Decision for dispute CAC-UDRP-101216

Case number	**CAC-UDRP-101216**
Time of filing	**2016-06-13 10:47:36**
Domain names	**biovitae.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**NEXTSENSE SRLS**

Respondent

Name	**JInsoo Yoon**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant states that the name BIOVITAE identifies Complainant's biotechnology product (patent pending no. 102016000036840 - UA2016A002467) which is now publicly and internationally acknowledged following the product's official presentation at a press conference held in Italy on 14th April 2016 and at a press conference held at the CANNES FESTIVAL on 17th April 2016, followed by high media coverage (various internet press release are attached to the Complaint). In addition, the Complainant claims that the "domain name "BIOVITAE.COM" is identical to their name/figurative mark BIOVITAE that is registered at UIPO under the European Community Trademark (EUTM) with registration n. 015352156". Further, the Complainant states that it owns the following domain names BIOVITAE.IT, BIOVITAE.NET and BIOVITAE.EU.

The Respondent did not file a response to the complaint.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

In addition to the rights put forward by the Complainant (as mentioned above), the Complainant claims that it tried to register the domain name BIOVITAE.COM as soon as its EU Trademark "was issued", but that it was already registered but in grace period status.

The Complainant states a chronology of events by which it missed the registration of the domain name once it became available because the Respondent managed to register it first. According to the Complainant, it contacted "dropcatch.com" and subsequently the Respondent and, in the words of Complainant "asked to either have the domain name transferred to us

or entering into a UDRP dispute."

The Respondent never replied, but the Complainant became aware that the domain name BIOVITAE.COM was displayed for sale (at a price of EUR 4900) at the website www.sedo.com.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant claims to have a Trademark "registration" covering the European Union. However, from the documentation put forward by the Complainant and the limited research this Panelist is entitled to carry out in accordance with UDRP precedents and paragraph 10 (a) of the Rules, it appears that -at the time of drafting this decision- the Complainant is the owner of a (published) EU trademark application (application date 18th April 2016) which is still subject to opposition.

This brings the controversial question of whether a trademark application is sufficient basis to start a UDRP case. This Panel has been able to identify a number of decisions supporting both approaches. In some cases, panelists ruled that a trademark application was sufficient to launch a UDRP case, while in others, panelists found that a trademark application by itself, was insufficient to support a case under the UDRP. It is important to note that in both lines of argument, panelists considered whether there were additional “rights” (eg. common law rights or unregistered marks) resulting that, in some cases where a trademark application was considered enough, the Panel also found there were common law rights or unregistered marks. In other cases where an application met the burden under Paragraph 4(a)(i), the Complaint subsequently failed under the other two requirements of the UDRP. See WIPO Case No. D2005-0994.

This Panel considers that UDRP cases based on trademark applications need to be looked at on a case-by-case basis. It is important to consider not only the specific circumstances in which the domain name in question was registered (facts that would be more relevant to the finding of legitimate interest/bad faith), but also the use of the mark prior to the domain name registration and the specific procedural stage of the trademark application.

In the current case, the Complainant is only putting forward a trademark application that is still subject to opposition. In addition, nothing on the record suggests that as a consequence of the use, the mark BIOVITAE has become extensively known in the European Union or elsewhere. The Complainant only states that it has presented the product bearing the BIOVITAE mark at two press conferences, one held in Italy in April 2016, and the other one at the CANNES FESTIVAL, also in April 2016. The Complainant submits several recent press clippings (all in Italian language). However, the Complainant fails to provide any indication of the impact of these presentations on the market beyond the mark being "publicly and internationally acknowledged", which is a very vague statement in connection with the degree of knowledge of the mark on the market. No other information has been submitted, particularly in connection with the websites owned by the Complainant (registration dates of the domain names, visits, etc.).

Accordingly, this Panel finds that, even if there are instances where a trademark application could potentially serve as basis to file a UDRP case (all the factors considered), in the present case the Complainant has not put forward reasonably uncontested evidence of its trademark rights and as a result, the Complainant has not, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Based on the finding regarding paragraph 4(a)(i) of the Policy stated above, the Panel does not need to entertain the question whether the Respondent has rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

Based on the finding regarding paragraph 4(a)(i) of the Policy stated above, the Panel does not need to entertain the

question whether the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that on the facts of this case, the EU trademark application put forward by the Complainant is not sufficient to support a finding that the Complainant has rights to a trademark or service mark (within the meaning of paragraph 4(a)(i)of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **BIOVITAE.COM**: Remaining with the Respondent

PANELLISTS

Name	**Jose Checa**

DATE OF PANEL DECISION 2016-07-22

Publish the Decision