Panel Decision for dispute CAC-ADREU-004261

Case number	CAC-ADREU-004261
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Domain names	motorshowbolognafiere.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Fiere Internazionali di Bologna SPA - in short BolognaFiere SPA, Dr. Alessandro Savoia

Respondent

Organization / Name	Lexicon Media Ltd, Lexicon Media Ltd

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

FACTUAL BACKGROUND

1.
The Complainant is a company with seat of business in Italy and is doing business under the name “Fiere Internazionale di Bologna SPA – in short BolognaFiere SPA”. The Complainant is the owner of the registered Community Trademark “motor show BolognaFiere” no. 000368126 (“the CTM”). The CTM is a word/device mark consisting of the portion “motor show” in stylized letters, the portion “BolognaFiere” in differently stylized letters and a “V”-shaped device that is displayed behind the portion “motor show”. The CTM is registered in Classes 35, 41 and 42 for services which mainly relate to activities in connection with exhibitions and trade fairs. The CTM was registered on December 17, 1999.

2.
The Complainant owns several more trademarks with the portions “BolognaFiere” and “Motor Show” but does not base its claim on these trademarks. The Complainant submits database printouts of these trademarks only for the purpose to show the bad faith and lack of legitimate interest of the Respondent.

The Complainant also asserts that it owns the following domain names: “motorshow.info”; “motorshowbolognafiere.info”; “motorshowbolognafiere.biz”; “motorshow.net.cn”; “motorshow.org.cn”; “motorshow.sg”; “motorshow.in”; “motorshow.es”; “motorshow.eu”; “motorshowbolognafiere.com”; “motorshowbolognafiere.net” and “motorshowbolognafiere.org”.

3.
The Complainant is a provider for its exhibitions and trade fairs, doing business mainly in the Italian city of Bologna but also in other cities of northern Italy and offers – via a subsidiary – international exhibition services.

The Complainant submits its “2005 Trade Fairs Calendar” in order to provide proof for its activities. The “Motor Show BolognaFiere” word/device CTM, on which the claim is based, is, however, neither displayed in written submissions of the Complainant nor on the websites “www.bolognafiere.it” and “www.motorshow.it” to which the Complainant refers in its Complaint.

4.
On April 7, 2006 the Respondent registered the domain name “motorshowbolognafiere.eu” (in the following only: “the Domain”). The Complaint was filed on September 21, 2007. On October 12, 2007 the Notification of Commencement of ADR Proceeding was sent to the Respondent. With Non-standard Communication, the Respondent was reminded that the term for submitting a Response expires on

December 11, 2007. On December 12, 2007 a Notification of Respondent's Default was issued.

A. COMPLAINANT

5.
The Complainant asserts that it fulfills all requirements for a transfer of the Domain. Firstly, the Complaint is explicitly based on the Domain ("the principal trademark on which the Complaint is based is "Motor Show BolognaFiere""). Other trademarks are not submitted to base the claim on but only to show the reputation of the Complainant ("copies of several registration certificates for the trademarks, enclosed as examples, are provided in Annex 4."). Furthermore, the Complainant does not base its claim on non-registered trademark rights or business names.

6.
The Complainant asserts that it has rights to the word portions of which are identical to the Domain. It the opinion of the Complainant, this is sufficient to prove a case since the assumption of confusing similarity between the trademark and the main name were not refuted by the fact that the CTM of the Complainant contains an additional figurative element which cannot be produced in a domain name. The Complainant insofar refers to ADR.eu cases No. 02438-ask.eu and No. 03048-boscohotels.eu.

The Complainant also makes assertions with regard to the lack of rights and legitimate interest of the Respondent in the Domain as well as with regard to a registration of the Domain in bad faith.

B. RESPONDENT

7.
The Respondent did not submit a Response.

DISCUSSION AND FINDINGS

8.
The first issue that has to be dealt with is the Default of the Respondent. Art. 22(10) of the Commission Regulation (EC) No. 874/2004 of April 28, 2004 laying down public policy rules concerning the implementation and functions of the .eu Top-Level Domain and the principles governing registration (in the following only: "Regulation 874/2004") stipulates that the failure of any parties involved in an ADR procedure to respond within the given deadlines or appear to a panel hearing may be considered as grounds to accept the claims of the counterparty, leaving the decision to the discretion of the panel. Following the accepted practice in international arbitration not to "rubber stamp" the claims forwarded by the Complainant in case of the Default of the Respondent (cf. eg. Redfern/Hunter, Law and Practice of International Commercial Arbitration, 4th ed., at 8-46), this Panel will decide the Complaint on its merits under the assumption that the facts forwarded by the Complainant are not contended by the Respondent.

9.
A claim for the transfer of the Domain to the Complainant requires, according to Art. 21(1), 22(11) Regulation 874/2004 that the Panel finds that the Domain is identical or confusingly similar to the name in respect of which a right is recognized for established by national and/or Community law, such as rights mentioned in Art. 10(1) Regulation 874/2004 and that the Respondent has registered the Domain without rights or legitimate interest in the Domain or that the Respondent has registered or is using the Domain in bad faith.

10.
The only right in question in the present case (cf. above) is the registered Community word/device trademark No. 000368126 "motor show BolognaFiere" ("the CTM"). Although the CTM is registered and, therefore, formally existent, it has to be stated that the trademark is subject to the use requirement under Art. 15(1) of the Council Regulation (EC) No. 40/94 of December 20, 1993. Furthermore, the materials submitted by the Complainant do not show a use of the CTM but only of the isolated portion "motor show" in stylized letters. This raises the question of how to deal with a registered trademark that is subject to the use requirement within ADR.eu Proceedings in cases where the Respondent did not raise a respective objection claiming the non-use of the trademark. On the one hand, the fact that in Opposition Proceedings (cf. Art. 43(2) Regulation 40/94) and the infringement proceedings (cf. Art. 95(3) Regulation 40/94) require that the Applicant or Defendant expressly raise an objection referring to the non-use of the trademark. On the other hand, the owner of the CTM has in Opposition Proceedings and in litigation the chance to furnish proof for the use of its trademark after the Applicant or Defendant has raised the objection. Here, we deal with a "one-shot-only" arbitration where the Complainants, in case they do not submit evidence for the use of the trademark, will be excluded from further submissions. This might imply that the Complainant is forced to submit proof for the use of its trademark in the Complaint since it is completely arbitrary whether or not the Respondent will raise the objection of non-use. This might further imply that the Panel has the right to inquire proper use of the trademark according to Art. 15(1) of the Regulation 40/94 even if the Respondent is in default or did not raise the objection for other reasons. Furthermore, the Panel is, in its sole discretion, permitted to conduct its own investigations on the circumstances of the case (cf. Art. 7(a) .eu Alternative Dispute

Resolution Rules). However, this Panel decides to follow the regime under Arts. 43 and 95 Regulation 40/94 and to consider the non-use of a CTM under Art. 15 Regulation 40/94 only after a respective expressed objection by the Respondent. First, the Panel does not feel obliged to defend the Respondent's case where the Respondent himself does not deem it necessary to stand up for its position. Second, the ADR.eu proceedings are - unlike other international arbitration proceedings – not final since either party to the proceedings can initiate court proceedings under Art. 22(13) Regulation 874/2004. The Respondent will be free to raise the objection of non-use of the CTM in such proceedings.

11.
The CTM, although being a right under Art. 10(1) Regulation 874/2004, is not identical with the Domain. The Panel agrees with the prevailing case law of WIPO Administrative Panels under the UDRP, stating that a word/device trademark can never be identically reproduced in a domain name (cf. eg. WIPO Domain Name Decision No. D2003-0614 – spreewald.com).

12.
In the view of the Panel, the CTM is also not confusingly similar to the Domain. The Complainant asserts that the graphical elements of its CTM have to be ignored within the comparison between the CTM and the Domain. The Panel would be inclined to follow this view, however only in case the word elements of the CTM were distinctive. Although the Complainant asserts that the word elements "motor show BolognaFiere" are not "commonly known generic terms" the Panel finds that each of the word elements as well as their combination completely lack distinctiveness for the services in connection with a trade fair. That the portions "motor show" are merely descriptive for services in connection with trade fairs is evident and needs no further reasoning. The Italian portion "BolognaFiere" means, translated into English, "Bologna Trade Fair". Although the Complainant submits that the grammatically correct version in Italian was "Fiere di Bologna" (trade fair of Bologna) the Complainant itself contends that the relevant consumers will recognize the term "Bologna Fiere" as a short form for "trade fair of Bologna". The combination of two merely descriptive terms can, however, not create distinctiveness and the Panel insofar refers to the decision of the Board of Appeals at the Office for the Harmonization in the Internal Market of October 15, 1999, case No. R 214/1999-1 – "Frankfurt Motor Show", holding that the term "motor show" is merely descriptive of services in connection with a trade fair and that adding a merely geographical indication ("Frankfurt") cannot create distinctiveness.

Since the word portions of the word/device CTM are not distinctive, the Panel follows the prevailing case law of the WIPO Administrative Panels under the UDRP, stating that merely descriptive word elements of a word/device trademark cannot create a confusing similarity between trademark and domain name (cf. eg. WIPO Domain Name Decisions cases No. D2003-0645 – britishmeat.com; D2006-0778 – brabant-wallon.org; D2004-0717 – aberdeenairport.com; D2003-0614 – spreewald.com, all with further references). A different view does not follow from the ARD.eu cases No. 03048 – boscohotels.eu and No. 02438 – ask.eu. At least in the ask.eu case, the Panel explicitly stated that the word portion "ASK!" is distinctive and distinguishes the case expressly from word/device trademarks where the word portion is merely descriptive.

13.
Since the legal reasoning only refers to the CTM, the Panel does not have to deal with other trademarks submitted by the Complainant as annex to the Complaint. It is not in the responsibility of the Panel to identify the relevant right according to Art. 10(1) Regulation 874/2004. As far as the database printouts are submitted in Italian only, the Panel ignores these trademarks since they were not submitted in the language of the proceedings. For other CTMs claiming protection for "motor show" and "BolognaFiere" in stylized letters as word/device marks, the above reasoning applies mutatis mutandis. Other domain names comprising "motorshow" or "bolognafierre" cannot be considered "rights" under Art. 10(1) Regulation 874/2004.

14.
Since the Complainant cannot rely on a right that is identical or confusingly similar to the Domain, the further requirements of lack of legitimate interests, lack of rights and bad faith do not have to be discussed and the complaint has to be denied.

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	**Dr. Uli Foerstl, LL.M.**

DATE OF PANEL DECISION 2008-01-17

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Respondent registered the domain name “motorshowbolognafierre.eu”. The Complainant is doing business as a provider for trade fair services under “Fiere Internazionale die Bologna SPA” in short “BolognaFierre SPA”. The Complaint is based on a word/device Community Trademark “motor show BolognaFierre” registered for services relating to trade fairs (“the CTM”). The Respondent is in default. This Panel, in case of the Respondent’s default, will not automatically accept the claim but examine the case on its merits under the assumption that the facts presented by the Complainant are non-contentious. The CTM is subject to the use requirement under Article 15 Regulation 40/94 and the submissions of the Complainant do not show a proper use of the CTM. However, the Panel is of the opinion that a respective objection has to be expressly raised by the Respondent in order to be considered by the Panel.

The Complaint has to be rejected due to a lack of an identical or confusingly similar right. The Panel is of the opinion that a word/device mark can never be reproduced identically in a domain name. Although the Panel agrees with the Complainant in principle that the graphical elements of a word/device mark can be disregarded, leading to a confusing similarity, in the view of the Panel this applies only in cases where the word elements of the word/device mark are distinctive. The word elements of the CTM translate to “Motor Show Bologna Trade Fair” and the CTM is registered for services relating to trade fairs. Hence, the Panel regards the word elements as merely descriptive and without any distinctiveness whatsoever. Therefore, the Complaint had to be denied.