Panel Decision for dispute CAC-ADREU-000210

Case number	**CAC-ADREU-000210**
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Domain names	**bingo.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Bernd Single**

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 a natural person, with a place of business in Sigmaringen, Germany. He is a manufacturer of equipment for dentists and dental technicians. His business has traded since 1989, and makes crowns, inlays and implants for use in dental laboratories. The Complainant is the holder of the German word mark “bin GO” which was filed on 14 September 2005, and registered on 31 December 2005. The registration covers goods and services in class 5 (mass for taking impressions for dental purposes, alloys of precious metals for dental purposes, gold amalgam for dental purposes, porcelain for dental purposes), class 10 (tooth prosthesis, artificial teeth) and class 14 (services of a dental technician).
The party which registered the disputed Domain Name, Dentikon GmbH (“Dentikon”) is a German company, based in Wuppertal. The Complainant states that Dentikon is an internet service firm. It is the owner of the German word/picture mark “BINGO” registered on 14 April 2005, in class 2, covering paints, varnishes, lacquers, for business use, arts and crafts. The mark consists of the word “BINGO” in lower case, against the background of an arrow device, consisting of horizontal stripes, which (in descending order) are respectively red, blue, yellow and green, followed by a wider black stripe (where the word “BINGO” appears), and then a smaller black stripe. Dentikon is the owner of 21 other similar German word/picture marks, comprising the same arrow-like symbol, and the words “business”, “casino”, “computer”, “domain”, and seventeen other similar words in common use. All of them are registered in the same class, and for the same goods. Dentikon has also applied for .eu domain names for each of the words for which it has registered marks in this form.
The Respondent, EURid, decided to register the disputed Domain Name to Dentikon on 8 March 2006.

A. COMPLAINANT

The Complainant contends the following:
Lack of Prior Rights
The Complainant assumes that Dentikon has based its domain name application in the phased registration period upon the national German mark for “BINGO” identified above. In order to obtain a registration in the phased registration period, the applicant must meet the criteria of Articles 10 and 14 of Commission Regulation number 874/2004 (“the Public Policy Rules”). Article 10 provides that holders of prior rights recognized or established by national and/or Community law and public bodies should be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts. “Prior rights” include inter alia registered national trade marks. Article 14 requires the Registry (EURid) to examine all claims for prior rights, by reference to documentary evidence which demonstrates the right under the law by virtue of which it exists. EURid is to register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedures set out in Article 14.
In relation to the phased registration period the .eu Registration Policy and Terms and Conditions for Domain Name Applications made

during the Phased Registration Period ("the Sunrise Rules"), Section 19, provides that the documentary evidence required must clearly depict the name for which a prior right is claimed. A prior right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos, etc.) will only be accepted if:

(i) the sign exclusively contains a name, or
(ii) the word element is predominant, and can be clearly separated or distinguished from the device element,
provided that
(a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the Domain Name applied for, in the same order as that in which they appear in the sign, and
(b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear.

The Complainant argues that these conditions have not been fulfilled by Dentikon. The mark in question is a figurative one. The main and predominant part of the mark is the colourful arrow, whereas the word "BINGO" is a simple annex which lies by far outside of the predominant feature of the figurative mark. In support of this, the Complainant refers to the other marks which Dentikon has registered, and contends that the words on each mark are fully exchangeable, without any effects on the mark and its predominant colourful arrow. Therefore, the Complainant contends that EURid's decision to register the disputed Domain Name to Dentikon constitutes a breach of Articles 10 and 14 of the Public Policy Rules, and Section 19 of the Sunrise Rules.

Bad Faith
The Complainant's second argument is that the conduct by Dentikon in applying for the disputed Domain Name and 21 other domain names based upon the series of figurative trade marks, constitutes "speculative" registration, within the meaning of Article 21 of the Public Policy Rules, and that EURid's decision to register the disputed Domain Name to Dentikon in such circumstances is subject to review under Article 22(1)(b) of the Public Policy Rules, as "a decision taken by the Registry" which conflicts with the Public Policy Rules. In support of this contention, the Complainant refers to the fact that the twenty two figurative marks were all filed by Dentikon on the same date, before the phased registration period commenced, in respect of marks which relate to goods and services in class 2, which have no apparent connection with Dentikon. In addition, the words on those marks appear to have no connection to the goods in class 2. The Complainant argues that the registrations were made in bad faith, within the meaning of Article 21(3) of the Public Policy Rules as the circumstances indicate that the Domain Name bingo.eu was registered or acquired primarily for the purposes of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognised or established by national and/or Community law or to a public body. The Complainant argues that it is the holder of the mark "bin GO", which is identical or confusingly similar to the domain name.
Therefore, the Complainant contends that EURid's decision conflicts with Articles 10 and 14 of the Public Policy Rules, Section 19 of the Sunrise Rules, and also with Article 21 of the Public Policy Rules.
As the next Applicant in the queue for the domain name concerned, with prior rights in the "BINGO" name, the Complainant requests the attribution of the domain name bingo.eu to the Complainant, in accordance with the permitted basis in Section B11(c) of the .eu Alternative Dispute Resolution Rules ("ADR Rules").

B. RESPONDENT

The Respondent (EURid) replies to the Complaint as follows.
EURid confirms that it found that prior rights existed regarding the disputed Domain Name, on the basis of the application for the registration of the domain name bingo.eu by Dentikon on 7 December 2005, which was accompanied with documentary evidence by way of a copy Certificate of Registration from the German Trade Mark Office. This was in compliance with the requirements of Article 10(1) of the Public Policy Rules, and Section 13.1(1) of the Sunrise Rules which provide that where the prior right claimed by an applicant is a registered trade mark, the trade mark must be registered by a trade mark office in one of the member states. As Dentikon was the first in line of applicants for the disputed Domain Name, EURid accepted this application, and decided to register the domain on the first come, first served basis referred to in Article 14 of the Public Policy Rules.
Lack of Prior Rights
EURid does not accept the Complainant's contention that the word "BINGO" included in the figurative sign is not the predominant element, being just an annex, and not clearly separated from the device element. The Complainant refers to the word "BINGO" being exchangeable, and therefore not predominant, looking at the twenty one other trade marks concerned. EURid's response is that if the word is exchangeable, it must at least be clearly separated or distinguished from the device mark. EURid does not accept that because there are twenty one other trade marks registered by Dentikon with the same figurative element, that means that the figurative element is predominant. EURid concludes that the word element "BINGO" in this particular trade mark in question complies with Section 19 of the Sunrise Rules.
Bad Faith
EURid argues that it is obliged according to Article 14 of the Public Policy Rules to register the disputed Domain Name on the first come

first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in that Article, which Dentikon has done. The validation and registration rules for applications received during phased registration do not allow EURid to reject an application for its speculative or abusive character.

DISCUSSION AND FINDINGS

Lack of Prior Rights
The principal obligations of EURid regarding its decisions to register .eu domain names during the phased registration period are regulated by Article 14 of the Public Policy Rules. The final paragraph of that Article states that EURid shall register the domain name on a first come, first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in Article 14. Article 12(1) of the Public Policy Rules requires EURid to publish a detailed description of all the technical and administrative measures that it shall use to ensure a proper, fair and technically sound administration of the phased registration period. Those measures are set out in the Sunrise Rules. Section 19.2 of the Sunrise Rules is set out above.
The test which EURid has to apply in this case is whether the word element "BINGO" included in the figurative sign registered as a trade mark in Dentikon's name is predominant and can be clearly separated or distinguished from the device element. EURid concluded that the word element "BINGO" was predominant, and could be clearly separated from the device element.
The Complainant contends that the mark has to be regarded as being one of a series of marks, all with the same background, and that the background is therefore the predominant feature. However, the Panel agrees with EURid that each mark needs to be looked at individually (apart from anything else, faced with an application to register one particular domain name, EURid would not necessarily have access to any other information which would put that application in a wider context).
The Panel considers that the "device element" of the mark in this case lacks distinctiveness, being an unremarkable arrow shape, divided by a number of horizontal, parallel lines, or sections of colour. The Panel agrees with EURid's conclusion that the word element of the mark is predominant, and that it can be separated from the device element, without difficulty.

Bad Faith
The Complainant's arguments appear to the Panel to be misconceived. EURid's obligations as to registration of domain names in the phased registration period are set out clearly in Article 14 of the Public Policy Rules. 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 Article 21 of the Public Policy Rules.
Furthermore, the procedure involved in contesting EURid's decision to allocate the Domain Name to Dentikon does not permit Dentikon to be a party to these proceedings. Dentikon is not, therefore, in a position to answer the Complainant's grounds in this respect.
The Complainant points to Article 22(1)(a) of the Public Policy Rules as allowing a party to initiate an ADR procedure where the registration is speculative or abusive within the meaning of Article 21. However, in the Panel's view, such an ADR procedure would clearly envisage a procedure to which the holder of the domain name should be a respondent, not EURid. Where its conditions are made out, Article 21(1) of the Public Policy Rules itself expressly envisages the "revocation" of a domain name, not the refusal by EURid to register it. 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. The Respondent in this case is EURid, not Dentikon. In the context, this is an ADR procedure addressed solely at the decision taken by EURid to register the disputed Domain Name which, necessarily, requires consideration of EURid's obligations under Article 14 of the Public Policy Rules, and the Sunrise Rules, rather than the motives of the holder of the mark. The Panel considers that EURid's decision under those obligations is not subject to review in this ADR procedure by reason of the factors set out in Article 21.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the Complaint is Denied

PANELISTS

Name	Robert Elliott

DATE OF PANEL DECISION 2006-05-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant challenged EURid's decision to register the disputed domain name "bingo.eu". The Complaint proceeded on two grounds:

1. Lack of prior rights; and

2. Bad faith.

As to the adequacy of prior rights, the Panel agrees with EURid's assessment that the domain name holder had demonstrated prior rights in accordance with Section 19.2 of the Sunrise Rules. The Panel agreed with EURid's assessment that the word "BINGO" against the background of a device mark consisting of an arrow, in various colours, was the predominant feature of the registered trade mark in question, and capable of being separated from the remainder of the mark. The Panel rejected the Complainant's suggestion that the mark also needed to be considered in the context of 21 other marks owned by the domain name holder with similar backgrounds, but different words.

As to bad faith, the Complainant's argument was that the evidence showed that the registration was a speculative registration within the meaning of Article 21 of the Public Policy Rules. The Panel agreed with EURid's conclusion that it was not obliged to make an assessment in accordance with Article 21. Its decision which was subject to challenge was made under Article 14 of the Public Policy Rules, and not susceptible to challenge on the grounds of a conflict with Article 21 (which would require a separate ADR procedure addressed to the holder of the mark, rather than EURid).

The Panel dismissed the Complaint.