Panel Decision for dispute CAC-ADREU-000735

Case number	CAC-ADREU-000735
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Domain names	nice.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	National Institute for Health and Clinical Excellence, London, Mr Chris Harvey

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

No other legal proceedings that the panel is aware of

FACTUAL BACKGROUND

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 Terms 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 10 (3) of said Regulation 874/2004 provides that the registration by a public body may consist of the complete name of the public body or the acronym that is generally used.

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.

Article 11 of EC regulation 874/2004 is interpreted in the FAQ section on the web site of PwC, EURid's validation agent, as follows:

2. What if the name for which I claim a prior right contains special characters, spaces or punctuation that cannot form part of a domain name?
Article 11 of EC Regulation 874/2004 may provide you with an answer in this respect.
If the name over which a prior right exists contains a space between the textual or word elements, it may be omitted or replaced by a hyphen.
Where the name for which a prior right is claimed contains special characters, spaces or punctuation marks (such as ! & @ “ ’ # (§ { } * % £), they will be eliminated entirely from the corresponding domain name, replaced by hyphens or, if possible, rewritten.
For instance, if you have a trade mark “A & B” that is registered as a Community trade mark, you are entitled to apply for the domain names “A-B.eu” and “AB.eu”, but also for “AandB.eu”, “AetB.eu”, “AundB.eu”, and the like.

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 Applicant.

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) (i) 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.

The Complainant is a Non-departmental Public Body and specifically a Special Health Authority duly established and instituted as per Statutory Instrument 1999 No. 220 in the United Kingdom within the European Community.

On 7 December 2005, the Complainant applied to register the domain name <Nice.eu> during Phase I of the phased registration period.

In support of its application under the Sunrise Rules, the Complainant relied inter alia on the Statutory Instrument cited above as subsequently amended by Statutory Instrument 2005 No. 298 as establishing its Prior Right. The Registry had however received an application just under 7 minutes earlier from Traffic Web Holding BV and had proceeded to accept that application on the grounds of a trademark presented for <N&ICE>

The Respondent provided a late response arguing that the documentary evidence submitted by Traffic Web Holding BV had clearly established a prior right and thus justifying its decision to accept Traffic Web Holding’s application. It also argued that where a complaint is made on the grounds of speculative and abusive registration then the respondent is wrongly suited since such case should be made against the successful applicant rather than the Registry.

On July 25, 2006 the Complainant, by way of a nonstandard communication, provided supplemental arguments aimed to the purpose of drawing the Panel’s attention on precedent decisions in which the character &, included in a trademark to be evaluated as a prior right, was considered by the Panel as a character that cannot be omitted and must be rewritten (i.e. AND). Therefore, the Complainant concluded that no prior right exists to the domain name NICE.EU, if such a prior right is based on a trademark N&ICE

A. COMPLAINANT

The National Institute for Health and Clinical Excellence is a UK public health organisation known by the acronym ‘NICE’. It is a Special Health Authority established under the National Health Service Act 1977, to promote clinical excellence in the health service.

The Complainants cites Article 21 of the Public Policy Rules (EC874/2004) and contends that:

a) the current assigned holder has no legitimate interest in the domain name;
b) the current assigned holder has acquired the domain name for commercial resale;
c) that registration and use of the domain name would be in bad faith, precluding use by a prior applicant of the name NICE;
d) the claim on the trade mark N&ICE can only be interpreted as a domain name if the character ‘&’ is omitted.

The Complainant further contends that the applicant for the domain name is the holder of multiple domain names, based on a prior right attributable to a trade mark that incorporates the character ‘&’ and that the use of this device is not justified to make a prior claim. In

support of its contention the Complainant refers to:

a) Case no. 265 (LIVE) where the prior right in the domain name LIVE, was based on the trade mark LI&VE to get the LIVE.EU domain name;
b) Case no. 398 (BARCELONA) where the prior right to that name was based on the mark BAR&CELONA;
c) Case no. 457 (HELSINKI) where the prior right was based on the trade mark HELSI&NKI.

B. RESPONDENT

With regard to Complainant's arguments, the Respondent argues that, according to Article 10 of the EC Regulation 874/2004, the holder of a prior right recognized or established by national or community laws is entitled to apply for the corresponding domain name during the phased registration procedure. Furthermore, the Respondent states that, according to Article 14 of EC Regulation 874/2004, it shall register the domain name if it finds that the Applicant demonstrated a valid prior right. The Respondent stresses that Traffic Web Holding BV was the first Applicant for the contested domain name. Indeed, Traffic Web Holding applied for the domain name NICE.EU on December 7, 2005 and the validation agent received the Documentary Evidence on January 13, 2006 and, therefore, within the deadline of January 16, 2006. Since the Respondent found that Traffic Web Holding BV was the holder of a valid prior right in the sign NICE and in consideration of the fact that Traffic Web Holding BV was the first in line of applicants for the disputed domain name, the Respondent accepted this application. With regard to the Complainant's bad faith issue, the Respondent contends that, in its view, the above decision is correct since there is no legal ground for it 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. In addition, the Respondent argues that, according to Article 22/1 (a) of EC Regulation 874/2004 a party may initiate an ADR procedure against a speculative or abusive registration within the meaning of Article 21, but such an ADR procedure must be addressed against the holder of the domain name and not against EURid.

DISCUSSION AND FINDINGS

First of all, the Panel has to establish if the late Response of the Respondent, as well as the nonstandard communication sent on July 25, 2006 by the Complainant, may be considered in deciding the present case.
Thus, according to the ADR Rules, in case the Respondent does not submit a response within the given deadlines, it is up to the Panel to decide whether or not the Response may be accepted and considered in deciding the dispute. This finding is confirmed by the content of the Notification of Respondent Default sent by Czech Arbitration Court to the Respondent on July 21, 2006 (see paragraph 2).
Furthermore, according to Section B, Article 8 of ADR Rules, "the Panel may….admit, in its sole discretion, further statements or documents from either of the Parties.
Although both documents have been filed beyond the terms fixed for standard communications, the Panel exercises its discretion to accept both documents, especially considering that they include important elements to be evaluated in deciding the case

The Panel accepts that Traffic Web Holding BV relied on Trademark for <N&ICE> as establishing its Prior Right. This fact is not in dispute nor is the fact that Traffic Web Holding BV had submitted documentary evidence of trademark in good time.

The Panel accepts as correct the reasoning by the Complainant that Trademark for <N&ICE> is insufficient to establish prior right for the domain name NICE.eu and concludes that the Respondent was wrong to consider the trademark presented as being sufficient ground for establishing prior right and this also when considering the FAQs response provided by the Validation Agent as cited above. The reasons for this have already been entered into sufficient detail in Case Law as identified by the Complainant:

Case 265 (LIVE): where it was stated that from a conceptual point of view LI&VE and LIVE are not identical.

Case 398 (Barcelona): where a prior right to BARCELONA based on a trade mark BARC&ELONA was rejected and should have been written as BARCANDELONA.

Case 475 (Helsinki): where the use of the trademark HELSI&NKI for yarn to derive a prior right was claimed by the assignee to be in good faith for the information about the city of Helsinki but held by the Court to demonstrate bad faith as good faith would be demonstrated by use of the domain to offer yarn.

And most recently in Case No. 00839 (HANDY) where reliance on a trademark for <Handy.eu> was held to be insufficient ground for acceptance of an application for a domain name Handy.eu.

The Panel agrees that the Statutory instruments and other evidence presented are sufficient to consider that the Complainant is a Public Body in terms of Article 10 (3) of 874/2004 thus establishing prior right in terms of public policy and specifically since the same article 10 (3) explicitly makes provision that "The registration by a public body may consist of the complete name of the public body or the

acronym that is generally used." The evidence advanced confirmed that NICE was the acronym used by the Complainant for 6 years prior to application and was used as such in its website nice.org.

The Panel further accepts arguments by the Complainant that the registration of NICE was carried out in bad faith and should be rejected for all the reasons outlined in some detail in the decision in case 00475 (HELSINKI).

The Panel considered the arguments raised by the Respondent regarding it being declared non-suited since the case should have been instituted against "the domain name holder rather than the Respondent" but decided that these arguments are over-ridden by the fact of incorrect registration of a domain name based on a prior right consisting of a trademark containing an ampersand character since these would properly give rise to ADR proceedings against the Respondent and not the domain-name holder.

In the circumstances this Panel is satisfied that on the particular facts of this case the Complainant, which is next in the "first-come first serve" list as verified by consultation of WHOIS by the Panel on 3rd August 2006, complied with both the Regulation and the Sunrise Rules insofar as it was possible and immediately apparent so to do and that the Registry was wrong to accept the prior-received application by Traffic Web Holding BV since the documentary evidence supplied did not confirm the existence of the prior right pertinent to the domain name applied for in accordance with the Regulation.

In the circumstances the decision of Respondent should be annulled and the Complainant's requests accepted insofar as the domain name <nice.eu> be made available for the next eligible applicant in the queue.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the EURID's decision be annulled and that the Registry without delay shall decide whether or not to register the domain name <nice.eu> in the name of National Institute for Health and Clinical Excellence, London, United Kingdom as being the next applicant in the queue.

The above order by the Panel regarding registration of the domain name <nice.eu> is explicitly given since the complainant has sought a direction pursuant to Section 27 of the Sunrise Rules that the Respondent's decision be revoked and the panel allocate the Domain Name to the Complainant. In point of fact, the relevant paragraph of Section 27 (1) of the Sunrise Rules states:

If the ADR Proceeding concerns a decision by the Registry to register a Domain Name and the Panel or Panelist appointed by the Provider concludes that that decision conflicts with the Regulations, then, upon communication of the decision by the Provider, the Registry will decide whether or not to register the Domain Name in the name of the next Applicant in the queue for the Domain Name concerned, in accordance with the procedure set out in these Sunrise Rules.
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Under the circumstances, the Panel therefore cannot order automatic allocation of the domain name <nice.eu.> to the Complainant but restrict itself to the annulment of the decision regarding the application by Traffic Web Holding BV. In terms of the relevant paragraph of 27 (1) as cited above, in the circumstances of the case, it is now at the discretion of the Registry to decide as to whether or not to register the domain name <nice.eu> in the name of the Complainant even though the Panel is satisfied that prima facie the Complainant has adequately established prior right to that domain name in the course of the ADR proceedings.

PANELISTS

Name	**Veronica Marion Bailey**

DATE OF PANEL DECISION 2006-08-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The complainant challenged the acceptance by the Registry of the domain name application for "Nice.eu" by Traffic Web Holding BV and requested that the Registry's decision be annulled and the domain name <Nice.eu> be made available to the next applicant in the queue.

In support of its application under the Sunrise Rules, Traffic Web Holding BV relied on Benelux Trademark for <N&ICE> as establishing its Prior Right. The Complainant objected that such trademark did not confer prior right to the domain name <Nice.eu> and should not have

been accepted by the Registry. The Complainant further alleged that the application was made in bad faith, without legitimate interest and gave rise to confusion.

The Panel followed the reasoning explained in the FAQs provided by the Validation Agent as well as a number of previous decisions (LIVE, BARCELONA, HELSINKI, HANDY) and accepted the Complainant's contention that the documentary evidence establishing prior right to <nice.eu> was insufficient and annulled the Registry's decision. The Panel however held that, in the circumstances, the pertinent paragraph of 27 (1) of the Sunrise Rules did not grant the Panel the power to order automatic allocation of the domain name <nice.eu> to the Complainant but left such registration at the discretion of the Registry in compliance with the same Sunshine rules.