

Panel Decision for dispute CAC-ADREU-001255

Case number CAC-ADREU-001255

Time of filing 2006-05-11 12:59:55

Domain names liechtenstein.eu

Case administrator

Name Tereza Bartošková

Complainant

Organization / Name HSH Prince Nikolaus von Liechtenstein

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 legal proceedings.

FACTUAL BACKGROUND

The Complainant is a member of the princely family of the Principality of Liechtenstein and also acts as an ambassador of the Principality of Liechtenstein to the European Communities. The Respondent EURid as a Registry of ".eu" domains registered the disputed domain name "Liechtenstein.eu". The registration was made upon application by the Dutch company Traffic Web Holding BV, filed on 7 December 2005. The registration was made on the basis of a valid Benelux trademark "Liecht & enstein", of which the applicant is the holder.

A. COMPLAINANT

The Complainant contends that the name Liechtenstein is the name of a sovereign state - the Principality of Liechtenstein. The disputed domain name is also a family name of the princely family of the Principality of Liechtenstein, which has a special legal status according to the Constitution of the Principality of Liechtenstein.

The name was included in the draft of the list of broadly recognised names with regard to geographical and/or geopolitical names that cannot be registered as domain names by third parties. By mistake, the name does not appear in the final version of the list, except as the heading of the section submitted by the Principality of Liechtenstein (Annex to Commission Regulation (EC) No 1654/2005). The Complainant contends that the heading should also be regarded as one of the names on the list.

As for the application by the company Traffic Web Holding BV, the Complainant contends that it was made in bad faith. It was made on the basis of a Benelux trademark "liecht & enstein", which, according to registration rules, it was possible to register as a domain name without the character "&", even though the applicant has no factual connection with the name. The company Traffic Web Holding BV submitted a total of 805 such applications. The registration was also made against the principle of comity as recognized by public international law.

B. RESPONDENT

The Respondent claims that the registration was made on the basis of Article 14(4) of the Commission Regulation (EC) No 874/2004, which provides for registration on the first-come, first-served basis for applicants demonstrating a prior right. The disputed domain name was not included in the list of broadly recognised names with regard to geographical and/or geopolitical names, published in Regulation No 1654/2005, even though the European Economic Area countries, among others Liechtenstein, were also given opportunity to submit such names. The Respondent is not authorised to add names to that list. The Respondent also claims that the Panel in previous cases took the view, that the Registry is not obliged to make an assessment of the good faith of the registration (case No

00012 Eurostar, and case No 00210 Bingo). In such cases the complaint should be initiated against the domain name holder and not the Registry. The Respondent cannot question the validity of the Benelux trademark, on which the application was based.

DISCUSSION AND FINDINGS

It is undisputed that the name Liechtenstein is not included in the list of broadly recognized names, published in the Regulation No 1654/2005, amending the Commission Regulation (EC) No 874/2004, which cannot be registered by third parties. The Panel agrees with the Respondent, that the Respondent is not entitled to add names to that list.

The Panel also agrees, that the subject, against whom the ADR proceeding in cases involving registration in bad faith (Article 21 of Commission Regulation (EC) No 874/2004) should be initiated is the holder of the disputed domain name, not the Registry. This view was taken in the case No 00210 (Bingo). The holder of the domain name has to be given the opportunity to respond to the allegations of bad faith.

There have been two similar cases already decided, the case No 398 (Barcelona) and the case No 00394 (Frankfurt). In both cases the complainant was the municipality concerned and the Respondent was the Registry. The domain name holder was the same company as in the present proceedings, the Traffic Web Holding BV. The manner applied in registering the domain name was the same. The company registered trademarks "frankf & urt" and "barc & elona".

The Panel in both cases faced the same question: is the Registry obliged to assess lawfulness of an application in cases involving applications made according to Article 11 of the Regulation (EC) No 874/2004, concerning replacement or omission of special characters?

Article 10.1 of Commission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and principles governing registration (Regulation No 874/2004) states the following: "Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts".

Article 10.2 states:

"The 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."

Article 11, Paragraph 2 states:

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

The view of the Respondent in all cases concerned is the same: if a domain name is made in one of the three ways mentioned in Article 11 (elimination, replacement or rewriting of a special character), it meets the criteria for registration and the Registry cannot refuse to register such a domain name.

The Panel in the cases Barcelona and Frankfurt took a different view. In the case Frankfurt the Panel stated, that:

"The existence of 'Prior Rights' in the .eu domain name applied for is the basic requirement that must be met when applying for such domain name during the Sunrise period. In view of the Panel, the owner of the mark 'FRANKF & URT' does not have rights in the word 'Frankfurt' (but only in 'frankfandurt' or similar) and therefore, it is not eligible for the registration of the domain name 'frankfurt.eu' since it does not fulfil Article 10.1.

It is incumbent on the applicant of a .eu domain name in the Sunrise period to request a domain name that consists of the complete name for which the prior right exists (cf. Article 10.2 Regulation 874/2004). At the same time, validation agents should assess the right which is claimed in respect of a particular name, and subsequently allocated to the applicant, as provided for in Recital 12 of Regulation 874/2004. The word 'assess' implies at least some degree of judgment by the Respondent (or the validation agent) and not the automatic acceptance of the substitution of the symbols mentioned in Article 11 for any of the three options mentioned therein at the choice of the applicant. The Panel believes that in the present case such degree of judgment should have been exercised and the application for the domain name 'frankfurt.eu' based on the mark 'FRANKF & URT' rejected.

In view of the Panel, Article 11 is a technical provision and the priority of the three options included therein should be assessed by comparing the domain name applied for and the Prior Right on which it is based. In the present case, deleting the '&' symbol would grant rights to the applicant in a domain name for which it does not have prior rights according to Article 10.1 of Regulation 874/2004. Thus,

the other options i.e. a hyphen or, if possible, rewriting, should have been followed.”

The Panel in the present case entirely agrees with the view of the Panel in the Frankfurt case. The trademark “Liecht & enstein” does not correspond to the domain name “Liechtenstein”. Registration of the domain name “Liechtenstein.eu” would grant the applicant a right to a name, for which he does not have prior rights. And according to Article 11, the Registry has to assess whether the trademark corresponds to the domain name in question.

For the said reasons the Panel decides in favour of the Complainant.

The Panel is aware of the difficulties the Registry would face in assessing the registration requirements in cases that are not an obvious misuse of the registration regulations as in the present case and the cases of Barcelona and Frankfurt. The Panel does not wish to impose on the Registry the obligation to exercise a full scale investigation in such cases. The Panel agrees that, as stated in the opinion in the Frankfurt case, “at least some degree of judgement by the Respondent” should be made in application of Article 11 of the Regulation No 874/2004. Assessment of such obvious misuses and rejection of registration would spare the legitimate holders of the names and the provider of many unnecessary and costly proceedings.

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.

The Panel also takes the view that, in accordance with Article 10.3 of Commission Regulation No 874/2004, the Complainant, the Principality of Liechtenstein, is eligible for the registration of the domain name “liechtenstein.eu”. Therefore, if permitted by the Procedural Rules, Registration Policy, Sunrise Rules and the Terms and Conditions, the Panel orders that the domain name “liechtenstein.eu” be attributed to the Complainant, the Principality of Liechtenstein.

PANELISTS

Name	Blaz Mrva
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DATE OF PANEL DECISION 2006-08-13

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, the ambassador of the Principality of Liechtenstein to the European Union and a member of the princely family in Liechtenstein, in the name of his country and in his own name filed a complaint against the Respondent's decision to register the domain name “Liechtenstein.eu” on behalf of the applicant, the Dutch company Traffic Web Holding BV, on the basis of the valid Benelux trademark “liecht & enstein”.

The Complainant claimed the registration was made in bad faith, the Respondent contended it was not its duty to assess bad faith of the applicant and that such claims could only be directed against domain name holders.

There were two almost identical previous cases, the case No 398 (Barcelona) and the case No 00394 (Frankfurt). Both were initiated by the local governments concerned, the Respondent was the Registry and the domain name holder was the same company, Traffic Web Holding BV. The basis for registration were the respective trademarks: “frankf & urt” and “barc & elona”.

The Panel agrees with the reasons given in previous decisions, that in applying Article 11 of the Regulation (EC) No 874/2004, which deals with replacement of special characters in names to be registered as domain names, the Registry has to assess, whether the trademark corresponds to the domain name in question and cannot therefore automatically register a domain name if one of the three possibilities from Article 11.2 is applied (omission, replacement, rewriting). Since the Registry did not make such an assessment and did not find that the registered domain name does not correspond to the trade mark on which it was based, the Panel annulled the Respondent's decision.
