Panel Decision for dispute CAC-ADREU-000258

Case number	CAC-ADREU-000258
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Domain names	sex.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	topeu.com s.r.o., martin konig topeu.com s.r.o.

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

I am unaware of any other legal proceedings which are pending or decided and which relate to the disputed domain name

FACTUAL BACKGROUND

On 7 December 2005, a company called Yellow Register On Line AB ("Yellow") applied for the domain name "sex.eu" on the basis of a Prior Right - in this case a prior trade mark right. Yellow submitted documentary evidence in support of its application within the necessary deadlines and the Registry subsequently accepted Yellow's application and awarded it the "sex.eu" domain.

The Complainant argues that the Registry was wrong to allocate the domain to Yellow and that the Complainant is properly entitled to that domain on the basis of it holding a prior trade mark right covering the whole "sex.eu" domain name - inclusive of the '.eu' suffix.

The Complainant does not dispute (a) the fact that Yellow was first in line or (b) that Yellow has a prior right for the mark "sex"

A. COMPLAINANT

The Complainant seeks the revocation of the Registry decision whereby the domain name "sex.eu" was awarded to Yellow and asks that the domain be transferred to the Complainant.

The Complainant states that the allocation of the domain to Yellow was "illegal" and in violation of EU regulation 874/2004, in particular Article 10(2) of the said regulation. The Complainant contends that the proper interpretation of Article 10(2), especially the phrase "..the registration of the complete name for which the prior right exists" is that it means that the entire domain name, inclusive of the '.eu' suffix, must be reflected on the trade mark registration certificate or other document supporting the prior right.

Given this, they say that the Registry was mistaken in allocating the 'sex.eu' domain to Yellow and that the Complainant is properly entitled to that domain in that the Complainant holds a German trade mark registration for a word and device mark which includes the component "sex.eu".

B. RESPONDENT

The Respondent also relies on Article 10(2) but argues that the correct interpretation of the "complete name" is that it must exclude the '.eu' suffix. On this basis, the Respondent maintains that the Registry was correct in allocating the "sex.eu" domain to Yellow.

The Respondent also cites case No. 0271 (CASINO) in which the Complainant there relied on very similar arguments to the current Complainant (in fact, they are one and the same Complainant). The Respondent explains that the panel in the CASINO case rejected the Complainant's arguments as "incorrect" and stated that the '.eu' suffix is "no part of the domain name under the Regulations". The Panel

in CASINO concludes that " Prior rights in a domain name consequently only relate to wording of the domain name without the suffix .eu."

The Respondent further cites clause 11(c) of the ADR Rules and insists that even if the Registry decision were to be anulled, the Complainant's transfer request must be rejected; although the Respondent does not clarify on what basis.

DISCUSSION AND FINDINGS

I am unable to find anything in any of the Rules or the EU regulations which supports the arguments of the Complainant.

The clear intention of the Rules and Regulations is to give owners of prior rights the opportunity to register those rights under the new .eu tld regime. I therefore consider that it is self-evident that the meaning of "complete name" under Article 10(2) of EU regulation 874/2004 is the name excluding the .eu suffix. Were this not the case, then those companies who had gone out of their way (whether cynically or otherwise) to register a range of trade marks including '.eu' would effectively gain preference over all other trade mark owners in their rights to .eu domains. To impart such a construction would be to clearly contradict the letter as well as the spirit of the Regulations and to undermine the very purpose of the Sunrise period.

I think it is also worth pointing out that the Rules and Regulations generally draw a distinction between the "name" which an applicant seeks to register and the relevant domain name, which will include the addition of the .eu suffix. For example, section 19(2) of the Sunrise Rules states that "Documentary Evidence must clearly depict the name for which a Prior Right is claimed". This distinction is important, for it illustrates that they are two separate but linked components - namely the name which makes up the substantive part of the domain and the .eu suffix which is attached once that name is registered as a domain name. The two things are separate and distinct and are treated as such thoroughout the Rules and Regulations and I am not able to accept that we should ignore this distinction and treat the two as one. Section 2(2) of the EU Domain Name Terms and Conditions states that "Only the following names can be registered as a Domain Name.....(ii)(b) maximum of 63 characters (not including the .eu suffix)".; showing clearly that the name and the suffix are two separate elements of the domain.

I therefore reject the Complaint and conclude that the Complainant has shown no basis for questioning the Registry's decision in awarding the "sex.eu" domain to Yellow on a first-come, first-served basis.

I note the decision of the panel in case no. 271 (CASINO) and agree with the approach taken there. However, I would point out that, in its Response, the Respondent (and perhaps the panel in case no 0271) seems to have confused the use of the terms 'name' with the use of the term 'domain name. In stating that the "'.eu' suffix is no part of the domain name under the Regulations", the Respondent (or the panel) has confused these two terms. In my view the .eu suffix is an integral and necessary part of the domain name. The point is that the suffix is no part of the name, which is the element on which Prior Rights are based and which forms the other necessary part of a domain name.

Given my decision, there is no need to consider the merits of the trade mark registration submitted by the Complianant or any other aspect of its claims. However, I note that the Complainant requested the revocation of the Registry decision, a remedy strictly only available where the domain name holder is the Respondent. The panel in case no. 0271 (CASINO) has previously commented on this technicality and I will not elaborate further here.

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	**James Mitchell**

DATE OF PANEL DECISION 2006-09-06

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The panel is of the opinion that the arguments of the Complainant are not well founded and the Complaint is denied.

The construction which the Complainant seeks to put on Article 10(2) of EU regulation 874/2004 is not supported by evidence and is

plainly at odds with the spirit and the letter of the Rules and Regulations.

This panel is of the view that the meaning of "complete name" under Article 10(2) of EU regulation 874/2004 is the name excluding the .eu suffix. To impart any other construction would be to contradict the Regulations and to undermine the very purpose of the Sunrise period.

The decision of the panel in case no. 271 (CASINO) is noted and approved.

Given the decision, there is no need to consider the other remedies the Complainant seeks.