Panel Decision for dispute CAC-ADREU-000207

Case number	**CAC-ADREU-000207**
Time of filing	**2006-03-06 14:59:35**
Domain names	**merak.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Merak NV**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

The complaint was received by the Center by e-mail and in hardcopy on March 6th, 2006. The complainant challenges the rejection of the complainant's application for registering the Domain <merak.eu>.The formal commencement of the ADR proceeding is March 16th, 2006.

A. COMPLAINANT

The complainant is the holder of several trademarks; all of them contain the element "merak". On December 7th, 2005, the complainant filed with the accredited registrar Bsys the application for <merak.eu> during the first sunrise period. The complainant was the first applicant for the disputed domain; the second application for <merak.eu> was filed on December 20th, 2005 by Merka S.L Telecomunications I Sistemes.
Bsys uploaded the proofs of registration of the figurative community trademarks No 002962330, 000003020 and 000413187 on December 28th, 2005. The dominant element of the said trademarks is the word "MERAK".
Whereas the trademarks 000003020 and 000413187 are registered, the trademark No 002962330 is subject to opposition.
The registry's decision of January 25th, 2006 has merely taken into account the fact that the trademark is subject to opposition, but not the two other trademark registrations submitted to the validation agent which are in full force and effect.
One trademark registration is sufficient to show a prior right.
The decision of January 25th, 2006 therefore conflicts with article 14, § 10 of the Reg (EC) No 874/2004.

B. RESPONDENT

The respondent did not oppose the annulment of the decision.

DISCUSSION AND FINDINGS

By virtue of Art 10.2 Reg (EC) No 874/2004, prior rights shall be understood to include, inter alia, registered community trademarks. By virtue of Section 11 of the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period, during the first phase of the Phased Registration Period only Domain Names that correspond inter alia to community trademarks may be applied for. In order to prove the trademark registration, it is sufficient to submit an extract from an official database. A trademark application is not considered a Prior right; the same is

true for trademarks which are subject to opposition.
Because of the fact that the complainant was the first applicant for the domain <merak.eu> and its accredited registrar submitted extracts from the registered figurative community trademarks No 000003020 and 000413187 in time, the Panel is of the opinion, that when examining the complainants application for the domain <merak.eu>, the registry did merely take into account the trademark for which an opposition was pending, and disregarded the two other trademark registrations submitted to the validation agent which were in full force and effect. One trademark is enough to establish prior rights for the application in the first phase of the Phased Registration Period.
The fact that the trademarks in questions are figurative trademarks does not exclude the complainant from registering in the first phase, because the dominant element of the figurative trademarks is the word “MERAK”.
This finding is also supported by respondent’s contentions in its response.

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.

PANELISTS

Name	**Flip Jan Claude Petillion**

DATE OF PANEL DECISION 2006-05-23

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The complainant challenged the rejection of its domain name application by the registry. Although the complainant was the first applicant for the domain name <merak.eu> and its accredited registrar submitted the proofs of three community trademark registrations in time, the registry rejected the application.
One of the three uploaded trademark registrations was subject to opposition; the registry therefore took the view that the complainant did not poof its prior right. However, the registry did not take into account the two other trademark registrations submitted to the validation agent which were in full force and effect.
The Panel therefore annulled the registry’s decision, as the proof of one prior right is sufficient for an applicant to become the holder of a .eu domain name.