Panel Decision for dispute CAC-ADREU-000396

Case number	**CAC-ADREU-000396**
Time of filing	**2006-03-23 10:45:11**
Domain names	**capri.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Christian RIEGE (Organisation = CAPRI or Cabinet CAPRI)**

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

N/A

FACTUAL BACKGROUND

The Complainant has filed an application for the domain name capri.eu during the Sunrise Period. The application was based on the Community trademark CAPRI, number 000276113. According to the Sunrise Rules, the applicant for the domain name must be the owner of the claimed prior right. EURid refused to register .eu domain name CAPRI with an argumentation that there are many discrepancies and differences against the documents, namely the OHIM trademark certificate, which could not allow EURid to register the domain name for the applicant because it has not proven its right.

A. COMPLAINANT

The Complainant argues that he is an owner of the community trademark CAPRI, No. 000276113, and he has therefore a prior right for a domain name according to the Sunrise Rules. He is further arguing that CAPRI in fact is the same as “Cabinet CAPRI”, that Cabinet in French means and is commonly used as a “Law Firm”. He also argues that CAPRI is a well known patents and trademarks attorney law firm. As to the address, the Complainant is arguing that it is not mandatory to register a change of address before the OHIM. The Complainant finishes his complaint by the statement that the name Cabinet CAPRI is the same as the company name CAPRI and the fact that the change of the address shall not be an obstacle to the registration of the domain name.

B. RESPONDENT

The Respondent argues that the holders of prior rights recognized by a national or community law shall be eligible to apply to register domain names during a Sunrise Period and that the prior rights shall also be understood national and community trademarks. According to article 12.3 of the Commission Regulation (EC) No 874/2004 of 28 April 2004 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. The same rules 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 authority. However, the documentary evidence must clearly evidence that the applicant is the reported owner of the registered trademark. The OHIM Trade Mark Certificate certifies, however, that the owner of the trademark is “Capri André Pinguet 94 avenue de Mozart 75016 Paris”. It is therefore not clear from the trademark certificate that the owner CAPRI is a law firm, moreover a law firm established at another address. The validation agent could not reasonably assess that the owner of the trademark and the applicant for the domain name were one and the same.

DISCUSSION AND FINDINGS

1. All procedure requirements for .eu dispute resolution (ADR) were met.

2. The main question for the decision is whether according to Commission Regulation (EC) No 874/2004 of 28 April 2004, namely article 3, a request for a domain name registration constituted material inaccuracy in its element which shall constitute a breach of the terms of registration.

The so called ".eu Sunrise Rules" have to be also taken into the consideration. Chapter I General, Section 3, Obligations of the Applicant, para 1, subpara (i), clearly states that an application is only considered complete when "the full name of the Applicant" is provided.

3. The Panel/the Panelist carefully reviewed all documents provided by the parties. The Panel/the Panelist also visited all available websites and public information concerning .eu domain name registration and related trademark registrations, namely with OHIM. The Panel/the Panelist has also called in his non-standard communication the Complainant to clarify principle questions concerning name of the applicant, form of the applicant, address of the applicant and its different communications with relevant .eu domain names and trademark authorities.

4. Regulation (EC) No 733/2002 in its article 4 Obligations of the Registry, para 2, clearly says that the register shall "organise, administer and manage the .eu TLD in the general interest and on the basis of principles of quality, efficiency, reliability and accessibility".

There is no doubt that general basic principles shall to be obeyed at the same time taking into account the public policy rules as described by Commission Regulation (EC) No 874/2004.

5. It is very hard to decide whether a pure formalistic approach has to be applied or a less formalistic but generally more fair approach to the applicants has to be considered to respect the basic ADR principle – the justice.

6. The Panel/the Panelist therefore came to the following conclusions:

• The Panel/the Panelist is of the opinion that the justice shall always rule over the formalistic approach and technical means of communication.

• The complainant has finally proven that he is and was before filing the .eu domain name application an owner of the relevant Community trademark CAPRI, No. 000276113, he therefore properly claimed his prior right for the relevant .eu domain name.

• It has to be stated that the complainant has made many mistakes in its application which were very confusing and could have let the registry to believe that the complainant has not proven its right.

• The registry had, however, all possible means and rights to validate properly the prior rights. The registry is not only allowed but even obliged to obey all respective relevant regulations and obligations from these regulations to provide fair and complete validation process. The registry could have done the same validation process as the Panel/the Panelist did which would allow the registry to review more deeply the application and easily remove all relevant discrepancies in the .eu domain name application.

• They are many technical issues which do not give the applicants appropriate possibilities and space to fill fully and without any mistake the applications. The technique can not be an obstacle to register properly the .eu domain name and grant the priority rights.

• To conclude, the complainant/the applicant has proven his priority rights based on the Community trademark. He is therefore entitled to get the "CAPRI" EU domain name.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) of the Rules, the Panel/the Panelist orders that the EURID's decision be annulled and the domain name CAPRI be registered in the name of Cabinet CAPRI, (SAS), 33 rue de Naples, Paris, France.

PANELISTS

Name	**Vit Horacek**

DATE OF PANEL DECISION 2006-06-13

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The complainant has found an application for the domain name CAPRI.eu during the Sunrise Period. The application was based on the Community trademark CAPRI, No. 000276113. The applicant (and the complainant in this case) was not successful because its application was not accurate in many respects (name of the applicant, seat of the applicant and form of the applicant). The registry argued that there was no chance to register the .eu domain name because of the non-complainant application. The Panel/the Panelist has easily removed defects by public research and requests to the complainant/the applicant. The Panel/the Panelist therefore tested that the validation of the application could have been done easily and properly towards correct verification of the data provided by the complainant/the applicant. The Panel/the Panelist decided that justice shall rule over the strict formalistic approach and technical means and therefore decided that the complainant/the applicant has the right to get the “CAPRI.eu” domain name.