Panel Decision for dispute CAC-ADREU-000839

Case number	**CAC-ADREU-000839**
Time of filing	**2006-04-20 10:10:49**
Domain names	**handy.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**DAY Networks Marketing GmbH**

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

There are no other relevant legal proceedings of which the panelist is aware

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 Term 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. 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 10 section 2 of EC regulation 874/2004 is interpreted in the FAQ section on the web site of PwC, EURid's validation agent, as following:

“Technical issues regarding domain name application during phased registration period

3. What if I have a registered trade mark like “abcd.eu”, which thus already includes the “.eu” suffix? Am I entitled to the “abcd.eu” domain name.

No. Article 10(2) of the Public Policy Rules states that registration on the basis of a prior right consists of registration of the complete name for which the prior right exists, as written in the documentation that proves that the right exists.

If you have obtained trade mark protection for “abcd.eu” or “abcd.com” you will be entitled to apply for the domain names “abcdeu.eu” or abcdcom.eu” and “abcd-eu.eu” or abcd-com.eu (in accordance with Article 11 of the Public Policy Rules), but not for “abcd.eu.”

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) (ii) 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 limited commercial partnership engaged in networks marketing, duly incorporated in Austria within the European Community.

On 7 December 2005, Ing. Christian Golbs applied to register the domain name <Handy.eu> during Phase I of the phased registration period.

In support of his application under the Sunrise Rules, Ing. Christian Golbs relied on German Trademarks 396 34 157 for <HANDY> and 303 56 840.2 for <handy.eu> as establishing his Prior Right. Mr. Golb’s status as being a Licensee of German Trademark 396 34 157 and the owner of German Trademark 303 56 840.2 is not in dispute and Mr. Golb had submitted documentary evidence of said license and registration in good time. The cover sheet of the application by Mr. Golbs however only made reference to <handy.eu> as a prior right. The Complainant objected that Mr. Golb was not the owner of a trademark HANDY, that being the owner of HANDY.EU did not confer a prior right and that therefore his application should have been rejected. When, on disclosure of documentary evidence, it transpired that Mr. Golbs was in fact the licensee of the trademark HANDY and had submitted the documentary evidence of this in good time, the Complainant disputed whether the EURid could accept the application of Mr. Golbs given that on the cover sheet of the application the prior right cite was only <handy.eu> while <handy> was not cited as a prior right on the same cover sheet..

The Respondent provided a late response arguing that the documentary evidence submitted by Mr. Golbs had clearly established a prior right and thus justifying its decision to accept Mr. Golbs’ application. It also argued that, even if it’s decision regarding Golbs were to be annulled the Complainant’s request that the domain name be allocated to the next on the list does not follow automatically.

A. COMPLAINANT

In its initial complaint, the Complainant provides detailed argumentation as to why an application by Mr. Christian Golbs based on a prior right of a trademark <HANDY.EU> should not have been accepted by EURid for the domain name HANDY.EU since this would have given prior right to the domain name handy.eu..eu or handy-eu.eu. The documentary evidence subsequently disclosed showed Mr. Golbs to be the licensee of the trademark HANDY and the Complainant then filed a non-standard communication accepting that:
“In the documentary evidence Mr. Christian Golbs has included proof that he is owner of the registered German figurative trademark handy.eu.

In addition Mr. Christian Golbs has included a declaration form that he is a licensee of the registered national German figurative trademark handy.”

But arguing that “That means that Mr. Christian Golbs has made an application claiming a prior right for the complete name handy.eu and has provided documentary evidence for two different kinds of rights. “

repeating that “The registry should have rejected Mr. Christian Golbs’ application for the domain name handy.eu, which is based on the registered national German figurative trademark handy.eu. Mr. Christian Golbs does not have a prior right to obtain the domain name www.handy.eu. based on a registered national German trademark handy.eu.“

and then arguing that “While a license for a registered national German figurative trademark handy might have been a basis for an application for the domain name handy.eu, Mr. Christian Golbs did not claim a prior right for the complete name handy in his application or in the coversheet used by him. In his application and in the cover sheet Mr. Christian Golbs has claimed a prior right for the complete name handy.eu, and has also included evidence of a registered German national figurative trademark handy.eu.”

The Complainant further argued that “As a consequence of Mr. Christian Golbs’ application the sunrise whois database contained the information that a prior right was claimed for the complete name handy.eu, and that the prior right was based on a registered German national trademark.

Mr. Christian Golbs did not file a complete application with reference to Section 3 “Obligations of the Applicant” 1. (vi), (vii) of the Sunrise Rules, if he had desired to claim a prior right as a licensee for the complete name handy.

If Mr. Christian Golbs had desired to make an application based on a prior right from a license for the complete name handy, he could have filed a second application with a different cover sheet.

It is evident that the application based on a prior right for the complete name handy.eu was not an error by Mr. Christian Golbs, as Mr. Christian Golbs actually is owner of a national registered German figurative trademark handy.eu, and has included documentary evidence of his ownership of the registered national German trademark handy.eu.

The Complainant requests the Panel to decide that the decision by the registry to accept the application by Mr. Christian Golbs shall be annulled.”

B. RESPONDENT

The Respondent submitted that Pursuant to article 12 (2) of the Regulation licensees of trademark owner may also apply for the corresponding domain name. Section 20 (1) of the Sunrise Rules states that if an applicant has obtained a licence for a registered trade mark in respect of which it claims a prior right, it must enclose with the documentary evidence an acknowledgement and declaration form duly completed and signed by both the licensor of the relevant registered trade mark and the applicant (as licensee).
The documentary evidence submitted by the Applicant clearly shows that:
• Mr. Georg Diamantidis is the holder of a valid German trademark consisting of the sign HANDY; and
• Mr. Georg Diamantidis (Licensor) has licensed this trademark to the Applicant (Licensee).
The licence states that "Licensor authorises Licensee to apply during the Phased Registration Period for the Domain Name (HANDY)".
As the Applicant has been licensed to use a valid German trademark to apply for the HANDY domain name, the Registry's decision to accept the Applicant's application does not conflict with the Regulation.

Insofar as to the Complainant’s request to order the Registry to grant the domain name to the next applicant in the queue, the Respondent argued that
Section 11 (c) of the ADR Rules lists the remedies that are available to the Panel and states that with regard to any Registry decision relating to a prior right invoked during the phased registration period a transfer and attribution will only be granted by the Panel if the Complainant is the next applicant in the queue for the domain name concerned and subject to the decision by the Registry that the Complainant satisfies all registration criteria set out in the Regulation and to the subsequent activation by the Registry of the domain name in the name of the Complainant who is the next applicant in the queue.
Pursuant to section 11 (c) of the ADR Rules, the Registry cannot be ordered to grant the domain name to the next applicant in the queue. Indeed, the Registry must first assess if all registration criteria have been met. Only then can the Registry grant a domain name to an applicant”

DISCUSSION AND FINDINGS

The Panelist determines as follows:

The Panelist accepts that Ing. Christian Golbs relied on German Trademarks 396 34 157 for <HANDY> and 303 56 840.2 for <handy.eu> as establishing his Prior Right. Mr. Golb’s status as being a Licensee of German Trademark 396 34 157 and the owner of German

Trademark 303 56 840.2 is not in dispute nor is the fact that Mr. Golb had submitted documentary evidence of said license and registration in good time.

The Panelist accepts as correct the reasoning by the Complainant that Trademark 303 56 840.2 for <Handy.eu) is insufficient to establish prior right for the domain name Handy.eu but concludes that the same reasoning then militates for acceptance of licensee status for trademark <HANDY> as being sufficient ground for establishing prior right.

The Panelist further accepts arguments presented by the Respondent that “as the Applicant has been licensed to use a valid German trademark to apply for the HANDY domain name, the Registry's decision to accept the Applicant's application does not conflict with the Regulation”. In “Schoeller” Case 00253, the Panelist had determined that “The Registry is duty bound to observe the spirit and the letter of the Regulations. The purpose of the phased registration period as set out in Recital 12 of the Regulation is “to safeguard prior rights recognised by Community or national law.” The Applicant Golbs had demonstrated a prior right and the Registry respected this prior right. The facts of the case demonstrate that the Applicant Golbs was the applicant during the phased registration period and that the Applicant is the licensee of the Prior Right on which the application was accepted. The intended purpose of the phased registration period as set out in Recital 12 of said Regulation 874/2004 was “to safeguard prior rights recognised by Community or national law”.

The Panelist does not accept the reasoning by the Complainant that the Applicant could have submitted two separate requests based on two separate rights. The Cover sheet signed by Mr. Golbs was electronically generated by the registry and if the Registry (or the automated system employed by the Registry) omitted to include part of the name of a prior right or a number of prior rights then Mr. Golb was not authorized to correct the form. The fact that one single request was supported by compliant documentary evidence was sufficient for the Registry to decide that the Applicant had sufficiently proved prior right. That some of the evidence submitted was irrelevant or inadequate does not detract from the adequacy of the other documentary evidence that was in point of fact relevant and sufficient. To disallow such an application on the grounds that “HANDY” as the prior right was not listed on the cover sheet would be tantamount to pandering to a doubtful technicality which would run counter to the letter and spirit of the purpose of the phased registration period as set out in Recital 12 of the Regulation which is “to safeguard prior rights recognised by Community or national law.” This being said, it is recognized that listing of only one prior right when several may in fact exist (and may have been included in supporting documentary evidence), may cause inconvenience and futile complaints by third parties and that the Registry may be well-advised to improve facilities for listing of prior rights and their subsequent representation in databases.

In the circumstances this Panelist is satisfied that on the particular facts of this case the Applicant complied with both the Regulation and the Sunrise Rules insofar as it was possible and immediately apparent so to do and that it was reasonable for the Registry to accept the application since the documentary evidence supplied confirmed 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 confirmed and the Complainant’s requests denied.

DECISION

For all the foregoing reasons the Panelist orders that the EURID's decision regarding the domain name HANDY.eu be confirmed and the Complaint denied.

PANELISTS

Name	**Joseph André Cannataci**

DATE OF PANEL DECISION 2006-07-31

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 “Handy.eu” by Ing. Christian Golbs.

In support of his application under the Sunrise Rules, Ing. Christian Golbs relied on German Trademarks 396 34 157 for <HANDY> and 303 56 840.2 for <handy.eu> as establishing his Prior Right. Mr. Golb’s status as being a Licensee of German Trademark 396 34 157 and the owner of German Trademark 303 56 840.2 is not in dispute and Mr. Golb had submitted documentary evidence of said license and registration in good time. The cover sheet of the application by Mr. Golbs however only made reference to <handy.eu> as a prior right. The Complainant objected that Mr. Golb was not the owner of a trademark HANDY, that being the owner of HANDY.EU did not confer a prior right and that therefore his application should have been rejected. When, on disclosure of documentary evidence, it transpired that Mr. Golbs was in fact the licensee of the trademark HANDY and had submitted the documentary evidence of this in good time, the

Complainant disputed whether the EURid could accept the application of Mr. Golbs given that on the cover sheet of the application the prior right cite was only <handy.eu> while <handy> was not cited as a prior right on the same cover sheet.

The Panelist accepted the Registry's contention that since adequate documentary evidence establishing prior right (on the grounds of Mr. Golbs being a licensee of a German trade mark "HANDY") was received in good time, its acceptance of the application did not conflict with the Regulation.

The Panelist therefore confirmed the Registry's decision and denied the complaint.