Decision for dispute CAC-UDRP-102549

Case number	**CAC-UDRP-102549**
Time of filing	**2019-06-25 10:54:30**
Domain names	**milanocortina2026.com, milano-cortina2026.com**

Case administrator

Organization	**Iveta Špiclová (Czech Arbitration Court) (Case admin)**

Complainant

Organization	**CONI Comitato Olimpico Nazionale Italiano**

Complainant representative

Organization	**De Simone & Partners S.p.A.**

Respondent

Name	**Andreas Withaker**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks in Italy:

- TM No. 302018000034117, MILANO CORTINA 2026, filed on October 26, 2018 and registered on May 24, 2019 in 45 classes of the Nice Classification;

- TM No. 302018000037336, MILANO CORTINA 2026 CANDIDATE CITY OLYMPIC WINTER GAMES (figurative), filed on November 23, 2018 and registered on May 7, 2019 in 45 classes of the Nice Classification.

The Complainant is the owner of the following trademarks in Italy:

The Complainant is the owner of the following Italian trademark applications:

- Application No. 302018000034123 for MILANO 2026 filed on October 26, 2018 in 45 classes of the Nice Classification;

- Application No. 302018000034128 for CORTINA D'AMPEZZO 2026 filed on October 26, 2018 in 45 classes of the Nice Classification.

In additions, the Complainant is the owner of several domain names consisting of the names of the cities MILANO and/or CORTINA and/or D'AMPEZZO and/or 2026 and the relevant Top-Level suffix.

FACTUAL BACKGROUND

FACTUAL BACKGROUNDS

The Complainant, the Italian National Olympic Committee (the "CONI"), is the official representative of the International Olympic Committee (the "IOC") for the Italian territory, supervising and managing all sports matters Italy. One of the current tasks of the CONI is to promote and manage the joint candidature of the cities of Milano and Cortina d'Ampezzo that will host the Winter Olympics Games in 2026.

The Respondent is an individual named Andreas Withaker, resident of Fujairah in the United Arab Emirates. No other information is known about the Respondent.

The disputed domain names <milanocortina2026.com> and <milano-cortina2026.com> (the "Domain Names"), were registered on August 1, 2018 under a privacy statement, and currently results in parking pages, so any services are associated to them.

One of the obligations imposed to the CONI by the IOC is to provide protection of all distinctive signs consisting of the candidate cities + year of the Olympic Games 2026, under the scheme CITY + YEAR, which is the traditional format of the distinctive signs related to all Olympic Games that have been organized before. Such protection is expected to be assured by the trademark registrations and domain names registrations.

In view of the above-mentioned, on December 18, 2018, the Complainant sent a cease and desist letter to Register.it S.p.A., which was the only disclosed data related to the Domain Names, requesting that the owner voluntary abandon the Domain Names. The Response sent by the legal representative of the Domain Names holder indicated that their actual owner was the Italian company Mediatria S.r.l. and proposed to discuss the matter directly with the legal representative of the CONI.

According to the Complainant, the amicable settlement with Mediatria S.r.l. was unreachable, as long as the Complainant refused the proposal to pay a remarkable sum of money for the transfer of the Domain Names and after such refusal the communication with Mediatria S.r.l. was interrupted. Furthermore, after the communication between the CONI and the presumed Domain Name holder, Mediatria S.r.l., the Domain Names were apparently transferred to the Respondent.
NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT'S CONTENTIONS:

Identical or confusingly similar

The Complainant argues that the Domain Names <milanocortina2026.com> and <milano-cortina2026.com> are identical to the Complainant's registered Italian word trade mark No. 302018000034117, MILANO CORTINA 2026.

In addition, the Complainant argues that the Domain Names are confusingly similar with the Italian figurative trademark No. 302018000037336, MILANO CORTINA 2026 CANDIDATE CITY OLYMPIC WINTER GAMES, as the registered trademark fully incorporates the Domain Names.

The Complainant also points out that the applicable Top-Level suffix would usually be disregarded as it is a technical requirement of registration.

Finally, the Complainant contends that the post-date of the registration of the Domain Names is irrelevant for the purposes of paragraph 4(a)(i) of the Policy.

No rights or legitimate interests

The Complainant argues that there is no evidence at all that the Respondent is commonly known by the Domain Names or a name corresponding to the Domain Names, nor that the Respondent is making a bona fide offering of goods and services. Moreover, the Complainant states that the Respondent has not been licensed or otherwise authorized to use any of the Complainant's trademarks nor to apply for or use any domain name incorporating such trade marks.

Given such circumstances, the Complainant considers reasonable to infer that the registration of the Domain Names results in a typical case of abusive registration.

Registered and used in bad faith

As far as bad faith registration is concerned, the Complainant states that the pattern "CITY + YEAR" is synonymous with the Olympic Games and is a distinctive sign instantly capable of indicating to consumers the Olympic origins of the goods and services bearing that sign. As a result, it is also largely predictable that a city may acquire potential rights in the pattern "CITY + YEAR" as any candidature progresses, and the year is predictable.

The Complainant points out that the Domain Names were registered on August 1, 2018, when Italy (and the cities of Milan and Cortina d'Ampezzo) made official their decision to candidate and to host the Winter Olympic Games of 2026, which was publicly know as it was communicated in the press numerous times.

The Complainant argues that the Respondent could not be therefore unaware of the Complainant and its legitimate interest in the signs consisting of any variation of "Milano – Cortina d'Ampezzo – 2026" and registered the Domain Names in order:

(i) to prevent the Complaint to acquire the domain name related to the said signs with the principal top-level suffix ".COM"; and

(ii) to take advantage of the possible confusion between the said Domain Names and any potential future rights of the Complainant in the sign MILANO CORTINA 2026.

Finally, the Complainant underlines that, although the Domain Names are not being actively used by the Respondent, passive holding may amount to bad faith use under certain circumstances, as in this case, especially given that is the pattern "CITY + YEAR" is traditionally linked to the Olympic Games.

RESPONDENT'S CONTENTIONS:

The Respondent did not respond to the Complaint.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Names are identical or confusingly similar to trademarks in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Names have been registered and are 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

Paragraph 15 of the Rules states that the panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the panel shall draw such inferences therefrom as appropriate.

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant.

The Panel proceeds therefore to decide only on the basis of the Complainant’s factual statements and the documentary evidences provided in support of them.

According to the paragraph 4(a) of the Policy, a complainant must prove each of the following for a panel to order a transfer of the domain name(s) at issue:

1. the domain name(s) in question is/are identical or confusingly similar to a trademark(s) or service mark(s) in which the complainant has rights; and

2. the Respondent has no rights or legitimate interests in respect of the domain name(s); and

3. the disputed domain name(s) has/have been registered and is/are being used in bad faith.

In the light of the above-mentioned, the Panelist makes the following decision:

1. According the arguments and evidences provided in their support in the Complaint, it can be concluded that the Complainant is owner of the Italian trademarks and Italian trademark applications and Domain Names whose common distinctive elements is the reference to the cities that will host the Olympic Games in Italy and the year 2026, when the event will take place.

The Domain Names <milanocortina2026.com> and <milano-cortina2026.com> consist of the union of the words “MILANO” and “CORTINA” and the number “2026”, making thus reference to the most important sport event of 2026 – the Olympic Games in Milano and Cortina d'Ampezzo in 2026.

The Domain Names <milanocortina2026.com> and <milano-cortina2026.com> and the registered trademark MILANO CORTINA 2026 (Reg. No. 302018000034117) are identical, given that the Domain Names differ only in the Top-Level suffix “-.com” which is not distinctive.

The Domain Names <milanocortina2026.com> and <milano-cortina2026.com> and the registered figurative trademark MILANO CORTINA 2026 CANDIDATE CITY OLYMPIC WINTER GAMES (Reg. No. 302018000037336) are confusingly similar,

as the disputed Domain Names are fully included in the registered trademark.

The other Complainant's trademark applications, registered domain names and the Domain Names have the same word structure and thus the overall visual and phonetic impression they produce is very similar. Furthermore, the signs are conceptually identical to the extent that they make a clear reference to the Olympic Games that will be hosted by the cities Milano and Cortina d'Ampezzo in 2026.

The ownership of these trademarks, trademark applications and domain names are therefore considered as sufficient for the purposes of paragraph 4(a)(i) of the Policy, although it is noteworthy that they do not appear to predate the registration of the Domain Names.

2. With regard to rights or legitimate interests in the Domain Names the Paragraph 4(c) of the Policy sets out various ways in which a respondent may satisfy such requirement:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue."

The website at the Domain Names result currently into the parking pages and there is no evidence of having ever been associated with any goods or services.

Based on the arguments of the Complainant, the Respondent is not affiliated with or authorized by the Complainant in any way.

Furthermore, the Respondent is not making a legitimate noncommercial or fair use of the Domain Names.

Finally, the Respondent does not appear to be commonly known by the Domain Names or by the name “Milano Cortina 2026” or by a name corresponding to the Domain Names.

Therefore, and in the absence of a Response, the Panel finds that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the Domain Names.

3. As to the bad faith at the time of the registration, the Policy, sets out in the paragraph 4(b) four illustrative circumstances, which for purposes of the Policy, paragraph 4(a)(iii) shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Respondent registered the Domain Names the day in which Italy (particularly the two cities Milano and Cortina d'Ampezzo) made official the decision to candidate to host the Winter Olympic Games in 2026. Several press releases were made to announce this news to the general public.

At that moment, the Complainant had no property right over the names or domain names related to the 2026 Winter Olympic Games in Italy, but had the legitimate expectations to get the widest protection of the distinctive signs and domain names “CITY + YEAR” referring to the city and the year of the particular Olympic Games, not only for defense purposes and for the

promotion of the candidature of the two Italian cities, but also in order to comply with the requirement of the Candidature Process set out by the OIC.

Furthermore, since the structure of the official name of each Olympic Games "CITY + YEAR" became a traditional pattern of the globally most important sport event, it was also largely predictable that the official candidate may be interested in acquiring domain names and trademarks referring to the 2026 Winter Olympic Games in Milano and Cortina d'Ampezzo.

In this regard, the Panel agrees with the Complainant's allegations and finds that the Respondent was certainly aware of the Complainant and its legitimate interests in acquiring the Domain Names related to the 2026 Winter Olympic Games at the time that the Domain Names were registered.

In addition, it is well established that the domain name with the Top-level suffix ".com" is certainly the most important domain name and thus was the most obvious domain name to represent Milano and Cortina d'Ampezzo for the 2026 Olympic Games if Italy should be elected for host the 2026 Olympic Games.

These circumstances lead to the assumption that the Domain Names were registered to prevent the Complainant from registering them, even though his legitimate interest was obvious.

The Domain Names do not resolve to any website or other on-line presence, nor appear to have been used so far, however, prior panels have already discussed the passive holding of the Domain Names (e.g. in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003) and found that the passive holding itself can constitute a bad faith use.

The particular circumstances of this case, allow the Panelist to infer that this is the case when the inactivity of the domain name holder could be considered as a bad faith use, given that:

(i) the Complainant is widely known and the candidature of Milano and Cortina d'Ampezzo for the 2026 Olympic Games was made official exactly the same day in which the Domain Names in were registered;

(ii) the Domain Names structure in which the Complainant had the legitimate interest was predictable;

(iii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the Domain Names;

(iv) the original Domain Names holder has taken active steps to transfer the Domain Names to a third person, though he was aware of the Complainant rights and interests.

Bearing in mind these circumstances, the Respondent can be deemed to have registered the Domain Names for blocking purposes.

The Panel therefore finds that the Domain Names have been registered and are being used in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MILANOCORTINA2026.COM**: Transferred
2. **MILANO-CORTINA2026.COM**: Transferred

PANELLISTS

Name	**JUDr. Hana Císlerová, LL.M.**

DATE OF PANEL DECISION 2019-08-02

Publish the Decision