Panel Decision for dispute CAC-ADREU-001262

Case number	CAC-ADREU-001262
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Domain names	nationalbank.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	National-Bank AG

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

None

FACTUAL BACKGROUND

The Complainant is a German bank. It filed an application for the domain name <nationalbank.eu> (the “Disputed Domain Name”) on 7 December 2005. The application was first in the queue and the documentary evidence was received by the Respondent on 13 January 2006, before the deadline of 16 January 2006.

The documentary evidence consisted of a letter stating that the German trade mark N NATIONAL-BANK (no. 30523619.9) had been applied for by the Complainant. The Complainant’s application was rejected by the Respondent on 3 April 2006.

The Complainant filed a Complaint against the decision of the Respondent on 15 May 2006. The Respondent had 30 working days from the formal date of commencement of the ADR proceedings (24 May 2006) to file a Response, but failed to do so within the time period allowed. On 17 July the Respondent did file a Response, but this was 10 days after the permitted deadline and not on the correct form prescribed by the ADR Rules. On 27 July the Complainant filed a Reply to the Respondent’s Response.

The panel was appointed to decide the case on 1 August 2006.

A. COMPLAINANT

The Complainant contends that the Respondent’s decision conflicts with EC Regulation Number 874/2004 (the “Regulation”) and that the Disputed Domain Name should therefore have been registered in its name by the Respondent.

The Complainant evidences that it is the owner of the following prior rights:

German word/picture trademarks registered with the German Patent and Trademark Office:
- NATIONAL-BANK, no. 39743866.4
- NATIONAL-BANK, no. 39743867.2
- N NATIONAL-BANK, no. 0523619.9 (the Panel notes that the correct number is in fact 30523619.9)
- DAS ZEICHEN GUTER PARTNERSCHAFT. NATIONAL-BANK, no. 0523620.2
- N NATIONAL BANK no. 30523621.0

The Complainant also points out that, although its registered trade name is “National-Bank”, it is generally known in Germany under the unregistered trade name/business identifier “Nationalbank” and is frequently referred to as “Nationalbank” by customers and media. In

support of this contention, the Complainant has attached copies and printouts of media coverage to the Complaint.

The Complainant owns the domain name <nationalbank.de>.

The Complainant asserts that it is eligible to obtain the Disputed Domain Name during the phased registration period (commonly referred to as the "Sunrise Period") in accordance with Article 10(1) of the Regulation because it is the holder of prior rights, the textual or word elements of which are deemed identical to the Disputed Domain Name pursuant to Articles 10(2) and 11 of the Regulation.

Article 10(1) states that prior rights shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and in as far as they are protected under national law in the Member State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.

The Complainant's unregistered business identifier "Nationalbank" is protected under German law. Sections 5(1) and 5(2) of the German Trademark Act provide that business identifiers are protected if they are (i) names used as a trade name in business dealings by the enterprise or (ii) names considered as identifiers of the respective enterprise.

The Complainant is widely known to customers and media as "Nationalbank". Media and customers are usually not aware of the differences between the Complainant's registered trade name "National-Bank" and the term "Nationalbank", in particular because the latter reflects the grammatically correct way of composing words in German, namely writing them in one word. Hyphenating is less common in German. Therefore, the public identifies the Complainant by the name "Nationalbank" and so the name enjoys protection under Section 5(1) and 5(2) of the German Trademark Act.

Furthermore, the domain name <nationalbank.de> points to the Complainant's company website. The Complainant asserts that, according to German case law, the domain name under which a company's website can be accessed is generally considered a protected business identifier pursuant to Section 5(2) of the German Trademark Act.

The Complainant also asserts that it is holding other prior rights which are deemed identical to the Disputed Domain Name under Article 11 of the Regulation, due to the fact that it is the registered holder of the trade name "National-Bank" as well as the proprietor of several word/picture trademarks consisting of the textual element of "National-Bank".

The Complainant alleges that, for the purpose of identicality within the meaning of Articles 10 and 11 of the Regulation, the hyphen between the word elements "National" and "Bank" should be eliminated from the corresponding domain name. According to Article 11, Paragraph 2 of the Regulation, where the name for which prior rights are claimed contains special characters, spaces or punctuation marks, these shall be eliminated entirely from the corresponding domain name. Punctuation marks are symbols that do not correspond to either phonemes (sounds) of a language nor to lexemes (words and phrases), but which serve to indicate the structure and organization of a writing, as well as, usually, intonation and pauses to be observed when reading it aloud. The Complainant therefore asserts that hyphens are punctuation marks within this generally accepted meaning.

According to the Complainant, any contrary interpretation of the Regulation would lead to arbitrary results. If the Complainant's prior right consisted of a two word trade name, for example "National Bank", the Complainant would have been eligible to register both <nationalbank.eu> and <national-bank.eu>, because under Article 11, Paragraph 1 of the Regulation, the trade name "National Bank" would be deemed identical both to <national-bank.eu> and to <nationalbank.eu>. In the Complaint's opinion, there is no sound justification for treating the trade name "National-Bank" differently. Furthermore the Complainant states that this would result in discrimination under Community law, as due to the structure of the English language, holders of prior rights in English speaking Member States would be far less likely to hold protected names consisting of hyphenated word compositions. In English, words are generally composed by simply writing them one after another. Thus, prior right holders from English speaking Member States would usually be eligible to register two domain names under .EU (one with the hyphenated two word name plus one with their two word name written in one word), while prior right holders from Member States in which the hyphen is more commonly seen would usually have to stick to the exact hyphenated version.

Prior right holders from Member States where the hyphen is more commonly used would therefore be at a considerable disadvantage. According to the Complainant, internet users tend to employ two main search methods when they are trying to "guess" a company's website address without using a search engine. One is to type the exact company name into the address bar, and the other is to type the company name in one word. Holders of hyphenated two word names would not be found by users adopting the second method, while holders of non hyphenated, two word names would be found with either method. In the Complainant's opinion, it would be unreasonable to grant the holders of two word names such a significant commercial advantage, and this would be in direct opposition to the

underlying principles of the Regulation. The establishment of the Sunrise Period was aimed at safeguarding prior rights recognised by Community or national law. According to Article 21 of the Regulation, only speculative or abusive registrations within the Sunrise Period are subject to revocation. The Complainant's application for registration of the domain name in question is clearly not speculative or abusive, and so the Respondent's decision prevents the Complainant from safeguarding its protected rights which are recognised by the Regulation.

The Complainant therefore requests that the Panel annul the Respondent's decision and attributes the Disputed Domain Name to the Complainant. The Complainant asserts that it is the next applicant in the queue for the Disputed Domain Name and meets all requirements set out in the European Union Regulations.

On 27 July 2006 the Complainant submitted a Reply to the Respondent's late Response and asserted that the Complaint should be decided with reference to the Complaint only, in accordance with Section B3(g) of the Alternative Dispute Resolution Rules (the "ADR Rules"). The Response was deficient as it was submitted late and the Respondent did not use the form prescribed by the ADR Rules and the Supplemental ADR Rules.

The Complainant did not contend that the documentary evidence initially provided to the Respondent did not refer to a trade mark registration, but to a trade mark application, and also that a trade mark application is not considered a prior right within the meaning of Article 10 of the Regulation.

However, in the Complainant's opinion, the issue to be resolved by the Panel is solely whether the decision taken by the Respondent conflicts with the Regulation or Regulation 733/2002 (collectively referred to as the "Regulations"), in accordance with Article 22 of the Regulation and that the Sunrise Rules should not be taken into account. The Complainant states that it is not the Panel's task to determine subjectively whether the Respondent erred in its decision, but objectively whether the decision is in conflict with Community law. The Complainant points out in this regard that the Panel in Case Number 325 (ESGE) ruled in favour of the Complainant despite the fact that the decision of rejection by the Respondent was well-founded on the merits. The Panel in ESGE stated: "Logically therefore, the domain name must be attributed to the Complainant since the documents which the Panel has reviewed evidence that at the time when the application for the domain name was filed and was examined, the Complainant was in fact the proprietor of an identical trade mark in force in Germany and was therefore entitled to the domain name." According to the Complainant, the Panel in ESGE attributed the domain name in question to the Complainant although it was uncontested that the documentary evidence provided in the application process was insufficient to substantiate a prior right. The Panel was particularly influenced by the fact that the Respondent relied on formal grounds in its defence, but failed "to expound the grounds of its decision within the time limits of the ADR proceedings", as in the present case. Consequently, the Panel found the Respondent had created "an unfair situation in which the Complainant has not been given a chance to develop an appropriate defence within the framework of an equitable inter partes procedure". The Complainant asserts that the situation in the present case is entirely based on comparable facts.

The Complainant also alleges that it can also be inferred from the provisions about ADR fees that the objective of the ADR procedure is not limited to the determination of whether the Respondent acted wrongfully in rejecting the Complainant's application. If this was the case, it could reasonably be expected that the ADR Rules would provide for a remedy, namely reimbursement of the ADR costs incurred by the successful Complainant. In the Complainant's opinion the absence of a remedy indicates that the ADR procedure is not concerned with whether the Registry is to blame for rejecting the application, but solely with whether the decision objectively conflicts with Community law, irrespective of possible errors or mistakes on the part of the Respondent.

The Complainant disagrees with the Respondent's conclusions drawn from the Panels' findings in Case Number 119 (NAGEL) and Case Number 404 (ODYSSEY) and asserts that these cases must be distinguished from the present one. In the present case, the Complainant argues that it is irrelevant whether a trade mark application that becomes a registered trade mark after the domain registration may be considered a prior right within Article 10 of the Regulation, as the Complainant is the owner of both registered and unregistered trade marks as well as trade names that existed before the domain application. In the present case, the Complainant states that it is not relying on a trade mark application that was pending at the time of the domain name application.

The Complainant also alleges that there is nothing in the Regulations which prevents the Panel from taking new evidence into account. Article 22 of the Regulation provides that the Complaint must be made in accordance with the Regulation and with supplementary procedures of the ADR provider. In this regard Section B1(b)(16) of the ADR Rules expressly states that the Complainant may "[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." The Complainant claims that the ADR Rules therefore expressly provide that new evidence may be submitted in the course of ADR proceedings, which demonstrates that the Panel is able to review the evidence provided by the Complainant and may base a decision on such new evidence. This view is supported by Section B7(a) of the ADR Rules, which permits the Panel to conduct its own investigations into the circumstances of the case in its sole discretion. In the Complainant's opinion, this

provision also demonstrates that the facts of the case are not solely to be determined by the formal evidence provided in the application process, but may also be determined by facts presented or found in the course of the ADR procedure. Section B11(a) of the ADR Rules clarifies this issue as follows: “A Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Procedural Rules”. According to the Complainant, it can only be inferred from this provision that the Panel shall take into account all documents submitted during the ADR process, as long as such documents were provided in accordance with the Procedural Rules. The Respondent does not dispute that the documents provided by the Complainant were submitted in accordance with the Procedural Rules, and so they should therefore be taken into account.

The Complainant further submits that, even if the formal view taken by the Respondent is right, it would be entirely unreasonable and a violation of fair trial principles. In the Complainant’s opinion, the formalism put forward by the Respondent is even more surprising because the Respondent itself failed to comply with the formal requirements of the ADR Rules. In Case Number 396 (CAPRI), the Respondent also rejected an application on purely formal grounds. The Panel in that case ruled that “justice shall rule over the strict formalistic approach”. The Complainant therefore requests the Panel in the present case to adopt this approach.

The Complainant points out that the Respondent does not challenge the Complainant’s submission that the Complainant is indeed the legitimate holder of prior rights within the meaning of the Regulation. In the Complainant’s view the Respondent thus concedes that the Respondent is the eligible holder of such rights, including the unregistered trade mark and the trade name “Nationalbank”, and so the Respondent solely relies on formal grounds for the rejection of the Complaint. In the Complainant’s view such formalism runs counter to the express rationale for the implementation of the Regulation, which is “to safeguard prior rights recognised by Community or national law”. The evidence provided clearly shows that the Complainant is a holder of such prior rights. Such rights undisputedly give the Complainant eligibility to the domain name in question. To ignore the evidence would amount to a denial of the rights recognised by Community law. In fact, this view also was taken by the Panel in Case Number 431 (CASHCONTROL). The Panel decided that, although the Respondent was right not to register the domain name at issue, ruling that the decision was lawful would be contrary to the reasons why the procedure was laid down.

B. RESPONDENT

The Respondent rejected the Complainant's application for the Disputed Domain Name because Article 10(1) of the Regulation states that only holders of prior rights which are recognised or established by national or Community law shall be eligible to apply to register domain names during the Sunrise Period. The validation agent concluded from its examination of the documentary evidence that the Complainant had based its application on a trade mark application, rather than a registered trade mark, and so it was therefore rejected.

The documentary evidence did not prove that the Complainant owned a registered trade mark, as referred to in Section 13.1(i) of the Sunrise Rules. Section 13.1(ii) of the Sunrise Rules expressly states that a trade mark application is not considered to be a prior right. No proof of the actual registration of the trade mark was provided.

The Respondent asserts that it is widely accepted, inter alia by the Panels in Case Number 119 (NAGEL) and Case Number 404 (ODYSSEY), that an applicant should comply with the Sunrise Rules. This also evidenced by the fact that the Complainant signed the cover letter submitted with its application, which includes the following statement: "The Rules, including the special terms that relate to the phased registration period [i.e. the Sunrise Rules], apply and have been read and approved without reservation by the Applicant".

In Case Number 404 (ODYSSEY), the Panel examined a near-identical factual construction, where the domain name applicant had only submitted a trade mark application as documentary evidence (although in this case the trade mark had been registered between the domain name application and the decision of the Registry). The Panel decided, on the basis of the Regulation and the Sunrise Rules that (i) a trade mark application does not constitute a prior right, and (ii) it is irrelevant if the trade mark application becomes a registered trade mark after the domain name application.

According to Section 21.2 of the Sunrise Rules, the Registry is only obliged to examine the documentary evidence. Indeed, Article 14(4) of the Regulation states that it is up to the applicant to substantiate that he holds a prior right. The applicant must do this by submitting documentary evidence which allows the Registry to assess if the applicant holds a prior right. As far as the Respondent is concerned, the Complainant failed to submit documentary evidence showing that he was the holder of a prior right as only proof of a trade mark application was submitted. Section 21.3 of the Sunrise Rules provides that there is no obligation for the Registry to conduct its own investigations concerning the prior right claimed (for example to verify whether the trade mark application has been registered since its application).

In addition, the Respondent asserts that the Disputed Domain Name did not consist of the complete name of the prior right. Article 10(2) of the Regulation states that registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, which is further clarified by Section 19.2 of the Sunrise Rules, which states that all alphanumeric characters (including

hyphens, if any) included in the sign must be contained in the domain name applied for, in the same order as that in which they appear in the sign. The Respondent therefore asserts that the complete name of the prior right would be NNATIONAL-BANK, not NATIONALBANK and argues that Article 10 (2) of the Regulation and Section 19 of the Sunrise Rules must be applied strictly, as in Case Number 470 (O2). The wording of both Articles is very clear, and both refer to the complete name, not a similar name.

The Respondent further points out that the Complainant did not enclose the trade mark registration, or even refer to it in any way, with its documentary evidence. Documents referring to a number of trade marks, domain names and an alleged trade name were only provided to the Respondent for the first time in the context of the ADR proceedings. Section 21.2 of the Sunrise Rules states that the validation agent must examine whether the applicant has a prior right to the domain name concerned exclusively on the basis of a prima facie review of the first set of documentary evidence received. In Case Number 294 (COLT), the Panel agreed that documents submitted in the framework of an ADR proceeding when assessing the validity of a decision of the Registry should not be taken into account. Therefore only the documentary evidence which the Respondent was able to examine at the time of validation of an application should be considered by the Panel. Indeed, Article 22(1)(b) of the Regulation states that ADR proceedings may only be initiated against the Respondent when the Respondent's decision conflicts with the Regulations. The Respondent asserts that it cannot have made a decision in conflict with these texts if it wasn't provided with all information, and the new evidence submitted by the Complainant should therefore be disregarded.

Finally, the Respondent points out that the new evidence provided by the Complainant does not prove any prior right. The Complainant's application was submitted on 7 December 2005, the first day of the Sunrise Period. Domain names applied for during the first stage of the Sunrise Period could not be based on trade names, as stated in Article 12(2) of the Regulation. In addition domain names are not considered to be prior rights under Article 10(1) of the Regulation, as observed by the Panel in Case Number 1375 (RABBIN), and furthermore the other trade marks the Complainant refers to in its Complaint (not submitted as documentary evidence) would not be sufficient to grant a right to the Disputed Domain Name in accordance with Article 10(2) of the Regulation.

DISCUSSION AND FINDINGS

Firstly the Panel notes that the Respondent's Response was filed late and that the Complainant has filed a Reply in response. In this regard the .EU ADR Rules provide that the Panel may decide whether or not to consider late or additional filings in its sole discretion. In the interests of a fair hearing the Panel has decided to take the additional documents into consideration, although it would like to emphasise that nothing in either the Response or the Reply alters its decision, which would have been identical had it been decided on the strength of the Complaint alone.

Article 22(11) of the Regulation states that, in the case of a procedure against the Registry, as is the case here, the Panel must decide whether the Registry's decision conflicts with the Regulations. The Panel must therefore decide, from a purely objective standpoint, whether the Respondent's actions were in accordance with the Regulations. The Panel would also add that, whilst the Sunrise Rules are helpful in clarifying the meaning of the Regulations, and set down detailed procedures for applicants to follow, they are not particularly pertinent when deciding whether the Respondent's actions were in accordance with the Regulations.

The Complainant applied for the Disputed Domain Name on 7 December 2005, the first day of the Sunrise Period, and so was therefore required to demonstrate ownership of a valid prior right in accordance with Article 12(2) of the Regulation, namely a registered national or Community trade mark or a geographical indication (in view of the Complainant's status as a bank, the rules on public bodies are not relevant). As can be seen from the documentary evidence disclosed by the Respondent, the Complainant only made reference to a trade mark application, which is not a valid prior right under the terms of Article 10(1) of the Regulation. However, the Panel's own brief research has revealed that the German trade mark in question (N NATIONAL-BANK, Number 30523619.9) was in fact registered on 23 August 2005.

The Panel is aware that numerous prior .EU ADR decisions have focused upon the extent of the Respondent's duties when faced with defective documentary evidence. It is therefore arguable that the Respondent, when faced with evidence of a trade mark application, should have taken two minutes to perform a search of the German trade mark register to discover that the Complainant did indeed possess a valid prior right. However, in these particular circumstances this particular line of enquiry is not particularly relevant, as, even if the Respondent had been aware that N NATIONAL-BANK was registered, it would still have been acting in accordance with the Regulations by refusing the application. Article 10(2) of the Regulation provides that the complete name for which the prior right exists must be reflected in the domain name applied for. A valid application for the Disputed Domain Name would therefore need to have been supported by a registered trade mark consisting of the words NATIONALBANK or NATIONAL BANK (the first paragraph of Article 11 of the Regulation states that spaces may either be eliminated or replaced by a hyphen). The provisions of the Regulation therefore effectively provide that the Respondent's trade mark in N NATIONAL-BANK could only have been used to apply for <nnational-bank.eu>.

The Panel would also like to point out that the second paragraph of Article 11 provides that if the name of a prior right contains special

characters, spaces or punctuation marks these must be either eliminated entirely from the corresponding domain name, replaced with hyphens, or rewritten. The third paragraph of Article 11 lists special characters and punctuation marks, but does not include hyphens. In the Panel's view this is not an omission as the purpose of Article 11 is to set out how prior rights should be treated when they contain characters that, for technical reasons, cannot be reflected in domain names. Hyphens can appear in domain names and so there is no need to provide special rules relating to them. This means that, when applying Article 10(2), which provides that the complete name for which the prior right exists must be reflected in the domain name applied for, Article 11 is not relevant in this particular case. According to the meaning of the Regulation, prior rights containing hyphen(s) can only be used to apply for domain names containing corresponding hyphen(s). In the Panel's opinion the Complainant's detailed arguments in relation to the fact that applicants should be able to delete hyphens from prior rights when applying for domain names do not advance the Complainant's case any further, as the wording of the Regulation is clear. The Panel is only bound to assess the Respondent's compliance with the Regulations, not whether the Regulations themselves are in accordance with Community or indeed any other law. If the Complaint wishes to challenge the legality of the Regulations themselves then the ADR procedure is not the correct forum.

In considering whether or not the Respondent's decision conflicts with the Regulations, it is only necessary for the Panel to consider the Respondent's actions at the time events took place. For the Complainant to have successfully applied for the Disputed Domain Name on the first day of the Sunrise Period, it would have needed to prove that it was the holder or licensee of a registered trade mark that would have entitled it to apply for the Disputed Domain Name in accordance with the Regulation. As demonstrated above, the Complaint does not appear to be in possession of such a trade mark. In the Panel's view, this is the distinguishing factor between this case and Case Number 325 (ESGE) cited by the Complainant. In ESGE the Complainant was indeed in possession of a valid prior right at the time of its application and so succeeded in its Complaint, even though the Panel was of the opinion that the Respondent's Response was valid and would have succeeded in preventing the granting of the domain name to the Complainant had it been filed in time.

The fact that the Complainant may in fact be in possession of other prior rights that may have entitled it to make a successful application at the opening of the second phase of the Sunrise Period in accordance with Article 12(2) of the Regulation is not relevant. The Complainant has put forward quite extensive evidence to demonstrate that it is in possession of unregistered rights in the term NATIONALBANK. If this is indeed the case, and it is not for the Panel to decide, then the Complainant should have submitted a correct application for the Disputed Domain Name on the opening of the second phase of the Sunrise Period on 7 February 2006, at which point the Disputed Domain Name was not taken. In fact what the Complainant appears to have done is to have made another application based on the same German trade mark on 29 March 2006. The Complainant argues that the ADR Rules do not prevent the admission of new evidence, but in the Panel's view the relevant provisions of the ADR Rules referred to are aimed at ADR proceedings brought against the registrant of a domain name, rather than the Registry, which in this case is the Respondent, where there is a clear cut off date provided for with regard to the submission of documentary evidence. It is not for the Panel to perform the task of the validation agent retrospectively and examine new evidence relating to prior rights. In the Panel's opinion to allow a Panel to do this would in effect be giving a Respondent a second bite at the cherry, contrary to Article 14 of the Regulation. In any event the Complainant was unable to prove a relevant prior right in phase one of the Sunrise Period, and failed to make an application based upon its unregistered rights in NATIONALBANK during phase two.

In this regard the Panel would point out that, in view of the sheer scale of the launch of the .EU extension, from a practical point of view it was necessary to insist that applicants complied with the relevant procedures and time periods set down in the Regulation. In the Panel's view those applicants who failed to do so should have not have any recourse against the Respondent (in the event that the Respondent correctly applied the Regulations), and to find otherwise would be impractical. It was not for the Respondent to correct the mistakes of applicants, as this would have been an almost infinite task.

The Panel therefore concludes that the Respondent's decision to reject the Complainant's application for <nationalbank.eu> does not conflict with the Regulations. As the Respondent's decision is in accordance with the relevant texts, the Panel is therefore obliged to uphold it and deny the Complainant's request that the Disputed Domain Name be awarded to the Complainant.

The Panel has also briefly observed that the next application to be considered once the ADR procedure is completed is that of an organisation referred to as LLTF, which filed an application on 6 April 2006 (the last day of the Sunrise Period) on the basis of a supposed Benelux trade mark in the term N&AT&IONALBANK. The Panel is aware that Panels in a number of prior decisions against the registrant of a domain name have viewed the registration of trade marks containing ampersands as an indication of bad faith, see for example Case Number 475 (HELSINKI). The Panelist would agree with this contention and observe that the Complainant may therefore have been better advised to wait until the Disputed Domain Name was registered and bring a Complaint against the registrant, in accordance with Article 21 of the Regulation. In any case, nothing in this decision prevents the Complainant from pursuing any further remedies against any subsequent registrant of the Disputed Domain Name.

DECISION

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	**David Taylor**

DATE OF PANEL DECISION 2006-08-06

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Respondent's Response was filed late and the Complainant filed a Reply in response. In the interests of a fair hearing the Panel decided to take the additional documents into consideration, although nothing in either the Response or the Reply altered its decision, which would have been identical had it been decided on the strength of the Complaint alone.

The Complainant applied for the Disputed Domain Name on the first day of the Sunrise Period, and so was required to demonstrate ownership of a valid prior right in accordance with Article 12(2) of the Regulation. However, the Complainant only made reference to a trade mark application, which is not a valid prior right under the terms of Article 10(1) of the Regulation.

In actual fact the trade mark in question (N NATIONAL-BANK, Number 30523619.9) was registered on 23 August 2005. However, even if the Respondent had been aware that the trade mark was registered, it would still have been acting in accordance with the Regulations by refusing the Complainant's application. Article 10(2) of the Regulation provides that the complete name for which the prior right exists must be reflected in the domain name applied for. A valid application for the Disputed Domain Name would therefore need to have been supported by a registered trade mark consisting of the words NATIONALBANK or NATIONAL BANK (the first paragraph of Article 11 of the Regulation states that spaces may either be eliminated or replaced by a hyphen). The provisions of the Regulation therefore effectively provide that the Respondent's trade mark in N NATIONAL-BANK could only have been used to apply for <nnational-bank.eu>.

In considering whether or not the Respondent's decision conflicted with the Regulations, it was only necessary for the Panel to consider the Respondent's actions at the time events took place. For the Complainant to have successfully applied for the Disputed Domain Name on the first day of the Sunrise Period, it would have needed to prove that it was the holder or licensee of a registered trade mark that would have entitled it to apply for the Disputed Domain Name in accordance with the Regulation, which did not appear to be the case.

The fact that the Complainant may have been in possession of other prior rights that may have entitled it to make a successful application at the opening of the second phase of the Sunrise Period in accordance with Article 12(2) of the Regulation was not relevant. If the Complainant was indeed in possession of unregistered rights in the term NATIONALBANK, then it should have submitted a correct application for the Disputed Domain Name on the opening of the second phase of the Sunrise Period, at which point the Disputed Domain Name was not taken.

It was not for the Panel to perform the task of the validation agent retrospectively and examine new evidence relating to prior rights. The Panel was of the opinion that to allow a Panel to do this would in effect be giving a Respondent a second bite at the cherry, contrary to Article 14 of the Regulation. In view of the sheer scale of the launch of the .EU extension, from a practical point of view it was necessary to insist that applicants complied with the relevant procedures and time periods set down in the Regulation. In the Panel's view those applicants who failed to do so should have not have any recourse against the Respondent (in the event that the Respondent correctly applied the Regulations), and to find otherwise would be impractical. The Complaint was therefore denied.