Panel Decision for dispute CAC-ADREU-001467

Case number	**CAC-ADREU-001467**
Time of filing	**2006-05-25 15:30:13**
Domain names	**televork.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Televõrgu AS, Mr Kirill Lezeiko**

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 or decided cases which are related to the disputed domain name.

FACTUAL BACKGROUND

1. On December 7th, 2005, Televõrgu AS (hereinafter, also, the “Applicant” or the “Complainant”), filed an application (Annex 1 to the Complaint) to register the domain name “TELEVORK.EU” (hereinafter, also, the “Domain Name”), on the grounds of the trademark “TELEVÕRK”, registered by the Complainant in the Republic of Estonia on March 22nd, 2004.

2. The Applicant filed the Documentary Evidence, annexing to the Application the Certified Excerpt from the Registry of the Trademarks of the Estonian Patent Office (hereinafter, also, the “Excerpt”) (Annex 2 to the Complaint).

3. On April 11th, 2006, EURID (hereinafter, also, the “Register” or the “Respondent”) notified the Applicant the refusal to register the Domain Name (see Annex 3 to the Complainant) (EURID:45683:Y2ufWTcO4s+ObcUzk/JdZQ – April 11th, 2006, hereinafter, also, the “Decision”).

4. The Applicant asked the Register for an explanation in order to clarify the exact reason which the registration of the Domain Name has been refused. The Register explained that, after having approached one of its Documentary Evidence Validation Agent, it reached the decision of rejecting the Complainant’s application on the ground that the “trademark <televork> is not sufficiently protected”, because the Excerpt indicates “registration of the trademark does not give exclusive right for the use of the word TELEVÕRK” (see Annex 4 to the Complaint).

5. Televõrgu AS filed a Complaint before this Czech Arbitation Court (hereinafter, also, the “Court”) challenging the Decision that rejected the application for registration of the Domain Name. The Applicant attached original documents and relative certified translation in English. The (original) documents are:
1. Registration Application,
2. Certified excerpt from the registry of trademarks of the Estonian Patent Office,
3. E-mail from EURID, on April 11th, 2006,
4. E-mail from EURID, on April 13th, 2006.

6. The Court aknowledged the receipet of the Complaint by e-mail on May 19th, 2006, and in hardcopy on May 25th, 2006. The Court notified EURID on the Complaint and its time of filing.

7. The Court asked EURID for some information for verification of administative compliance of the Complaint. EURID answered to the

request with a Non-standard Communication and relative Documentary Evidence as far as the Domain Name is concerned.

8. EURID has been also notified on the formal date of the commencement of the ADR Proceeding (June, 1st, 2006) and it has been invited to submit a Response (and to make any required payment, in case of choice of a three member Panel) within 30 working days from the delivering of the notification. It has been also advised of the consequences in case the Response would not have been sent within the deadline or if it would not have complied with all adminatrative requirements mentioned in the ADR Rules and the ADR Supplementale Rules.

9. EURID filed the Response to Complaint asking for the rejection of the Complaint.

10. The Court aknowledged the receipt of the Response on July 21st, 2006.

11. On July 21st, 2006, the Court notified EURID that it has failed to comply with the above mentioned deadline, for the submission of the Response. EURID didn't challenge this notification.

12. The Court appointed this Panel (Marco Vincenti), who accepted to serve as a Panelist under .eu Dispute Resolution Rules and Supplemental Rules of the Court.

13. On July 31st, 2006, the Court notified to the parties that this Panel has been appointed and that he has submitted the Statement of Acceptance and Declaration of Indipendence and Impartiality.

14. The Panel is required to forward his decision within August 21st, 2006.

A. COMPLAINANT

In support of its position, Complaint contents as follows.

The refusal of EURID to register the Domain Name has no legal basis, and it has restricted the rights of the Complainant, in a way not compatible with applicable rules and law.

Reference made to various kinds of trademarks, there can be also figurative or composite one: they have the function "not to preclude other market players to use the protected term in their business activities".

In particolar, it can be deemed that the existance of the right to use the word contained in the trademark – as domain name – could be sufficiently evidenced by the fact that "a figurative mark containing the name applied for is validly registered to the Complainant".

As far as the basis of registration of Domain Name is concerned (that is, the existance of the prior right), the Complainant states that – pursuant to Section 11 of Sunrise Rules – "during the first phase of the Phased Registration Period, Domain Names that correspond to registered national trade marks may be applied for by the holder of the prior right concerned".

No differences are made between the protected / non protected part of a trademark, or the kind of registred trademark.

In the same meaning is art. 10, Reg. 874/2004. In particular, "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" should be considered, inter alia, prior rights.

As far as figurative / compositive signs are concerned, "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 device element".

The Complainant refers to Case No. 0012 as a pracedent in this meaning.

In particular, the Complainant deem that all the above mentioned requirements has been fulfilled, and proved by the Excerpt.

Last, Complainant puts in evidence that no other Applications have been filed to register the Domain Name during the First Phase Registration Period. This should bring to consider that potential restriction or abuse of other Applicants can be excluded with a reasonable probability.

B. RESPONDENT

With regards to Complainant's arguments, Respondent contests as follows.

The Compliainant has no prior right on the word "TELEWORK" and it has, in particular, failed to fulfill the obligation about the pertinent Documentary Evidence.

Pursuant to art. 10.1 of Reg. 874/2004, the Respondent states that only holders of prior rights shall be eligible to apply for .eu domain names. Pursuant to art. 14.4 of Reg. 874/2004, every Applicant shall submit Documentary Evidence in order to demonstrate the link between the existence of the prior right and the domain name.

In particular, Respondent states that "a mere right to use is not sufficient when a prior right is a trademark".

The Respondent observes that the Documentary Evidence submitted by the Complainant would show that the Complainant did not own exclusive rights on the word "TELEVORK" as such but only on the combination of the word toghether with the figurative elements of the trademark.

Because of the lack of competence in assessing trademarks, and because of the fact that the Respondent is bound to the assessment of trademark officies, the Respondent assessed that the Complainant had not any prior right on the "TELEVORK sign as such".

DISCUSSION AND FINDINGS

Before entering into the merit of the case, the Panel wishes to make the following preliminarily consideration.

According to Art. 22.8 of Reg. 874/2004, the Respondent shall submitt a Response within 30 days of the date of the receipt of the Complaint. The Complaint was notified to the Respondent on June, 1st, 2006, therefore the Respondent had to submit its Response by no later than June 30th, 2006. However, the Response was only filed on July 21st, 2006.

The Court notified the parties of the Respondent's default on July 21st, 2006. According to art. 3.g (Section B) of ADR Rules, the Respondent could have challenged the notification of the default within a pecific period (5 days from the receipt of the notification of the default). In the case at issue, the Respondent did not challenge the notification of its default as it could have done: this can be considered an implicit recognition of the default. Therefore, pursuant to art. 10.a of ADR Rules, the Panel shall proceed – at his discretion – to a decision based only on the Complaint (and relative Documentary Evidence).

As far as the case at issue is concerned, this Panel will not consider the defective Response, even if he thinks to make some consideration about.

In addition to the above procedural remarks, the Panel expresses as follows.

According to art. 22, par. 11 (2nd alinea) of Reg. 874/2004, the Panel: "In case of a procedure against the Registry, the ADR Panel shall decide whether a decision taken by the Registry conflicts with this Regulation (874/2004) or with Reg. 733/2002".

According to art. 4, par. 2 (alinea b) of Reg. 733/2002, "The Register shall: (..) b) register domain names in the .eu TLD through any accredited .eu Registrar by any: (i) undertaking having its registered office, central administration or principle place of business within the Community, or (ii) organisation established within the Community without prejudice to the application of the national law, or (iii) natural person resident within the Community".

Art. 10.1 of Reg. 874/2004 states that: "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.
'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".

Art. 10.2 of Reg. 874/2004 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".

In this regard, it has to be considered also Section 19.2 of the Sunrise Rules, that 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 device 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”.

The Panel considers tha the Complainant has a prior right on the word “TELEWORK” and that it has submitted sufficient and valid Documentary Evidence.

The Excerpt shows that the figurative trademark consists in the word “televõrk”. Reference made to the Domain Name “televork.eu”, this Panel considers that requirements ex Section 19.2 of the Sunrise Rules have been completely fulfilled by the Complainant.

As can be seen by the Excerpt, the sign contains the name “televork” (letter “õ” is to be considered as “o”).

Reference made to the note in the Excerpt saying: “registration of the trademarkk does not give the exclusiv right for the use of the word <<TELEVORK>>”, this Panel consider that the existance of a prior right does not means the existance of an exclusive right on the word considered for the application. In case of existance of more rights on the same word, it will be eligible to apply the relative .eu domain name the holder of the right that – among other things - has made the application first (rule: “first come, first served”).

In the case at issue, on the grounds of Complainant’s thesis, there are no more Application for the domain name “televork.eu” and it cab be shared the opinion that potential restriction or abuse of right of other Applicants can be excluded with a reasonable probability. On this regard, the Panel is not aware of other Application on the same Domain Name, and the circumstance is not challenged by the Respondent, nor it provide elements to justify other opinion.

Even if the Respondent has failed to comply with the deadline to submit its Response, this Panel deems to make some consideration on the Defective Response.

It is correct to say that the Respondent (the Register) has no competence in order to access the validity of a trademark.
But it is uncorrect to consider that any prior rights on the word (“televork” in the case at issue) does not exist only on the basis of the fact that there is not an exclusive right on the use of the mentioned word.

In particular, art. 10.1 (2nd par.) provides an open list, which can include figurative trademarks. Accordingly, registered (national / communitary) figurative trademark con be consider prior right.

By the end, Respondent didn’t provide this Panel any element to justify the application rejection (e.g.: documentation provided or found by the Validation Agent): the Register didnt’t prove to have made effort (requested on its behalf to the Validation Agent) to conduct investigations into the circumstances of the Application, the Prior right claimed and the Documentary evidence produced. In this meaning it can be cited Case N. 00174 : “No evidence of such reasonable and minimal attempt on behalf of the Validation Agent nor of failure of the Applicant to respond to such request has been advanced by the Respondent.” While the same section 21 (3) of the Sunrise Rules grants the Validation Agent “sole discretion” to carry out such investigations, it is a fundamental principle of justice that, when granted such discretion, the Validation Agent is not exempted from the requirement to act reasonably. Indeed, it may be argued that the extent of the discretion granted to the Validation Agent implies a higher standard of care and reasonableness. In the circumstances of the case, the Validation Agent could have easily cleared up any doubts by seeking and obtaining further proof of identity... It would be unreasonable for the Validation Agent not to have expended the minimum of effort required to clear any small doubt. For it is clearly the intention of the .eu Sunrise Rules that the role of the Validation Agent should go far beyond that of a mere clerical function, otherwise it would not have endowed this office with such wide and important investigative powers”.

All the considered circumstacens bring the Panelist to think that the Respondent’s Decisions should be annulled and Complainant’s requests granted: in particular, it has to be aaplied Section 27.1, 3rd par., that states: “If the ADR Proceeding concerns a decision by the Registry not to register a Domain Name and the Panel or Panelist appointed by the Provider concludes that that decision conflicts with the Regulations, then, upon communication of the decision by the Provider, the Registry will register the Domain Name in the name of the Applicant and will immediately activate the Domain Name”.

DECISION

For all the foregoing reasons, in acordance with ADR Rules and Supplemental ADR Rules, the Panel orders that Eurid's decision be annulled and the domain name "televork.eu" be registered in the name of Televõrgu AS.

PANELISTS

Name	**Marco Vincenti**

DATE OF PANEL DECISION 2006-08-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contests the decision of rejection issued by the Respondent against its domain name application for "televork.eu" under Sunrise Period.
The rejection was based on the fact that Respondent, taking into consideration the Documentary Evidence submitted by the Complainant, has deemed that the Applicant has no prior right on the word that the application was requested for.
The Documentary Evidence provided with the Application concerns a figurative trademark [the letteral part of the sign (televõrk) exaclty consists in the domain name that the application was requested for (except for letter "õ" that is to be considered as "o").
The Respondent failed to comply with the deadline for the submission of its Response.
The Panel finds that the Resiter's Decision is in contrast with Reg. 733/2002, Reg. 874/2004 and with Sunrise Rules : therefore, the Decision must be annulled and the Domain name is to be registered in the name of the Complainant.