Panel Decision for dispute CAC-ADREU-000513

Case number	**CAC-ADREU-000513**
Time of filing	**2006-04-19 11:28:26**
Domain names	**tradedoubler.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Tradedoubler AB**

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

The Panel is not aware of any other pending or decided legal proceedings concerning this domain name.

FACTUAL BACKGROUND

The German national trade mark No. 304 67 808 TRADEDOUBLER was registered on 3 February 2005. On 16 December 2005 the domain name holder applied for the domain name www.tradedoubler.eu during the sunrise period on the basis of his German registered trade mark.

The Complainant has alleged that the domain name should not have been registered by the Registry on the basis of this prior right and has asserted that the application for the www.tradedoubler.eu domain was made in bad faith.

A. COMPLAINANT

The substance of the Claimant's submission is as follows:

The Complainant is a Swedish company founded in 1999 provides online marketing and sales solutions.

It is the proprietor of several registered trademarks including a Community Trade Mark (CTM) No. 001550870 for the word TRADEDOUBLER which was registered on 8 June 2003.

The Complainant alleges that the applicant for registration had registered the domain name www.tradedoubler.pl in Poland on 4 February 2003 and subsequently applied for a trade mark registration TRADEDOUBLER in Germany in bad faith.

At the time that the application for the disputed domain name was made, the Complainant asserts that the applicant was familiar with Tradedoubler AB and the Complainant's registered trade mark rights and it was therefore applied for in bad faith.

The application for this domain name is, according to the Complainant, part of a strategy adopted by the domain name holder, in which national domain names have been applied for and national trade marks have been registered, with full knowledge of the Complainant's earlier rights with the aim of disrupting the Complainant's legitimate trade. These trade marks and domain names have been registered in bad faith.

B. RESPONDENT

The substance of the Registry's submission is as follows:

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.

Article 14 (7) of the Regulation states that 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.

Article 22 (b) 1 of the Regulation states that the Panel in the present ADR proceedings must determine if the decision taken by the Registry conflicts with the Regulation.

Article 12 (3) of the Regulation 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, such as a trademark, as well as other relevant information, such as trademark registration number or information concerning publication in an official journal or government gazette.

Rafael Badzag (hereafter "the Applicant") applied for the domain name on December 7, 2005. The validation agent received the documentary evidence on 16 December 2006, which is before the January 16, 2006 deadline.

As the Registry concluded that the documentary evidence showed that the Applicant was the holder of a registered trademark at the time of validation, the Applicant's application for the domain name TRADEDOUBLER was accepted.

Article 22 (1) b of the Regulation states that an ADR procedure may be initiated by any party where a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002.

Article 20 of the Regulation states that the Registry may revoke a domain name at its own initiative and without submitting the dispute to any extrajudicial settlement on certain limited grounds.

However, in the case at hand the Registry did not make a decision pursuant to article 20 of the Regulation. Therefore, the present ADR proceedings have no object and the Complaint must be rejected.

Article 14.7 of the Regulation provides that under the phased registration the Registry shall register the domain name if it finds that the applicant has demonstrated a prior right. Therefore, during the phased registration period, the decision by the Registry whether or not to register the domain name, can only be taken on the ground of the findings whether or not the applicant has demonstrated a prior right. There is no legal ground in the Regulation for the Registry to reject an application for a domain name on the presumption that the application may have been made in bad faith or for speculative reasons.

Pursuant to article 22 (1) b of the Regulation, the Panel must decide whether the Registry's decision conflicts with the Regulation. As the Registry must not and cannot assess the possible bad faith of the applicant when registering the domain name, the Registry's decision is not in conflict with the Regulation. In case n° 12 (EUROSTAR), the Panel agreed that arguments regarding the bad faith of the applicant in ADR proceedings against the decision of the Registry to register a domain name must be rejected: "The additional important question is whether or not the validation agent or the Registry are also obliged, before the decision on the registration of the domain name, to examine whether or not the application has been made in good faith. […] The Registry simply and, in the Panel’s view correctly, 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 EDT has demonstrated a prior right in accordance with the procedure set out in article 14 of the Public Policy Rules, has accepted its application, and has registered the domain name on the first come, first served basis".

It should be noted that ADR proceedings regarding speculative and abusive registration of the domain name can be directed against the domain name holder once his validated application is activated (article B.1 (a) of the ADR Rules). If in such ADR proceedings against the domain name holder the Panel finds that the domain name has been registered or is being used in bad faith, this may lead, subject to the other requirements being met, to the revocation of transfer of the domain name. Such ADR proceedings against the domain name holder should however clearly be distinguished from ADR proceedings against the Registry, as in the case at hand.

The Registry would like to refer the Panel to article 10 (1) and 12 (3) of the Regulation. Pursuant to article 12 (3) the Applicant is only required to submit a trademark registration number or information concerning publication in an official journal or government gazette in order to be found to have a prior right. Article 10 (1) states that the holder of such a prior right is entitled to apply for the corresponding domain name during the phased registration procedure. The Regulation does not allow the Registry to determine whether a registered trademark is invalid. Indeed, the Registry's authority is with registering domain names, not with revoking trademarks. Only a trademark

Office or a court may assess and revoke a trademark. For the reasons mentioned above, the Complaint must be rejected.

DISCUSSION AND FINDINGS

These ADR proceedings are governed by Regulation 874/2004 of 28 April 2004 (hereafter "the Regulation"). The proceedings have been issued by the Complainant against the Registry - they have not been commenced against the Applicant for the domain name.

Article 22(1) of the Regulation provides that an ADR procedure may be initiated by any party where: (a) the regulation is speculative or abusive within the meaning of Article 21; or (b) a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002. The second paragraph of Article 22(11) of the Regulation provides that:

"In the case of a procedure against the Registry, the ADR panel shall decide whether a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002…"

The relevant provisions of the Regulation are Articles 10, 12 and 14. The final paragraph of Article 14 provides that:

"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 the second, third and fourth paragraphs."

The second, third and fourth paragraphs among other things require the applicant for a domain name during phased registration to submit documentary evidence showing that the applicant is the holder of the prior right claimed. Article 10(1) defines 'prior rights' to include registered national and community trade marks.

In this case the Applicant for the domain name tradedoubler.eu, Rafael Badziag, submitted a copy of a trade mark registration certificate for the German national trade mark No. 304 67 808 Tradedoubler in support of his application.

The Complainant, Tradedoubler AB, is the proprietor of an earlier Community Trade Mark for TradeDoubler. The Complainant alleges that the German trade mark owned by Rafael Badzaig was applied for in bad faith and/or contrary to its prior right in the following terms:

"The national trade mark No. 30467808 TRADEDOUBLER was registered on 3 February 2005. (To file an application for another persons trade mark in bad faith is one ground for having the application rejected. Moreover the holder of an earlier right, valid in Germany – as the CTM, may oppose the filed application and in case the opposition period is finalized, initiate cancellation action.) In our opinion the complainant should have won such cases."

The Registry is not required under the Regulation or otherwise to assess the validity of any prior trade mark registrations relied upon by the Applicant and the basic principle to be applied by the Registry is that domain names are to be allocated on a first come first served basis.

Indeed, although not strictly relevant to this decision, it is to be noted that despite the Complainant's assertions that it '…should have won such cases', it has not provided any evidence to the effect that the Applicant's national trade mark has been revoked or even that it has made such an application for revocation.

Under these circumstances there is nothing in the Registry's decision which conflicts with the Regulation or Regulation 733/2002 and accordingly, for these reasons and those submitted by the Registry, this Complaint is 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	Nicholas Saunders

DATE OF PANEL DECISION 2006-07-12

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

English Summary:

The German national trade mark No. 304 67 808 TRADEDOUBLER was registered on 3 February 2005. On 16 December 2005 the domain name holder applied for the domain name www.tradedoubler.eu during the sunrise period on the basis of his German registered trade mark. The Complainant has alleged that the domain name should not have been registered by the Registry on the basis of this prior right and has asserted that the application for the www.tradedoubler.eu domain was made in bad faith.

These ADR proceedings are governed by Regulation 874/2004 of 28 April 2004 (hereafter “the Regulation”). The proceedings were issued by the Complainant against the Registry - they have not been commenced against the Applicant for the domain name. Where proceedings have been issued against the Registry, the ADR panel is required to decide whether the decision taken by the Registry conflicts with the Regulation or with Regulation (EC) No 733/2002. Article 14 of the Regulation provides that the Registry is to register domain names on a first come first served basis if it finds that the applicant has demonstrated a prior right.

In this case the Applicant for the domain name tradedoubler.eu, Rafael Badziag, submitted a copy of a trade mark registration certificate for the German national trade mark No. 304 67 808 Tradedoubler in support of his application.

The Registry is not required under the Regulation or otherwise to assess the validity of any prior trade mark registrations relied upon by the Applicant and the basic principle to be applied by the Registry is that domain names are to be allocated on a first come first served basis.

Under these circumstances there is nothing in the Registry’s decision which conflicts with the Regulation or Regulation 733/2002 and accordingly this Complaint is dismissed.