Panel Decision for dispute CAC-ADREU-001459

Case number	CAC-ADREU-001459
Time of filing	2006-05-22 11:44:40
Domain names	cese.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Comité économique et social européen (CESE), an institution of the European Community, paivi seppanen

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 any other legal proceedings involving the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a European Union consultative body that gives representatives of Europe's socio-occupational interest groups, and others, a formal platform to express their points of view on European Union related issues.

The Respondent is EURid which granted the disputed domain name: CESE.EU.

A. COMPLAINANT

The Complainant's submission in its complaint may be summarised as follows:

1. The Complainant states that it has earlier right to the name CESE. The acronym of the complainant read as CESE in the French, Italian, Spanish and Portuguese language, since the Bureau of the complainant has approved use of the name "comité économique et social européen" and therefore has a right established by common law on the name CESE as per February 19, 2002. The Applicant, Traffic Web Holding B.V., applied for the domain name on January 31, 2006, claiming prior right and submitted documentary evidence of a trade mark registered on January 30, 2006, namely reg. No 0790455 C & E (a composite mark made of the letters C, E and special character ampersand and figurative elements).
2. Further the Complainant contests that the domain name has been registered according to the various legal rules governing the .EU domain name applications during the so called Sunrise Period. Article 11 of the Commission Regulation No 874/2004 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 characters as referred to above shall include inter alia the character &.
3. Section 19:2 of the Registration Policy states, "A prior right claimed to a name included in figurative or composite signs /…/ will only be accepted if: (ii, a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the domain name applied for, in the same order as they appear in the sign, and (ii, b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear."
4. Section 19:6 of the Registration Policy states that "For names other than standard Latin script, the application must contain a transliteration into standard Latin script of the name for which the prior right is claimed. The transliteration must be done according to generally accepted transliteration standards. No transliteration of a script not generally used in an official language of the European Union will be accepted."
5. The Complainant further states that the above section (19:6 of the Registration Policy) only refers to names in other than standard Latin script, thus this section cannot be applied to the present case, since the claimed prior right contains characters used in the

standard Latin script.
6. Even if this section (19:6 of the Registration Policy) should be applied to the present case, according to the knowledge of the Complainant the special character & is not translated or is not considered as being a symbol equivalent to the letter combination ES in any of the official languages of the European Union.
7. Consequently, the general impression of the name protected by the prior right is not apparent in the domain name, and does not relate to the domain name as applied for. Further, there is a reasonable possibility of misreading the characters of which the name consists, since there is no corresponding translation ES of the symbol & in any of the official European languages. This constitutes a breach of the Article 11 of the Commission Regulation No 874/2004.
8. The Complainant requests the annulment of EURID's decision granting the domain name application for CESE.EU in the name of Traffic Web Holding B.V.

B. RESPONDENT

The Respondent's submission in its response to the complaint may be summarised as follows:

1. The Respondent states that top domain .EU serves to promote the European identity on the Internet. Further, through the top domain .EU the internal market should acquire higher visibility in the virtual market place based on the Internet. The internal market is a concept which is wary of geographical as well as linguistic limitations. Such limitations would be a bar to the further development of the internal market and should be avoided as much as possible. Therefore, it is the Respondent's understanding that the top domain .EU should have the same wariness with regards to geographical and linguistic limitations.
2. The validation agent handling the application for the domain name CESE.EU concluded from the documentary evidence that the applicant was the holder of a prior right, and therefore the Respondent accepted the Applicant's application - all in accordance with Article 10, 11 and 14 of the Commission Regulation No 874/2004, as well as Section 21 (2) of the Registration Policy.
3. Article 11 of the Commission Regulation 874/2004 allows the applicant to, if possible, rewrite special characters such as the character &. In this case the Applicant chose to use the letter combination ES instead of the special character &. The letter combination or word ES is a correct transcription of the character & in the Hungarian language which is one of the official languages of the European Union.

DISCUSSION AND FINDINGS

The Complainant challenges the Respondent's acceptance of the Applicant's application and the registration of the domain name CESE.EU under Article 11 of the Commission Regulation 874/2004 as well as under Section 19:2 of the Registration Policy.

The Complainant argues that the Applicant applied for the domain name CESE.EU claiming prior right on the basis of a Dutch trademark, when in fact the prior right consisted of a Benelux trade mark. The Respondent should therefore have rejected the domain name application as there was no identity between the data submitted with the application and the documents submitted to support the application.

The mere fact that the data submitted with the application claimed a Dutch trade mark as the prior right, when in fact the documents supporting the prior right showed a Benelux trade mark, does not constitute a hindrance to acceptance of the application.

Article 11 of the Commission Regulation states; As far as the registration of complete names is concerned, where such names compromise 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:

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

Section 19:2 of the Registration Policy states: "Documentary Evidence must clearly depict the name for which a prior right is claimed. A prior right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos etc.) will only be accepted if

(i) the sign exclusively contains a name, or

(ii) the word element is predominant, and can be clearly separated or distinguished from the element,

provided that

(a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the domain name applied for, in the same order as that in which they appear in the sign, and

(b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear. "

Both the Complainant and the Respondent make point of Article 11 of the Commission Regulation 874/2004. Where the name for which prior rights are claimed contains special characters, as in this particular case, namely the character &, the aforementioned Article provides three options, either the special character must be eliminated, replaced with a hyphen or rewritten. The third option will of course only be possible to use if the special character can in fact be rewritten. In this case the special character & also known as ampersand and it may very well be rewritten (an English transcription would be AND).

Given the fact that Article 11 of the Commission Regulation does not refer to any linguistic limitations and that such limitations would contest the fact that the European Union as well as the internal market is about bringing down both geographic and linguistic barriers, the transcription should, as a main rule, be accepted by the Respondent if made in any of the official European Union languages. The third paragraph of Article 6 of the Commission Regulation supports this interpretation.

Consequently, the principal rule would be; if the special character & may be rewritten, according to generally accepted transliteration standards, into the standard Latin script and reproduced in the ASCII code in any of the official European Union languages the transliteration should be accepted by the Respondent.

The Respondent argues that the letter combination ES is the correct transcription of the special character & in the Hungarian language which is an official language of the European Union.

However, despite of the argument put forward by the Respondent, the correct transcription of the special character & in the Hungarian language is ÉS rather than ES. There is no evidence that the special character & transcripts merely to the letter combination ES, in any of the official languages of the European Union. Therefore if the trade mark C & E, should be rewritten correctly it would read CÉSE.EU. However, É can not be reproduced in ASCII code due to the additional element of the apostrophe.

Article 11 paragraph 4 of the Commission Regulation states "/…if the prior right name contains letters which have additional elements that cannot be reproduced in ASCII code, such as ä, é or ñ, the letters concerned shall be reproduced without these elements (such as a, e, n). or shall be replaced by conventionally accepted spellings (such as ae). In all other respects, the domain name shall be identical to the textual or word elements of the prior right name."

However, the rule can only be applied if the PRIOR RIGHT contains letters which have additional elements. In this case it is not the prior right name, that is the Benelux registration for the trade mark C&E, that contains additional elements – it is the already rewritten trade mark.
The wording of the Commission Regulation does not support the right to rewrite, amend or alter prior right names that have already been rewritten in virtue of the same Commission Regulation. Thus the aforementioned Article can not be applied to the present case.

Further, in cases of transliteration there exists no "documentary evidence" per se – as the prior right in such cases is not the same as the domain name applied for – unless documentary evidence is provided for by the Applicant of the correctness of the transliteration or if the transliteration anyhow obviously is correct according to generally accepted transliteration standards.

The Panel finds no reason to comment upon the argument lodged by the Complainant regarding earlier prior right to the name CESE established by common law, nor the arguments regarding Section 19:2 of the Registration Policy.

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

PANELISTS

Name	**Raoul Smitt**

DATE OF PANEL DECISION 2006-08-15

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Given the provision of Article 11 of the Commission Regulation 874/2004, the Panel finds that the principal rule is that if the special character can be rewritten, according to generally accepted transliteration standards, into the standard Latin script and reproduced in the ASCII code in any of the official European Union languages the transliteration should be accepted by the Respondent.

However, in the present case the Panel has not been presented with any evidence supporting the assertion that the special character & transcripts into the letter combination ES in any of the official European Union languages. There is no doubt that the correct transcription is ÉS. ÉS can not be reproduced in ASCII code due to the additional element of an apostrophe and with the consequence that it can not be accepted.

Article 11 § 4 of the Commission Regulation can only be applied if the prior right contains letters which have additional elements. In this case it is not the prior right name, that is the Benelux registration for the trade mark C&E , that contains additional elements – it is the already rewritten trade mark. The wording of the Commission Regulation does not support the right to rewrite, amend or alter prior right names that have already been rewritten in virtue of the same Commission Regulation. Thus the aforementioned Article can not be applied to the present case.

For all the foregoing reasons the Panel orders that the decision of EURid shall be annulled.