Panel Decision for dispute CAC-ADREU-005250

Case number	**CAC-ADREU-005250**
Time of filing	**2008-10-29 13:40:54**
Domain names	**ferriera-valsabbia.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Ferriera Valsabbia SpA., Ferriera Valsabbia SpA.**

Respondent

Organization / Name	**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

As far as the Panel is aware, there has been another proceeding that concerns the domain name <FERRIERA-VALSABBIA> [Complainant: Valsabbia Praha, s.r.o., Vojta; Respondent: Lexicon Media, Ltd.; Case: 04910; Time of filing: 2008-02-22 09:09:25; Decision: 2008-06-18].

FACTUAL BACKGROUND

Ferriera Valsabbia S.p.A. (hereinafter, also, “the Complainant”) is an Italian company (S.r.l.), based in Odolo (BS), and mother company of several companies in Europe. The Company was registered in Italian Companies Registry (CCIAA) on 1990, July 19th.
The Company is specialised in the metal construction, and it says that it is known on the market under its business firm “Ferriera Valsabbia”, in the entire Europe.
The Complainant says to have registered several domains, related to its name, in an effort to avoid possible speculative registrations. It says also that there is a company’s web presentation operated under majority of the domains (www.ferriera-valsabbia.com, www.ferriera-valsabbia.info, www.ferrieravalsabbia.info).
As the Complainant’s business is focused on the European market, the company tried to register – under “.eu” - the domain name <FERRIERA-VALSABBIA> (hereinafter, also, “the Domain”), but it found out that the Domain has already been taken by on other subject, Lexicon Media, Ltd. (hereinafter, also, “the Respondent”), that have registered the Domain on 2006, April 7th.
The Complainant argued that the current registration is unlawful, because the Respondent registered the Domain without any legitimate interest and in bad faith, for the only purpose of the occupation and eventual sale.
On this basis, Ferriera Valsabbia S.p.A. filed (2008-10-29 13:40:54) a complaint against Lexicon Media, Ltd., as far as the Domain is concerned.
The Complaint was checked by the Czech Arbitration Court (hereinafter, also, “CAC”) and notified to the Respondent.
The Respondent failed to comply with the deadline in the Notification of the Complaint and Commencement of ADR Proceeding for the submission of its Response.
The CAC selected the Panel, Marco Vincenti, who declared to accept to serve as Panelist in the case concerning the Domain. Parties didn’t challenge Panel’s appointment.
Absent exceptional circumstances, the Panel has been requested to forward its decision by 2009, March 3rd.
The Panel asked the Complainant to produce the power of attorney to his Authorized Representative. The Complainant submitted the document requested.

A. COMPLAINANT

The Complainant says that the Domain is 100 % identical to its business-firm (“Ferriera-Valsabbia”), well-known to the consumers and business partners.
The Complainant says also that there is no web presentation running under the disputed domain name, and that the Respondent has not been using the registered domain for 2 and half years since it has registered it (in the moment of submitting the Complaint), and that

even it has not been using any name corresponding to the Domain in any commercial relations, nor makes any preparations for that use.
The Complainant states also that the Respondent is neither an undertaking, a legal entity nor a natural person that is generally known under the Domain, in contrast to the Complainant.
The Complainant says that in the whole Internet network it isn't possible to find any reference to the commercial use of the name corresponding to the Domain by the Respondent.
The Complainant adds to have learnt about the existence of two decisions against the same Respondent: Decision No. 04141, concerning the domains <AIRFRANCESUCKS> and <AIFRANCE-JP>, and Decision No. 04371, concerning the domain <SIMTEK>. In both cases, the Panel has concluded that the Respondent didn't present any justification for the use of the disputed domain names, and that the Respondent hasn't any rights to or legitimate interests in the respective domain name. During these disputes, the Respondent didn't submit any Response to the notifications sent by the CAC.
Based on the aforesaid, the Complainant has to express his conviction, that the Respondent registered the disputed domain without any legitimate interest and in bad faith, for the only purpose of the occupation and eventual sale.
The Complainant concludes affirming to have a strong interest [based on the registration of his company name in Italian Companies Registry (CCIAA)] to use the disputed domain in his business activity, while the Respondent doesn't show any indications of its existence, nor of its intention to use the Domain.
For the above-mentioned reasons, the Complainant suggests that the Panel orders the transfer of the Domain from the Respondent to the Complainant.

B. RESPONDENT

The Respondent didn't submit any Response or challenge to the Notification of Default.

DISCUSSION AND FINDINGS

In preliminary way
Before deciding the merit of the Complainant, the Panel points out that Par. B 3(f) ADR Rules states that: "If a Respondent does not submit a Response or submits solely an administratively deficient Response, the Provider shall notify the Parties of Respondent's default. The Provider shall send to the Panel for its information and to the Complainant the administratively deficient Response submitted by the Respondent.".
Moreover, Par. B 10 ADR Rules states that: "In the event that a Party does not comply with any of the time periods established by these ADR Rules or the Panel, the Panel shall proceed to a decision on the Complaint and may consider this failure to comply as grounds to accept the claims of the other Party.".
The fact that the Respondent didn't submit any Response will be taken into account by the Panel.

First of all, after examining the Complaint, the arguments and the documents, the Panel observes that Complainant's commercial name and its reputation in its field of activity are not questionable, taking into consideration all over that the Respondent chose not to say anything on the matter.

The Complainant considers that Domain's registration is unlawful.
In order to establish whether a registration is unlawful, it has to be taken into consideration art. 21, par. 1, Reg. (CE) n. 874/2004, that states: "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.". Art. 10, par. 1 Reg. (CE) n. 874/2004 states that: "Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of. eu domain starts. "Prior rights" shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works. (…)". Art. 10, par. 2 Reg. (CE) n. 874/2004 states that: "The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.".
The Panel believes that elements requested by those rule are observed.
In fact, the Complainant has proved that it is the holder of the commercial name "Ferriera Valsabbia", that has been registered in Italian Companies Registry (CCIAA) on 1990, July 19th (see annex 1 to the Complainant) and that is identical to the Domain.
As far as Italian law, commercial name is protected by art. 2563 and following cod. civ.
As said before, in order to revoke an registered domain name, it is necessary that two requirements are observed – in alternative way - : the domain name "has been registered by its holder without rights or legitimate interest in the name" or it "has been registered or is being used in bad faith.".

The legitimate interest to register a domain name may be demonstrated where [ex art. 21, par. 2 Reg. (CE) n. 874/2004]: "(a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so; (b) the holder of a domain name, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law; (c) the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law.".
The bad faith in registration or using a domain name may be demonstrated, where [ex art. 21, par. 3 Reg. (CE) n. 874/2004]: "(a) 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 recognised or established by national and/or Community law or to a public body; or (b) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognised or established by national and/or Community law, or a public body, from reflecting this name in a corresponding domain name, provided that: (i) a pattern of such conduct by the registrant can be demonstrated; or (ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or (iii) in circumstances where, at the time the ADR procedure was initiated, the holder of a domain name in respect of which a right is recognised or established by national and/or Community law or the holder of a domain name of a public body has declared his/its intention to use the domain name in a relevant way but fails to do so within six months of the day on which the ADR procedure was initiated; (c) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or (d) the domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognised or established by national and/or Community law or a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the holder of a domain name; or (e) the domain name registered is a personal name for which no demonstrable link exists between the domain name holder and the domain name registered.".
Although those requirements are alternative, and not cumulative, the Panel thinks that could be useful to exam both for the sake of completeness.
The Complainant has declared that: "There is no web presentation running under the disputed domain name" and that "(t)he Respondent doesn't use the registered domain for 2 and half years (in the moment of submitting the complaint), and even he doesn't use any name corresponding to this domain name in any commercial relations, nor makes any preparations for that use". The Complainant has said also that "(t)he respondent is neither an undertaking, a legal entity or a natural person that is generally known under the domain name" and that "(i)n the whole Internet network it isn't possible to find any reference to the commercial use of the name corresponding to the domain name by the Respondent".
On this basis – referring also to Decision n. 04141 and Decision n. 04371 - the Complainant has expressed his conviction that the Respondent registered the Domain "without any legitimate interest and in bad faith, for the only purpose of the occupation and eventual sale".
The Panel agrees with Complainant's thesis, but he thinks that it is necessary to say that evidence provided can be considered enough only because Respondent didn't submitted any Response.
In particular, Panel agrees with Panel's Decision n. 04141 as far as "Rights or legitimate Interest" issue is concerned, and he thinks useful to quote it as follows.
"As far as the right or legitimate interest are concerned, it must be stressed that, in most cases, it is sometimes very harsh for a Complainant to demonstrate with absolute certainty the absence of a right or legitimate interest of a Respondent. The Panels usually expects the Complainant to make a reasonable demonstration rather than bring absolute evidence. This demonstration rests on the various facts and legal elements of each case. The response is then the occasion for the Respondent to challenge and contradict the reasonable demonstration of the Complainant and to draw the Panel's attention on other facts and legal elements to support its view. In this case, the least that can be said is that the complaint is quite persuasive. It underlines facts and legal elements that are indeed good signs that the domain name "has been registered by its holder without rights or legitimate interest in the name" (art. 21 of EC regulation 874/2004), as per the factual and legal elements depicted in the section "Parties' contentions". The respondent had a chance to reply; it chose not to. Such an attitude may be construed as an absence of rights or legitimate interest by the Panel."
Panel also agrees with Panel's Decision n. 04141 as far as "Bad faith in registration / use" issue is concerned, and he thinks useful to quote it as follows.
"Bad faith registration: This point cannot be denied considering the well-known aspect of the Complainant's trademark, which as it has already been decided "creates a prima facie presumption that the respondent registered the domain name for the purpose of selling it to Complainant or one of its competitors, or that it was intended to be used in some way to attract for commercial gain users to the website by creating a likelihood of confusion with Complainant's mark".
Bad faith use: This point seems to be more delicate to determine, as the domain names are not exploited. How can "use in bad faith" be determined? Should "passive holding" be taken into consideration, as such, and would it be sufficient to prove "use in bad faith"? The Panel is of the opinion that use in bad faith has to be appreciated essentially in view of factual elements such as the length or absence of use, the presence of static web pages, i.e. "under construction", or again "parking web pages". However, among all these possible

ways to put a domain name in “stand-by” for real and effective exploitation, some have to be construed carefully. Indeed, the sole idea of the period of time when the domain name is not really in use and being an effective form of exploitation cannot always be, in itself, sufficient. Indeed, to secure a project, one would reserve a domain name with one or several extensions or combinations as early as possible. Then, one would need to finalize his/her web page design. Would a “passive holding” necessarily constitute “use in bad faith”?
The Panel would like to mention that the principle of specialty of trademark rights may constitute an obstacle to an administrative complaint, in presence of an identical or confusingly similar domain name. Therefore, a “passive holding” in such a case would deny the rights of the holder of a domain name for different goods or services than those claimed by the Complainant and lead the Panel to an unfair decision. Thus, “passive holding” may, according to the facts of each and every case, be considered as a use in bad faith, but it cannot be systematic to demonstrate it as such.”
The Panel does not agree with Decision n. 04910. In this case, the Complaint was denied because the Complainant (Valsabbia Praha s.r.o., Vojta - a limited liability company based in the Czech Republic) requested the transfer of the domain name <FERRIERA-VALSABBIA> only on the basis of its company name protected by Czech law ("Valsabbia"). The Panel of case 04910 found that the word "ferriera" was not part of the company name "and as such was also not registered in the Commercial Register if the Czech Republic". The Panel of case 04910 enunciated that "the legal protection of the registered name of the company belongs to the Complainant only as far as the part of the wording of the disputed domain is concerned, namely regarding the word “valsabbia”. The second part of the disputed domain - the word “ferriera” - does not form the company name of the Complainant and therefore it does not enjoy legal protection pursuant to the Czech law". For this reason, the Complaint was denied.
This Panel - Marco Vincenti - thinks that, as far as Case n. 04910 is concerned, in any case, even if Complainant's commercial name does nor correspond (exactly) to the disputed domain names, its registration by the Respondend - that clearly has no evident link to the word <valsabbia> nor makes activity related with ironworks - could be considered as a circumstancial evidence of bad faith or a prejudicial behavior towards the Complainant. The commercial name could be considered "quite similar" to the disputed domain name, with an interpretation in large way of similarity.
In any case, this Panel - Marco Vincenti - thinks that, as far as Case n. 05250 is concerned, Complainant's commercial name ("Ferriera Valsabbia") protected by Italian law corresponds exaclty to the Domain ("FERRIERA-VALSABBIA") and that it is not relevant - in Panel's opinion - that the two words that compose the Domain ("Ferriera" and "Valsabbia") are divided by the sign "-" (hyphen).

The Complainant satisfies the criteria for eligibility for .eu TLD set out in Art. 4, par. 2 (b) Reg. (CE) n. 733/2002.

In conclusion, the Panel decides that the Domain shall be transferred to the Complainant.

DECISION

For all the foregoing reasons, in accordance with art. 21, parr. 1, 2 and 3 Reg. (CE) n. 874/2004 and Par. 3(f) and Par. B.10 ADR Rules, the Panel orders that the domain name <FERRIERA-VALSABBIA> be transferred to the Complainant.
This decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction.

PANELISTS

Name	**Marco Vincenti**

DATE OF PANEL DECISION 2009-03-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant requested to receive the transfer of the Domain <FERRIERA-VALSABBIA> based on the existence of prior rights on the terms “Ferriera Valsabbia” – as commercial name protected by Italian law - and its reputation on European market. The Complainant argued that (i) the domain name was identical to its commercial name, (ii) the domain name was registered with no rights or legitimate interests, and (ii) the domain name has been used in bad faith. The Panel asked the Complainant to produce the power of attorney to his Authorized Representative and the Complainant submitted the document requested. Then, the Panel dealt with the question arising from the default of the Respondent to reply and concluded that this default can be taken into consideration in assessing the case. The Panel examined whether or not the Complainant has proved that the registered domain name is identical to a name in respect of which a right is recognized or established by the national law of a Member State, and whether or not the domain name has been registered by the Respondent without rights or legitimate interest in the name or has used it in bad faith. The Panel considered that all three conditions were met and decided to transfer the domain name <FERRIERA-VALSABBIA> to the Complainant.