Entscheidung der Schiedskommission for dispute CAC-ADREU-000827

Case number	**CAC-ADREU-000827**
Time of filing	**2006-04-15 12:21:09**
Domain names	**travex.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**AG Blatná, družstvo**

Respondent

Organization / Name	**EURid**

ANDERE RECHTLICHE VERFAHREN

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed decision or the disputed domain name.

SACHLAGE

1. History of the Request for Registration

1.1. The Complainant is AG Blatná, družstvo ("The Complainant"), based in the Czech Republic.

1.2. The Complainant applied for the domain name travex.eu ("the Domain Name") on December 9, 2005. The Complainant's application was received by the Registry in second. The first application for the Domain Name was received on December 7, 2005.

1.3. The applicant in first position was Viatris GmbH & Co. KG ("the Applicant"). The documentation upon which the Applicant proved it has a prior right under Article 10 of EC Regulation 874/2004, was received by the Registry on January 5, 2006. The Complainant's documentation was received by the Registry on January 12, 2006. Both companies submitted their evidences before the ultimate day on which the Documentary Evidence, defined in the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period ("the Sunrise Rules"), must be received by the Processing Agent.

1.4. The date before which an ADR procedure against the decision of the Registry could be initiated was April 17, 2006.

2. History of the ADR Proceeding

2.1. The Complainant submitted a complaint against EURid ("The Respondent") to the ADR Center for .eu attached to the Arbitration Court attached to the Economic Chamber of the Czech Republic and Agricultural Chamber of the Czech Republic ("the Court"). The complaint was received on April 13, 2006. This complaint was submitted in Czech language.

2.2. The Court sent a request for verification to the Registry, which confirmed on April 24 that the Domain Name had been applied for on December 7, 2005 at 11:07:25.884, and registered in the name of the Applicant. The Registry's answer disclosed the Documentary Evidence (six pages, not including the Cover Letter defined at Section 8 of the Sunrise Rules).

2.3. On April 24, the Court notified to the Complainant, in English and in Czech, that the Registrar was not the person actually stated in the Complainant's writings, and that the language of the Proceeding against EURid had to be English. The Court asked the Complainant to file an amended complaint both through the online platform and in hardcopy.

2.4. On May 5, the Complainant solicited from the Court a term extension until May 17, for technical reasons. On this very day, the Court confirmed the deadline for delivery of the amended complaint in said ADR Proceeding was postponed to May 17. The amended complaint ("the Complaint") was filed on May 15, followed by additional comments submitted through a non standard communication form. The ADR Proceeding commenced on May 16.

2.5. The Respondent was properly notified that the Response was to be submitted within thirty working days from the delivery of the notification. The Respondent was also properly notified that, should it fail to send the Response within such period of time, the Respondent would be considered in default, that an ADR Panel would still be appointed to review the facts of the dispute and to decide the case, and that this Panel would not be required to consider a Response filed late, but would have the discretion to decide whether to do so and might draw such inferences from the default as it would consider appropriate, as provided for by the .eu Alternative Dispute Resolution Rules ("the ADR Rules"), Paragraph B.10.

2.6. The Court received the Respondent's Response on July 7. The Respondent was notified on July 11 that it failed to comply with the deadline indicated in the Notification of Complaint and Commencement of ADR Proceeding for the submission of its Response. The consequences of the default were subsequently listed.
As a consequence, the ADR Panel and the Complainant are informed of the default, and the ADR Panel will decide in its sole discretion whether or not to consider the defective Response in deciding the case.
Respondent was also notified of its right to challenge the Notification in a written submission to the Court filed within five days from receiving the Notification. It did not challenge the Notification.

2.7. The Panel was duly appointed on July 20.

2.8. On reviewing the ADR Proceeding documents and elements, the Panel observed the Complaint mentioned as evidence and enclosure:
"- The International Office of the World Intellectual Property Organisation in Geneva announcement concerned the international trademark proprietary rights assignment from 21/06/2004" (sic)
- "The Trademark Register Report from the Industrial Property Office of the Czech Republic"
- "The International Trademark Register Report from the International Office of the World Intellectual Property Organisation in Geneva"
- "Demande et Certificat d'enregistrement international d'une marque" (sic)
- "The translation of the exact wording of the international trademark from French language into Czech language."
Under Paragraph B.1 (b) (16) of the ADR Rules, "[t]he Complaint shall be submitted in hard copy and in electronic form and shall … [a]nnex any documentary or other evidence, including any evidence concerning the rights upon which the Complaint relies, together with a schedule indexing such evidence." As there were no annexes attached to the Complaint in electronic form, on July 22 the Panel – which shall ensure that the Parties are treated fairly (Paragraph B.7 (b) of the ADR Rules) – invited the Complainant to submit in electronic form the evidences that were listed in the Complaint, and reminded the Complainant that under Paragraph A.3(c) of the ADR Rules, "[a]ll documents … made as part of the ADR proceeding shall be made in the language of the ADR proceeding."
The Complaint also mentions as evidence (but not as enclosure) "The internet report of Internet domain register of EURid association." Such a report being accessible online, the Panel did not invite the Complainant to submit it.

A. BESCHWERDEFÜHRER

3. The Complainant contends as follows:

3.1. “On the basis of the No.0203 trademark proprietary rights assignment contract on 24/03/2003, [it] became the rights holder to the national trademark “Travex” registered with the Industrial Property Office of the Czech Republic, registration number 93656 valid on the Czech Republic territory and [it] became the rights holder to the verbal international trademark “Travex” registration number R313818 registered with the International Office of the World Intellectual Property Organisation in Geneva. According to the Nice Classification of Goods and Services these aforementioned trademarks are classified into goods and services class number 1 and 5, where class number 1 represents chemical products and class number 5 represents pharmaceutical preparations and substances to vermin exterminating. The national trademark “Travex” was registered with the Industrial Property Office of the Czech Republic on 02/02/1926 and the verbal international trademark “Travex” was registered with the International Office of the World Intellectual Property Organisation in Geneva on 21/06/1926. The validity of the international trademark ends on 23/05/2006. In November 2005 [the Complainant] applied for its renewal inclusive of the Federal Republic of Germany.”

3.2. “In 2005, negotiations with VIATRIS GmbH & Co.KG, Weismüllerstr. 45, 60314 Frankfurt am Main, Federal Republic of Germany on the international trademark propriety rights sale proceeded. This company had applied for the international trademark “Travex” registration with the International Office of the World Intellectual Property Organisation in Geneva in 1995. However the registration had been refused for all required countries.”

3.3. “In December 2005, at the first round of Sunrise Period Internet EU Domain Registration, [the Complainant] placed an order to the Internet domain Travex.eu registration with the registrar Volný (Czech On line a.s.). ... [Its] application was taken by the EURid association on 09/12/2005. All documents necessary for registration were taken on 12/01/2006. Subsequently [the Complainant] found out that on 07/12/2005 the company VIATRIS GmbH&Co.KG had placed an application for the same Internet domain, therefore Travex.eu registration. This application by the company VIATRIS GmbH&Co.KG is now being occurred under the acceptance period” (sic).
The Complainant “would like to point out that [it] [has] never sold national nor international trademarks “Travex” to the company VIATRIS GmbH&Co.KG. In spite of that their application was taken and accepted by the EURid association, although both national and international trademarks “Travex” holder has been [the Complainant’s] cooperative.
[It] assume[s] that a slight mistake occurred on the part of EURid association and its decision contradicts European Union orders.”
“Given domain name was accepted without an authorization to this domain name” (sic). “According to the European Parliament and the Council of the European Union order No. 733/2002 and the European Commission order No.874/2004 only registered trademarks holders were authorised to register Internet EU domains during the first round of Sunrise Period Internet EU Domain Registration. This legal person is [the Complainant] only, which has properly registered national and international trademarks “Travex” and not the company VIATRIS GmbH&Co.KG.”
The Complainant then alleges that, should Viatris GmbH & Co. KG be granted the right to use the Domain Name, “a confusion of names with both [its] national and international trademarks, which are protected by both intrastate law of the Czech Republic and European Union law, could come.
[The Complainant] consider[s] the company VIATRIS GmbH&Co.KG behaviour to the action in bad faith because it was made wilfully with the aim to forestall [it] using the trade name “Travex” as corresponding domain name” (sic). “As a consequence of this behaviour the devaluation of [the Complainant’s] national and international trademarks “Travex” occurred. According to [the Complainant’s] information the company VIATRIS GmbH&Co.KG is not using the trade name “Travex” at present and it is going to use it for drugs some time in future. [The Complainant] assume[s] that there is no provable connection between the company VIATRIS GmbH&Co.KG and the trade name “Travex” at present”. The Complainant also points out that its rights to the trade name “Travex” date back to 1926.
“Although [it] [is] not aware of the basis of what the EURid association had decided on the Travex.eu domain acceptance for the company VIATRIS GmbH&Co.KG, [the Complainant] assume[s] that it should be take[n] into consideration in fairness ADR proceedings interest” (sic).

3.4. Then the Complaint lists as evidences “The International Office of the World Intellectual Property Organisation in Geneva announcement concerned the international trademark proprietary rights assignment from 21/06/2004” (sic), “The Trademark Register Report from the Industrial Property Office of the Czech Republic”, “The International Trademark Register Report from the International Office of the World Intellectual Property Organisation in Geneva”, “Demande et certificat

d'enregistrement international d'une marque", "The translation of the exact wording of the international trademark from French language into Czech language."

3.5. The Complainant "assert[s] [its] rights within the bounds of ADR proceedings" and "suggest[s] the arbitration court to assign contentious internet domain to the complainant."

3.6. After it submitted the Complaint, the Complainant also submitted, through a non standard communication form, the following remarks on what it considered to be a response from the Respondent, whereas it simply was the Registry's confirmation described above at 2.2:
"On 15/04/2006 we brought an action against EURid association, based at Park Station, Woluwelann 150, 1831 Diegem, Belgium. This action is being conducted before the Czech Arbitration Court, case number 00827.
On 24/04/2006 we received the respondent comments on our proposal of action. The respondent submitted a Geneva WIPO/ ROMARIN register report number 651397 as evidence that the internet domain Travex.eu registration for the company VIATRIS GmbH&Co is based on.
On the basis of this register report the company VIATRIS GmbH&Co has allegedly had registered the trademark Travex since 27/02/1996 and according to the respondent comments it rightly applied for the internet domain name Travex.eu registration.
Our service organisation, the company PATENTSERVIS Praha a.s., has made literature searches for the verbal trademark TRAVEX. During these searches there was found the trademark Travex, which holder is the company VIATRIS GmbH&Co in Geneva WIPO/ ROMARIN register under the number 651397. However, this trademark registration attempt for this holder had been refused for all required countries.
The trademark TRAVEX, which has been registered in Geneva WIPO/ ROMARIN register under the number 313818 since 21/06/1926 for industrial chemical products included in class number 1 and for pharmaceutical preparations and substances to vermin animal and vegetable exterminating included in class number 5 is at present owned by our company.
On the basis of aforementioned evidence we assume that we are entitled to the domain name Travex.eu registration in comparison with the company VIATRIS GmbH&Co, because we are the trademark Travex regular holder. Therefore we continue insistence on our proposal of action and we suggest the arbitration court to assign contentious internet domain to the complainant."

B. BESCHWERDEGEGNER

4. In its administratively deficient Response, the Respondent contends as follows.

4.1. To explain the grounds on which it accepted the application for the Domain Name by the Applicant, the Respondent cites Articles 10 (1), 14 (4) and 14 (10) of EC Regulation 874/2004, and then writes that the Applicant "was the first to have applied for the TRAVEX domain name on December 7, 2005. The validation agent received the documentary evidence on January 5, 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 International TRAVEX trademark, the Applicant's application for the domain name TRAVEX was accepted."

4.2. To the Respondent, "[t]he Applicant is the holder of a prior right": "Pursuant to article 14 (7) of the Regulation, the Applicant submitted the international TRAVEX trademark with registration number 651397. This international trademark is validly registered in inter alia Germany.
The Applicant also submitted an official letter from WIPO dated June 17, 2002 stating that the name of the holder of the TRAVEX trademark, inter alia, would be replaced with that of the Applicant.
Therefore, the Respondent correctly considered that the Applicant was the holder of a prior right and accepted the Applicant's application.
The Respondent has noted that the Complainant also holds an international TRAVEX trademark. It appears that both trademarks coexist. However, the Respondent would like to note, as the Complainant does, that the Applicant was the first to have applied for the TRAVEX domain name and was therefore considered first pursuant to the first-come-first-served principle of article 2 of the Regulation."

4.3. "Transfer to the Complainant

With regard to the Complainant's request to have the domain name transferred, and merely for the sake of completeness, 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."

4.4. For the foregoing reasons, the Respondent requests that the Complaint be rejected.

WÜRDIGUNG UND BEFUNDE

5. Before ruling on the merits of the Complaint, the Panel has to address the following two preliminary issues.

5.1. The Complainant submitted a statement described above at 3.6 ("the Statement").

5.1.2. Does the Panel have to regard the Statement as part of the Complaint? ADR Rules define a complaint as "the document including all annexes prepared by the Complainant to initiate a cause of action under the ADR Proceeding." The Statement does not initiate a cause of action since it replies to a document that follows the filing of a complaint. The Statement can not either be deemed an annex to the Complaint.

5.1.3. Does the Panel have to take into account the Statement? Under Paragraph B.8 of the ADR Rules, "[i]n addition to the Complaint and the Response, the Panel may … admit, in its sole discretion, further statements or documents from either of the Parties." In the Statement, the Complainant makes observations on the Documentary Evidence upon which the Respondent made the decision challenged by the Complainant. The Complainant could not know before initiating the ADR Proceeding what this Documentary Evidence consisted of. The Statement adds little to the Complaint. Therefore, the Panel will admit the Statement.

5.2. The Response is administratively deficient. The Panel is not required to consider a Response filed late, but has the discretion to decide whether to do so.

5.2.1. Under Paragraph B.7 (b) of the ADR Rules, the Panel shall ensure that the Parties are treated fairly and with equality.

5.2.2. After it solicited on May 5 a term extension until May 17 for delivering the amended complaint, the Complainant was granted such extension by the Court.
The Respondent did not file its Response within 30 working days from the delivery of the notification that an ADR Proceeding had been commenced against it, and filed it on July 7 instead.
The Panel finds it would be unfair not to take into account this late Response, since the Complainant was granted an extended period of time under Paragraph A.2. (i) of the ADR Rules. The Panel decides it will consider the Response.

6. The Panel has to rule on whether or not the Respondent's decision is lawful.

6.1. Article 2 of EC Regulation 874/2004 provides that an eligible party under Article 4(2)(b) of EC Regulation 733/2002 (viz undertaking having its registered office, central administration or principal place of business within the Community, or organization established within the Community without prejudice to the application of national law, or natural person resident within the Community) may register one or more domain names under .eu TLD, and provides that "a specific domain name shall be allocated for use to the eligible party whose request has been received first by the Registry in the technically correct manner and in accordance with this Regulation."
Article 10.1 provides "a period of phased registration before general registration of. eu domain starts" for holders of prior rights. "'Prior rights" shall be understood to include … registered national and community trademarks." Under Article 10.2, "[t]he 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." This documentary evidence must be "verifiable" and must demonstrate the right under the law by virtue of which it exists, according to Article 14. This article

adds: “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” of this Article.

6.2. The Documentary Evidence described above at 2.2. first consists of a one page extract from the WIPO’s online Madrid Express Database, for the trademark No. 651397. In the field 732 (Name and address of the holder of the application), the document mentions the name of Viatris GmbH & Co. KG, which address is Benzstrasse 1 61352 Bad Homburg v. d. Höhe (DE). TRAVEX appears in field 540 (Mark). It has been registered on February 27, 1996 (Field 151) for 20 years (Field 171). Field 831 (Designations under the Madrid Agreement) contains the following country codes: AL, AM, AT, AZ, BA, BG, BY, CH, CN, CU, CZ, DE, DZ, EG, ES, FR, HR, HU, IT, KG, KP, KZ, LI, LR, LV, MA, MC, MD, MK, MN, PL, PT, RO, RU, SD, SI, SK, SM, TJ, UA, UZ, VN, YU (WIPO Standard ST.3, standard two-letter code for the representation of States). The footer of the document shows it was printed on December 28, 2005 at 13.54.
The following two pages of the Documentary Evidence contain an extract from the International Registry of Marks dating back to November 13, 1997 and written in French, which certifies that the word mark TRAVEX is registered for 20 years under the number 651397 since February 27, 1996, for analgesic products (not including those used for dental purposes) and antirhumatismal preparations. The extract shows that trademark rights were claimed in 43 countries, and refused in 5. The trademark is in the name of ASTA MEDICA B.V., based in Netherlands, and was transmitted to Asta Medica A.G., 45, Weismüllerstrasse, D-60314 Frankfurt Am Main (Germany) on October 1, 1996.
There are also two WIPO letters informing that there has been a modification in the name or address of a trademark holder in the International Registry. The first letter, dated June 17, 2002, shows that the trademark holder is VIATRIS GmbH & Co. KG, Weismüllerstrasse, D-60314 Frankfurt Am Main, Germany, since April 3, 2002. Only the first page of this letter was provided to the Registry, and it is not possible to identify the trademark(s) for which this change happened. According to the second letter, dated September 26, 2005, VIATRIS GmbH & Co. KG, Benzstrasse 1, 61352 Bad Homburg v.d. Höhe, Germany is the trademark holder registered since August 25, 2005. The second page shows that such change happened for several trademarks, including No. 651397 TRAVEX.

6.3. The Complainant contends that it is the holder of “all” international and national TRAVEX trademarks, and that the Applicant is not the holder of a prior right in the sign TRAVEX. The Complainant alleges the Applicant’s trademark registration has been refused for all required countries. The Documentary Evidence shows that, on the day the Applicant applied for the Domain Name, it was, under EC Regulations, eligible to apply for it and was the holder of prior rights on the word mark TRAVEX in several countries of the European Union.

6.4. The Complainant contends the Applicant acted in bad faith. The Proceeding is aimed at challenging the Respondent’s decision to allocate the Domain Name to the Applicant. Registration or use in bad faith can be a cause of domain name revocation when the action is based upon Articles 21 and 22 (a) of EC Regulation 874/2004 and when the respondent is the domain name holder. Therefore, this argument will be rejected, as it was in Cases No. 12 (EUROSTAR), 210 (BINGO), 265 (LIVE), 317 (LUMENA), 382 (TOS), 449 (CANDY), 532 (URLAUB), and 685 (LOTTO).

6.4. The Complainant alleges that it has trademark rights on the name TRAVEX since 1926. A domain name must be granted to the first to apply, and not the holder who has senior rights. In Cases No. 35 (PST), 143 (VITANA), 382 (TOS), the panels confirmed that a domain name must be allocated to the first to register, and not to the person who has older rights on a trademark.

6.5. Therefore, the Respondent’s decision to allocate the Domain Name to the Applicant is valid under EC Regulations. The Domain Name must not be transferred to the Complainant; As a consequence, the Panel does not have to address whether or not the Complainant’s application satisfied the requirements of the Regulation (including whether or not the Complainant brought proper evidence it has trademark rights on the word Travex), as the Respondent suggested above at 4.3.

ENTSCHEIDUNG

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint be Denied.

PANELISTS

Name	Cedric Manara

DATUM DER ENTSCHEIDUNG DER SCHIEDSKOMMISSION 2006-07-26

Summary

EINE ENGLISCHSPRACHIGE KURZFASSUNG DIESER ENTSCHEIDUNG IST ALS ANLAGE 1 BEIGEFÜGT

The complainant filed an application for travex.eu, which was rejected by EURid on the grounds that the application arrived in second position.
To the complainant, the person whose application was received in first position and who was granted the domain name did not have a prior right. The complainant claims it is the sole owner of all TRAVEX international and national trademarks.
After examination of the documentary evidence, the Panel ruled that the first applicant had prior rights under EC Regulations and was entitled to register the domain name. The complaint is dismissed.