Panel Decision for dispute CAC-ADREU-000261

Case number	**CAC-ADREU-000261**
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Domain names	**best.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

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain names.

FACTUAL BACKGROUND

This present case arises further to a complaint filed by a Czech company Topeu.com s.r.o. (“the Complainant”) against the decision by Eurid (“the Respondent”) to register the domain “best.eu” (“the Disputed Domain Name”) to Olaf Sprinz (“the Applicant”).

On 7 December 2005, Olaf Sprinz applied for the domain “best” under the top level domain “.eu” during the first so-called “sunrise period”. The Applicant relied on German trade mark registration n° 1186833 BEST filed on 12 June 1990 and duly renewed on 13 June 2000. The documentary evidence, of the rights owned by the Applicant, was submitted to the Eurid in due course and received by the validation agent on 10 January 2006 i.e. before the deadline set for 16 January 2006. The evidences consist of, in particular, a registration excerpt of the German Trade Mark Office database and a certified copy of the renewal of registration.

The validation agent and Eurid accepted to registration the domain BEST under the top level domain “.eu” in the light of the evidences filed.

On 30 May 2006 the complainant filed a complaint before the Czech Arbitration Court, requesting the revocation of the decision of grant of the Disputed Domain Name and the transfer of the latter to its benefit for being the second in queue.

On 31 May 2006 the Czech Arbitration Court acknowledged receipt of the complaint and notified it to the Eurid.

On 25 July 2006, the Respondent filed a response to the Complaint.

On 27 July 2006, the Czech Arbitration Court appointed Mr David-Irving TAYER as sole panelist in this case. The Panel finds that it was properly constituted and submitted the Statement of acceptance and Declaration of Impartiality in compliance with the ADR Rules and Supplemental ADR Rules.

On even date the Complainant challenged the appointment of Mr David-Irving TAYER as panelist.

On 2 August 2006, the Czech Arbitration Court decides that the challenge was groundless and confirmed the appointment.

A. COMPLAINANT

Complainant contends that the complaint is lodged due to the illegal registration of the domain “best.eu” to a third party directly under the “.eu” top level domain.

Complainant alleges that the disputed decision of the register is in violation of the EU Regulations and was realized during the sunrise period.

Complainant has put forward the following reasons, recapitulated briefly by the Panel, for its complaint:

1. Complainant is the owner of prior rights with regard to the Domain Names, namely registered national trade marks, according to Article 10 (1) of Regulation (EC) n° 874/2004 of the Commission dated 28 April 2004. Complainant provided documentary evidence that it is the owner of German device marks containing the name “best.eu”.

2. In the disputed decision, the Respondent accepted the application of the other applicant filed on 7 December 2005, as they were able to provide evidence of a prior right. The domain “best.eu” is now in the 40-day waiting period, after which expiry they will be activated for the applicant.

3. Based on prior rights, namely registered national trade mark, the applicant applied for the domain directly under the “.eu” top level domain. Complainant asserts that the claimed prior right exists for “best”.

4. The decision of the Registry is in contradiction to the pertinent EU Regulations, since contrary to the decision of the Registry, which accepted the application of the Applicant for the Disputed Domain Name, whilst the applicant cannot claim prior rights in the complete name of the Disputed Domain Name i.e. “best.eu”, which would justify registration of the Domain Names for the Applicant.

5. According to Article 10 Para. 2 of Regulation (EC) n° 874/2004, the registration on the basis of a prior right consists of the registration of the complete name, for which the prior right exists. The disputed decisions of the register allow for the registration, directly under the “.eu” top level domain, of the domain name “best.eu”:

6. The Complainant alleges that a prior right exists for the Disputed Domain Name and thus prior right in the complete Disputed Domain Names. The prior rights of the Complainant are violated by the disputed decision of the register. The Domain name is identical to the prior right of Complainant. Insofar, a revocation of the Domain names ought to be made according to Article 21(1) of Regulation (EC) n°874/2004.

7. Therefore, Article 10(2) of Regulation (EC) n° 874/2004 is to be interpreted to the effect that the registration of a domain name applied for has to be made above all based on a prior right in the complete domain name. Thus, contrary to the disputed decision of the register, the Disputed Domain Name “best.eu” can only be realized based on prior rights in the complete domain name under consideration of the protective purpose of Regulation (EC) n° 874/2004, if prior right in the Disputed Domain Names exist and is claimed and not merely based on prior rights in “best”. “Best.eu” is mentioned in the cover letter of the validation agent documents as the prior right to be claimed.

8. One purpose of Regulation (EC) n° 874/2004 was the prevention of the violation of existing prior rights in the course of the awarding of the new EU top-level domain. Since prior right in the Disputed Domain Names exists here, the awarding of the Disputed Domain Name “best.eu” merely on the basis of prior right in “best”, compellingly violated the already protected right of the Complainant on “best.eu”. This result contradicts the sense and purpose of Regulation (EC) n° 874/2004. The claimed prior right of the Complainant is, according to Complainant, identical with the present Disputed Domain Names. Article 11 of Regulation (EC) n° 874/2004 thus cannot be applied to the Complainant although his prior right contain special characters, because there are no technical reasons, which could oppose an assignment of a corresponding domain name and which would have to be regulated in such manner through the application of Article 11 of Regulation (EC) n° 874/2004.

9. Consequently, the registration of the Disputed Domain Name “best.eu” can only be made exclusively based on a prior right “best.eu”. The decision of the registry to accept an application based of a prior right in “best” thus violates Regulation (EC) n° 874/2004. Therefore, the disputed decision of the Register is to be rescinded.

10. The Complainant contends that he fulfils the qualification criteria for a registration of the Disputed Domain Name according to Article 4 (2) (b) of Regulation (EC) n° 733/2002. Complainant alleges he is the first in the waiting queue and the next claiming a prior right in the complete names “best.eu” and who is entitled to prior rights in the complete domain names “best.eu” namely the registered national trademarks “best.eu”. The Applicant merely claims a prior right in “best”.

According to Complainant the Disputed Domain Name therefore should be transferred to the Complainant.

B. RESPONDENT

On 25 July 2006 the Respondent filed a “Response to Complaint” in which it sets out the ground on which the Registry accepted the application for the Domain Names.

Respondent first discusses the relevant regulations in respect of the notion of (i) “complete name” in the application for a domain and (ii), secondly, argues the aspect of “speculative and abusive registration”:

(i) The Respondent exposed that Article 10 (1) of Commission Regulation (EC) n° 874/2004 of 28 April 2004 provides that holders of prior rights recognized 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 trade marks.

With respect to Article 10 (2) of the same Regulation states “that Article 10 (2) of the Regulation states that a domain name applied for during the Sunrise Period must consist of the complete name of the prior right on which the application is based. The Complainant's argument cannot be accepted. Indeed, the rationale of the phased registration is to grant right holders, such as holders of trademarks, the opportunity to register a domain name under the .eu tld. The definition in the Sunrise Rules of a domain name clearly distinguished the actual domain name from the .eu tld. In eurid.eu, the domain name is considered to be “eurid”, where the ".eu" is the TLD. When article 10 (2) of the Regulation states that the domain name must consist of the complete name of the prior right, one must obviously ignore the tld in that exercise. The best examples that the Complainant's argument is wrong are the thousands of domain names that have been registered under the .eu tld on the basis of a prior right which did not consist of the “xy.eu””.

(ii) Now turning to the notion ““speculative and abusive registration” the Respondent argued that the provisions of Article 22 (1) (b) of the Regulation can only apply when the respondent is any third party but the Eurid. The sole issue at stake is whether the Applicant has demonstrated a prior right. The Respondent support its position in citing several ARD cases and notably case n° 532 (URLAUB), n° 382 (TOS).

The Respondent concluded to the rejection of the Complaint.

DISCUSSION AND FINDINGS

In accordance with Paragraph B11 (a) of the ADR Rules the Panel shall decide a Complaint on the basis of the statement and documents submitted and in accordance with the Procedural Rules.

Pursuant to Paragraph B7 (d) of the ADR Rules the Panel shall determine in its sole discretion the admissibility, relevance, materiality and weight of the evidence. Furthermore, the Panel is permitted in its sole discretion to conduct its own investigations on the circumstances of the case, Paragraph B7 (a) of the ADR Rules.

The Panel has reviewed the statements and allegations of Complainant and conducted its own investigation on the circumstances of the case. The claims of Complainant all relate to the interpretation of Paragraph 10 (2) of Regulation (EC) n° 874/2004 in combination with the definition of the terms “domain name”. Paragraph 10 (2) of Regulation (EC) n° 874/2004 deals with the registration on the basis of a prior right in the Sunrise period and stipulates:

“The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exist, as written in the documentation which proves that such a right exists”.

Complainant shares the view that the Domain Names on the basis of this Paragraph can only be applied for if the prior right is identical to the domain name, inter alia the domain name “best.eu” can only be applied for if a prior right exist for the complete identical name BEST.EU. Hence, a prior right composed of the sole term BEST should not be taken into consideration. Complainant subsequently alleges that the Domain Names should have been granted to him, since Complainant has showed sufficiently that solely Complainant has prior rights which are completely identical to the Domain Names, i.e. the national trade mark registrations “best.eu”.

The Panel observes that Complainant’s interpretation of Paragraph 10 (2) of Regulation (EC) n° 874/2004 and Complainant’s understanding of a “domain name” as set out above is incorrect.

A “domain name” means, under the Regulation, a domain name registered directly under the “.eu” Top Level Domain or for which a

request for registration or application has been filed with the Registry. The suffix ".eu", the European Top Level Domain, therefore does not form part of the domain name according to the Regulation. Prior rights in a domain name consequently only relate to the wording of the domain name without the suffix ".eu".

The Panel would specify that the term "domain name" or "name" as used in the Regulations (instead of the term "second top level domain" to be fully in accordance with the definition given to the term "domain name"- as argued by the Complainant) ought to be construed as embracing all kind of level domain i.e. top, second or even third level domain and therefore considered in its usual and general sense and not in its "technical" definition.

Furthermore, pursuant to Paragraph 10 (2) of Regulation (EC) n° 874/2004 registration of a domain name on the basis of a prior right consists in the registration of the complete name for which the prior right exists. An application for registration of a domain name comprising part of the complete name for which prior rights exists is not possible, Section 19 (1) Sunrise Rules.

Section 19 (5) of the Sunrise Rules more specifically determines:

"If an Applicant claims a Prior Right to a name that includes an internet top-level domain (such as, but not limited to, .com, .net or .eu), the complete name for which a Prior Right exists includes that domain suffix."

Complainant claims he has prior rights in the trade mark "best.eu". This implies that the complete name of this trade mark has to be taken into consideration and consequently, after the Panel verified the trade mark name, it is with no doubt that this trade mark does not match the domain name. The complete name of the trade mark is not identical to the Disputed Domain Name, since the concerned trade mark i.e. "best.eu (+ device)" contains the internet top-level domain ".eu".

In such circumstances, the domain name "besteu.eu" or "best-eu.eu" would have been another option for the Complainant.

On the basis of the statements and evidence provided by Complainant, the Panel concludes that Complainant has no prior right that is relevant for making a valid Sunrise claim in relation to the Disputed Domain Name. Hence, the Panel reaches the conclusion that Complainant has no legal interest in having the decision of Respondent annulled as this would never lead to a situation where the Disputed Domain Name would be transferred to the Complainant or that the Complainant in any other way would become the Domain Name holder.

Considering the foregoing the Panel takes the view that it is not necessary to consider the other contentions of Complainant.

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	**David Irving Tayer**

DATE OF PANEL DECISION 2006-08-24

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Complainant challenged the decision of the Registry to award the domain name "best.eu" in the Sunrise period to the applicant for this domain name. Complainant contended that this domain name should have been awarded to him, and therefore Complainant requested the Panel to revoke the decision of the Registry and transfer the domain name to Complainant.

The Panel first deals with Complainant's allegations that solely Complainant has prior rights in the domain names. Complainant shares the view that a domain name on the basis of Paragraph 10 (2) of Regulation (EC) No 874/2004 can only be applied for if the prior right is identical to the domain name, inter alia the domain name "best.eu" can only be applied for if a prior right exist for the complete identical name BEST.EU. The Panel points out that Complainant's understanding of a domain name, in the light of Regulations is incorrect. The suffix ".eu", the European Top Level Domain does not form part of the domain name under the Regulation. Prior rights in a domain name consequently only relate to the wording of the domain name without the suffix ".eu".

Consequently, the Panel establishes that Complainant has no prior right that is relevant for making a valid Sunrise claim in relation to the domain name, and therefore the Panel concludes that Complainant has no legal interest in having the decision of Respondent annulled as this would never lead to a situation in which the domain names would be transferred to the Complainant or that the Complainant in any other way would become the domain name holder.

The complaint is thus denied.