

Panel Decision for dispute CAC-ADREU-000487

Case number **CAC-ADREU-000487**

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Domain names **bentley.eu**

Case administrator

Name **Josef Herian**

Complainant

Organization / Name **Depmarc**

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

None of which the Panel is aware.

FACTUAL BACKGROUND

On December 7, 2005 Bentley Systems Europe ("the Applicant"), a computer software company residing in the Netherlands, applied to the Respondent to register the domain name BENTLEY.EU. The Applicant's documentary evidence, filed within time on January 16, 2006, showed the Applicant to be the licensee of Bentley Systems Incorporated of Pennsylvania, U.S.A., the registered proprietor of OHIM registered trade mark No. 003041761, a composite mark comprising the word BENTLEY preceded by the stylized letter "B", registered on February 27, 2004.

The Complainant applied for the domain name BENTLEY.EU on January 27, 2006 and claims to be next in line to the Applicant. The Complainant seeks annulment of the Respondent's decision to accept the Applicant's application for the domain name, the transfer or attribution of the domain name to the Complainant and that the Respondent pay the Complainant's costs.

A. COMPLAINANT

The Complainant's sole ground of objection is that the Applicant made an error in its application when submitting its documentary evidence, namely that it entered in the "prior right on name" field of the standard form "BENTLEY & B Design".

The Complainant relies on Art 10(2) of Commission Regulation (EC) No 874/2004 of 28 April 2004 ("the Regulation"), which provides: "The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists". The Complainant says that "BENTLEY & B Design" does not consist of the complete name for which the prior right exists.

Further, the Complainant relies on (i) a statement on page 14 of the PWC Dot-eu sunrise Validation Services for EURid that the domain name must exactly match the name for which the prior right exists; and (ii) a Newsflash put out by the Respondent on December 9, 2005 drawing attention to a mandatory policy regarding errors, namely that inaccuracies in the "prior right on name" field cannot be rectified and that the only possibility is for a new application to be lodged, which would be ranked on the basis of its date and time of receipt.

In anticipation of the argument that the Newsflash is not binding on the Respondent, the Complainant submits that the Respondent is an administrative authority which, in issuing the Newsflash, created the expectation that if errors were made in the application, this should inevitably lead to the denial of the domain name.

B. RESPONDENT

The Respondent says what the Applicant seems to have done in the "prior right on name" field is to enumerate the two different elements of the composite mark: "Bentley" and (&) "B design".

Section 19(2) of the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period

(“the Sunrise Rules”) allows a composite mark to give rise to a prior right in the word element of the mark if that element is predominant and can be clearly separated or distinguished from the device element. To describe the composite mark as a whole in the application does not render the application void.

The Complainant appears to be arguing that the Registry must assess only the covering letter and not the accompanying documentary evidence, yet Article 14 of the Regulation requires the documentary evidence to be assessed. Hence the Registry must compare the domain name with the documentary evidence and is not bound by the “prior right on name” field in the covering letter.

DISCUSSION AND FINDINGS

Article 10.2 of the Regulation, the terms of which appear above, compels the conclusion that the documentation proving an Applicant’s right to the trademark (in this case as licensee) must prevail over any error in the description of the trademark made by the Applicant in forwarding the documentary evidence. In any event, the Panel considers that the description made by the Applicant in this case is not an error since it merely enumerates the different elements of the composite trademark.

Article 19.2 of the Sunrise rules provides as follows:

“A Prior Right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos, etc.) will only be accepted if

- (i) the sign exclusively contains a name, or
- (ii) the word element is predominant, and can be clearly separated or distinguished from the device element, provided that

- (a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the Domain Name applied for, in the same order as that in which they appear in the sign, and
- (b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear.”

According to article 19.1 of the Sunrise Rules an applicant may not obtain registration for part of the complete name for which the prior right exists. Article 19(2) enables the complete name for which the prior right exists to be identified where it is included in a figurative or composite sign. In the present case article 19.2(i) does not apply because the sign does not exclusively contain a name but also a logo, the stylised letter “B” on a black square. So far as Article 19.2(ii) is concerned the word element “Bentley” is undoubtedly predominant and can be clearly separated or distinguished from the device element (which, according to Article 19.1, may consist in a logo).

There are two conditions attached to Article 19.2(ii). As to condition (a), the “Bentley” trademark (sign) does not contain an alphanumeric character, since the composite mark comprises two distinct elements i.e. the word “Bentley” and a logo being a stylised letter “B” within a square. Accordingly, this condition is satisfied. Condition (b) is also satisfied because there is no risk of misreading. Accordingly, the trademark meets the requirements of the Section 19.2 of the Sunrise rules.

The Registry has respected the Regulations, therefore the complaint must be dismissed.

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	Ignace Vernimme
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DATE OF PANEL DECISION 2006-07-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Applicant applied to the Respondent to register the domain name BENTLEY.EU. The documentary evidence showed the Applicant to be the licensee of OHIM registered trade mark No. 003041761, comprising the word BENTLEY preceded by the stylized letter “B”.

The Complainant objects that the Applicant made a fatal error in its application when submitting its documentary evidence, namely that it entered in the “prior right on name” field of the standard form “BENTLEY & B Design”.

The Respondent says the Applicant merely enumerated the different elements of the composite mark, which meets the requirements of Art. 19(2) of the Sunrise Rules and says the Registry must compare the domain name with the documentary evidence and is not bound by the “prior right on name” field in the covering letter.

The Panel considers that Article 10.2 of Commission Regulation (EC) No 874/2004 of 28 April 2004 compels the conclusion that the documentation proving an Applicant's right to the trademark (in this case as licensee) must prevail over any error in the description of the trademark made by the Applicant in forwarding the documentary evidence. In any event, the Panel considers that the description made by the Applicant in this case is not an error since it merely enumerates the different elements of the composite mark.

According to article 19.1 of the Sunrise Rules an applicant may not obtain registration for part of the complete name for which the prior right exists. Article 19(2) enables the complete name for which the prior right exists to be identified where it is included in a figurative or composite sign. In the present case article 19.2(i) does not apply because the sign does not exclusively contain a name but also a logo, the stylised letter "B" on a black square. So far as Article 19.2(ii) is concerned the word element "Bentley" is undoubtedly predominant and can be clearly separated or distinguished from the device element (which, according to Article 19.1, may consist in a logo).

There are two conditions attached to Article 19.2(ii). As to condition (a), the "Bentley" trademark (sign) does not contain an alphanumeric character, since the composite mark comprises two distinct elements i.e. the word "Bentley" and a logo being a stylised letter "B" within a square. Accordingly, this condition is satisfied. Condition (b) is also satisfied because there is no risk of misreading. Accordingly, the trademark meets the requirements of the Section 19.2 of the Sunrise rules.

The Registry has respected the Regulations, therefore the complaint must be dismissed.
