Panel Decision for dispute CAC-ADREU-001308

Case number	**CAC-ADREU-001308**
Time of filing	**2006-05-18 12:12:44**
Domain names	**pia.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**PIA Protect Invest Alliance**

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 which are pending or decided and which relate to the disputed Domain Name.

FACTUAL BACKGROUND

This decision arises from a complaint filed by the German company PIA Protect Invest Alliance GbR ("the Complainant"), against the decision by EURid ("the Respondent"), to register the domain name pia.eu (“the disputed Domain Name”) to a third party, Traffic Web Holding B. V. ("Traffic Web").

On 26 January 2006 at 15:52:31, Traffic Web applied for the disputed Domain Name under the first part of the phased registration period. The mark on which Traffic Web relied was the Benelux trade mark registration No. 781 189 "p & a" (word), filed on 01 December 2005. Documentary evidence of the registered trademark was submitted by the Complainant in due time.

The Respondent accepted the application on the basis that the right of Traffic Web to the name had been proven.

On 16 May 2006, the Complainant filed a complaint with the Czech Arbitration Court, asking to cancel the decision of the Respondent in accepting the application for the disputed domain name filed by Traffic Web.

On 18 May 2006, the Czech Arbitration Court informed the Respondent about the complaint and requested it to disclose information and documentary evidence related to the disputed Domain Name. On 23 May 2006, the Respondent provided the requested information and evidence.

On 24 May 2006, the Czech Arbitration Court notified the Complainant of some deficiencies relating to his Complaint (Paragraphs B1 (b) (7)(10)(11)(15) of the ADR Rules, Paragraph B1 (c) of the ADR Supplemental Rules). The deficiencies were corrected by the Complainant within the extended time limit set by the Czech Arbitration Court.

On 26 June 2006, the ADR proceedings commenced.

On 16 August 2006, the Respondent submitted its response with the Czech Arbitration Court.

On 22 August 2006, the Czech Arbitration Court appointed Mr. André Pohlmann as sole Panelist in this matter.

The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence in compliance with Paragraph B5 of the ADR Rules and Paragraph B(5) of the Supplemental ADR Rules.

A. COMPLAINANT

In support of its position, the Complainant contends as follows:

1. The decision of the Respondent regarding the disputed Domain Name infringes Article 10(2) of EC Regulation No. 874/2004. According to that provision, the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists. In case of the disputed Domain Name, Traffic Web is owner of the registered Benelux trade mark "p & a". Since the registered trade mark of Traffic Web and the domain name are not identical, the registration does not consist of the registration of the complete name in the meaning of Article 10(2) of EC Regulation No. 874/2004. Thus, the decision of the Respondent regarding the contested Domain Name is void.

2. Furthermore, the decision of the Respondent infringes Section 10(2) of the Sunrise Rules, which states that: "The Validation Agent examines Documentary Evidence for identical Domain Names in the order in which Applications are received by the Registry, in accordance with the procedure set forth in Article 14 of the Public Policy Rules. For non-identical Domain Names, the Validation Agent may - for efficiency purposes - determine the order in which Documentary Evidence is examined as it sees fit, depending on, for instance, (i) the number of Applications received for non-identical Domain Names, (ii) the languages in which Documentary Evidence for the various Applications is provided, (iii) the time and resources required for actually validating the existence of Prior Rights on the basis of the Documentary Evidence produced." The Complainant's understanding of the aforementioned provision is that identical Domain Names have priority to non- identical Domain Names.

3. In conclusion, the Complainant requests the annulment of the Respondent's decision to accept the application for the disputed Domain Name filed on behalf of Traffic Web.

B. RESPONDENT

The Respondent makes the following observations:

1. The decision of the Respondent is not in conflict with Article 10(2) of EC Regulation No. 874/2004. Article 10(2) of the Regulation states that: "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". Certain special characters, such as the ampersand ("&"), cannot be transcribed in a domain name for technical reasons. Therefore, Article 11 of the Regulation provides three options to solve the situation; either the special character must be eliminated entirely, replaced with hyphens, or, if possible, rewritten. In the case at hand, the Applicant chose to rewrite the ampersand, rather than eliminate it or replace it with a hyphen. The Applicant decided to replace the ampersand by its translation "i" ("and") in Polish, one of the official languages of the European Union. Recital 6 of EC Regulation No. 733/2002 states that through the .eu TLD, the Internal market should acquire higher visibility in the virtual market place based on the Internet. The .eu TLD should provide a clearly identified link with the Community, the associated legal framework, and the European market place. It should enable undertakings, organisations and natural persons within the Community to register in a specific domain which will make this link obvious. Recital 7 of EC Regulation No. 733/2002 also states that the .eu TLD can accelerate the benefits of the information society in Europe as a whole, play a role in the integration of future Member States into the European Union, and help combat the risk of digital divide with neighbouring countries. As should be clear from these recitals, the .eu TLD is an important tool in ensuring that the internal market is realized. The .eu TLD should therefore avoid any geographical and linguistic limitations. As the ampersand in the case at hand has been rewritten in one of the official languages of the European Union, the Applicant's application was accepted. "PIA" is thus a correct way to transcribe the prior right on the complete name "P&A" into a technically acceptable domain name, pursuant to Article 11 of EC Regulation No. 874/2004. Therefore, the Respondent's decision to accept the application did not conflict with the Regulation. It is also in line with decision No. 1239 (PESA). That case dealt with the identical Benelux trade mark "p & a", which was also the basis for the domain "pesa.eu". The applicant chose to rewrite the ampersand by using the word “ES” (which means “and” in Hungarian). The Panel accepted the prior right as basis for the domain.

2. The contested decision is not in conflict with Section 10 (2) of the Sunrise Rules. This section should be interpreted as follows: There is no particular order in which applications for different domain names (cfr. "non-identical") should be validated. However, in a situation where multiple applications were made for the same domain name (cfr. "identical"), the validation agent must first validate the application which was first received. In the case at hand, the Applicant and the Complainant applied for an identical domain name: PIA. The Applicant's application however was first received. The Complainant's application can therefore not be accepted.

3. The Respondents requests to dismiss the Complaint.

DISCUSSION AND FINDINGS

The Complainant’s application is made pursuant to Article 22(1)(b) of EC Regulation No. 874/2004, which provides that an ADR

procedure may be initiated by any party where a decision taken by the Registry conflicts with this Regulation or with EC Regulation No. 733/2002. Pursuant to Article 22(11) second subparagraph of EC Regulation 874/2004, the sole purpose of these proceedings is accordingly to determine whether the decision taken by the Respondent was in accordance with EC Regulation No. 874/2004 or with EC Regulation No. 733/2002.

1. As a preliminary remark, the Panel cannot see any deficiency in the allocation process itself. In particular, the Respondent has observed the "first come first served" principle which also applies to the first part of the phased registration period (see Article 14(10) of EC Regulation No. 874/2004). More for the sake of completeness, it should be added that Section 10(2) of the Sunrise Rules only refers to the order in which documentary evidence shall be examined by the validation agents: In the case of various applications for one identical domain name, the "first come first served" principle also applies to the examination of the evidence. If a number of applications is submitted for non-identical domain names, the validation agent may examine the evidence as it sees fit. There is no indication that the criterion of first receipt has been infringed when allocating the disputed Domain Name to Traffic Web. The Complainant's allegations have to be dismissed on this point.

2. As regards the question whether or not the prior Benelux trade mark "p & a" constitutes a valid basis for the registration of the disputed Domain Name, the following provisions of EC Regulation No. 874/2004 require particular consideration:

Article 10(2): 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: […] 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:

~ @ # $ % ^ & * ( ) + = < > { } [ ] | \ /:; ',. ?

[…]

Article 14(7): The relevant validation agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name. If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this.

As stated in Article 14 of EC Regulation No. 874/2004, it is the obligation of the validation agent to examine whether "the applicant that is first in line to be assessed for a domain name" has prior rights on the claimed name. Article 14 seventh paragraph indicates that the validation agent has to exercise a certain degree of judgment when "assessing" and "examining" the prior right. This is also confirmed by Recital 12 of Regulation No. 874/2004 which states that the validation agent should assess the right which is claimed for the domain name on the basis of the evidence provided by the applicant. When comparing the prior right and the applied domain name, the validation agent has to evaluate whether the domain name is covered by the prior right (see Decision No. 394 of 02 June 2006 [FRANKFURT]).

As a general rule, only the holders of prior identical rights shall be eligible to apply for a domain name during the phased registration (Article 10(2) of EC Regulation No. 874/2004). Article 11 of the Regulation contains the following three exceptions from the principle of identity between the prior right and the requested domain name:

- Signs containing a space between the word elements of a prior right may be written with a hyphen between the word elements or combined in one word (Article 11 first paragraph).
- Special characters may be eliminated, replaced with hyphens, or, if possible, rewritten under the conditions of Article 11 second paragraph.
- Finally, letters which cannot be reproduced in ASCII code may be reproduced without the additional elements of the letters or replaced by conventionally accepted spellings if the requirements of Article 11 fourth paragraph are met.

Being an exception to the general rule of identity, Article 11 has to be interpreted in a restrictive manner. Variations from the prior right can only be accepted if the result of the modification is still covered by the scope of protection of the prior right. The Panel takes the view that the scope of protection of the prior Benelux trade mark "p & a" does not cover the sign "PIA". The relevant public for the assessment of the scope of protection of the prior sign is the public of the territory where the earlier sign is protected (see Decision No.

1760 of 05 September 2006 [NEN]). In the proceedings at hand, the prior trade mark is protected in the Benelux. The Polish word "i" ("and" in English) is not known to the average consumer in the Benelux. Consequently, the scope of protection of the Benelux trade mark "p & a" does not include its Polish translation. The consumers in the Benelux would not refer to the Polish version "PIA" when being confronted with the sign "p & a". The fact that the Polish consumers refer to "PIA" when being confronted with the sign "p & a" is irrelevant because the prior trade mark claimed by Traffic Web is not protected in Poland.

The reason behind the phased registration is to ensure opportunities for holders of prior rights to register their names (Article 5(1)(b) of EC Regulation No. 733/2002), provided that the requested domain name consists of the complete name of the prior right (Article 10(2) of EC Regulation No. 874/2004). The identity rule between domain name and prior right implies that translations of the prior rights cannot be used as basis for a requested domain name. To give an example, it is quite clear that the registration of the domain name "gato.eu" would not be covered by the prior UK mark "cat" although "gato" is the Spanish translation of "cat". The prior Benelux trade mark "p & a" may have been a valid basis for the registration of domains like, for example, "pena.eu" (Dutch: "P en A") or "peta.eu" (French: "P et A") but not for its Polish version "PIA".

It is true that the purpose of the .eu TDL is to ensure the internal market of the Community in the digital age. The .eu TDL certainly enables undertakings, organisations and natural persons within the Community to register a clearly identified link with the European Community and it may also play an integrating role in the European Union. However, denying protection for the domain name "PIA" on the basis of the prior Benelux mark "p & a" does not lead to any geographical or linguistic limitations. In Decision No. 1239 of 15 May 2006 [PESA], the Panel observed that there is no explicit rule obliging the applicant to rewrite a special character in a particular language. However, contrary to the assessment made by the Panel in the PESA case, this does not mean that the owner of a national mark may choose a translation of the special character in any of the official EU languages. The scope of protection of the prior right has to be taken into account when assessing its capability of forming the basis for the requested domain during the phased registration period. Only if the scope of protection covers the whole territory of the EU (e.g. in the case of a registered Community trade mark), the applicant would indeed have the possibility to translate the ampersand in any EU language of his choice. However, in the case at hand, the scope of protection of the prior Benelux trade mark "p & a" does not cover the disputed Domain Name "PIA" since the public in the Benelux will not understand the meaning of the Polish word "i" ("and" in English) between the letters "P" and "A".

3. Consequently, Traffic Web was not eligible to apply for the disputed Domain Name during the first part of the phased registration on the basis of the claimed prior Benelux trade mark. The decision of the Respondent to accept the application was in conflict with Article 10(2) and Article 11 of EC Regulation No. 874/2004.

DECISION

For the reasons given above, and in accordance with Article 22(11) second subparagraph of EC Regulation No. 874/2004 and Paragraph B11(c) of the ADR Rules, the Panel decides that

- the decision of the Respondent to allow the application for the domain name pia.eu filed by Traffic Web Holding B.V. shall be annulled.

PANELISTS

Name	**André Pohlmann**

DATE OF PANEL DECISION 2006-09-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

This case concerns the question whether the Benelux trade mark "p & a" meets the criteria for the registration of the domain name "PIA". The Panel takes the view that the Polish translation "PIA" ("P i A" meaning "P and A" in English) is not covered by the scope of protection of the prior Benelux trade mark "p & a". The relevant public for the assessment of the scope of protection of the prior sign is the public of the territory where the earlier sign is protected (here: the Benelux). The Polish word "i" ("and" in English) is not known by the average consumer in the Benelux. The fact that the Polish consumers would refer to "P i A" when being confronted with the sign "p & a" is irrelevant because the prior right claimed by the applicant is not protected in Poland. The scope of protection of the Benelux trade mark "p & a" does not include its Polish translation. Consequently, the decision of the Respondent to accept the domain name pia.eu on the basis of the prior Benelux trade mark "p & a" is in conflict with the rule of identity between domain name and prior right (Article 10(2) of EC Regulation No. 874/2004) and not covered by the exceptions to the identity rule mentioned in Article 11 of the Regulation.