Panel Decision for dispute CAC-ADREU-000271

Case number	**CAC-ADREU-000271**
Time of filing	**2006-03-17 11:49:08**
Domain names	**casino.eu, auto.eu, keno.eu, porn.eu, porno.eu, bank.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

On 7 December 2005, Complainant applied, on behalf of topeu.com s.r.o., a limited liability company incorporated under the laws of the Czech Republic and domiciled at Pilsen (30100), Bendova 16, for the Domain Names under the phased registration (“Sunrise”) period.

On the same date, but earlier in real time, Classic Internet applied for the domain name CASINO, Internetportal und Marketing GmbH applied for the domain name AUTO, Multham B.V. applied for the domain name PORN, Cars VOF applied for the domain name PORNO, La Française des Jeux applied for the domain name KENO and Internetportal und Marketing GmbH applied for the domain name BANK. The six applicants all applied for the domain name on the basis of a prior right, a registered trade mark. After validation of the applications of these six applicants the Respondent found that these applicants had demonstrated a prior right in the domain name in accordance with the procedure set out in Regulation 874/2004 and decided to register the Domain Names on the first come, first served basis, in the name of the applicant, which had applied for the domain name. Consequently, as a result of the first come, first served principle the Domain Names for which Complainant applied, were not registered in its name.

The Complainant has lodged this Complaint against Respondents decision to award the Domain Names to third parties.

A. COMPLAINANT

Complainant contends that the complaint is lodged due to the illegal registration of the domain names “casino.eu”, “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu”, and “bank.eu” to a third party directly under the .eu domain on the top level. 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 for its complaint, which reasons have been recapitulated briefly by the Panel:

1. Complainant is the owner of prior rights with regard to the Domain Names, namely registered national trademarks according to Art. 10 (1) of Regulation (EC) No. 874/2004 of the Commission dated April 28th, 2004. Complainant provided documentary evidence that it is the owner of German device marks containing the names “casino.eu”, “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu” and “bank.eu”.

2. In the disputed decision, the Respondent accepted the application of the other applicants filed on December 7th, 2005, as they were able to provide evidence of a prior right. The Domain Names are now in the 40-day waiting period, after which expiry they will be activated for the applicants.

3. Based on prior rights, namely registered national brands, the applicants applied for the Domain Names directly under the .eu domain on the top level. Complainant asserts that the claimed prior right exists for “casino”.

4. The decisions of the Registry are in contradiction to the pertinent EU regulations, since contrary to the decisions of the Registry, which accepted the applications of the applicants for the Domain Names, whilst the applicants cannot claim prior rights in the complete name of the Domain Names “casino.eu”, “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu” and “bank.eu”, which would jusitify registrations of the Domain Names for the applicants.

5. According to Art. 10 Para. 2 of Regulation (EC) No. 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 domain of the top level, of the domain names:

a) “casino.eu” based on a prior right in “casino” and thus not in the complete domain name “casino.eu”;

b) “auto.eu” based on an prior right in “auto” and thus not in the complete domain name “auto.eu”;

c) “keno.eu” based on an prior right in “keno” and thus not in the complete domain name “keno.eu”;

d) “porn.eu” based on an prior right in “porn” and thus not in the complete domain name “porn.eu”.

e) “porno.eu” based on an prior right in “porno” and thus not in the complete domain name “porno.eu”;

f) “bank.eu” based on an prior right in “bank” and thus not in the complete domain name “bank.eu”.

6. The Complainant alleges that prior rights exists for the Domain Names “casino.eu”, “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu” and “bank.eu” and thus prior rights in the complete Domain Names. These prior rights of the Complainant are violated by the disputed decision of the register. The Domain names are identical to the prior rights of Complainant. Insofar, a revocation of the Domain names ought to be made according to Art. 21(1) of Regulation (EC) No. 874/2004.

7. Therefore, Art. 10(2) of Regulation (EC) No. 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 Domain Names “casino.eu”, “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu” and “bank.eu” can only be realized based on prior rights in the complete domain name under consideration of the protective purpose of Regulation (EC) No. 874/2004, if prior right in the Domain Names exist and are claimed and not merely based on prior rights in respectively “casino”, “auto”, “keno”, “porn”, “porno” and “bank”. Insofar, “casino.eu”, “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu” and “bank.eu” are mentioned in the cover letters of the validation agent documents as the prior rights to be claimed.

8. One purpose of Regulation (EC) No. 874/2004 was the prevention of the violation of existing er rights (the panel assumes that with the wording “er rights” “ip rights” are meant by Complainant) in the course of the awarding of the new Eu top-level domain. Since prior rights in the Domain Names exists here, the awarding of the Domain Names “casino.eu” “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu” and “bank.eu” merely on the basis of prior right in “casino”, “auto”, “keno”, “porn”, “porno” and “bank” compellingly violated the already protected rights of the Complainant in respectively “casino.eu”, “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu” and “bank.eu”.

This result contradicts the sense and purpose of Regulation (EC) No. 874/2004. The claimed "er rights" of the Complainant are, according to Complainant, identical with the present Domain Names. Art. 11 of Regulation (EC) No. 874/2004 thus cannot be applied to the Complainant although his "er rights" 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 Art. 11 of Regulation (EC) No. 874/2004.

9. Consequently, any registration of the Domain Names “casino.eu”, “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu” and “bank.eu” can only be made exclusively based on a prior right in “casino.eu”, “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu” and “bank.eu” . The decision of the register to accept an application based of a prior right in “casino”, “auto”, “keno”, “porn”, “porno” and “bank” thus violates Regulation (EC) No. 874/2004. Therefore, the disputed decisions of the Register are to be rescinded.

10. The Complainant contends that he fulfils the qualification criteria for a registration of the Domain Names according to Art. 4 (2) (b) of Regulation (EC) No. 733/2002. Complainant alleges he is the first in the waiting queue and the next claiming a prior right in the

complete names casino.eu, auto.eu, keno.eu, porn.eu, porno.eu, bank.eu and who is entitled to "er rights" in the complete domain names casino.eu, auto.eu, keno.eu, porn.eu, porno.eu and bank.eu namely
the registered national trademarks casino.eu, auto.eu, keno.eu, porn.eu, porno.eu and bank.eu.
All applicants in the waiting queue in front of the Complainant merely claim a prior right in “casino” “auto”, “keno”, “porn”, “porno” and “bank”.

According to Complainant the Domain Names therefore should be transferred to the Complainant.

Consequently the following remedies are sought by Complainant:

1. to decide the complaints in an ADR procedure according to the procedural rules, B1 (b) (1) ADR Rules;

2. the decision of the Register concerning the awarding of the domain names casino.eu, auto.eu, keno.eu, porn.eu, porno.eu, and bank.eu be revoked, B11 (b) ADR Rules;

3. the domain names casino.eu, auto.eu, keno.eu, porn.eu, porno.eu, and bank.eu be transferred to the Complainant, B11 (c).

B. RESPONDENT

On 22 May 2005 Respondent was notified (“Notification of Respondent’s Default”) by the Case administrator that Respondent failed to comply with the deadline indicated in the Notification of Complaint and Commencement of ADR Proceeding for the submission of Respondent’s Response.

Under Paragraph B3 (g) of the ADR Rules Respondent has the right to challenge the Notification of Respondent’s Default by providing a written submission to the Czech Arbitration Court filed within 5 days from receiving the Notification of Respondent’s Default. The Czech Arbitration Court shall acknowledge receiving the challenge and shall forward it to the Panel within 3 days from its receipt.

Respondent filed a Challenge of Notification of Respondent Default in accordance with Paragraph B3 (g) of the ADR Rules. In the challenge Respondent sets out the grounds on which the Registry accepted the application for the Domain Names.

Respondent first discusses the relevant regulations:

Art. 10 (1) of Commission Regulation (EC) No 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.

According to art. 12.3 of the same regulation the request to register a domain name based on a prior right must include a reference to the legal basis in national or Community law for the right to the name, such as a trademark, as well as other relevant information, such as the trademark registration number.

The .eu Registration Policy and the Terms and Conditions that apply for all applications during the phased registration period in accordance with art. 3 (d) of the said Regulation, provide under section 13.1 (1) that where the prior right claimed by an applicant is a registered trademark, the trademark must be registered with a competent trademark office.

The same terms provide under section 13.2 that it is sufficient to submit as documentary evidence a copy of an official document issued by the competent trademark office indicating that the trademark is registered, such as a certificate of registration. The documentary evidence must clearly evidence that the applicant is the reported owner of the registered trademark.

Subsequently Respondent addresses each application for the registration of the Domain Names by applicants and contends that the Registry, upon notification of the findings by the validation agent that prior rights exist regarding the Domain Names that are first in line, has found that these applicants have demonstrated a prior right in accordance with the procedure set out in Regulation 874/2004 and has decided to register the Domain Names on the first come, first served basis.

With respect to the statements and allegations made in the complaint Respondent alleges the following:

Complainant claims that according article 10.2 of Regulation 874/2004 the registration of a prior right consists of the registration of the complete name for which the prior right exists. Therefore the Registry was not allowed to register the names in the Domain Names, i.e.

CASINO, AUTO, KENO etc., but is allowed to register the complete names casino.eu, auto.eu, keno.eu, porn.eu, porno.eu and bank.eu for which prior rights exist and of which the Complainant claims to be the owner.

Respondent remarks that there seems to be some confusion with the Complainant on what is meant by a domain name as the word is used in the Regulation and wherein .eu is referred to as the Top Level Domain (TLD) while a domain name may be registered under the .eu TLD. The obligation to register the complete name for which a prior right exists under the .eu TLD therefore does not require the prior right to include .eu, which on the contrary would result in the obligation for the Registry to register the domain names casino.eu.eu, auto.eu.eu and so on.

Further the Complainant, named Martin König, claims to be the owner of the trademarks casino.eu, auto.eu, keno.eu, porn.eu, porno.eu and bank.eu while the attached evidence shows that the said trademarks are owned by a.i.m. Unternehmensberatung GmbH & Co, KG. Therefore the Complainant can not claim a prior right on the said domain names.

Finally, the Complainant claims that said domain names be revoked and transferred to him. However, the Complainant nor even the trademark owner have ever applied for one of these names during the phased registration under Chapter IV of the Regulation while article 14 provides in an examination in chronological order of receipt of such applications until a claim is found for which a prior right exists.

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.

The Complaint is filed against the Registry. In accordance with Paragraph B11 (c) the main remedy available pursuant to an ADR Proceeding where the Respondent is the Registry shall be the annulment of the disputed decision taken by the Registry. The Panel may decide in appropriate cases pursuant to the Procedural Rules, Registration Policy, Sunrise Rules and/or the Terms and Conditions that the domain name in question shall be transferred, revoked or attributed. However, with regard to any Registry decision relating to a prior right invoked during the phased registration period such measures of transfer and attribution will only be granted by the Panel if the Complainant is the next applicant in the queue for the domain name concerned and subject to the decision by the Registry that the Complainant satisfies all registration criteria set out in the European Union Regulations and to subsequent activation by the Registry of the domain name in the name of the Complainant who is the next applicant in the queue.

Complainant, however, requests to revoke the decision of the Register concerning the awarding of the Domain Names casino.eu, auto.eu, keno.eu, porn.eu, porno.eu, and bank.eu pursuant to Paragraph B11 (b) of the ADR Rules.

Paragraph B11 (b) of the ADR Rules stipulates the remedies available pursuant to an ADR Proceeding where the Respondent is the Domain Name Holder in respect of which domain name the Complaint was initiated shall be limited to the revocation of the disputed domain name(s) or, if the Complainant satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b) of Regulation (EC) No 733/2002, the transfer of the disputed domain name(s) to the Complainant.

Taking the foregoing into consideration the Panel considers that Complainant has requested a remedy, inter alia revocation of the decision of the Register concerning the awarding of the Domain Names casino.eu, auto.eu, keno.eu, porn.eu, porno.eu, and bank.eu, which can only be invoked in the event Respondent is the Domain Name Holder as stipulated in Paragraph B11 (b) of the ADR Rules. The Panel therefore concludes that the remedy sought by Complainant will and can not be dealt with in this ADR Proceedings, since this remedy is solely available against Respondents, who qualify as Domain Names Holder and not against the Registry, i.e. Respondent.

Notwithstanding the foregoing the Panel will address the factual and legal grounds of Complainant for as far the Panel in its sole discretion deems necessary for its decision.

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) No 874/2004 in combination with word “domain name”. Paragraph 10 (2) of Regulation (EC) No 874/2004 deals with the registration on the basis of a prior right in the Sunrise period:

“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 “casino.eu” can only be applied for if a prior right exist for the complete identical name CASINO.EU. Prior rights with respect to the name CASINO should therefore not be taken into consideration, according to Complainant. 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 “casino.eu”, “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu” and “bank.eu”.

The Panel observes that Complainant’s interpretation of Paragraph 10 (2) of Regulation (EC) No 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 denomination of the European Top Level Domain therefore is no 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”.

Furthermore, pursuant to Paragraph 10 (2) of Regulation (EC) No 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 a 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 marks “casino.eu”, “auto.eu”, “keno.eu”, “porn.eu”, “porno.eu” and “bank.eu”. This implies that the complete name of these trade marks has to be taken into consideration and consequently, after the Panel verified the trade mark names, it is completely obvious that these trade marks do not match the domain names. The complete names of the trade marks are not identical to the Domain names, since all trade mark names contain the word “.eu”. Additionally, the Panel notes that each trade mark of Complainant is a device mark and the Panel has serious doubts if in fact any word element in these device marks is predominant at all to qualify as prior right.

On the basis of the statements and evidence provided by Complainant the Panel concludes that Complainant has no prior rights that are relevant for making a valid Sunrise claim in relation to the Domain Names, 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. In addition the Panel considers that the Complainant is not the next in the waiting queue after the current holders of the Domain Names and that the Sunrise applicants that are before the Complainant in the waiting queue prima facie have a valid prior right.

Complainant has requested that the Domain Names should be transferred to him. As the Complainant is not the first in the waiting queue such request would be in violation of paragraph 11(c) of ADR Rules.

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

Finally, the Panel remarks that it took notice of Respondents Challenge of Notification of Respondent Default and decided to consider the grounds set out in the challenge in this case as this has not harmed the interests of Complainant in this case. Moreover, even if Respondent would not have submitted this challenge the Panel would have come to the same conclusion. In its consideration the Panel varified if the acceptance of the challenge would conflict with Paragraph 7(b) of the ADR Rules. As set out above, the Panel did not find any facts or circumstances which should prevent the Panel from considering the challenge or that would conflict with Paragraph 7(b) of the ADR Rules.

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	**Willem Leppink**

DATE OF PANEL DECISION 2006-07-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Complainant challenged the decisions of the Registry to award the domain names casino.eu, auto.eu, keno.eu, porn.eu, porno.eu, and bank.eu in the Sunrise period to the applicants for these domain names. Complainant contended that these domain names should have been awarded to him, and therefore Complainant requested the Panel to revoke the decisions of the Registry and transfer the domain names to Complainant.

The Panel first considers that the request of Complainant for revocation of the decision can only be invoked in the event Respondent is the Domain Name Holder as stipulated in Paragraph B11 (b) of the ADR Rules and therefore the Panel will not deal with this remedy sought by Complainant, since this remedy is solely available against Domain Name Holders.

The Panel subsequently 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 .casino.eu. can only be applied for if a prior right exist for the complete identical name CASINO.EU. The Panel point out that Complainants understanding of a .domain name. is incorrect. The suffix ..eu., the denomination of the European Top Level Domain is no 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 rights that are relevant for making a valid Sunrise claim in relation to the domain names, 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 Panel took notice of Respondents Challenge of Notification of Respondent Default and decided to consider the grounds set out in the challenge in this case as this has not harmed the interests of Complainant in this case and considers that even if Respondent would not have submitted this challenge the Panel would have come to the same conclusion.