

Panel Decision for dispute CAC-ADREU-000386

Case number **CAC-ADREU-000386**

Time of filing **2006-03-27 10:02:00**

Domain names **stockholm.eu**

Case administrator

Name **Tereza Bartošková**

Complainant

Organization / Name **Stockholms Stad**

Respondent

Organization / Name **Traffic Web Holding BV**

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 any other legal proceedings involving the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a public body, and is responsible for governing a particular geographical territory, namely Stockholm, the capital of Sweden.

The Complainant does not own any registered trademarks that contain the word STOCKHOLM.

The Respondent is the current registrant of the <stockholm.eu> domain name (the “disputed domain name”). The Respondent is a Dutch company. It is the registered owner of Benelux trademark n° 0781011, in class 40 for the treatment of materials. The trademark consists of a device consisting of two sets of letters separated by an ampersand in the form STOCKH & OLM with an ornamental line above and below this combination of letters and ampersand.

The Respondent applied for the disputed domain name on December 7, 2005, i.e. on the first day of the first part of the phased registration or ‘Sunrise’ period. The basis of the Respondent’s application on this date was that it possessed a prior right within the meaning of Commission Regulation (EC) N° 874/2004 of 28 April 2004 (“Regulation 874”). The prior right was the registered national trademark for the STOCKH & OLM trademark.

The disputed domain name was registered to the Respondent on March 27, 2006.

A. COMPLAINANT

The Complainant’s submissions in its Complaint may be summarised as follows:

1. ‘Stockholm’ is the “acronym” which is generally used for the public body Stockholm Stad;
2. Article 10 states that the domain name registration of a public body may consist of the acronym which is generally used for it;
3. The Complainant has a “certificate” issued by the Government Validation Point (‘PTS’) for Sweden showing that the conditions of Article 10 are fulfilled. (The certificate takes the form of a letter from the Legal Affairs department of PTS, the material part of which reads as follows;

“PTS has not received a request for a validation regarding the domain name “stockholm.eu”. If, however, PTS had received such a request initiating from “Stockholm stad” (the City of Stockholm municipality”) the request would have been validated. PTS considers Stockholm stad to be a public body under the regulation. Further, PTS considers the name “stockholm” to be “the acronym which is generally used” for Stockholm stad as well as “the name under which the territory [for which Stockholm stad is responsible] is commonly known”);

4. The Complainant owns several municipal companies such as Stockholm Event AB and Stockholms Hamn AAB. These names include the word Stockholm. The Swedish Trade Names Act states that the holder of a registered company name has the exclusive right to that name;

5. The Complainant owns the domain name "stockholm.se" and the site at that web address is frequently visited;
6. Stockholm is the name of the territory for which the Complainant is responsible. Stockholm is very well known as a city.

The Complainant submitted a supplementary statement in answer to the Respondent's submissions, which may be summarised as follows:

1. The relevant consideration is not trade mark law. The Complainant's rights arise not from any registered trade mark but on the right of a public body according to Article 10. The issue for determination is who has a better right to the domain name in question according to the ADR Rules and the Regulation.
2. The UDRP decisions are not relevant since the ADR Rules and the UDRP Rules are not the same.
3. Just because the member state did not reserve a certain geographical name in accordance with Commissions Regulation (EC) number 1654/2005, the public body concerned still had the possibility to apply for the domain name as a public body during the phased registration or Sunrise period. The fact that the name was not on the list supplied by Sweden does not automatically mean that the Complainant allowed any third party to register the domain name.
4. The reason why the Complainant's prior right was not validated is because the first application had been granted and so there was no need for validation to take place. The Certificate of Validation states that if PTS had been asked by EURID to validate the prior right of Stockholm Stad, it would have done so.
5. The Complainant also submitted additional evidence of bad faith, alleging that the Respondent had changed the website associated with the disputed domain name from a commercial to a non-commercial use after the dispute began.

B. RESPONDENT

1. The starting point for consideration is that geographical indications may be freely used by the public at large;
2. Pursuant to Article 3 (1) (c) of the European Trade Mark Directive, trade marks which consist exclusively of signs or indications which may serve in trade to designate the geographical origin of services or goods shall not be registered or if registered shall be liable to be declared invalid. The European Court of Justice has interpreted this provision broadly and held that it precludes registration of an indication of geographical origin as a trade mark;
3. A valid trade mark can only subsist in relation to a geographical indication in the event that the indication does not refer to the geographical area in relation to the goods and services.
4. The principle that geographical indicators are not to be owned or used exclusively has been applied to domain names in various cases under the Uniform Dispute Resolution Policy ("UDRP"). Numerous decisions are cited by the Respondent who accepts that in a limited number of cases the panel decided in favour of the legal authority of a geographical area. The Respondent seeks to distinguish those cases from other cases where Complainants were unsuccessful.
5. In the specific context of the .eu domain name extension, the European legislator has given ample consideration to the issue of whether or not to award specific protection to public bodies. Such bodies were given the opportunity to reserve any geographical name as they desired for a prolonged period - see article 5/2 of Regulation number 733/2002 and annex to Regulation number 1654/2005. Moreover, pursuant to article 10 of the Regulation, holders of prior rights were entitled to prior registration of the corresponding domain names during the Sunrise period. Prior rights holders included public bodies who could register the complete name of the territory for which they were responsible and the name under which the territory was commonly known. No additional protection to public bodies was awarded. Accordingly, the European Legislator specifically allowed third parties to register geographic indicators as .eu domain names.
6. The municipality of Swedish city Stockholm did not include the name Stockholm to the list supplied by Sweden pursuant to article 5 sub 2 of Regulation number 733/2002. Moreover, the Complainant did not request PTS to validate the domain name. Accordingly, the Complainant does not hold any relevant prior rights. The holding of two trade names that contain the words Stockholm does not alter this conclusion - the trade names are not identical or confusingly similar to the name Stockholm and do not provide the Complainant with a right to the name STOCKHOLM.
7. The trade names do not in any event award the Complainant any relevant protection to determine the issue at hand. Pursuant to Article 3 of the Swedish Trade Name Act, a trade name holder can prevent others from using trade names within the field for which the trade name was registered but are confusingly similar to the registered trade name. In order to lead to confusion the trade name would need to have some distinctive character, which the name STOCKHOLM does not. There are numerous domain names that contain the name Stockholm, most of which are used on a non-commercial basis. In any event the two trade names are not relevant to the issue at hand because trade names do not qualify as prior rights during the first phase of the sunrise period. There are 19 community trade marks registered that contain the word Stockholm. None of them is owned by the

Complainant.

DISCUSSION AND FINDINGS

The Complainant challenges the Respondent's registration of the disputed domain name under Article 21 of Regulation 874 on the basis that it is a speculative and abusive registration. Article 21.1 states that "a registered domain name is subject to revocation where the name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10 (1), and where it:

- (a) has been registered by its holder without rights or legitimate interest in the name; or
- (b) has been registered or is being used in bad faith."

Article 10(1) states that:

"Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.

'Prior rights' shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.

'Public bodies' shall include institutions and bodies of the Community, national and local governments, governmental bodies, authorities, organisations and bodies governed by public law, and international and intergovernmental organisations."

The difficult element in this case is whether the Complainant has established a 'right' 'recognised or established by national and/or Community law' in a name similar or identical to the disputed domain name. In respect of the meaning of 'right' in Article 21(1) the Panel notes as follows:

1. Article 21(1) rights include registered national and community trademarks. However, the Complainant does not own any registered national or community trade marks including STOCKHOLM;

2. Other rights protected under national law in the Member-State are sufficient. The Complainant relies on the following:

(i) Its ownership of municipal companies such as Stockholm Event AB and Stockholms Hamm AB. The Complainant has produced evidence from the Swedish Trade Names Act that the holder of a registered company name has an exclusive right to that name. However, the exclusive right is to the full company name and not simply to part of it. That is, the right is to 'Stockholm Event' and 'Stockholms Hamn' rather than simply to the word 'Stockholm' in isolation;

(ii) The Certificate issued by the Government Validation Point for Sweden confirming that the Complainant satisfied the conditions for phased registration of the disputed domain name under Article 10 of Regulation 874. Whilst the letter establishes to the satisfaction of the panel that Stockholm is the common name generally used for Stockholms Stad (which the letter wrongly equates with an acronym), and is the name under which the territory for which Stockholms Stad is responsible is commonly known, the letter does not establish that under national law in Sweden the name is equivalent to (for example) a unregistered trade mark, a trade name or a business identifier. Moreover, where claims are made to a place name such as Stockholm, differences between the Complainant's name, Stockholms Stad, and the domain name in issue, Stockholm, are material;

(iii) The Complainant produces other evidence which refers to the fame of the City of Stockholm. However, it does not produce evidence which shows that, first, such fame accrues to the Complainant under Swedish Law and second that such fame would be equivalent in Swedish law to unregistered trade marks, trade names and or any of the other non-exhaustive examples (or equivalent concepts) set out in Article 10;

3. There is no evidence that STOCKHOLM is protected as a geographical indication or designation of origin under Swedish law.

4. Finally, Article 21(1) refers to "the rights mentioned in Article 10(1)." What are these rights? The natural interpretation of 'rights' in Article 21(1) is as a reference to 'prior rights' defined in Article 10(1).

However, Article 10(1) in fact creates a new and specific right in Community Law. This is the right of a limited class (namely "holders of prior rights [as defined] and public bodies") to apply for a domain name during the Sunrise period. It is not disputed (and in any event is confirmed by the Certificate from the Government Validation Point for Sweden) that the Complainant is a public body within the meaning of Article 10(1) and therefore had a right to make a Sunrise application for the name of the territory for which it is responsible; that is, Stockholm. There is no evidence before the Panel, however, that this right was ever exercised, and the period for its exercise has now passed.

The Complainant therefore has an expired right under Article 10(1). Is this sufficient to support a Complaint against a domain name holder under Article 21(1) for a speculative and abusive registration? In the view of the Panel it is not sufficient. Article 21(1) must be supported by a right which "is

recognised or established”; that is, a valid and subsisting right.

Article 21 requires the Complainant to possess a right recognised by specific juridical orders (namely, national and/or Community law). The Panel’s mission is not to create or deny a right to the Complainant, but to verify if such a right exists prima facie. With this in mind and having considered the submissions and evidence provided with the Complaint, it is the Panel’s opinion that this condition is not satisfied. The Complainant has not demonstrated any right recognised or established by national and/or Community law in a name similar or identical to the disputed domain name, and accordingly the Complainant is dismissed.

The Panel concludes with three further observations.

Firstly, the references to cases under the UDRP is of little help. Decisions under the UDRP do not bind panelists considering subsequent UDRP cases. Moreover, as both parties acknowledge, decisions under the UDRP in relation to place names conflict. Furthermore, and importantly, the criteria under the UDRP for determining Complaints differ from the .eu ADR Rules. The most that can be said is that panelists may derive some help in looking at the analysis adopted in UDRP decisions, and must always pay close attention to the proof offered in each individual case for the existence of an alleged right to a geographical name. The most sensible course for panelists will usually be to embark afresh on their consideration of Complaints under the .eu ADR rules.

Secondly, the Panel notes that the Respondent has engaged in a pattern of conduct aimed at exploiting an ambiguity in Regulation 874 to obtain Sunrise registrations of well known geographical names. The Panel is aware that there are decisions in cases where the Registry has been the respondent finding that the use of the ampersand in the manner used to obtain the disputed domain name in the present case was contrary to the proper interpretation of Regulation 874 and therefore the Registry should not have accepted as valid the trademark used as a basis for the Prior Right (see for example, ADReu case 00394 relating to FRANKF & URT). This question is not however before this Panel under the Article 21(1) procedure adopted by the Complainant in this case.

Lastly, there is also ample evidence of bad faith in the present case. However, a Complainant under the Article 21 procedure needs to establish its own rights in a name which is identical or similar to the domain name. The European Legislator did not establish an absolute right for a public body to the sole and exclusive ownership of the .eu domain for the geographical territory for which it was responsible. It did however, give such public bodies considerable advantages over other applicants. The Complainant has not availed itself of these advantages with the result that the Respondent has secured registration of the domain name <stockholm.eu>.

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	Didier Deneuter
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DATE OF PANEL DECISION 2006-07-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Article 21 requires the Complainant to possess a right recognised by specific juridical orders (namely, national and/or Community law). The Panel’s mission is not to create or deny a right to the Complainant, but to verify if such a right exists prima facie. With this in mind and having considered the submissions and evidence provided with the Complaint, it is the Panel’s opinion that this condition is not satisfied. The Complainant has not demonstrated any right recognised or established by national and/or Community law in a name similar or identical to the disputed domain name, and accordingly the Complainant is dismissed.
