Panel Decision for dispute CAC-ADREU-001273

Case number	CAC-ADREU-001273
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Domain names	private.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Cine Craft Ltd, Oriol Abad

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 other legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, Cine Craft Limited, is a company domiciled in Gibraltar and the owner of several trademark registrations of the word “PRIVATE”. The Complainant has applied for the domain name PRIVATE.eu claming a prior trademark right to the name.

However, the Complainant’s application was denied by the Respondent, EURID, due to the fact that the Dutch company Traffic Web Holding BV had applied for the same domain name prior to the Complainant’s application.

The Complainant challenges the Respondent’s decision to admit the application for the domain name PRIVATE.EU based on Traffic Web Holding BV’s registered Benelux trademark “PRIVATE” (registered in class 04, “Smeermiddelen”). Consequently, the Complaint claims that Traffic Web Holding BV’s application for the said domain name has bad been applied in bad faith. Pursuant to Article 21(1), cf. Article 21(2) and 21(3) of Regulation (EC) No. 874/2004 (hereinafter referred to as the Regulation) the Complainant requests the Panel to annul EURID’s decision and transfer the domain name to the Complainant, who is second in queue for the domain name.

A. COMPLAINANT

The Complainant has stated that the concerned domain name is identical to the Complainant’s worldwide registered PRIVATE trademark (among others issued by OHIM trademark No. 000873125 and as Benelux trademark No. 582.024). Internet users will not be able to distinguish the concerned domain name from Complainant’s PRIVATE trademark or the Complainant’s domain name private.com.

Traffic Web Holding BV has no legitimate prior right to the name PRIVATE, and the Complainant has never licensed or authorized Traffic Web Holding BV to use the trademark PRIVATE. Moreover, Traffic Web Holding BV has not previously used the name PRIVATE to sell or offer goods or services. Whereas the Complainant has used the trademark PRIVATE commercially since 1965 and has registered the PRIVATE trademark since 1972 (the mark is registered in more than 50 countries). Also, the PRIVATE trademark has acquired a special distinctiveness; cf. the decision made by the Office for Harmonization of Internal Market in case no. 2.603.348.

The Complainant has stated that Traffic Web Holding BV registered the domain name in bad faith for two main reasons. Primarily for taking advantage of – among others - the Complainant’s reputation and goodwill in order to confuse Internet users and gain traffic to its website. Secondly, Traffic Web Holding BV has registered the domain name in order to resell it to the Complainant for a higher price than originally paid.

In support of the argument of bad faith, the Complainant has presented a list of domain names which have been registered by Traffic

Web Holdings BV. The Complainant has seemingly traced 805 domain names registered by Traffic Web Holding BV without – according to the Complainant – any legitimate prior right hereto. These registrations include:

www.africa.eu, www.albania.eu, www.algeria.eu, www.alicante.eu, www.america.eu, www.amsterdam.eu, www.andorra.eu, www.angola.eu, www.ankara.eu, www.argentina.eu, www.armenia.eu, www.asia.eu, www.athens.eu, www.australia.eu, www.barcelona.eu, www.beijing.eu, www.belarus.eu, www.belfast.eu, www.birmingham.eu, www.bosnia.eu, www.bosniaherzegovina.eu, www.brazil.eu, www.budapest.eu, www.cambodia.eu, www.cambridge.eu, www.canada.eu, www.chile.eu, www.china.eu, www.cologne.eu, www.colombia.eu, www.copenhagen.eu, www.dubai.eu, www.dublin.eu, www.dusseldorf.eu, www.dvd.eu, www.ecuador.eu, www.edinburg.eu, www.egypt.eu, www.elsalvador.eu, www.football.eu, www.frankfurt.eu, www.geneva.eu, www.georgia.eu, www.glasgow.eu, www.guatemala.eu, www.guinea.eu, www.helsinki.eu, www.hollywood.eu, www.hongkong.eu, www.india.eu, www.iraq.eu, www.israel.eu, www.istambul.eu, www.japan.eu, www.jersey.eu, www.korea.eu, www.kuwait.eu, www.lastminute.eu, www.lasvegas.eu, www.liechestein.eu, www.lisbon.eu, www.liverpool.eu, www.london.eu, www.macedonia.eu, www.mallorca.eu, www.mexico.eu, www.milan.eu, www.moscow.eu, www.moldova.eu, www.monaco.eu, www.montenegro.eu, www.morocco.eu, www.munich.eu, www.nice.eu, www.nepal.eu, www.newzealand.eu, www.niederlande.eu, www.nigeria.eu, www.oslo.eu, www.pakistan.eu, www.panama.eu, www.paris.eu, www.phillippines.eu, www.prague.eu, www.riga.eu, www.rome.eu, www.russia.eu, www.saudiarabia.eu, www.serbia.eu, www.singapore.eu, www.sofia.eu, www.southafrica.eu, www.stockholm.eu, www.swiss.eu, www.switzerland.eu, www.sydney.eu, www.taiwan.eu, www.thailand.eu, www.turkey.eu, www.tunisia.eu, www.usa.eu, www.ukraine.eu, www.unitedstates.eu, www.vatican.eu, www.venice.eu, www.vienna.eu, www.warsaw.eu, www.washintong.eu, www.zurich.eu.

Due to these facts the decision taken by the Respondent conflicts with Article 21(1), cf. Article 21(2) and Article 21(3) of the Regulation and has to be annulled and the domain name shall be transferred to the Complainant.

B. RESPONDENT

Article 10(1) of the Regulation states that holders of prior rights which are recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before the general registration of .eu domain starts. A registered Benelux trademark – such as presented by Traffic Web Holding BV - is considered to be a prior right.

Pursuant to article 14(4) of the Regulation, the Respondent shall register the domain name on a first-come-first-serve basis if it finds that the applicant has demonstrated a prior right.

Traffic Web Holding BV applied for the domain name PRIVATE on December 7, 2005. As the documentary evidence consisted of a valid Benelux trademark for the mark PRIVATE, the Respondent has accepted the application for the domain name PRIVATE.

With regard to the Complaint's reference to the domain name being registered in bad faith the Respondent refers the Panel to article 22 (1)b of the Regulation, where after an ADR procedure may be initiated by any party where a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002.

Article 14(7) of the Regulation provides that under the phased registration the Respondent shall register the domain name if it finds that the applicant has demonstrated a prior right. Therefore, during the phased registration period, the decision by the Respondent whether or not to register the domain name can only be taken on the ground of the findings whether or not Traffic Web Holding BV has demonstrated a prior right.

According to the Respondent, there is no legal ground in the Regulation for the Respondent to reject an application for a domain name on the presumption that the application may have been made in bad faith or for speculative reasons. As there is no obligation under the Regulation for the Respondent to assess the bad faith of the applicant and as article 22 (1)b states that a decision by the Respondent can only be annulled when its decision conflicts with the Regulation, the Complaint must be dismissed. The Respondent has referred the Panel to the decisions in case no 00210 (BINGO) and case no 00012 (EUROSTAR).

In the case of a speculative and abusive registration, ADR proceedings must be initiated against the domain name holder itself, not the Respondent, cf. the decisions in cases no 532 (URLAUB), 382 (TOS), 191 (AUTOTRADER) and 685 (LOTTO). Such ADR proceedings are still open to the Complainant.

DISCUSSION AND FINDINGS

Initially the Panel notices that the Respondent has not submitted its answer to the Complaint in due time which is 30 days after receiving the complaint. Respondent has therefore in this aspect not complied with article 22(8) of the Regulation. However, the information in the

Respondent's delayed response does not include information that would have changed the Panel's decision and therefore the Panel had decided to admit the response submitted by the Respondent.

The Panel notes that the delayed response does not automatically result in a decision in favour of the Complainant, cf. Article 22(10) of the Regulation.

Moreover, the Panel notes that the Complainant at times in the Complaint makes reference to the Respondent being in bad faith when registering the domain name, and that the Respondent has no legitimate interest in the domain name. For the sake of order the Panel notes that it has assumed that this has been a spelling mistake, and that the Complainant instead has meant "Traffic Web Holding BV".

When examining an application for a domain name the Respondent's principal obligations are stated in article 14 of the Regulation. According to article 14(7) the Validation Agent shall examine whether or not the applicant holds a prior right to the domain name. Pursuant to article 10(1) a prior right can consist of a registered national trademark. The Respondent grants the domain name to the applicant if the application and the documentary evidence satisfy the conditions set out in the Regulation.

In the Panel's opinion Traffic Web Holding BV's application and documentary evidence meets the formal requirements in the Regulation and the additional ADR-Rules for being granted the domain name. Thus, Traffic Web Holding BV has submitted documentary evidence for a prior right in the form of a trademark registration.

The Complainant's main argument is, however, that the registration has been made in bad faith, and the decision therefore should be annulled. There are circumstances in the material presented before the Panel that could indicate that Traffic Web Holding BV has been in bad faith when registering PRIVATE.eu. Thus, Traffic Web Holding BV's has made a vast number of registrations of .eu domains under the Sunrise Periods based on trademarks registered shortly before the Sunrise Period started. Some of these have already been found to be registered with a speculative purpose in mind, cf. the ADR-decision in case no. 00394 where the trademark "FRANKF&URT" was registered in order to try to obtain the domain name "FRANKFURT.EU".

The Panel, however, does not find that the Respondent was obliged to make investigations as to whether the registration was made in bad faith according to Article 21 of the Regulation. Such investigations should only be initiated if it is obvious – from the material presented to the Respondent – that the registration is made in bad faith, or the Respondent has received a notice from a party having a legitimate interest herein, that the registration has been made in bad faith. This is not the case in the matter at hand. The Respondent's obligations are to safe guard that the formal requirements in the Regulations are respected. These formal requirements have been met in this case. Thus, it must also be kept in mind that the Respondent has received a vast number of applications during the Sunrise Periods, and it would not have possible for the Respondent to investigate the potential bad faith arguments in all of these cases.

The Panel adopts the approach of the panellists in case no. 00685 (LOTTO), where the Panel stated that the Registry, in the absence of a specific notice regarding the existence of factual circumstances regarding the (possible) bad faith of the applicant, is not required to assess whether the applicant is acting in good faith or not.

Moreover, the Panel refers to case No. 00210 (BINGO) in which the Panel found that the Respondent was not obliged to make an assessment in accordance with Article 21 of the Regulation.

Finally, it would also conflict with legal principles of fair procedure if Traffic Web Holding BV was not given a right to defend itself against the allegations of the bad faith registration. This can only be done if Traffic Web Holding BV is a part of the ADR-case, which is not the case in the matter at hand.

The Panel finds that the case therefore should have been initiated directly against Traffic Web Holding BV if the Complaint would have had the Panel to make a material decision as to whether the registration had been made in bad faith. The Panel thereby adopts the findings of the Panel in CORK (case no. 00504).

Consequently, the Complainant must initiate an ADR-procedure directly against Traffic Web Holding BV if the Complainant wishes to have the argument of bad faith tested. The Panel notes that it will still be possible for the Complainant to initiate such an ADR-procedure against Traffic Web Holding BV.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the Complaint is Denied

PANELISTS

Name	Jakob Plesner Mathiasen

DATE OF PANEL DECISION 2006-08-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant challenged Eurid's decision to allow the registration of PRIVATE.eu to the company Traffic Web Holding BV on a first to file basis. Eurid allowed the registration to Traffic Web Holding BV since the company applied first for the domain name and supplied documentary evidence in the form of a Benelux trademark of PRIVATE.

The Complainant has challenged this registration since the registration according to the Complainant has been made in bad faith.

The Panel found that Traffic Web Holding BV's application met the formal requirements in the Regulation. There were no obvious circumstances – in the material sent to Eurid – proving that the application was made in bad faith. In the absence of these obvious circumstances the Panel found that Eurid had not been obliged to make an investigation of whether the registration had been made in bad faith.

The Panel found that in the absence of these obvious circumstances a case regarding a potential bad faith registration should be initiated directly against the registrant of the domain name – Traffic Web Holding BV – and not Eurid.

The Panel has therefore not been able to make a material assessment of whether the registration was actually made in bad faith.

The Panel therefore dismissed the Complaint.