Panel Decision for dispute CAC-ADREU-000382

Case number	**CAC-ADREU-000382**
Time of filing	**2006-04-11 10:15:21**
Domain names	**tos.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**TOS**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

On March 21, 2006, the Complainant informed the Centre that it had allegedly filed the complaint against the registration of the domain TOS.EU via telefax and via post on March 17, 2006. Such fact could not be verified by the Panel.

However, on April 10, 2006 the Complainant submitted its complaint to the Centre in electronic form. The Complainant claims that it has prior rights to the mark TOS and TOS.EU than the Registrant, Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. The Complainant claims that the Respondent, EURid, wrongly granted the domain to Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V.

A. COMPLAINANT

The Complainant asserted that the name “TOS” is typical for the Complainant in the territory of the Czech and Slovak Republic (former Czechoslovakia) since October 31, 1947. The trade mark “TOS” is allegedly registered as the combined trade mark, where the word “TOS” is dominant and it is possible to distinguish it from the figurative field.

The Complainant mentioned further that it is the exclusive holder of the word trade mark “TOS” having the Prior Right since January 12, 1948. The Complainant stressed out that it is the holder of the international word trade mark “TOS” registered at the World Intellectual Property Organization (“WIPO”) with the Prior Right since February 20, 1948, This trademark registered by the WIPO is allegedly applicable in the EU countries. The Complainant is also allegedly the exclusive holder of the above-mentioned trade mark for the territory of the United Kingdom and the Northern Ireland having the Prior Right since June 25, 1949.

The Complainant’s company name is registered in the Commercial Register in Prague as “TOS, a.s.” with the prior right since October 21, 2004.

The last evidence submitted by the Complainant was the extract from the database of the Office for Harmonization in the Internal Market (“OHIM”) evidencing that the Complainant has registered the name “tos.eu” and combined name “TOS” with the Prior Right since June 23, 2005.

B. RESPONDENT

The Respondent referred in its submission to the interpretation of Articles 10 (1), 14 (7) and 22 (1) b of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter the "Regulation").

The Respondent summarized the prior proceedings in which Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. (the Registrant) applied for the domain name TOS on December 7, 2005. The validation agent received the documentary evidence on December 14, 2006, which is before the January 16, 2006 deadline. As the Registry concluded that the documentary evidence showed that the Registrant was the holder of a registered trademark at the time of validation, the Registrant's application for the domain name TOS was accepted.

According to the Respondent's point of view, it shall be noted that pursuant to Article 14 (7) of the Regulation, 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. As the Registrant was the first to apply for the domain name and as it submitted documentary evidence that it is the holder of a prior right, the Registry correctly registered the domain name. Therefore, according to the Respondent, the Complaint must be rejected.

According to the Respondent, the Panel cannot order the Registry or the Registrant to transfer the domain name to the Complainant if the Complainant is not the next applicant in the queue for the domain name concerned. As the Complainant is not the next in the queue, the request may not be granted. Therefore, the Complainant's transfer request must be allegedly denied.

DISCUSSION AND FINDINGS

According to Article 10.2 of Commission Regulation (EC) No. 874/2004 of April 28, 2004, the holders of prior rights which are recognized or established by national or Community law shall be eligible to apply to register domain names during the period of phased registration prior to the general registration of .eu domain.

In accordance with Article 14 of Commission Regulation (EC) No. 874/2004, the Registry shall register the domain name on the first-come-first-serve basis if it finds that the applicant has demonstrated a prior right.

The purpose of Commission Regulation (EC) No. 874/2004 is not to ascertain that the entity which holds the first right to a trademark within the Community is granted the corresponding domain, and the purpose of these ADR proceedings is not to determine whose trademark right first came into existence.

The purpose of the Regulation 874/2004 is, inter alia, to grant domain names during the sunrise period on first come first served basis provided that the applicant can demonstrate a right which is prior to his domain name application.

According to whois-information, the current holder of the domain www.tos.eu, i.e. Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. (hereinafter referred to as the "Registrant") applied for registration of the aforementioned domain on December 07, 2005 at 13:04:53.

According to whois-information, the Complainant applied for registration of the same domain not earlier than on December 22, 2005 at 08:54:44.

According to whois-information at whois.eu, the contested domain name was registered in favour of Registrant on March 20, 2006.

The principal obligations of the Registry regarding its decisions to register .eu domain names during phased registration are regulated by Article 14 of Commission Regulation (EC) No. 874/2004, and especially by the last paragraph of Article 14 which states that the Registry shall register the domain name on the first-come-first-serve basis if it finds that the applicant has demonstrated a prior right in accordance with the requirements set out in Article 14.

The Registry accepted that Registrant had a prior right to the disputed domain name since it is the proprietor of a trademark consisting of the word TOS registered with the German Patent and Trade Mark Office. The existence of the respective trademark of the Registrant was not disputed by the Complainant.

The Complainant emphasized in its submission the good reputation and very old tradition of his trademark(s) compared to the trademark of the Registrant.

The Panel would like to stress that a trademark with an earlier priority right (more senior trademark) does not have priority over a more junior trademark for the purposes of the .eu domain name registration, which is primarily based on the “first come, first served” principle. As a result, the mere existence of the Complainant’s more senior trademark (or other prior right, as the case may be), that is identical to the domain name, does not necessarily constitute a bar for registration of the domain by the Respondent.

Although the Complainant did not allege bad faith of the Registrant, such objection might be implied from its submission. The Complainant repeatedly mentioned good reputation, well-known character or good name of the said Complainant’s trademark(s), however such fact is not relevant in this case. The Panel is aware that well known denominations are often hijacked or they are subject to cyber-squatting (domain grabbing) or other malicious practices; however, bad faith under Article 21 of Commission Regulation (EC) No. 874/2004 is not a valid ground upon which ADR proceedings against EURid could be based. Therefore, EURid's decision to grant the disputed domain name to the Registrant is not in conflict with the applicable EC Regulations. The Panel would like to stress out that it has no power to dispute the Registrant’s trademark registration as it is not the purpose of these ADR proceedings to asses whether the Registrant’s national trademark could be subject to potential revocation or invalidation.

The Complainant implicitly claims that it has an earlier trademark than the Registrant. Because the Registrant also has a valid trademark corresponding to the domain name and was the first to file the domain name application, the Respondent had correctly registered the domain name. Therefore the complaint must be denied.

For all the reasons mentioned above, the Registrant’s trademark TOS was a 'Prior Right' in accordance with the applicable provisions of Article 14 of EC Regulation No. 874/2004. Therefore, by granting the registration of the domain name TOS.EU to the Registrant, EURid did not violate the applicable EC Regulations.

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	**Pavel Safar**

DATE OF PANEL DECISION 2006-06-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The purpose of Commission Regulation (EC) No. 874/2004 is not to ascertain that the entity which holds the first right to a trademark within the Community is granted the corresponding domain, and the purpose of these ADR proceedings is not to determine whose trademark right first came into existence.

The purpose of the Regulation 874/2004 is, inter alia, to grant domain names during the sunrise period on first come first served basis provided that the applicant can demonstrate a right which is prior to his domain name application.

The mere existence of the Complainant’s more senior trademark (or other prior right, as the case may be), that is identical to the domain name, does not necessarily constitute a bar for registration of the domain by the Respondent.

Because the Registrant also has a valid trademark corresponding to the domain name and was the first to file the domain name application, the Respondent had correctly registered the domain name. Therefore the complaint must be denied.