Panel Decision for dispute CAC-ADREU-000830

Case number	**CAC-ADREU-000830**
Time of filing	**2006-04-15 12:12:21**
Domain names	**adi.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**David Adam Cohen**

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 legal proceedings which are pending or decided and which relate to the disputed domain name

FACTUAL BACKGROUND

On 7 December 2005 Honeywell SA, in his capacity as licensee of Honeywell International Inc., applied for the domain name ADI.EU based on a national Benelux trademark registration, which was erroneously referred to as an "international/Community trademark" valid in the UK. The relevant documentary evidence was sent to the Validation Agent on time.

The Registry/Respondent rejected the domain name application on the grounds that the Applicant should have indicated Benelux as the the territory where it had a prior right, rather than the UK.

The Complainant challenges EURID's decision not to grant the registration of ADI.EU and requests the Panel to annul said decision.

The Respondent failed to submit a Response within the given deadline. The Respondent notified a Response somedays after the expiry of the relevant deadline. Thus, the ADR Center notified the Respondent's default.

A. COMPLAINANT

The Complainant recognises that mentioning the UK rather than Benelux as the territory where the Applicant had trademark rights was a mistake. However, the Applicant's mistake should be considered of minor importance. Both for the Validation Agent and for the Registry it was very clear that the trademark right on which the request for the registration of the domain name ADI.EU was based was correct and valid.

The Complainant cites an article of the magazine "Managing Intellectual Property" where Mr. Bart Lieben of Price Waterhouse Coopers, the Validation Agent for .EU domain names applied for during the phased registration periods, listed a series of mistakes that domain name Applicants made during the phased registration periods: "Applicants not completing the "name" field in the application or writing simply "No" or "Not applicable". · Applicants basing their registration on a Benelux trade mark ticked the box for "international/Community trade marks" presumably not realising that Benelux registrations count as national marks. · Applicants applying based on a national registration, but ticking the box marked "international/ Community registration" or vice versa. · Applicants basing their filing on an international registration providing a WIPO certificate as evidence. This is not strictly in accordance with the rules as WIPO is not a competent trade mark office. · Applicants making a spelling mistake in part of the form, such as in the name of the right on which the application is based.

About these mistakes Mr. Bart Lieben said: "Strict implementation of the rules could lead to a shock for many applicants. We're being

slightly relaxed about the application of those rules or we would have to reject 50% of those applications."

The quoted article further reads: "In consultation with EURid, the validator is adopting a more lenient approach, filling in missing information and doing additional investigation in 30% of cases."

The Complainant cites the domain name registration of CITY.EU as an example of a registration that was accepted despite the applicant made a mistake comparable to Honeywell SA's one. According to the Complainant, this registration was accepted although the Applicant indicated that he had a right for the name Moravia (and not for City). Therefore, EURID should have applied the same criteria also regarding the registration of ADI.EU.

B. RESPONDENT

The Respondent filed its Response on 28 June 2006. The main points of the Response are the following:

As the Complainant itself agrees that its application was not in line with section 3 (1) of the Sunrise Rules, the Complaint must be rejected. The Registry would like to note that the cover letter which the Complainant submitted with its application states that: The Applicant has understood that any breach of the Rules can invalidate the application for the domain name or result in the cancellation of the Registration itself. This statement is included in the cover letter pursuant to article 3 (d) of the Regulation which states that the request for domain name registration shall include an undertaking from the requesting party that it shall abide by all terms and conditions for registration, including the policy on the extra-judicial settlement of conflicts. The existence of these rules is further approved by Article 12 (1) of the Regulation. Moreover, these rules have been published on the Registry's website pursuant to article 12 (1) 3 of the Regulation. Therefore, these rules cannot be disregarded and should be applied by the Panel.
In case n° 119 (NAGEL) the Panel agreed that an applicant should comply with the Registry's rules. Therefore, the Complainant is bound by the Sunrise Rules. Its failure to comply to the Sunrise Rules is the reason why its application was rejected. For the reasons mentioned above, the Registry was correct in rejecting the Complainant's application.

DISCUSSION AND FINDINGS

Before entering into the merits of the case, the Panel wishes to make the following preliminarily consideration.

According to Article 22(8) of the EC Regulation No. 874/2004 the Respondent shall submit a Response to the Provider within 30 days of the date of receipt of the Complaint. The Complaint was notified to the Respondent on 5 May 2006, therefore the Respondent had to submit its Response by no later than 4 June 2006. However, the Response was only filed on 28 June 2006.

The ADR Center notified the parties of the Respondent's default on 29 June 2006. Under Paragraph 3(g) of the ADR Rules, the Respondent could have challenged the Provider's notification of the Respondent's default within a specific time period. In the case at issue, the Respondent did not challenge the notification of his default as he could have done . Accordingly, the Respondent recognized that he did not file the Response within the deadline.

Therefore, in compliance with Paragraph 10(a) of the ADR Rules, the Panel shall proceed to a decision on the Complaint.

The main issue of these proceedings is to determine whether by indicating the UK as the country where the Prior Right claimed is protected and submitting documentary evidence relating to the Benelux, the Applicant violated EC Regulations on .EU domain names. As a matter of fact, the reason why the registration of the domain name ADI.EU was not granted, is not that the Applicant applied for the domain name on the basis of an invalid Prior Right (although not expressly mentioned in the Complaint, the Panel assumes that the registration number and any other detail referring to the Prior Right submitted in the application for the domain name registration where consistent with the data resulting from the relevant documentary evidence subsequently filed), nor that the documentary evidence was sent after the relevant deadline. The domain name application was rejected merely because of an inconsistency between the Prior Right claimed in the application and the documentary evidence supplied afterwards.

Article 12(3) of Regulation No. 874/2004 provides that "the request to register a domain name based on a prior right under Article 10(1) and (2) 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, information concerning publication in an official journal or government gazette, registration information at professional or business associations and chambers of commerce".

Regulation No. 874/2004 does not clarify what is intended for "the legal basis in national or Community law for the right to the name". However, Section 3(1) of the Sunrise Rules, provides that "an Application is only considered complete when the Applicant provides the

Registry, via a Registrar, with at least the following information: (...) (ix) the country in which the Prior Right claimed is protected; (...) The information referred to (viii) and (ix) above is deemed to constitute the legal basis in national or Community law for the claimed Prior Right to the name".

Thus in principle, by simply reading Section 3(1) of the Sunrise Rules as reported above, in conjunction with Article 12(3) of Regulation No. 874/2004, one could conclude that the Registry correctly refused to grant the registration of ADI.EU due to the Applicant's mistake in the relevant application.

However, the Panel believes that adopting a too formalistic approach is contrary to the spirit of the phased registration as identified in the 12th Recital of Regulation No. 874/2004: "[I]n 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 appointed validation agents perform validation of the rights. On the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name".

It appears from the above that the scope of the phased registration of .EU domain names is to provide holders of prior rights with the opportunity to protect the corresponding names as .EU domain names before the general public.

In the Panel's view, in deciding whether to grant a domain name during the phased registration the Validation Agent/Registry should adopt a substantive and not a formalistic approach. The following provisions support such a belief:

Article 14 of Regulation No. 874/2004: "[T]he 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. (...) If the validation agent finds that prior rights exist regarding the application for a particular domain name that is first in line, he shall notify the Registry accordingly";

Section 21(2) of the Sunrise Rules: [T]he Validation Agent examines whether the Applicant has a Prior Right to the name exclusively in the basis of a prima facie review of the first set of Documentary Evidence received and scanned by the Processing agent (...) and in accordance with the provisions of these Sunrise Rules";

Section 21(3) of the Sunrise Rules: "[T]he Validation Agent is not obliged, but is permitted in its sole discretion, to conduct its own investigations into the circumstances of the Application, the Pior Right claimed and the Documentary Evidence produced".

In the case at issue, a prima facie review of the Documentary Evidence the Applicant supplied unequivocally showed that the Applicant owned a valid Prior Right to the name for which it requested domain name registration. Therefore, in the case at issue it is not even necessary to assess whether the Validation Agent had to conduct independent investigations on the Applicant's Prior Right according to Section 21(3) of the Sunrise Rules. The point is that the Validation Agent adopted a purely formalistic approach in the validation process, as such contravening the scope of the phased registration as provided for by Regulation 874/2004, and acting in contrast with Article 14 of said Regulation and Article 21(2) of the Sunrise Rules.

Indeed, mentioning the wrong territory of validity of the Prior Right claimed in support of the domain name application is a minor mistake that cannot entail such a material consequence as the denial of the domain name registration. Particularly because, as mentioned above, the Applicant supplied valid Documentary Evidence prima facie showing the existence of a valid Prior Right.

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 the domain name ADI.EU be registered in the name of Honeywell S.A., Bourgetlaan 3, Evere, 1140, Belgium.

PANELISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2006-07-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Registry rejected the application for the registration of ADI.EU on the grounds that the Applicant indicated the wrong territory of

validity of the prior right claimed as the basis of the relevant application.

The Panel finds that the Registry's decision is in contrast with the spirit of the phased registration as clarified in Regulation 874/2004 and with Article 14 of the same Regulation and Section 21(2) of the Sunrise Rules.

The Applicant's mistake is minimal and self-evident. The documentary evidence the Applicant supplied enabled the Validation Agent to assess the existence of a valid Prior Right on the basis of a prima facie review, without further investigations.

For these reasons the Panel concludes that the Registry's decision not to grant the domain name registration is in contrast with the applicable EC Regulations and must be annulled. The domain name ADI.EU is to be registered in the name of the Applicant.