Entscheidung der Schiedskommission for dispute CAC-ADREU-000466

Case number	**CAC-ADREU-000466**
Time of filing	**2006-05-09 11:34:25**
Domain names	**cashpoint.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**CASHPOINT Sportwetten Gesellschaft m.b.H.**

Respondent

Organization / Name	**EURid**

ANDERE RECHTLICHE VERFAHREN

Panel is not aware of any pending proceedings regarding the disputed decision or related domain name.

SACHLAGE

Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") 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.

Shelf Service NV (hereafter "the Applicant") applied for the domain name on December 7, 2006. The validation agent received the documentary evidence on January 14, 2006, which is before the January 16, 2006 deadline. As the Respondent concluded that the documentary evidence showed that the Applicant was the holder of a validly registered Benelux CASHPOINT trademark, the Applicant's application for the domain name CASHPOINT was accepted.

The complainant is a limited liability company founded in 1996 and registered with the Austrian Trade Registry since June 28th, 1996, no. FN 146190k under the Company Name of “CASHPOINT Sportwetten Gesellschaft m.b.H.”.
Common business purpose is Sports Bets (selling and positioning of internet self service terminals) as well as Online services for Casino and Gaming. The Internet Platform “www.cashpoint.at” was first set up in 2000.
CASHPOINT Sportwetten Gesellschaft m.b.H. is the sister company of the continuously growing CASHPOINT Malta Ltd., the overall sales volume increasing from EUR 60 billion (2004) over EUR 142 billion (2005) to an expected number of EUR 350-380 billion in 2006.
CASHPOINT operates 2200 branches in Europe, 300 of which are betting agencies.

Through its then representative, Mr. Josef Zimmerl, CASHPOINT Sportwetten Gesellschaft m.b.H. first registered the word-figurative mark “Cashpoint” with the Austrian Patent Office’s Trademark Register in accordance with the Austrian Federal Law on the Protection of Trade Marks 1970 (BGBl 1970/260), on November 11th, 1995, Reg. No. 163617 (protection starting

April 12th, 1996). The licensee, Mr. Zimmerl, transferred his property rights over the word-figurative mark “Cashpoint” to Ms. Waltraud Urschinger, one of the company’s shareholders, on May 9th, 2000.
The registration of the word-figurative mark “Cashpoint” – for class no.41 (sports betting transactions and betting office services) – with the Austrian Patent Office was renewed on February 15th, 2001, Reg. No. 193 500 (protection starting Jan 23rd, 2001, lasting for ten years), the holder of the trademark now being CASHPOINT Sportwetten Gesellschaft m.b.H.
On February 20th, 2004, the word-figurative mark “Cashpoint” was registered for classes no. 9 (soft- and hardware for automated gaming apparatuses and gaming machines, software for handling betting transactions, especially via internet), 28 (gaming machines, automatic and coin-operated) and 41 (betting transactions, especially sports bets; betting office services) with the Austrian Patent Office, Reg. No. 215 159 (protection starting Jan 27th, 2004, lasting for ten years), the holder of the trademark being CASHPOINT Sportwetten Gesellschaft m.b.H.
On August 27th, 2004, CASHPOINT Sportwetten Gesellschaft m.b.H. applied for registration of a Community trade mark with the Alicante-based Office for Harmonization in the Internal Market (Trade marks and Designs), application no. 003982121.
On May 13th, 2005, the figurative mark “CASHPOINT” owned by CASHPOINT Sportwetten Gesellschaft m.b.H. received the Approval of Application of a Community Trade Mark by the Office for Harmonization in the Internal Market (Trade marks and Designs), application no. 003982121.
On October 10th, 2005, the figurative mark “CASHPOINT” was registered with the Office for Harmonization in the Internal Market (Trade marks and Designs), no. 003982121, Nice classification nrs. 9, 28 and 41; the trade mark owner being CASHPOINT Sportwetten Gesellschaft m.b.H.
On January 26th, 2006, CASHPOINT filed for the registration for the word mark “CASHPOINT” with the Alicante-based Office for Harmonization in the Internal Market (Trade marks and Designs), no. 003982121, Nice classification nrs. 9, 28 and 41; the trade mark owner being CASHPOINT Sportwetten Gesellschaft m.b.H.; the application was accepted.

A. BESCHWERDEFÜHRER

The Complainant argues that it is the holder of a prior right in the CASHPOINT sign since 1995. Therefore, the Complainant argues, any application for the CASHPOINT domain name other than made by itself must have been rejected. Moreover, the Complainant argues that the Registry activated the CASHPOINT domain name too early. The Complainant requests that the Respondent's decision to grant the CASHPOINT domain name to the Applicant be annulled and requests that it be granted the domain name.

The disputed decision of EURid conflicts with Regulation (EC) No 733/2002 as well as Commission Regulation (EC) No 874/2004.

Regulation (EC) No 733/2002, Article 10 (1) says that holders of prior rights recognised or established by national and/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.

As shown above, CASHPOINT Sportwetten Gesellschaft m.b.H. holds the rights for the trade mark “CASHPOINT” recognised both by national and Community law. The national trade mark “CASHPOINT” was first recognised and established already in 1995. As the complainant is in any case holder of a prior right, any registration of the disputed domain name for third parties is illegitimate and against Community law.

In addition, it needs to be emphasised that CASHPOINT is also the complainant’s Company name since 1996, whereas it obviously is not for the registrant SHELF SERVICE.

EURid has obviously also infringed upon Commission Regulation (EC) No 874/2004, especially Article 4, as especially adequate procedural guaranties for the complainant were not provided. The registration of the disputed domain for a company other than the complainant which is not even acting under the name of CASHPOINT is against the registry’s duty to ensure effective and fair conditions of competition.

Finally, it is to be mentioned that the registry has already activated the disputed domain before the respective sunrise period of March 27th, 2006, 24:00 p.m. has ended. This is clearly a violation of the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration (“Sunrise Rules”).

The Complainant therefore proposes the following decision of the ADR panel:

1.Annulment of the disputed decision taken by the Registry.
2.The domain name in question shall be revoked and transferred to the complainant.

B. BESCHWERDEGEGNER

The effect of the first-come-first-served principle Article 2 ("Eligibility and general principles for registration") of the Regulation states that: a specific domain name shall be allocated for use to the eligible party whose request has been received first by the Respondent in the technically correct manner and in accordance with this Regulation. For the purposes of this Regulation, this criterion of first receipt shall be referred to as the 'first-come-first-served' principle. Article 14 (6) of the Regulation also states that the first application in line must be considered first by the validation agent: Validation agents shall examine applications for any particular domain name in the order in which the application was received at the Respondent. The effect of the first-come-first-served principle is mentioned in article 14 (7) of the Regulation: The relevant validation agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name. This article clearly states that the validation agent must consider the first application for as long that the documentary evidence for that application is received within the deadline. It is undisputed in the case at hand that the Applicant was the first in line for the CASHPOINT domain name. It is also undisputed that the Applicant's documentary evidence was received in time. Moreover; it is undisputed that the Applicant is the holder of a valid prior right. Indeed, the Applicant's Benelux CASHPOINT trademark was registered in August 1993, which is even before the Applicant's first trademark. Therefore, pursuant to article 14 (10) of the Regulation, the Respondent correctly granted the CASHPOINT domain name to the Applicant.

The Respondent would like to note that any alleged early activation is not relevant to the Complainant's request to annul the Respondent's decision to grant the CASHPOINT domain name to the Applicant. These are 2 separate decisions.

With regard to the Complainant's request to have the domain name transferred, the Registry would like to refer the Panel to article 11 (c) of the ADR Rules. Two conditions need to be met before the Panel may order the transfer of a domain name: • the Complainant must be the next applicant in the queue for the domain name concerned; • the Registry must decide that the Complainant satisfies all registration criteria set out in the Regulation. The Registry must first assess, via the normal validation procedure, whether the Complainant's application satisfies the requirements of the Regulation. Therefore, the Complainant's transfer request must be rejected. For the reasons mentioned, the Complaint must be rejected.

WÜRDIGUNG UND BEFUNDE

This Complaint arises out of the interpretation and application of Commission Regulation (EC) No 874/2004 of 28 April 2004 ("Regulation 874/2004") and the .eu Registration Policy and Term and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter "the Sunrise Rules").

Art. 10 (1) of said 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.

Art. 12(3) of said Regulation 874/2004 provides that 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, as well as other relevant information, such as trademark registration number.

Recital 12 of said Regulation 874/2004 sets out the purpose of the phased registration period in the following terms: "In order to safeguard prior rights recognised by Community or national law, a procedure for phased registration should be put in place. Phased registration should take place in two phases, with the aim of ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights. The Registry should ensure that validation of

the rights is performed by appointed validation agents. On the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name. Allocation of that name should then take place on a first-come, first-served basis if there are two or more applicants for a domain name, each having a prior right."

The Sunrise Rules govern all applications during the phased registration period (vide Object and Scope).

Section 3.1 (1) of the Sunrise Rules states that an application is only considered complete when the Applicant provides the Registry, via a registrar, with at least the following information, inter alia the full name of the prior right.

Section 11 (1) of the Sunrise Rules provides that "[d]uring the first phase of the Phased Registration Period, only Domain Names that correspond to (i) registered Community or national trade marks or (ii) geographical indications or designations of origin, may be applied for by the holder ...of the Prior Right concerned..."

Section 13 (1) (ii) of the Sunrise Rules provides that "[w]here the Prior Right claimed by an Applicant is a registered trademark, the trade mark must be registered by a trade mark office in one of the member states, the Benelux Trade Marks Office or the Office for Harmonisation in the Internal Market (OHIM), or it must be internationally registered and protection must have been obtained in at least one of the member states of the European Union."

Section 11 (3) the Sunrise Rules, the Applicant for a domain name must be the owner or licensee of the claimed Prior Right.

Article 14 (10) of the Regulation states that the Respondent shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right. Shelf Service NV (hereafter "the Applicant") applied for the domain name on December 7, 2006. The validation agent received the documentary evidence on January 14, 2006, which is before the January 16, 2006 deadline. As the Respondent concluded that the documentary evidence showed that the Applicant was the holder of a validly registered Benelux CASHPOINT trademark, the Applicant's application for the domain name CASHPOINT was accepted.

ENTSCHEIDUNG

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	**Martin Maisner**

DATUM DER ENTSCHEIDUNG DER SCHIEDSKOMMISSION 2006-08-07

Summary

EINE ENGLISCHSPRACHIGE KURZFASSUNG DIESER ENTSCHEIDUNG IST ALS ANLAGE 1 BEIGEFÜGT

The Complaintant challenged the Eurid decision regarding the registration of the eu.domain name, providing evidence, that he has the Prior Right due to the Rules and that the EU Regulation 874/2004 was violated in several important principles.

The ADR Panel found that

a) the Claimant arguments cannot be taken as a basis for revoking the Eurid decision and the interpretation of the EU Regulation 874/2004 is not exact and correct

b) the Respondent performed the registration of said domain name in accordance with all relevant regulation, that all rules and regulations were duly followed and that the acceptance of disputed Applicant application for the registration of said domain name on the basis of the Prior right and first-come-first-serve basis was correct.