# Panel Decision for dispute CAC-ADREU-000323

| | |
|---|---|
| Case number | **CAC-ADREU-000323** |
| Time of filing | **2006-04-06 11:27:02** |
| Domain names | **beauty.eu, reise.eu, business.eu, versicherung.eu, car.eu, sport.eu, hotel.eu, shop.eu, travel.eu, music.eu** |

## Case administrator

| | |
|---|---|
| Name | **Josef Herian** |

## Complainant

| | |
|---|---|
| Organization / Name | **Markus Boldt** |

## 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

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain names.

FACTUAL BACKGROUND

“Dom.info e.K” filed an application for the registration of domain name <beauty.eu>. The documentary evidence submitted confirms that “Dom.info e.K” is the registered owner of the trademark “beauTY” No. 303 46 062 registered on December 11, 2003 with the German Patent and Trademark Office. Upon validation of “Dom.info e.K”’s prior right, the Registry accepted “Dom.info e.K”’s application.

“Internetportal und Marketing GmbH” filed applications for the registration of the domain names listed below. The documentary evidence submitted confirms that “Internetportal und Marketing GmbH” is the registered owner of the trademarks mentioned below:

- <business.eu>: “Business” figurative trademark No. 228446 registered on November 22, 2005 with the Austrian Patent and Trademark Office.
- <car.eu>: “CAR” figurative trademark No. 228447 registered on November 22, 2005 with the Austrian Patent and Trademark Office.
- <hotel.eu>: “HOTEL” figurative trademark No. 228284 registered on November 16, 2005 with the Austrian Patent and Trademark Office.
- <reise.eu>: “REISE” figurative trademark No. 228380 registered on November 21, 2005 with the Austrian Patent and Trademark Office.
- <shop.eu>: “SHOP” figurative trademark No. 228429 registered on November 22, 2005 with the Austrian Patent and Trademark Office.
- <sport.eu>: “SPORT” figurative trademark No. 228432 registered on November 22, 2005 with the Austrian Patent and Trademark Office.
- <versicherung.eu>: “Versicherung” figurative trademark No. 228434 registered on November 22, 2005 with the Austrian Patent and Trademark Office.

Upon validation of “Internetportal und Marketing GmbH”’s prior rights, the Registry accepted “Internetportal und Marketing GmbH”’s applications.

“Yellow Register On Line AB” filed applications for the registration of the domain names listed below. The documentary evidence submitted confirms that “Yellow Register On Line AB” is the registered owner of the trademarks mentioned below:

- <music.eu>: “MUSIC” trademark No. 376308 registered on November 11, 2005 with the Sweden Patent and Trademark Office.
- <travel.eu>: “TRAVEL” trademark No. 376309 registered on July 18, 2005 with the Sweden Patent and Trademark Office.

The above applications were filed during Phase I of the phased registration period and are subject to the Commission Regulation (EC) No 874/2004 of 28 April 2004 and the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (the “Sunrise Rules”).

On April 5, 2006, by email, and in hardcopy on May 9, 2006, the Complainant, Markus Boldt, submitted its Complaint against the Registry, concerning the following domain names, in accordance with the .eu Alternative Dispute Resolution Rules (the "ADR Rules"): <beauty.eu>, <reise.eu>, <business.eu>, <versicherung.eu>, <car.eu>, <sport.eu>, <hotel.eu>, <shop.eu>, <travel.eu>, <music.eu>, <sex.eu>.

The Complainant requests the decision by EURid to register the domain names to the three applicants be annulled.

The ADR Center for .eu (the "ADR Center") accepted the Complaint against the Registry, involving these domain name registrations by three different applicants. On April 25, 2006, the ADR Center notified the Complainant of deficiencies in the Complaint, and in response, on May 2, 2006, the Complainant stated: "For Domain Name SEX I decide to cancel this name in complaint No 323," and on May 5, 2006, the Complainant submitted an amended Complaint.

On May 9, 2006, the ADR Center formally notified the Commencement of the ADR proceeding. On July 9, 2006, the Respondent submitted its Response.

Pursuant to Article 4 of the ADR Rules, the ADR Center contacted the Undersigned requesting his services as a sole Panelist to consider and decide this dispute. The Undersigned accepted, signed and sent his Statement of Acceptance and Declaration of Impartiality on July 11, 2006. On July 11, 2006, the ADR Center appointed the Undersigned.

On August 11, 2006, the Complainant filled a supplemental filing. On the same date, the ADR Center requested the Registry to disclose the documentary evidence related to the disputed domain names. On August 14, 2006, the Registry disclosed the documentary evidence. The decision due date was extended in light of the delay in receiving the documentary evidence for the disputed domain names.

## A. COMPLAINANT

The Complainant states as follows:

"Check disputed domain names because they don't pursuant with Sunrise Rules and EU Regulations. The domain names has[sic] been registered in bad faith. There are circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to other. Rejection of incorrect requests please. Thank you."

With respect to the <beauty.eu> domain name application, the Complainant contends that:

"The applicant takes 189 German trademarks for generic words. All trademarks are registered in absurd class of goods. Brands like this are not for use in business. These trademarks are faked. It has been registered or is being used in bad faith."

With respect to the domain name applications <reise.eu>, <business.eu>, <versicherung.eu>, <car.eu>, <sport.eu>, <hotel.eu> and <shop.eu>, the Complainant contends that:

"The applicant registered only pictures as trademark. The picture has a dominant position in this brand. Word trademarks for these names are not possible to register in this class of goods in Austria. The applicant is holder of min. 112 brand names in Europe. All of this is versions of generic words. So it has been also registered or is being used in bad faith."

With respect to the domain name applications <travel.eu> and <music.eu>, the Complainant contends that:

"The company Yellow Register On Line AB registered at 11.11.2005 above trademarks together with trademark "poker", all in class of goods (29): for "Kokosolja" (coconut oil)".

In its supplemental filing, the Complainant draws the Panel's attention to a decision rendered against of one of the applicants of the disputed domain names, "Internetportal und Marketing GmbH" (Case No. 00910, <reifen.eu>), makes reference to three articles, and also states that it "submitted a petition to the Committee on Petitions of the European Parliament, which concerns the irregularities within the scope of the Sunrise Period."

## B. RESPONDENT

The Respondent states that:

"Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation) states that only holders of prior

rights which are recognised 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.

Article 10 (2) of the Regulation states that the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.

Section 19 (2) of the Sunrise Rules states that 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 the sign exclusively contains a name or if the word element is predominant, and can be clearly separated or distinguished from the device element.

All documentary evidence for these applications were received in time by the validation agent. The validation agent concluded from its examination of the documentary evidence that valid registered trademarks were submitted as documentary evidence with all applications. Therefore, the Respondent has accepted all these applications."

The Respondent further states that:

"The complete name of the word element of the trademarks is transcribed in the corresponding domain names. Moreover, the Panel will see when examining these trademarks that the word element is predominant and can be clearly distinguished from the figurative element. Therefore, the Respondent's decision to accept these applications was correct."

Finally, with respect to the Complainant's contentions on the speculative and abusive registrations, the Respondent states:

"Pursuant to article 22 (1) b of the Regulation an ADR procedure may be initiated by any party where a decision taken by the Respondent conflicts with this Regulation or with Regulation (EC) No 733/2002.

Article 14.7 of the Regulation provides that under the phased registration the Respondent shall register the domain name if it finds that the applicant has demonstrated a prior right. Therefore, during the phased registration period, the decision by the Respondent whether or not to register the domain name, can only be taken on the ground of the findings whether or not the applicant has demonstrated a prior right.

There is no legal ground in the Regulation for the Respondent to reject an application for a domain name on the presumption that the application may have been made in bad faith or for speculative reasons. As there is no obligation under the Regulation for the Respondent to assess the bad faith of the applicant and as article 22 (1) b states that a decision by the Respondent can only be annulled when its decision conflicts with the Regulation, the Complaint must be dismissed."

The Respondent cites decisions rendered in Case No. 00210 <bingo.eu> and Case No. 00012 <eurostar.eu> in support of its contentions above.

## DISCUSSION AND FINDINGS

The Complaint is filed against the Registry for its decision to register the disputed domain names applied for during Phase I of the phased registration period.

Paragraph 11(d) of the ADR Rules states that "[t]he Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complaint proves […] (2) In ADR Proceedings where the Respondent is the Registry that the decision taken by the Registry conflicts with the European Union Regulations." Article 14 of Public Policy Rules on "Validation and registration of application received during phased registrations" states that "[…] The Registry shall 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 procedure set out in the second, third and fourth paragraphs."

Prior rights

The Panel shall examine whether or not the Registry's decision to register the disputed domain names was in accordance with the Regulations.

The relevant provisions are:
Article 10.1 of the Public Policy Rules, which states that "'Prior rights' shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin […]."

Section 19.2 of the Sunrise Rules, which states that "[…] 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."

<beauty.eu>
The documentary evidence submitted demonstrates that "Dom.info e.K.", the registrant of the domain name <beauty.eu>, is the registrant of the word mark "beauTY", registered with the German Patent and Trademark Office (No. 303 46 062) on December 11, 2003. The Panel agrees with the Registry's finding that the domain name applicant has demonstrated a prior right as required by the Public Policy Rules.

<business.eu>
The documentary evidence submitted demonstrates that "Internetportal und Marketing GmbH", the registrant of the domain name <business.eu>, is the registrant of the figurative mark registered with the Austrian Patent Office (No. 228 446) on November 22, 2005. The mark consists of the word "Business" written on a briefcase. The Panel finds that the word "Business" is predominant and that it can be clearly separated and distinguished from the device element. The Panel accordingly agrees with the Registry's finding that the domain name applicant has demonstrated a prior right as required by the Public Policy Rules.

<car.eu>
The documentary evidence submitted demonstrates that "Internetportal und Marketing GmbH", the registrant of the domain name <car.eu>, is the registrant of the figurative mark registered with the Austrian Patent Office (No. 228 447) on November 22, 2005. The mark consists of the word "CAR" in upper case, written against the background of a rectangular device, which sits above a triangular device facing downwards. The Panel finds that the word "CAR" is predominant and that it can be clearly separated and distinguished from the device element. The Panel accordingly agrees with the Registry's finding that the domain name applicant has demonstrated a prior right as required by the Public Policy Rules.

<hotel.eu>
The documentary evidence submitted demonstrates that "Internetportal und Marketing GmbH", the registrant of the domain name <hotel.eu>, is the registrant of the figurative mark registered with the Austrian Patent Office (No. 228 284) on November 16, 2005. The mark consists of the word "HOTEL" in upper case, written against the background of an open cylinder device. The Panel finds that the word "HOTEL" is predominant and that it can be clearly separated and distinguished from the device element. The Panel accordingly agrees with the Registry's finding that the domain name applicant has demonstrated a prior right as required by the Public Policy Rules.

<reise.eu>
The documentary evidence submitted demonstrates that "Internetportal und Marketing GmbH", the registrant of the domain name <reise.eu>, is the registrant of the figurative mark registered with the Austrian Patent Office (No. 228 380) on November 21, 2005. The mark consists of the word "REISE" in upper case, written against the background of a star-shaped device. The Panel finds that the word "REISE" is predominant and that it can be clearly separated and distinguished from the device element. The Panel accordingly agrees with the Registry's finding that the domain name applicant has demonstrated a prior right as required by the Public Policy Rules.

<shop.eu>
The documentary evidence submitted demonstrates that "Internetportal und Marketing GmbH", the registrant of the domain name <shop.eu>, is the registrant of the figurative mark registered with the Austrian Patent Office (No. 228 429) on November 22, 2005. The mark consists of the word "SHOP" in upper case, written against the background of a rectangular shape connected on its left by a solar figurative element. The Panel finds that the word "SHOP" is predominant and that it can be clearly separated and distinguished from the device element. The Panel accordingly agrees with the Registry's finding that the domain name applicant has demonstrated a prior right as required by the Public Policy Rules.

<sport.eu>
The documentary evidence submitted demonstrates that "Internetportal und Marketing GmbH", the registrant of the domain name <sport.eu>, is the registrant of the figurative mark registered with the Austrian Patent Office (No. 228 432) on November 22, 2005. The mark consists of the word "SPORT" in upper case, written against an oval-shaped device. The Panel finds that the word "SPORT" is predominant and that it can be clearly separated and distinguished from the device element. The Panel accordingly agrees with the Registry's finding that the domain name applicant has demonstrated a prior right as required by the Public Policy Rules.

<versicherung.eu>
The documentary evidence submitted demonstrates that "Internetportal und Marketing GmbH", the registrant of the domain name <versicherung.eu>, is the registrant of the figurative mark registered with the Austrian Patent Office (No. 228 434) on November 22,

2005. The mark consists of the word “Versicherung”, written against a diamond-shaped device within an oval shape. The Panel finds that the word “Versicherung” is predominant and that it can be clearly separated and distinguished from the device element. The Panel accordingly agrees with the Registry’s finding that the domain name applicant has demonstrated a prior right as required by the Public Policy Rules.

<music.eu>
The documentary evidence submitted demonstrates that “Yellow Register On Line AB”, the registrant of the domain name <music.eu>, is the registrant of the word mark “MUSIC”, registered with the Swedish Patent and Registration Office (No. 376308) on November 11, 2005. The Panel agrees with the Registry’s finding that the domain name applicant has demonstrated a prior right as required by the Public Policy Rules.

<travel.eu>
The documentary evidence submitted demonstrates that “Yellow Register On Line AB”, the registrant of the domain name <travel.eu>, is the registrant of the word mark “TRAVEL”, registered with the Swedish Patent and Registration Office (No. 376309) on November 11, 2005. The Panel agrees with the Registry’s finding that the domain name applicant has demonstrated a prior right as required by the Public Policy Rules.

Accordingly, the Panel agrees with the Registry’s finding that the applicants of the disputed domain names applications have demonstrated prior rights as required by the Public Policy Rules.

Allegation of bad faith

The Complainant asserts that the disputed domain names are not “pursuant with Sunrise Rules and EU Regulations” and that the “domain names has[sic] been registered in bad faith. There are circumstances indicating that the domain names was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to other.” The Complainant asserts that “Dom.info e.K.” “takes 189 German trademarks for generic words.” The Complainant further asserts that “Internetportal und Marketing GmbH” “is holder of min. 112 brand names in Europe. All of this is versions of generic words.”

However, the Panel having found that the Registry correctly concluded in its determination of domain name applicants’ prior right, it is not for this Panel to examine further whether the domain name registrations were abusive or speculative. When complaints deal with allegations of bad faith on the part of the domain name holder, the complaints under the ADR proceedings should be filed against such domain name holder on grounds of “speculative or abusive registration”. (Sunrise Rules, Section 27, ADR Rules B.1. (10)) The decision referred to by the Respondent in its supplemental filing is filed against the domain name registrant and not the Registry. The registrants of the disputed domain names are not party to this ADR proceeding and it is not for this Panel to determine whether or not the domain name registrations are speculative or abusive.

Furthermore, this Panel agrees with the finding by the panel in Case No. 00012 (Eurostar (U.K.) Limited v. EURid) that stated, “[w]ith respect to a question whether or not the validation agent or the Registry are also obliged, before the decision on the registration of the domain name, to examine whether or not the application has been made in good faith, the Panel concluded that the Registry is not obliged to make such an assessment; any such examination should be conducted in accordance with the specific procedure provided under Article 20 […]”. See also decision in Case No. 000210 (Bernd Single v. EURid), where the panel stated that “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”)

The Panel accordingly concludes that this ADR proceeding, which has been brought against the Registry’s finding that the domain name applicants have demonstrated a prior right as required by the Public Policy Rules, is not the appropriate forum to decide on broader allegations of bad faith registration by the domain name applicants.

DECISION

For the reasons stated above and in accordance with Paragraphs B12(b) and (c) of the Rules, the Panel orders that the Complaint is denied.

## PANELISTS

| Name | **Felipe Lorenzo** |
|---|---|

DATE OF PANEL DECISION 2006-08-21

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complaint is filed against the Registry for its decision to register the disputed domain names applied for during Phase I of the phased registration period. The Complainant asserts that the domain name registrations are in violation of Sunrise Rules and Regulations, and also that they are in bad faith.

Having examined the documentary evidence submitted for the disputed domain names, the Panel agrees with the Registry's finding that the applicants of the disputed domain names applications have demonstrated prior rights as required by the Public Policy Rules.

With regard to the Complainant's assertions that the domain name registrations are in bad faith, the Panel finds that this proceeding which has been brought against the Registry is not the appropriate forum to decide on broader allegations of bad faith registration by the domain name applicants.