Decision for dispute CAC-UDRP-107300

Case number	CAC-UDRP-107300
Time of filing	2025-03-11 09:59:03
Domain names	savinopartners.com

Case administrator

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

Complainant

Name	Mr. Luca Savino

Complainant representative

Organization	Studio Legale Jacobacci & Associati

Respondent

Organization	Savino & Partners a.s.

Respondent representative

Organization	Eversheds Sutherland

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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of

- EU figurative trademark “Savino & Partners” number 018288861, with the registration day on December 10, 2020;
- EU figurative trademark “SAVINO & PARTNERS” number 019074639, with the registration date on December 4, 2024.

The disputed domain name has been registered on December 10, 2001.

FACTUAL BACKGROUND

The Complainant (natural person with the surname “Savino”) was the former shareholder of the Respondent who withdrawn from the company of Respondent in 2024.

PARTIES CONTENTIONS

FACTS ASSERTED BY THE COMPLAINANT:

The Complainant asserts rights in respect of the disputed domain name based on his ownership of registered European Union trademarks No. 018288861 (registered in 2020) and No. 019074639 (application filed in September 2024). The Complainant also relies on longstanding use of the “Savino & Partners” name since 1960 in Italy and since 1991 in Prague, as well as ownership of the domain name <savinopartners.it> created in 2003.

The Complainant contends that the Respondent lacks rights or legitimate interests in the disputed domain name. He emphasizes that, following the Complainant’s withdrawal from the Respondent – Czech company “Savino & Partners a.s.” – and the subsequent agreement, the Respondent agreed to cease using the “Savino & Partners” name. Therefore, any previous authorization for the Respondent’s use of the Complainant’s name and associated goodwill was validly revoked. The Complainant refers to case law, notably Sanofi-aventis v. Watson Pharmaceuticals, Inc. (WIPO Case No. D2010-0800), supporting the principle that legitimate rights can be lost when consent is withdrawn.

Regarding bad faith, the Complainant argues that the Respondent’s continued use of the domain name after the agreement to abandon the “Savino & Partners” name constitutes bad faith use under Paragraph 4(b)(iv) of the Policy. He points to the confusion caused by the redirection from the disputed domain to the Respondent’s new website under a different business name, suggesting that consumers may be misled into believing there is a commercial connection between the Complainant and the Respondent.

Consequently, the Complainant seeks the transfer of the disputed domain name.

FACTS ASSERTED BY THE RESPONDENT:

The Respondent asserts that the Complainant has failed to meet the three cumulative requirements under Paragraph 4(a) of the Policy.

Specifically, the Respondent denies any bad faith in either the registration or use of the disputed domain name. It emphasizes that the domain was registered in 2001 and continuously used for over twenty years in connection with the Respondent’s legitimate business activities in the Czech Republic. The Respondent disputes the Complainant’s interpretation of bad faith as a unitary concept, citing WIPO precedent (Case No. D2010-0800) that bad faith registration and bad faith use must both be proven separately.

The Respondent claims legitimate rights and interests in the disputed domain name, based on longstanding use of the business names “SAVINO ASSOCIATED, a.s.” and “SAVINO & PARTNERS a.s.” until the name changed to Axevera Consulting a.s. on 31 October 2024. The Respondent asserts that the parties negotiated a framework agreement in September 2024, under which the Complainant abandoned any claim to the disputed domain name. Notably, a provision for the domain’s transfer to the Complainant, proposed in an earlier draft, was omitted from the final signed agreement.

Furthermore, the Respondent asserts that there is no real risk of confusion between the parties’ services, noting that it is licensed to operate only in the Czech Republic, while the Complainant’s business activities are based in Italy.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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

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

BAD FAITH

The Complainant has not, to the satisfaction of the Panel, shown the disputed 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 Complaint has been submitted in English. Based on the Registrar verification, the CAC notified the Complainant that the language of the registration agreement is Czech, and that the Complaint should be therefore either translated into the language of the Registration agreement, or the Complainant has to request for the change of the language into English.

In the amended Complaint the Complainant requested the change of the language into English and presented certain Annexes originally presented in Italian translated into English. The Complainant however failed to submit any argument why the language of the proceeding should be changed from Czech into English.

The Respondent's response has been presented in English as well without any objections with regards to the language of the proceedings.

Pursuant to Paragraph 11 of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Although it is usual for the Complainant to accompany his request for a change of language of the proceedings with at least minimal justification, and although in this case the Complainant completely renounced this practice and only stated that he was proposing a change of language, the Panel proceeded from the fact that it was within its jurisdiction to decide on a change of language "having regard to the circumstances of the administrative proceeding" and, given that the Respondent also responded in English, it decided that it is appropriate for the language of these proceedings to be English.

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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

I. The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
II. The respondent has no rights or legitimate interests in respect of the domain name; and
III. The domain name has been registered and is being used in bad faith.

I. Identical or Confusingly Similar

a) Registered trademark

The Complainant has established the fact that it has valid rights for the trademarks "Savino & Partners" with the registration in December 2020 and December 2024. The entirety of the Complainant's trademarks "Savino & Partners" is reproduced within the disputed domain name with the omission of the character "&" between the words "Savino" and "Partners", which character is not technically allowed in domain names. Accordingly, the disputed domain name is confusingly similar to the Complainant's "Savino & Partners" trademarks for the purposes of the Policy. For the purpose of the assessment of the rights the generic top-level domain COM should not be taken into account as the relevant gTLD is the essential part of each domain name.

The fact that the disputed domain name was registered 19 years before the Complainant acquired trademark rights does not by itself preclude the Complainant's standing to file the present UDRP case or a finding of identity or confusing similarity under the first element.

Therefore, the Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the Complainant's trademarks "Savino & Partners" in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

b) Unregistered trademark

The Complainant further claimed that the surname "Savino" has been used from 1960 by Complainant's father, becoming one of the most traditional firms in the Trieste area known for highly qualified services. In fact, the Complainant claimed that it has common law rights in unregistered mark "Savino" being the Complainant's surname used for years in the tax, corporate and administrative business.

It is not necessary to have a registered trademark in order to prove the identicality or similarity according to the paragraph 4(a)(i) of the Policy. Many UDRP panels have held that it is possible to obtain unregistered trademark rights to satisfy the requirements of this paragraph. However, to establish unregistered or common law trademark rights for purposes of the UDRP, the Complainant must

show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys (see the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 1.3).

The purpose of requiring evidence on this vital and pivotal issue is to show that the name that is claimed to be a trademark is recognized in the market as the mark of the trader and that the mark is identified with the person who is relying on it.

Therefore, the Panel expects that the Complainant presents not only that it uses the unregistered mark, but that the mark acquired the distinctiveness or secondary meaning. The fact that the name of the Complainant is identical to such unregistered trademark doesn't mean that the mark acquired the distinctiveness.

There is simply no evidence to this effect brought forward by the Complainant. The Complainant in the present case has thus not proved or even attempted to prove that it has such an unregistered and/or common law trademark in "Savino" or "Savino & Partners" within the meaning of paragraph 4(a)(i) of the Policy. The Panel finds that the Complainant has not sufficiently demonstrated secondary meaning of the unregistered trademark that identifies it solely (or at least primarily) with the Complainant. In other words, the Complainant did not show that marks "Savino" or "Savino & Partners" have become a distinctive identifier which consumers associate with the Complainant or Complainant's goods and/or services.

II. Rights or Legitimate Interests

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (ii) the respondent has no rights or legitimate interests in respect of the domain name.

The Respondent has been established on April 26, 2006, while the disputed domain name has been registered on December 10, 2001. It does not follow from the Registrar verification nor from the parties' submissions, who was the original registrant of the disputed domain name in 2001 and how it was acquired by the Respondent after its establishment in 2006.

It follows from both the Complainant's and Respondent's submissions that the Respondent had rights and legitimate interest in respect of the disputed domain name at the time of its acquisition as it was corresponding to its business name (name of the Respondent's company). And both parties confirmed that the Respondent's name has been changed at the end of October 2024 following the leave of the Complainant from the Respondent's company.

It further follows from the Agreement signed on September 18, 2024, between the Complainant and others, that "within sixty days the company with the new name shall remove any reference to the surname from documents, deeds, plaques, advertising and/or communication items and correspondence from that date onward". It is evident, that the "surname" mentioned in the Agreement is the surname of the Respondent and the first part of the disputed domain name "Savino".

It has been therefore proved that the Respondent has no rights or legitimate interests in respect of the disputed domain name from the beginning of year 2025.

The Panel does not agree with the Respondent's view that the fact that the final version of the Agreement omitted an explicit reference to the termination of use of the disputed domain name, as opposed to one of the working versions, which stipulated that the Respondent was not entitled to continue using the disputed domain name, means that the Respondent's right to use it continues to exist. The Agreement explicitly states that the Respondent shall remove any reference to the surname and this, according to Panel, includes the surname as the part of the disputed domain name.

The Panel therefore considers that the Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

III. Registered and Used in Bad Faith

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (iii) the domain name has been registered and is being used in bad faith.

The wording of the Policy is clear, and the Panel is persuaded that bad faith registration and bad faith use are cumulative requirements, not the alternatives. The Complainant must therefore prove (in order to succeed) that the disputed domain name was registered in bad faith AND that is used in bad faith.

However, the Complainant failed to prove that the disputed domain name was registered in bad faith and further did not disclose how the Respondent acquired the disputed domain name 5 years after its registration and failed to prove that the Respondent has been in bad faith when acquiring the disputed domain name.

While the current use of the disputed domain name may be considered use in bad faith as the Respondent lost its right to use the surname of the Complainant in its business after the Complainant's participation in the Respondent terminated, the registration (or acquisition) of the disputed domain name is a different issue.

The Panel notes that at least the acquisition of the disputed domain name after the establishment of the Respondent in 2006 was consistent with the agreements between the parties and the Respondent acquired the disputed domain name with the knowledge of the Complainant and apparently with his consent. The Panel further notes that the Complainant did not object to the registration of

the disputed domain name prior to its leave from the Respondent in 2024. On the balance of probabilities, the Panel concludes that the Respondent acquired the disputed domain name in good faith to promote its products and/or services on the basis of the agreements that included the Complainant as the shareholder of the company as well. On the totality of the evidence, the Panel finds that the Respondent did not register the disputed domain name in bad faith.

As stated above, the conditions under this third element are cumulative and if registration in bad faith has not been proven, the Complaint cannot be granted even if the disputed domain name was used in bad faith.

Thus, the Complainant has not, to the satisfaction of the Panel, shown the disputed domain name has been registered AND used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Scope of the Policy

It must also be mentioned, that the Policy was adopted to deal as is with the problem of cybersquatting, the registration of domain names identical or confusingly similar to trademarks. The questions under the Policy to be addressed by the panels are relatively simple and straightforward. The proceeding is a summary one, without the benefit of confrontation of witnesses, or even of a hearing. In the case present, it is evident, that the dispute brought before this Panel is rather based on the long-term mutual relationships and agreements. The fact that the parties were unable to agree on a comprehensive settlement of their mutual relations upon termination of the Complainant's participation in the Respondent, which would also include resolving the right to use the Complainant's name in the disputed domain name, should not be compensated for by these administrative proceedings.

The Panel considers that the Complainant has shown that the disputed domain name <savinopartners.com>, is confusingly similar to trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name is being used in bad faith. However, the Complainant failed to show that the disputed domain name has been registered (or acquired) in bad faith. The Complainant thus has not established all three elements of paragraph 4(a) of the Policy and the Complaint must be therefore rejected.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **savinopartners.com**: Remaining with the Respondent

PANELLISTS

Name	**Petr Hostaš**

DATE OF PANEL DECISION 2025-04-29

Publish the Decision