Panel Decision for dispute CAC-ADREU-000181

Case number	**CAC-ADREU-000181**
Time of filing	**2006-03-06 12:04:00**
Domain names	**oscar.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Jean-Baptiste PINEL**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

This Complaint arises out of the interpretation and application of Commission Regulation (EC) No 874/2004 of 28 April 2004 (“Regulation 874/2004”) and the .eu Registration Policy and Term and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter “the Sunrise Rules”)

Art. 10 (1) of said Regulation 874/2004 provides that holders of prior rights recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts, and that prior rights shall be understood to include, inter alia, registered national and community trademarks.

Art. 12(3) of said Regulation 874/2004 provides that the request to register a domain name based on a prior right 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.

Art. 3 of said Regulation 874/2004 provides that the request for a domain name shall include inter alia the name and the address of the requesting party and further that any material inaccuracy in the name shall constitute a breach of terms of registration.

Recital 12 of said Regulation 874/2004 sets out the purpose of the phased registration period in the following terms:

“In order to safeguard prior rights recognised by Community or national law, a procedure for phased registration should be put in place. Phased registration should take place in two phases, with the aim of ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights. The Registry should ensure that validation of the rights is performed by appointed validation agents. On the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name. Allocation of that name should then take place on a first-come, first-served basis if there are two or more applicants for a domain name, each having a prior right.”

The Sunrise Rules govern all applications during the phased registration period (vide Object and Scope).

Section 3.1 (1) of the Sunrise Rules states that an application is only considered complete when the Applicant provides the Registry, via a registrar, with at least the following information, inter alia the full name of the Applicant.

Section 11 (1) of the Sunrise Rules provides that "[d]uring the first phase of the Phased Registration Period, only Domain Names that correspond to (i) registered Community or national trade marks or (ii) geographical indications or designations of origin, may be applied for by the holder ...of the Prior Right concerned…"

Section 13 (1) (ii) of the Sunrise Rules provides that "[w]here the Prior Right claimed by an Applicant is a registered trademark, the trade mark must be registered by a trade mark office in one of the member states, the Benelux Trade Marks Office or the Office for Harmonisation in the Internal Market (OHIM), or it must be internationally registered and protection must have been obtained in at least one of the member states of the European Union."

Section 11 (3) the Sunrise Rules, the Applicant for a domain name must be the owner or licensee of the claimed Prior Right.

The Complainant is an agricultural co-operative undertaking, established in France within the European Community and is the registered owner of Community Trade Mark OSCAR, CTM n° 004007101, filed on 18 August 2004, and registered on 15 November 2005.

On 7 December 2005, the Applicant applied to register the domain name <oscar.eu> during Phase I of the phased registration period.

In support of its application under the Sunrise Rules, the Complainant relied inter alia on said CTM registration OSCAR, CTM n° 004007101 as establishing its Prior Right. The Complainant's ownership of said trade mark registration is not in dispute and the Complainant has submitted documentary evidence of said registration in the form of an extract from the OAMI-online database.

The Complainant submits that the domain name and the trade mark on which it claims a Prior Right are absolutely identical. This is obvious and is not disputed by the Respondent.

The automated application system provided to applicants, including the Complainant, by the registrar imposed a limitation of 30 characters on the field in which applicants were permitted to enter their respective names. It is a fact not in contention.

In the application for the domain name <oscar.eu> received from the Complainant by the Respondent, the name of the Complainant was therefore, due to the technical limitations of the automated system, truncated to "SOCIETE COOPERATIVE AGRICOLE D" rather than the full name "SOCIETE COOPERATIVE AGRICOLE DES PRODUCTEURS DE KIWIFRUITS DE FRANCE".

The Respondent refused to register the domain name <oscar.eu> in the name of the Complaint during the Sunrise Period on the grounds that the Complainant’s application did not provide the full name of the Complainant and that the documentary evidence furnished did not substantiate that the applicant for the domain name is the holder of the Prior Right on the domain name.

A. COMPLAINANT

The Complainant submits that the error in its name was due to a technical problem created by the limitations of the automated application system made available to applicants by the Registrar. The automated system was deficient in that the limitation on the number of characters in the field provided for the name of an applicant, resulted in the Complainant’s name being truncated because it was too long.

The Complainant submits that even though its name was truncated in the Application, it was easily recognisable. Furthermore, the address of the Complainant in the Application for registration of the <oscar.eu> domain name is identical to its address in the documentary evidence provided by the Complainant relating to its business and its CTM registration.

The Complainant requests that in considering the foregoing, i.e the identity of the Complainant's address in the Application and in the documentary evidence provided by the Complainant, and the similarity between the beginning of the name of the Applicant in the Application and the name of the owner of the claimed Prior Right, the Panel should determine that the deficiency was only technical, and was not legal.

The Complainant requests the Panel to decide that its Application was in accordance with the .eu Regulations, and that the Respondent's decision to reject the Application was not in accordance with the .eu Regulations.

B. RESPONDENT

The Respondent submits that application received by the Registry referred to the Applicant as being the "SOCIETE COOPERATIVE AGRICOLE D". The documentary evidence on the other hand referred to the owner of the CTM being the Prior Right as being the SOCIETE COOPERATIVE AGRICOLE DES PRODUCTEURS DE KIWIFRUITS DE FRANCE".

Therefore the Respondent, upon notification of the findings by the validation agent that the Application did not provide the full name of the Complainant and that the documentary evidence did not substantiate that the applicant for the domain name is the holder of the Prior Right on the domain name rejected the application.

Specifically addressing the statements and allegations made in the Complaint, the
Respondent submits as follows:

1. The Complainant is said to be a M. Jean-Baptiste PINEL, resident at the same address of the applicant but without further qualification, while the authorised representative of the Société Coopérative is said to be a Mr Olivier Barloy. The Registry nevertheless assumes that the Complainant is the Société Coopérative Agricole des Producteurs de Kiwifruits de France, represented by the said persons.

2. The Complainant states that the truncation of the name of the applicant was due to a technical problem with the registrar. The number of characters in the name of the Applicant was limited to the first 30 by the Registrar's automaton. The Respondent does not dispute this statement.

3. The Complainant claims that the beginning of the applicant's name, even if it has been truncated is easily recognisable. Furthermore, the identity between the address in the application and the address in the documentary evidence is not ambiguous, as both addresses are strictly identical and asks the Panel to state that the problem was only technical and was not legal.

The Respondent submits however, since article 3 of EC Regulation 874/2004 states that a material inaccuracy in the name of the applicant constitutes a breach of the terms of registration, the problem is on the contrary to be considered as legal, not or not only as technical. The Registry nor the Panel are allowed to consider the said inaccuracy otherwise than as a breach of the terms of registration.

4. The argument that the identity of the addresses in the application and in the documentary evidence and the similarity in the names of the applicant and of the trademark owner make the name recognisable is therefore not relevant.

DISCUSSION AND FINDINGS

Based on the case file the Panel determines as follows:

The Panel accepts the Respondent's assumption that that the Complainant is the Société Coopérative Agricole des Producteurs de Kiwifruits de France and not M. Jean-Baptiste PINEL

The Complainant is the owner of the CTM registration OSCAR. Due to a technical limitation in the automated application system provided by the Registrar, the Complainant was limited to thirty characters in the field provided for its name. This is

not disputed by the Respondent.

The Complainant correctly inserted its name insofar as the automated system permitted.

The purpose of the phased registration period as set out in Recital 12 of the Regulation is “to safeguard prior rights recognised by Community or national law.”

The Respondent does not dispute that the Complainant is both the owner of the CTM registration for the trade mark OSCAR. Neither does the Respondent dispute that the Complainant and was the applicant for the <oscar.eu> domain name. There is no question of there being any bad faith or error on the part of the Applicant. The difficulties were caused solely by a technical limitation in the system.

Contrary to the Respondent’s submission, the Complainant’s argument that the identity of the addresses in the application and in the documentary evidence and the similarity in the names of the applicant and of the trademark owner make the name recognisable is very relevant.

These facts that demonstrate that the Complainant was the applicant during the phased registration period and that the Complainant is the owner of the Prior Right on which the application is based. The intended purpose of the phased registration period as set out in Recital 12 of said Regulation 874/2004 was “to safeguard prior rights recognised by Community or national law”.

In the circumstances this Panel is satisfied that on the particular facts of this case, a teleological or purposive interpretation of the legislation would classify the problem met by the Complainant in this case as being technical and not legal. The Complainant complied with both the Regulation and the Sunrise Rules insofar as it was possible so to do. The possibility of applying under an acronym was not available to it under either the Regulation or the Sunrise Rules.

This Panel is satisfied that there was no “material inaccuracy” in the name of the Complainant as contemplated by Art. 3 interpreted in a teleological manner the light of Recital 12 of said Regulation 874/2004.

In the circumstances the decision of Respondent should be annulled.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the EURID's decision be annulled and the domain name <oscar.eu> be registered in the name of Société Coopérative Agricole des Producteurs de Kiwifruits de France.

PANELISTS

Name	**James Bridgeman**

DATE OF PANEL DECISION 2006-05-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Article 3 of Commission Regulation (EC) No 874/2004 of 28 April 2004 provides that a request for a domain name shall include inter alia the name and the address of the requesting party and further that any material inaccuracy in the name shall constitute a breach of terms of registration.
Due to technical limitations in the automated application system provided by the Registrar the Complainant was unable to include all characters in its long name Société Cooperative Agricole des Producteurs de Kiwifruits de France.
The application received by the Registry referred to the applicant for this domain name as being the "SOCIETE COOPERATIVE AGRICOLE D" and the application was refused.
The Complainant submitted that the error was technical only. The Respondent submitted that the error was both technical

and legal. The Panel determined that the defect in the application was technical in nature and that there was no “material inaccuracy” in the name of the Complainant as contemplated by Art. 3 interpreted in a teleological manner the light of Recital 12 of said Regulation 874/2004.

The Panel directed that the decision of EURID be annulled and the domain name <oscar.eu> be registered in the name of Société Coopérative Agricole des Producteurs de Kiwifruits de France.