Panel Decision for dispute CAC-ADREU-000168

Case number	CAC-ADREU-000168
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Domain names	marstall.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Marstall GmbH

Respondent

Organization / Name	EURid

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

There are no other legal proceedings.

FACTUAL BACKGROUND

The Complainant is a licensee of the Community Trade Mark MARSTALL.

At 11:02 a.m. on December 17, 2005 the Bayerische Staatsschauspiel filed an application to register the domain name <marstall.eu> (hereafter the “disputed domain name”) supported by documentary evidence.

At 11:24 a.m. on December 17, 2005 the Complainant filed an application to register the disputed domain name.

On March 1, 2006, the Respondent Registry, after notification of the validation of the German Government Validation Point, accepted the application for the disputed domain name from Bayerische Staatsschauspiel on the first come first served basis in accordance with Article 14 of 'Commission Regulation (EC) Nº 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration' (hereafter “Commission Regulation 874”).

The Complainant filed the Complaint dated March 1, 2006 with the Czech Arbitration Court. The Complaint requested the Czech Arbitration Court to require EURid to disclose the Documentary Evidence as defined in '.eu Registration Policy and Terms and Conditions for Domain Name Applications Made during the Phased Registration Period' (hereafter the “Sunrise Rules”), that is the documentation “provided by (or on behalf of) the Applicant to the Processing Agent, in accordance with these Sunrise Rules”. On March 14, 2006 the Czech Arbitration Court filed the Documentary Evidence. On March 17, 2006 the Complainant submitted its comments on the Documentary Evidence.

On April 28, 2006 EURid submitted its Response.

On May 5, 2006 and after receiving the Statement of Acceptance and Declaration of Impartiality the Czech Arbitration Court appointed David J.A. Cairns as a Single Member Panel. On May 10, 2006 the Case File was forwarded to the Panel.

A. COMPLAINANT

The Complainant contends that the awarding of the disputed domain name to Bayerisches Staatsschauspiel violates Article10(2) of Commission Regulation 874 because according to this Regulation, the registration must relate to the complete name for which a prior right exists.

However, the complete name of the theatre is “Marstall-Theater”. The Complainant states that this is now the theatre is publicly known, and submitted documentary evidence in support.

The Complainant further stated that under Article 10 of Commission Regulation 874, public bodies have the possibility to register their own names. However, ‘Marstall’ is not the name of a public body. Rather ‘Bayerisches Staatsschauspiel’ is the name of the public body.

Further, Bayerisches Staatsschauspiel did not provide evidence of a registrable right to the name ‘Marstall’. Solely the ‘Bayerisches Staatsschauspiel’ but not ‘Marstall’ is registered in the validation list of the Free State of Bavaria. The fact that ‘Marstall’ is the designation for a building does not suffice, as only the complete name and not an abbreviation is registrable.

By way of remedy, the Complainant requests the annulment of the Registry’s decision to award the disputed domain name to Bayerisches Staatsschauspiel, and an order that it be transferred to the Complainant.

B. RESPONDENT

The Registry states that it accepted the application for the registration of the disputed domain name on the basis that Article 10 of Commission Regulation 874 provides that public bodies shall be eligible to apply to register domain names during the period of phased registration, and that the registration by a public body may consist of the complete name of the body or the acronym that is generally used. In accordance with Article 13 of Commission Regulation 874, the Member States provide for validation of these names.

The applicant is an institution of a local government and the name Marstall is the name generally used for a theatre in Munich administered by the applicant.

Therefore the Registry, upon notification of the validation by the German Government Validation Point, accepted for registration the application for the domain name Marstall on the first come first served basis in accordance with Article 14 of the Commission Regulation 874 .

The Respondent further states that Article 10 of Commission Regulation 874 does not require public bodies to hold a prior right. The Registry further states that Article 10(3) permits the registration of the name of a public body or the acronym generally used. The Government Validating Point, on behalf of the Member State, has examined and validated the application, so that the Registry must assume that the complete name of the public body as generally used is indeed Marstall.

DISCUSSION AND FINDINGS

Commission Regulation 874 provides, inter alia, for a procedure of phased registration for the .eu Top Level Domain in order to safeguard prior rights recognised by Community or national law. Phased registration is based on validation of rights, performed by appointed validation agents. The period of phased registration is also known as the ‘Sunrise Period’.

Article 10 of the Commission Regulation 874 provides for the eligible parties for phased registration and the names they can register. Article 10 recognises two distinct categories of eligible parties: (i) ‘holders of prior rights recognised or established by national and/or Community law’; and (ii) public bodies. Articles 10(2) and 10(3) define the names each type of eligible party might register.

Article 12 defines the principles for phased registration. It divides the Sunrise Period into two distinct parts of two months each. Article 12(2) provides that in the first part (‘Sunrise 1’): (i) Prior rights holders can apply only on the basis of registered national and Community trademarks and geographical indications; and (ii) Public bodies may apply on the basis of “the complete name of the public body or the acronym that is generally used” or the name of a territory governed by the public body.

Article 12.3 provides that a request to register based on prior rights “shall include a reference to the legal basis in national or Community law for the right to the name, as well as other relevant information, such as trademark registration number, information concerning publication in an official journal or government gazette, registration information of professional or business associations and chambers of commerce.” The documentary evidence required for a prior rights application is further set out in the Sunrise Rules.

The first part of the phased registration (Sunrise 1) began at 11:00 a.m. CET on December 7, 2005. The second part began at 11:00 a.m. on February 7, 2006.

Article 13 of Commission Regulation 874 provides for validation agents. There are two types of validation agents, reflecting the two types of eligible parties for phased registration: (i) Validation agents for prior rights (in practice PriceWaterhouseCoopers with whom EURid had an agreement to perform this service); and (ii) ‘Government Validation Points’ for the names of public bodies. These

Government Validation Points were designed by the Member States, and in the case of applications from Bavaria was the Ministry of the Interior of the State of Bavaria. The two types of validation agents had quite distinct functions.

The two eligible types of parties for phased registration (i.e. prior rights holders and public bodies) were not mutually exclusive in that a public body with a prior right could apply on the basis of its prior right and might also do so, for example, where its prior right related to a name for which the public body did not qualify for registration under Article 10.3.

Turning to the facts of the present case, there is confusion as to the basis of the application for registration of the disputed domain name by Bayerisches Staatsschauspiel. The application asserts a prior right to marstall, and is supported by a declaration and a letter confirming it is a public body, and the owner and user of the Marstall Theatre in Munich.

The application was filed in Sunrise 1, meaning that if a registration on the basis of a prior right was claimed, then it required evidence of a registered national or Community trademark for MARSTALL, or a geographical indication. The application was not supported by the required evidence, but only the declaration and letter mentioned above. The application was treated, however, as an application by a public body and referred to the Government Validation Point. The Response states that the Government Validation Point "considered that the applicant is known under the name Marstall", and has validated the application "so that the Registry must assume that the complete name of the public body as generally used is indeed Marstall."

Article 22(1)(b) of Commission Regulation 874 enables a complainant to initiate an ADR proceeding whenever "a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002." Paragraphs B11 and B12 of the ADR Rules provide for the basis and form of the decision.

This proceeding raises a question of the proper interpretation of Article 10(3) of Commission Regulation 874. In this Panel's view, Article 10(3) permits a public body to register: (i) its complete name; (ii) an acronym generally used; or (iii) the complete name of a territory (where the public body is responsible for governing that particular geographical territory). The right of a public body to phased registration is strictly defined, and there is no general right of public bodies to special treatment, or to priority in the registration of names they use. In particular, the fact that a public body is generally known by a certain name, or administers a facility under a certain name does not justify registration under Article 10(3). An acronym generally used, but not a name generally used, is registrable by a public body during phased registration.

This Panel is satisfied that the disputed decision of EURid to accept the application by Bayerisches Staatsschauspiel to register the disputed domain name conflicts with Commission Regulation 874 for the following reasons: (i) Bayerisches Staatsschauspiel had no prior right to register <marstall.eu> during Sunrise 1 because it provided no evidence of a a registered national or Community trademark for MARSTALL, or a geographical indication; (ii) Bayerisches Staatsschauspiel was not entitled to register <marstall.eu> as a public body pursuant to Article 10(3) because marstall is not its complete name, its acronym generally used, or the name of a territory for which it is responsible; (iii) the fact that the relevant Government Validation Point has examined and validated the application does not prove compliance with Commission Regulation 874 as there is no corroborative evidence before the Panel that Marstall is the complete name or acronym generally used of Bayerisches Staatsschauspiel, and the Registry's Response suggests the Government Validation Point misinterpreted Article 10(3) and wrongfully validated the application on the basis that it is the name generally used for a theatre in Munich administered by the applicant rather than the applicant's complete name or acronym generally used as required by Article 10(3).

The Complainant is entitled to an order annulling the registration, but not to the immediate transfer of the disputed domain name. The appropriate remedy in this type of case is provided for in Paragraph B11(c) of the ADR Rules. The Complainant is entitled to transfer provided that the Complainant is the next applicant in the queue for the registration of <marstall.eu> and subject to a decision by the Registry that the Complainant satisfies all registration criteria set out in the European Regulations and to the subsequent activation by the Registry of the domain name in the name of the Complainant who is the next applicant in the queue.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the decision of EURid Nº 00168 of March 1, 2006 is annulled and the domain name in question shall be transferred to the Complainant provided the Complainant is the next applicant in the queue for the registration of <marstall.eu> and subject to a decision by the Registry that the Complainant satisfies all registration criteria set out in the European Regulations and to the subsequent activation by the Registry of the domain name in the name of the Complainant who is the next applicant in the queue, in accordance with Paragraph B11(c) of the ADR Rules.

PANELISTS

Name	David Cairns

DATE OF PANEL DECISION 2006-05-10

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Article 10(3) of Commission Regulation 874 permits a public body to register: (i) its complete name; (ii) an acronym generally used; or (iii) the complete name of a territory (where the public body is responsible for governing that particular geographical territory). An acronym generally used by a public body is registrable during the phased registration period, but not a name generally used (other than its complete name). In the present case the Registry accepted the registration of the name generally used for a theatre in Munich administered by the applicant, but which was not the applicant's complete name or acronym generally used as required by Article 10(3). The Panel annulled the decision of the Registry and ordered its transfer to the Complainant provided that the requirements of Paragraph B11(c) of the ADR Rules were satisfied.