Entscheidung der Schiedskommission for dispute CAC-ADREU-001049

Case number	**CAC-ADREU-001049**
Time of filing	**2006-05-02 12:06:41**
Domain names	**five.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Channel 5 Broadcasting Limited, Mr Paul Chinnery**

Respondent

Organization / Name	**EURid**

ANDERE RECHTLICHE VERFAHREN

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

SACHLAGE

This decision arises from an appeal by the Complainant, Channel 5 Broadcasting Limited against the decision by the Respondent, EURid, to register the domain name five.eu ("the Domain Name") to a third party P Dinnissen Beheer BV ("Dinnissen").

On 9 December 2005, Dinissen applied for the Domain Name under the phased registration ("Sunrise") period. The mark on which it relied was the Benelux word trademark n° 0782495, which was applied for on 8 December 2005 and granted on 9 December 2005. The form of the word trade mark comprises two words in upper case and one special character "fi&ve". There is no space between the words and the special character.

It can be seen that if the special character "&" (the ampersand) are removed, the word element of the mark becomes "five".

Article 3.c of the Commission Regulation (EC) 874/2004, provides that the requesting party must affirm that the request for the domain name registration is made in good faith and does not infringe any rights of a third party.

The Complainant is a broadcasting operator based in the UK, which has also applied on 27 March 2007 for the domain name under the provisions of the Sunrise period. The Complainant is the next applicant in the queue for the Domain Name. The prior rights (trademark and/or company name) on which the Complainant refers are not expressly identified and might be the number 5 (five), which is part of the English company name of the Complainant.

The Complainant's application is made pursuant to Section 22.2 of the Sunrise Rules which provides that following a decision by the Registry to register a Domain Name, an interested party may initiate an ADR proceeding against the Registry on the grounds of non-compliance of that decision with the Regulations. Pursuant to the provisions of B11 (d) (2) of the .eu

Alternative Dispute Resolution Rules and Article 22.11 of Regulation n° 874/2004, the sole purpose is accordingly to determine whether the decision taken by the Registry was in accordance with the applicable EU Regulations.

The relevant regulations which require particular consideration are as follows:
- Article 10(2) of Regulation n° 874/2004:
The registration on the basis of a prior right shall consist of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.

- Article 11 of Regulation n° 874/2004:
As far as the registration of complete names is concerned , where such names comprise a space between the textual or word elements, identicality shall be deemed to exist between such complete names and the same names written with a hyphen between the word elements or combined in one word in the domain name applied for.

Where the name for which prior rights are claimed contains special characters, spaces, or punctuations, these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten.

Special characters and punctuations as referred to in the second paragraph shall include the following: @ # $ % ^ & * ( ) + = < > { } [ ] | \ /: ; ' , . ? …

A. BESCHWERDEFÜHRER

For the complainant, the decision of the Registry to accept application no. 2 in the name of Dinnissen for the domain name five.eu based on a registered trade mark for “fi&ve” conflicts with Articles 10 and 11 of Commission Regulation (EC) 874/2004.

These provisions were designed to ensure that the .eu domain name and the name for which the prior right was claimed were identical or at least that there was as much “identicality” as possible where the prior right included elements that could not be reproduced exactly in the domain name.

For the Complainant, interpreting the second paragraph of Article 11 so to allow removal / hyphenation of special characters as of right is likely to result in domain names which are materially different to the relevant prior right. In the case of “fi&ve” removal of the special character means elimination of the most distinctive aspect of the relevant trade mark and has the effect of changing the nature and meaning of the trade mark to something significantly different.

Therefore, in line with the legal principles applicable to interpretation of EU legislation, the second paragraph of Article 11 can and should be interpreted in a way which is consistent with the purpose of the regulation and which avoids such absurd results, namely that the special characters must be rewritten if possible. Reference is made to the Barcelona decision (case n° 398).

The Registry’s mechanical approach (in allowing special characters to be deleted / hyphenated without requiring that they be rewritten) is not consistent with its statements and guidance in other contexts concerning the need for identicality between the name subject to prior rights and the domain name, which shows the importance attached to achieving as close a match as possible between the name subject to the prior rights and the domain name.

It would be a relatively straightforward matter for the Registry to determine whether or not a domain name applicant should have rewritten a special character rather then deleted or hyphenated it. Indeed guidelines could have been given as they have been in relation to so many other aspects of .eu Sunrise.

In any case, the Registry is already called upon to make detailed assessments of such matters as whether the domain name comprises the complete name in respect of device or figurative marks and whether a Sunrise applicant has established unregistered prior rights based on the relevant National law.

It is well established in case law of the European Court that a broad purposive approach must be taken to interpretation of

EU legislation.

B. BESCHWERDEGEGNER

In the Respondent's view, article 11 of the Regulation does not provide in an order of priorities. An applicant has the choice between three options when a special character can be rewritten. Therefore, the Respondent basically disagrees with the Complainant’s argument that the three options referred to in the second paragraph of article 11 are not always available and that the Respondent must determine which option should have been chosen in the specific circumstances of each case.

The Respondent notes that the Complaint's reasoning with regard to the interpretation of article 11 of the Regulation is similar to the reasoning of the Panel in case n° 398 (BARCELONA). The Panel in the BARCELONA case considers that the use of the words "if possible" means that one must look both at the type of special character and the prior right itself, "The position as to what is possible may depend on the Prior Right and the particular special character under consideration".

The Respondent disagrees with the Panel's interpretation that “if possible" means that a special character must be transcribed when it actually has a meaning and when the relevant public only understands the trademark in its transcribed variant. The use of the word "if possible" merely refers to the third option being available when the character can be rewritten. "If possible" as such refers to a possibility, not an obligation.

Moreover, the validation agent cannot be expected to determine how the relevant public understands a certain trademark. It is only empowered to examine domain name applications, not the trademarks which were submitted as prior right. Only courts and the trademark offices are empowered to make an assessment of a trademark.

The BARCELONA case was a proceeding against EURid. The holder of the trademark was not present in those proceedings while it is imperative that the holder of the trademark is given the opportunity to clarify its position on the relevant public's understanding of the trademark.

With regard to the Complainant's request to have the domain name transferred, the Respondent 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 should the Panel consider that the Registry’s decision must be annulled the Complainant's transfer request must be rejected.

WÜRDIGUNG UND BEFUNDE

The procedural rules applicable in the present case, i.e. action against the registry, exclude by definition the intervention of the concerned Applicant for a domain name on the basis of its prior trademark. This exclusion is maintained despite the fact that such procedure could result in the annulment of an EURID’s decision to grant a domain name on the basis of the said trademark. However, such annulment has per se no impact on the validity of the trademark at stake.

As already underlined in the Barcelona decision (case n° 398), the Article 11 is not free from ambiguity. Even if at first sight it is unclear as to whether the applicant is obligated to choose any particular course in preference to another the reasoning developed in the Barcelona decision remains fully relevant in the present case which deals with the special character &. This special character has the specific meaning “and”.

With regard to the use of the words "or" and "if possible", the Panel in that case stated that:
"The relevant phrase points both ways. The word “or” suggests that the applicant has an unfettered choice as to which of the 3 courses it should follow, whereas the words “if possible” tend to suggest that, if it is possible to re-write the name, that course should be followed. If the Article were construed in a manner which gave an Applicant an unfettered choice, it could lead to some surprising results. For example, the owner of a trademark for B&A&R&C&E&L&O&N&A could have chosen to

use it as the basis of a sunrise application for BARCELONA. eu. It should be presumed that the words “if possible” are not otiose. They must be intended to affect the meaning of a phrase which would otherwise give the applicant an entirely free hand, by requiring it to rewrite the name to deal with special characters where that is possible. The position as to what is possible may depend on the Prior Right and the particular special character under consideration but it is considered that it was possible on these facts to rewrite the name and that, on these facts, the Prior Rights should have been rewritten as BARCANDELONA."

In the particular case at stake the deletion of the special character "&" instead of its replacement by the word “and” is a fundamental and obvious change. The acceptance of an unfettered choice to the applicant regarding the use or not of “and” would render the words “if possible” inserted in Article 11 totally otiose in the specific circumstances of the present case. On these facts, the prior rights should have been rewritten as “fiandve” as in the Barcelona case, they should have been rewritten “BARCANDOLA”. Accordingly, it is not considered that the Respondent’s decision in this respect was in accordance with the Regulations.

With regard to the Complainant's request to have the domain name transferred, this latter fails to indicate the nature of his rights (trademark, company name …). In addition, the Registry must first assess, via the normal validation procedure, whether the Complainant's application satisfies the requirements of the Regulation.

ENTSCHEIDUNG

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders by majority that EURID’s decision be annulled.

The Complainant has asked the panel to allocate the Domain Name to it. However, beyond the existing uncertainty as to the panellist’s powers to order such transfer, as already underlined in the Barcelona decision and in the Respondent argumentation, such claim must anyway be rejected as the Complainant fails to explicitly identify his rights.

PANELISTS

Name	**James Bridgeman**

DATUM DER ENTSCHEIDUNG DER SCHIEDSKOMMISSION 2006-09-07

Summary

EINE ENGLISCHSPRACHIGE KURZFASSUNG DIESER ENTSCHEIDUNG IST ALS ANLAGE 1 BEIGEFÜGT

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The procedural rules applicable in the present case, i.e. action against the registry, exclude by definition the intervention of the concerned Applicant for a domain name on the basis of its prior trademark. This exclusion is maintained despite the fact that such procedure could result in the annulment of an EURID’s decision to grant a domain name on the basis of the said trademark. However, such annulment has per se no impact on the validity of the trademark at stake.

As already underlined in the Barcelona decision (case n° 398), the Article 11 is not free from ambiguity. Even if at first sight it is unclear as to whether the applicant is obligated to choose any particular course in preference to another the reasoning developed in the Barcelona decision remains fully relevant in the present case which deals with the special character &. This special character has the specific meaning “and”.

In the particular case at stake the deletion of the special character "&" instead of its replacement by the word “and” is a fundamental and obvious change. The acceptance of an unfettered choice to the applicant regarding the use or not of “and” would render the words “if possible” inserted in Article 11 totally otiose in the specific circumstances of the present case. On these facts, the prior rights should have been rewritten as “fiandve” as in the Barcelona case, they should have been rewritten “BARCANDOLA”. Accordingly, it is not considered that the Respondent’s decision in this respect was in accordance with the Regulations.

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For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders by majority that EURID’s decision be annulled.

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