Panel Decision for dispute CAC-ADREU-000393

Case number	**CAC-ADREU-000393**
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Domain names	**4m.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Dr Spiros Papathanasiou**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

The complainant's company entitled „4M- advanced systems of technical software s.a." (www.4m.gr) specializes in producing and developing exclusively technical software and web based applications, working on the internet. Since 1998, he is also the proprietor of the trademark „4M" registered in Greece for computer programs and computers (class 9 of Nice Classification), information obtained via the Internet (class 38) and computer programming (class 42). The complainant expands his business activities throughout Europe and other countries.
On October 22, 2005, the complainant filed an application for 4M.eu domain name via registrar approved by EURid („Instra Corporation Pty Ltd"; hereinafter INSTRA) with the aim to gain the registration of that domain name in Sunrise phase 1. On the same day, the complainant paid the initial fee and received confirmation from Instra of receipt of the application for 4M.eu domain name and the payment.
In subsequent two months, the complainant was unsuccessful in obtaining information from Instra regarding the progress of his application. Due to lack of communication on the part of Instra and in order to secure his first application from October 22, 2005, the complainant submitted a second identical application to Instra on December 19, 2005. On the aforementioned day, Instra responded through an email, stating that the application was confirmed for Sunrise phase 2 for the 4m.eu domain name and it is scheduled for processing on February 7, 2006. Therefore, the complainant sent to Instra a certificate of his Greek national trademark registration, making clear that he was interested in registering 4M.eu domain name in Sunrise phase 1.
The complainant was surprised when he found out that a Polish Company by the name „4M Spółka z o.o." (www.4m.pl) had obtained the same domain name based on an application dated December 13, 2005, thus a later application than the complainant's original one, but earlier than complainant's application of December 19, 2005. The complainant's application for 4M.eu domain name was submitted to EURid on January 4, 2006.

A. COMPLAINANT

The complainant presents two legal grounds for favoring his position:
1. The acceptance by EURid of the registration for the domain name '4M.eu' amounts to a clear violation of the rule 'First Come First Served', as well as of the applicable legal principle "prior in tempore potior in jure", because the complainant's application was filed and concluded by the payment on October 22, 2005 and the opposite application on December 13,

2005. The confusion was caused purely by Instra's misconduct.
2. The opposite Applicant's registration for the aforesaid domain name alone is in pure violation of the Article 21 of the Public Policy Rules (EC Regulation 874/2004) and is subject to revocation since it is identical to complainant's brand name '4M', which is already recognized and established by National law, whereas its Company name and trademark seem to be later established in 2003.
In addition to that, the complainant argues that the history, the pure I.T. profile, the market territory and brand name of his company and its products within the I.T. field, should be seriously considered regarding the rights of "4m.eu".
Due to, inter alia, the European and worldwide presence of the complainant's company, he submits that he not only crucially needs, but also deserves the domain name 4m.eu, for two reasons:
- To keep a strong European (EU) profile, while doing business with European companies all over Europe and while providing software solution to European customers
- To carry proudly its European profile, while cooperating with companies outside Europe, thus promoting, among others, the European technology all over the world.
Obviously, the use of 4m.eu domain name by his company absolutely complies and fits with EURid's objectives and policies.

For all the above reasons the complainant requests to:
1. Revoke the registration from December 13, 2005 for the 4M.eu domain name of „4M Spółka z o.o.", and
2. Approve his registration Nr #APQ-26846-831 from October 22, 2005 for the 4M.eu domain name.

B. RESPONDENT

As the grounds on which the respondent (the Registry) accepted the application for the domain name 4M by "4M Spółka z o.o.", it first cites the following pertinent provisions of Community law, particularly Regulation (EC) No 733/2002 of 22 April 2002 on the implementation of the .eu Top Level Domain (hereinafter Regulation 733/2002), REGULATION (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration (hereinafter Regulation 874/2004) and The .eu Registration Policy and the Terms and Conditions for Domain Name Applications made during the Phased Registration Period referred to as Sunrise Rules:
1. Article 10 (1) of Regulation 874/2004 provides that holders of prior rights 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 and that prior rights shall be understood to include, inter alia, registered national and community trademarks.
2. According to article 12 (2) of the aforementioned Regulation, the holders of the rights or their licensees may apply for these domain names in the first part of phased registration and under article 12 (3) of the same Regulation, the request to register a domain name based on a prior right shall include a reference to the legal basis in national or Community law for the right to the name, for example, a trademark, as well as other relevant information, such as trademark registration number.
3. Section 13.1 (i) of Sunrise Rules provides that where the prior right claimed by an applicant is a registered trademark, the trademark must be registered, inter alia, by a trademark office in one of the member states. Under section 13.2 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.
4. Under Article 14 of Regulation 874/2004, the Registry shall register the domain name on the first come first served basis, if it finds out that the applicant has demonstrated a prior right in accordance with the procedure set out in the same article.
On December 13, 2005, 4M Spółka z o.o. filed an application for the registration of the domain name 4M on the ground of a registered national trademark and submitted in due time, on December 27, 2005 as documentary evidence a certificate of registration issued by the competent Polish Patent Office certifying that the trademark is registered under nr 139461 and that 4M Spółka z o.o. is the reported owner of the trademark.
Therefore the Registry, upon notification of the findings by the validation agent that prior rights exist regarding the domain name that is first in line, has found that this applicant has demonstrated a prior right in accordance with the procedure set out in Regulation 874/2004. It has accepted the application of 4M Spółka z o.o. and decided to register the domain name on the first come, first served basis.

With respect to statements and allegations made in the complaint, the respondent states as follows:
According to Article 4 (2) (b) of Regulation 733/2002 and article 4 of Regulation 874/2004, only registrars accredited by the Registry are permitted to offer registration services for names under the .eu TLD. Under Section 5 of the Sunrise Rules, the registrar selected by the applicant acts on behalf of the applicant, but for its own account. Neither the Registry nor the validation agent are party to the agreement between the applicant and the registrar and therefore can not incur any obligation or liability under these agreements.
It was announced by the Registry through the media and on its website that registration of domain names under Sunrise was possible as of December 7, 2005, the so-called .eu launch. Therefore, the Complainant could not have applied validly before that date.
The Registry can only confirm that the first application for the domain name 4M was made on December 13, 2005 by 4M Spółka z o.o. while the application by the Complainant was made on January 4, 2006.
In the respondent's opinion, should the allegation that the confusion in this respect was caused by the Registrar be correct, the Registry can not be held liable for such shortcoming, nor could the panel decide to annul the decision taken without violating the first come, first served rule. It is up to the complainant to consider the agreement with the Registrar.

DISCUSSION AND FINDINGS

At the outset, it is important to understand that there are four parties mentioned in the Complaint: 1) the complainant, 2) the complainant's registrar (Instra), 3) the registrant (4M Spółka z o.o.), and 4) the Registry (EURid). The present matter is between only 1) and 4), and the Panel's decision must be seen in light of this relationship.

From the case file it is apparent that the complainant meets the eligibility requirements set forth in Article 4 (2) (b) of Regulation 733/2002 and pursuant to Article 10 (1) of Regulation 874/2004 he was entitled to file an application for an .eu domain name registration in Sunrise phase 1 since he is the proprietor of the trademark "4M" registered in Greece which follows from the certificate of registration annexed to his complaint.

The ADR panel examined the grounds of the complaint and reached the following conclusions:
1.Speculative and abusive Registration
The complainant, inter alia, argues that the opposite Applicant's registration of 4M domain name directly violates Article 21 of Regulation 874/2004 and is subject to revocation because it is identical to the complainant's trademark '4M'. In that respect, it must be pointed out that the purpose of Article 21 is to allow a person to raise claims against a domain name holder (for instance, 4M Spółka z o.o.) and not against the Registry. However, in such a case, the complainant would have to prove the establishment of all elements set out in the aforesaid Article. But in the present matter, the proceedings are brought against the Registry and therefore, Article 22 (1) (b) of Regulation 874/2004 is at issue. For this reason, the panel could not proceed with that complainant's allegation any further and thus, could not take it into account.

2.First-come-first-served Principle
A more serious argument, which the complainant puts forward, is the alleged breach of the pivotal principle first-come-first-served being relevant especially in phased registration in the context of prior rights. Before the panel undertakes to examine that allegation, it must be emphasized that by virtue of Article 22 (1) (b) in connection with paragraph (11) of the same article of Regulation 874/2004, the ADR panel is entitled only to decide whether a decision taken by the Registry conflicts with this Regulation or with Regulation 733/2002.
According to Article 4 (2) (b) of Regulation 733/2002 and Recital 2 together with Article 4 of Regulation 874/2004, requests for registering .eu domain names can be submitted through registrars accredited by the Registry and only these registrars are permitted to offer registration services for names under the .eu TLD. Each registrar shall be bound by contract with the Registry to observe the terms of accreditation and in particular to comply with the public policy principles set out in Regulation 874/2004.
Article 14 (2) of Regulation 874/2004 provides that "The Registry, upon receipt of the application, shall block the domain name in question until validation has taken place or until the deadline passes for receipt of documentation." It means that each application in phased registration can be further processed including validation of prior rights only if it has been received by the Registry. Under the same provision "If the Registry receives more than one claim for the same domain during the phased registration period, applications shall be dealt with in strict chronological order."
It is obvious that the complainant's application for 4M domain name was submitted to the accredited Registrar on October

22, 2005 and confirmed by it on the same day. That application could have been filed by the registrar (Instra) on behalf of the complainant to the respondent (the Registry) on December 7, 2005 which did not occur, to the prejudice of the complainant. The first application for the 4M domain name was of 4M Spółka z o.o. being filed on December 13, 2005. On December 27, 2005, that applicant in compliance with Article 12 (3) of Regulation 874/2004 furnished a certificate of registration issued by the competent Polish Patent Office proving its ownership of 4M trademark.
Under the last paragraph of Article 14 of Regulation 874/2004, 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 that article. The respondent could not be aware of the complainant's application because that was not passed over to it by Instra prior to December 13, 2005. Hence after notification of successful validation of prior rights of 4M Spółka z o.o. and following the rule first-come-first-served, it decided to register the 4M domain name for the benefit of that company.
According to Article 4 (1) of Regulation 733/2002, the Registry shall, inter alia, observe the rules, policies and procedures laid down in this Regulation and also transparent and non-discriminatory procedures. But from this provision, the erroneousness of its decision cannot be inferred due to the improper handling of the complainant's application caused by the registrar chosen by the complainant. The relationship between the complainant and his registrar regarding registration services is governed by a separate contract to which the respondent is not a party. Such an opinion is also supported by the wording of Section 5 (3) of Sunrise Rules as the respondent states. Even though this issue is beyond the scope of jurisdiction of the panel, it would be proper if the respondent drew appropriate conclusions from such cases towards registrars because not doing so might be detrimental to the credibility of the registration process as a whole.
Furthermore, neither Regulation 733/2002 nor Regulation 874/2004 provides a remedy against the Registry based on willful or negligent misconduct of accredited Registrar(s). Moreover, as it has been mentioned above, the panel can only determine whether or not the Registry's decision complies with those Regulations. But the complainant may consider seeking appropriate legal remedy against the registrar at the competent court.
There is no reason to doubt the significant presence of the complainant's company in the market in the field of software over the past years but this information is not related to the nature of the dispute concerned.

After careful examination of the facts, arguments and pertinent legal provisions mentioned above, the panel unanimously reached a conclusion that the disputed Registry's decision does not conflict with either Regulation 733/2002 or Regulation 874/2004.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the Complaint be Denied

PANELISTS

Name	**Apostolos Anthimos**

DATE OF PANEL DECISION 2006-06-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The complainant, who is the proprietor of 4M trademark registered in Greece, filed an application for 4M.eu domain name through an accredited registrar (Instra Corporation Pty Ltd) on October 22, 2005. Payment and receipt of that application was confirmed by the registrar on the same day. In subsequent two months, the complainant was unsuccessful in gaining information from the registrar regarding the progress of his application and on December 19, 2005, he submitted a second identical application. On December 22, 2005, the complainant found out that identical domain name had been obtained by another company from Poland (4M Spółka z o.o.) based on an application dated December 13, 2005. The complainant's application for 4M.eu domain name was submitted to the Registry (EURid) on January 4, 2006.
The complainant brought the complaint against EURid seeking: 1) revocation of the registration of 4M domain name of the Polish company by virtue of Article 21 of Regulation 874/2004, and 2) approval of his application from October 22, 2005.
The Panel dismissed the claim for revocation under Article 21 (speculative and abusive registrations) of Regulation

874/2004 because such claims may be directed against domain name holders and the respondent is not a holder of 4M domain name.
Furthermore, the Panel reached a conclusion that EURid's decision to register the 4M domain name for the benefit of the Polish company is not in conflict either with Regulation 733/2002 or Regulation 874/2004. The relationship between the complainant and the registrar regarding registration services is governed by a separate contract to which the respondent is not a party. The respondent could not be aware of the complainant's application which the registrar did not submit to it prior to December 13, 2005. It properly followed the rule „first-come-first-served" pursuant to Article 14 of Regulation 874/2004. This conclusion does not prevent the complainant from seeking appropriate legal remedy against the registrar at the competent court.
However, the Panel also pointed out that it would be proper if the respondent drew appropriate conclusions from such cases towards registrars because not doing so might be detrimental to the credibility of the registration process as a whole.

The Panel rejected the complaint.