Panel Decision for dispute CAC-ADREU-000191

Case number	**CAC-ADREU-000191**
Time of filing	**2006-03-16 12:03:19**
Domain names	**autotrader.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Trader Media**

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

None the Panel is aware of.

FACTUAL BACKGROUND

The Complainant is Trader Media Group Limited.
On 07 december 2005 First European Technology Limited (hereinafter “First”) applied for the domain name “autotrader.eu”, on the basis of a prior right based on Benelux trademark n. 1091502 for the word “autotrader”, registered on 22 november 2005 Pursuant to art. 14 of Regulation 874/04 of 28 April 2005.
On 05 january 2006, before the deadline of 16 january 2006, the Registry received documentary evidence of the prior right.
On 07 december 2005, 26-minutes after First, complainant filed an application for the same domain name.
On 05 march 2006, the Registry decided to accept First application.
On 03 march 2006, complainant filed compliant against respondent, asking the annulment of respondent decision on the basis of art. B 11 (c) of Alternative Dispute Resolution Rules (“ADR Rules”) and its transfer to complainant, the next in the queue of contested domain names.
Upon notification of some deficiencies in the complaint by the Czech Arbitration Court (CAC) and subsequent amendments timely filed by complainant, on 10 april 2006 CAC notified the parties of the commencement of ADR proceeding, according to paragraph B.2 (a) and of ADR Rules.
Having failed to respond within the time limit set out in the above communication, on 02 june 2006 CAC filed the Respondent with the Notification of Respondent’s Default.
On 06 june 2006 Respondent filed a non-standard communication through the On-line platform, taking position against complainant findings;
On 12 june 2006 CAC appointed Mr. Roberto Manno as sole Panelist in deciding this case
On 22 june 2006 the Panel asked the Complainant to disclose further evidence about some circumstances referred by complainant, timely filed in the non-standard communication on 27 june 2006.

A. COMPLAINANT

Complainant contends as follows:
Complainant is the owner of national and community trademarks on the word autotrader (including: Ireland Auto Trader n. 176760 on 1995.27.1; Uk n. 2019603 on 18.10.1996; Germany n. 39935329 on 10.05.2000 and other EC community trademarks); using “auto trader” brand extensively for hardcopy and online selling motoring magazine through several ccTLDs as .de/.ie/.nl/.nu/.no/.co.uk; and therefore owns earlier rights on the word “auto trader”.
It is complainant’s submission that First application of “autotrader.eu”, which is identical to complainant’s brand name, have been made in bad faith, under circumstances set out under art.21.3 Regulation 874/04 – a): purpose of selling, renting, or otherwise transferring the

domain name to a holder of a name in respect of which a right is recognised or established by national and/or Community law; – b): registration of “autotrader.eu” as a blocking tactic in order to prevent the Complainant, which is the well known owner of the Auto Trader brand, from being able to reflect this name in a corresponding .eu domain name; and – c): registration for the primarily purpose of disrupting the professional activities of a competitor.
Complainant fulfills the burden of proof set out in Art. B 1(b) 10 (ii) of ADR Rules, providing evidence on the above-mentioned circumstances, which would substantiate the conflict between respondent’s decision and EU regulations.
Pursuant to Art. B 11 (c) of ADR Rules, the complainant asks the Panel that the Respondent annuls its disputed decision and transfers the domain name autotrader.eu to the complainant, as complainant states that he is the next applicant in queue for the domain name concerned, and as previous applications are expired, and having the general eligibility criteria for registration as for paragraph 4(2)(b) of Regulation EC 733/02 being fully satisfied.

B. RESPONDENT

Respondent failed to file a response in due time.
The Panel will refer to respondent’s late response for informational purposes. In its late response Respondent requested the dismissal of the complaint according to Art. 22.1 (b) of Regulation 874/04 and Section 26.2 of the Sunrise Rules, establishing that the sole object and purpose of ADR proceeding against the Registry is to verify whether the relevant decision by the Registry conflicts with Regulation 874/04 or Regulation 733/02.
The contested decision is therefore compliant with “first-come, first-served” principles as set out in Art. 14 of Regulation 874/04 and other validation and registration principles.

DISCUSSION AND FINDINGS

This case is dealing with bad faith as set out by Art. 21.1 (b) of Regulation 874/04 (the Public Policy Rules “PPR”), which provides that “A registered domain name shall be subject to revocation (…) where that name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10 (1), and where it: (…) (b) has been registered in bad faith.”
Those bad faith registrations, together with registration without right or legitimate interest in the domain name, form the basis for the art. 21 PPR “abusive and speculative registrations” revocation procedure.
The Panel believes that revocation procedure under art. 21 PPR may be initiated only against the domain name holder, who is the exclusive author of the intentional misleading, deceiving conduct oriented in gaining unlawful advantage.
Indeed, under Art. 22.11 PPR the ADR Panel shall decide in case of procedure against domain name holder the revocation of the domain name if he finds that registration is abusive or speculative; whereas in case of procedure against the Registry [the Panel] will decide (only) whether a decision taken by the Registry conflicts with PPR (chapter IV: phased registration provisions) or Regulation 733/02.
A different conclusion should deprive the domain name holder of the right to defense, which is a basic legal principle also confirmed by Art. 22.2 of PPR, where participation of the domain name holder (in speculative and abusive registration procedure) and the Registry (for failure to comply with Eurid’s obligations) is compulsory.
This opinion is consistent with case No. 210 (BINGO), where the Panel argued that “Eurid’s obligations as to registration of domain names in the phased registration period are set out clearly in Art. 14 of PPR. Eurid has no authority during the phased registration period to investigate whether or not an application is made in bad faith within the meaning of Art. 21 of PPR.” The Panel further agrees with that “It is inconceivable that EURid itself could address issues arising under Article 21, which self-evidently require the holder of the domain to be the respondent”.

Therefore, Complainant’s further allegations concerning First bad faith in the disputed domain name registration may not be taken into account in the present case. Notwithstanding this, the Panel argues that the confusion between complainant more senior right on the “auto trader” brand and First domain name registration, depends more on the descriptive nature of this sign rather than an intentional misleading purpose as set out under art. 21.3 (a), (b) or (c).
In the Panel view, complainant’s rights have been only accidentally and unintentionally involved in First’s strategy, consisting in gaining as much as possible generic TLDs, incl. “mortgageloan”; “cellphone” and “porno”. In presence of a valid trademark registration, as those issued by the Benelux trademark office, the Registry may only accept corresponding domain name applications, according to registration and validation principles set out by PPR and Sunrise Rules.

Having said that, it appears that respondent’s decision to accept First application was formally correct in respect of articles 10 (1); 12.3 and 14 of PPR. Respondent, after notification of the findings by the validation agent that a prior right exists regarding the domain name in the name of applicant (excerpt of online trademark database of Benelux Trademark Office for n.1091502 “Autotrader”), correctly decided to register the domain name.

DECISION

For the foregoing reasons, in accordance to Article 22.11 second subparagraph of EC Regulation no. 874/2004 and paragraph B11(c) of the ADR Rules, the Panel orders that:
- the complaint is denied

PANELISTS

Name	Roberto Manno

DATE OF PANEL DECISION 2006-06-20

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The complainant filed a complaint against Respondent on the basis of art. B 1(b)10(ii) of ADR Rules alleging that such decision to register the “autotrader.eu” was in conflict with EU regulation; namely “bad faith” under art. 21.1(b) of 874/04 Regulation (PPR). The complainant disclosed evidences according to art. 21.3 (a), (b) and (c) circumstances. The Respondent failed to file a response within the time limit. The Panel dismissed the compliant on the basis that, under art. 22.1 (b) and 22.11 second subparagraph, combined with section 26.2 of the Sunrise Rules, abusive and speculative registrations as set out in art.21 PPR are out of the scope of ADR proceedings against the Registry.