distinguish services and products related to the Superbikes motorcycles and racing. In addition, Complainant argues that the Respondent has registered the domain name <worldsbk.eu> without rights or legitimate interest in the name WORLDSBK and in bad faith. Actually, The Complainant points out that the the domain name <worldsbk.eu> is not active and that Respondent is already known because there are other domain names registered in the name of Zheng Qingying identical to trademarks belonging to third parties. In consideration of the above, the Complainant requests that the Panel orders the disputed domain name to be transferred to the Complainant.

B. RESPONDENT

The Respondent argues that at the time in which the domain name was registered (October 3, 2006), the Complainant's CTM WORLDSBK was not registered since registration occurred only on November 10, 2006. In addition, the Respondent points out that if

October 3, 2006 is considered, it must be outlined that none of the trademarks mentioned in the Complaint as well as in the subsequent nonstandard communication sent by Complainant were registered. In addition, the Respondent stresses that no unregistered trademarks possibly owned by Complainant may be considered in the present case since, in the Respondent's view, unregistered trademarks do not benefit of any protection in Italy. In consideration of the above, Respondent concludes that the Complainant has not demonstrated a valid prior right with respect to the contested domain name and, therefore, the Complaint must be refused.

DISCUSSION AND FINDINGS

In order to decide the present case, the Panel wishes to emphasise the following circumstances.
Since the contested domain name is <worldsbk.eu>, it is the Panel's opinion that the only name, between those mentioned by the Complainant, that may be considered as identical or confusingly similar to the disputed domain name is WORLDSBK.
Actually, the disputed domain name <worldsbk.eu> wholly incorporates the Complainant's trademark WORLDSBK. It is well-established that the specific top level of a domain name <.eu> does not affect the domain name for the purpose of determining whether it is identical or confusingly similar pursuant to Article 21 (1) of the Regulation (EC) No. 874/2004 (See CAC Case. No. 00227 - kunst.eu; CAC Case No. 00387 - gnc.eu; CAC Case No. 00596 - restaurants.eu; CAC Case No. 01584 – ksb.eu; CAC Case No. 02438 – ask.eu; CAC Case No. 00283 – lastminute.eu).
The other names mentioned by the Complainant (SBK, SBKTV, WSBK) are quite different from WORLDSBK and therefore the Panel believes that they are irrelevant in the present case.
In addition, although the Complainant filed one page with information related to the use of the names WORLDSBK and SBK, the Panel believes that it does not correspond to an evidence of the ownership on unregistered trademarks. This, in consideration of the fact that the Complainant did not specify the legal system under which the protection of unregistered trademarks is invoked. In case the issue of the legal system should be resolved in favour of the Italian law, as suggested by Respondent, the Complainant's rights on the unregistered trademark WORLDSBK will be considered as not established since the evidence submitted by the Complainant is clearly insufficient (under the Italian system in order to obtain the protection the owner of an unregistered trademark must prove that the sign is diffused in all the territory and that it is quite known). On the other hand, for the above reasons, the Panel dissents with the Respondent's assertion that unregistered trademark are not protected under Italian law.
In addition, the Panel disagrees with the Respondent with respect to the finding that prior rights in ADR have the same definition as prior right in the Sunrise Period. During the Sunrise Period only owners of well specified rights listed in Article 10 (1) of the Regulation (EC) No. 874/2004 have the right to apply for a domain name while in the ADR proceedings regulated by Article 21 and Article 22 (1) (a) of the Regulation (EC) No. 874/2004 a domain name shall be subject to revocation if it 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).
Since the Panel finds that there are not unregistered trademark to be considered in the present case and that the CTM application no. 4615936 and no. 4794418 as well as the CTM no. 4616413 must not be considered in the present case due to the differences with the contested domain name, the only Complainant's trademark that must be considered as identical or confusingly similar to the disputed domain is the CTM n. 4616157 WORLDSBK.
According to Article 21 (1) of Regulation (EC) No. 874/2004 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.

It is undisputed that the Complainant CTM for WORLDSBK is identical to the domain name <worldsbk.eu>. However, the Respondent contests that at the time of the registration of the disputed domain name, the CTM n. 4616157 WORLDSBK was not yet registered (the Panel has verified that the registration of said CTM occurred only after the registration of the disputed domain name).
In this respect, the Panel wishes to clarify that when a CTM application is concerned, the ADR Rules, in particular paragraph B.1 (b) (10) (A), do not require that the Complainant's Community Trademark should be registered but that the rights conferred by said sign are recognized or established by the Community law. The law on Community trade marks is contained in Council Regulation No, (EC) 40/94. In particular, Article 9.3 of this Regulation states that "The rights conferred by a Community trade mark shall prevail against third parties from the date of publication of registration of the trade mark." In addition the same article states that "Reasonable compensation may, however be claimed in respect of matters arising after the date of publication of a Community Trademark Application, which matters would, after publication of the registration of the trademark, be prohibited by virtue of the publication". In the Panel's view, said rule means that one may enforce a CTM (at the condition that the publication of the registration yet occurred) also to obtain the compensation for the violation of the rights deriving from third parties actions occurred after the publication of the Community Trademark Application. Actually it seems that the Council Regulation No, (EC) 40/94 includes other rules which clearly recognize rights connected to the CTM application (see in particular article 8.2.b regarding the right to file an opposition based on a CTM application and article 99.1 regarding the right to apply for provisional measures in respect of a Community Trademark Application).

In the case at hand, while the domain name <worldsbk.eu> was registered on October 3, 2006 (after the publication of the CTM application for WORLDSBK of May 1, 2006), the publication of the CTM registration for WORLDSBK occurred on November 20, 2006 and, therefore, before the Complaint was filed (December 14, 2006). According to the above, the Complainant has full rights with respect to the above CTM, and, in the opinion of the Panel, since said CTM is clearly identical to the disputed domain name, it is a sufficient basis for a claim under article 21 (1) of the Commission Regulation 874/2004 as well as paragraph B.1(b)(10)A of the ADR Rules.
Therefore, since the Panel found that the CTM of the Complainant is identical to the disputed domain name, The domain name <worldsbk.eu> shall be revoked by the panel if the registration is speculative or abusive as defined in Art. 21 Regulation (EC) No. 874/2004.
The registration would be speculative if the Respondent had registered the domain name without any legitimate interest as defined in Art. 21 (2) Regulation (EC) No. 874/2004.
In this respect, while the Complainant pointed out that Respondent does not use the disputed domain name for any legitimate commercial or non-commercial purposes, the Respondent did not present any evidence to prove that he is offering goods or services in connection with said domain name or that he is in preparation to do so, nor that he has been commonly known with the name WORLDSBK or that he is making any legitimate and non-commercial fair use of the disputed domain name. Therefore the Panel cannot establish any legitimate interest of the Respondent in registering the domain name <worldsbk.eu> .
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 behavior 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.
Finally, the Panel verified that the Complainant, being an Italian company, also satisfied the criteria for eligibility for a .eu TLD set out in Article 4 (2) (b) of Regulation (EC) No. 733/2002.
Accordingly, the Panel ordered the transfer of the Domain Name <worldsbk.eu> 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 WORLDSBK be transferred to the Complainant

## PANELISTS

| Name | **Guido Maffei** |
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DATE OF PANEL DECISION 2007-02-09

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant commenced a proceedings against the Respondent alleging that the Respondent's registration of the domain name <worldsbk.eu> was speculative or abusive according to Art. 21 of Commission Regulation (EC) No. 874/2004. The Complainant stressed that he has all the rights originated from a CTM consisting of the word WORLDSBK. In addition Complainant pointed out that Respondent does not use the domain name for any legitimate commercial or non-commercial purposes and that Respondent already registered domain names which refer to existing trademarks owned by third parties. Respondent only contested that the Complainant's Community Trademark may not be invoked in the present case since it was registered only after the registration of the contested domain name in favor of the Respondent. In the Panel's view the circumstance of the publication of the registration is only a condition for enforcing a trademark; once said condition is satisfied, remedies may be asked also for third parties actions occurred after the publication of the application. The Respondent has not demonstrated any legitimate interest in registering the domain name. In addition, it is undisputed that the Respondent already registered domain names which refer to existing trademarks owned by third parties without using them for his own business. The Panel, after having also verified that the Complainant is an Italian company and, therefore, satisfies the criteria for eligibility for a .eu TLD set out in Article 4 (2) (b) of Regulation (EC) No. 733/2002, ordered that the domain name <worldsbk.eu> be transferred to the Complainant.