Panel Decision for dispute CAC-ADREU-001711

Case number	**CAC-ADREU-001711**
Time of filing	**2006-06-07 09:32:37**
Domain names	**airco.eu, eircom.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Depmarc**

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 in relation to either of the disputed domain names <eircom.eu> and <airco.eu>.

FACTUAL BACKGROUND

The Complainant has requested annulment of two decisions made by the Respondent, EURid, regarding the domain names <eircom.eu> and <airco.eu>. The Complainant has further requested the disputed domain names to be either transferred or attributed to the Complainant.

Additionally, the Complainant has requested the Panel to order the Respondent to pay the costs of these ADR proceedings, including legal costs and ADR fees.

EIRCOM.EU

The first disputed domain name <eircom.eu> was applied by a company Eircom Ltd registered in Ireland, during the first phase of the phased registration period, i.e. the Sunrise I period. By a decision of the Respondent, EURid, the application was accepted and the domain name granted to Eircom Ltd. The documentary evidence for the application consists of an extract from the official database operated by the Irish Patents Office, which shows that the applicant Eircom Ltd is the proprietor of an Irish trademark registration no. 134954 EIRCOM.

The Complainant is a company registered in the Netherlands. It is the proprietor of the trade name E&I&R&C&O&M registered at the Dutch Chamber of Commerce. The Complainant filed an application for the domain name <eircom.eu> based on their aforementioned registered trade name on the first day of the second phase of the phased registration period, i.e. the Sunrise II period, for which the documentary evidence was duly provided. However, since Eircom Ltd had already filed an earlier application, which was later accepted, the Complainant's application could no longer lead to a registration.

AIRCO.EU

The second disputed domain name <airco.eu> was applied by the Complainant during the first phase of the phased registration period, i.e. the Sunrise I period. At the time of filing the application (4 February 2006) the Complainant had filed an application for the registration of the Benelux trademark AIR&CO for "Garens an draden voor textielgebruik" in international trademark class 23 and based its application on the said prior right. The said trademark application was filed on 3 February 2006 and the trademark wasregistered on 7 February 2006.

The Respondent, EURid, rejected the application filed by the Complainant and when requested by the Complainant to inform the reasons for the rejection, The Respondent stated that the Complainant's prior right on the trademark AIR&CO was not a registered trademark right at the time of filing the application for the domain name <airco.eu>, but instead a pending application for a trademark registration.

The Complaint regarding both of the above domain names <eircom.eu> and <airco.eu> was filed on 7 June 2006.

The Respondent failed to comply with the deadline indicated in the Notification of Complaint and Commencement of ADR Proceeding for the submission of its Response. The Panel therefore considers the Response mainly for information purposes.

A. COMPLAINANT

The Complainant makes the following contentions:

EIRCOM.EU

The Complainant contends that the domain name <eircom.eu> was incorrectly granted to Eircom Ltd by the Respondent, since Eircom Ltd had made an error in their application for the said domain name. In the field "Prior right on name" Eircom Ltd had erroneously inserted the information "Eircom Brand and Advertising" instead of "EIRCOM" which would have correctly indicated the prior right Eircom Ltd had.

The Complainant argues that based on Article 10 (2) of the Commission Regulation (EC) 874/2004, Article 19 (1) of the Sunrise Rules and the "Dot-eu Sunrise Validation Services for EURid" guidelines of the validation agent PricewaterhouseCoopers all state that a prior right shall consist of a registration of the complete name for which the prior right exists and that the applied domain name must exactly match the name for which the prior right exists.

The Complainant further argues that in the Respondent EURid's Newsflash publication of 9 December 2005, the Respondent informed that inaccuracies entered in applications cannot be rectified and that such errors would most likely lead into the fact that the applied domain name cannot be registered for the holder of such an application. In order to avoid the risk of losing their applied domain names the Respondent advised that new applications containing flawless information should be filed.

The Complainant also submits that, pursuant to Article 11 of the Commission Regulation (EC) 874/2004, it is fully entitled to the domain name <eircom.eu> based on its trade name registration E&I&R&C&O&M registered at the Dutch Chamber of Commerce and requests the Panel to annul the Respondent's decision and to be attributed the domain name.

AIRCO.EU

The Complainant contends that its application for the domain name <aircom.eu> should have been accepted by the Respondent, since the Complainant is of the opinion that their Benelux trademark application for the mark AIR&COM was a sufficient ground for an existing prior right.

In order to support their view, the Complainant argues that the Article 12 of the Benelux Trademark Act stipulates that one has a right to a trademark after it has been duly filed and that the same view has also been confirmed in the WIPO Decision of the UDRP Case No. 2000-1068 concerning the domain name pierrevanhooijdonk.com.

The Complainant further contends that The Respondent did grant various other domain name to their subject applicants although the domain name applications were based on such Benelux trademarks which had been filed, but not registered yet. The Complainant submits that such inconsistency by the Respondent in the acceptance of the domain name applications is against the principle that everyone should be treated equally before administrative authorities, such as the Respondent.

B. RESPONDENT

The Respondent makes the following contentions:

EIRCOM.EU

The Respondent submits that in accordance with the Article 3 of the Commission Regulation (EC) 874/2004 the mistakes on the requests for a domain name registration must be material for the application to be void and that an inaccuracy in the "prior right on

name" field of the application is not necessarily material, considering that one of the conditions for the inaccuracy to be material is that the documentary evidence does not allow the validation agent to correct the mistake made in the application.

The Respondent further contends that in accordance with the Article 14 of the Commission Regulation (EC) 874/2004 the validation agent must assess the documentary evidence in determining if there exists a prior right in the applied domain name. The Respondent therefore submits that once having assessed the documentary evidence, the validation agent can come into the conclusion that a mistake made in the application has been corrected by the information contained in the documentary evidence.

AIRCO.EU

The Respondent submits that in accordance with the Article 10 of the Commission Regulation (EC) 874/2004 (1) only the holder of a prior right is eligible to be granted the corresponding domain name and that the same Regulation clearly provides that the registered national or Community trademarks may be considered as prior rights. The said article is reflected in Section 13 of the Sunrise Rules, which provides in Section (1) (i) that "Where the Prior Right claimed by an Applicant is a registered trademark, the trademark must be registered by a trademark office in one of the member states, the Benelux Trade Marks Office or the Office of the Harmonization in the Internal Market (OHIM), or it must be internationally registered and protection must have been obtained in at least one of the member states of the European Union." and in Section 13 (1) (ii) that "A trademark application is not considered a prior right." Further, the Article 12 (2) of the Commission Regulation (EC) 874/2004 provides that "only registered national and Community trademarks may be applied as domain names."

The Respondent also refers to a number of ADR Decisions in order to support its view that a trademark application does not constitute a prior right as meant in the Commission Regulation (EC) 874/2004 and is thus irrelevant when assessing a .eu domain name application.

The Respondent further submits that its decision does not conflict with the Benelux Trademarks Act, as the first-come, first-served principle is duly followed in the application phases. However, the Respondent points to the fact that the in accordance with the Commission Regulation (EC) 874/2004 the applicant must not only be the first, but must also be the holder of the prior right at the time of filing the application.

The Respondent therefore finally submits that Commission Regulation (EC) 874/2004 and Sunrise Rules clearly and expressly provide that only registered trademarks can have been taken into account by the Respondent when they have assessed .eu domain name applications filed during the Sunrise I period.

DISCUSSION AND FINDINGS

First of all, the Panel states that the .eu Dispute Resolution Rules (the "ADR Rules") and the Supplemental ADR Rules do not render the Panel any competence to order either of the parties of an ADR case to pay the other party's ADR fees or legal costs in the ADR proceedings.

EIRCOM.EU

The intention behind the Commission Regulation (EC) 733/2002 on the implementation of the .eu Top Level Domain and the Commission Regulation (EC) 874/2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration, as is evident from the recitals of the said regulations, has been to allow holders of legitimate and genuine prior rights to register domain names, which correspond to their proprietary rights.

The Article 19 (2) of the Commission Regulation (EC) 874/2004 provides 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 documentation which proves that such a right exists." The Article 14 of the same Regulation provides that "Every applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question."

In accordance with the Section 21 (1) of the Sunrise Rules, the validation agent shall verify whether the official requirements for the documentary evidence and the requirement for the existence of a prior right to the name claimed by the applicant in the application is fulfilled. The Section 21 (3) goes on to provide that the validation agent is permitted to conduct its own investigations into the circumstances of the application, the prior right claimed and the documentary evidence produced.

The Panel finds that the main purpose of the Section 21 (3) of the Sunrise Rules has been to, reflecting the spirit of the Commission Regulations (EC) 733/2002 and (EC) 874/2004 allowing holders of legitimate and genuine prior rights to register domain names which correspond to their proprietary rights, allow the validation agent at his own discretion to correct obvious deficiencies in applications,

when it is clear that the applicant is de facto a holder of a genuine prior right and has simply made a clear mistake in the information provided in the application.

It appears that Eircom Ltd had misunderstood the meaning of the “prior right on name“ field in the application and although it was a true holder of a legitimate and genuine right, had mistakenly provided wrong information on the said application field.

Once the documentary evidence was reviewed by the validation agent, the agent was able to determine that the applicant was the true holder of a prior right, which was identical to the domain name it had applied for. The valid right and its identical nature to the domain name applied were clear and evident from the documentary evidence the applicant provided to the validation agent.

Based on the foregoing, the Panel finds that the decision made by the Respondent to grant the domain name to Eircom Ltd was justified and rejects the Complaint with respect to the domain name <eircom.eu>.

AIRCO.EU

The Article 12 (2) of the Commission Regulation (EC) 874/2004 very clearly provides that “During the first part of phased registration only registered national and Community trademark may be applied as domain names.” The Sunrise Rules Section (1) (i) provides further that “Where the Prior Right claimed by an Applicant is a registered trademark, the trademark must be registered by a trademark office in one of the member states, the Benelux Trade Marks Office or the Office of the Harmonization in the Internal Market (OHIM), or it must be internationally registered and protection must have been obtained in at least one of the member states of the European Union.” and in Section 13 (1) (ii) that “A trademark application is not considered a prior right.”

The Complainant applied for the domain name <airco.eu> during the first phase of the phased registration period, i.e. the Sunrise I period, based on its application for the Benelux trademark AIR&CO. At the time of filing the application the trademark was not yet registered, but instead only an application for a trademark registration.

The existence of unjust decisions made in error by the Respondent in other cases, in which the domain names have apparently been mistakenly granted to their applicant’s based on a trademark application alone as a prior right during the Sunrise I period, cannot be interpreted to mean that the Respondent would be obliged to repeat such errors.

Based on the foregoing, the Panel finds that the decision made by the Respondent to reject the application made by the Complaint was justified and rejects the Complaint with respect to the domain name <airco.eu>.

DECISION

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

the Complaint is Denied

in its entirety, with respect to both disputed domain names <eircom.eu> and <airco.eu>.

PANELISTS

Name	**Sanna Aspola**

DATE OF PANEL DECISION 2006-08-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant requested annulment of two decisions made by the Respondent, EURid, regarding the domain names <eircom.eu> and <airco.eu>. The Complainant further requested the disputed domain names to be either transferred or attributed to the Complainant.

EIRCOM.EU

The domain name <eircom.eu> was applied by Eircom Ltd, during the first phase of the phased registration period, i.e. the Sunrise I period. By a decision of The Respondent, EURid, the application was accepted and the domain name granted to Eircom Ltd. The documentary evidence for the application consists of an extract from the official database operated by the Irish Patents Office, which shows that the applicant Eircom Ltd is the proprietor of an Irish trademark registration no. 134954 EIRCOM.

The Section 21 (3) of the Sunrise Rules provides that the validation agent is permitted to conduct its own investigations into the circumstances of the application, the prior right claimed and the documentary evidence produced. The Panel finds that the main purpose of the Section 21 (3) of the Sunrise has been to, reflecting the spirit of the Commission Regulations (EC) 733/2002 and (EC) 874/2004 providing for holders of legitimate and genuine prior rights to register domain names which correspond to their proprietary rights, allow the validation agent at his own discretion to correct obvious deficiencies in applications, when it is clear that the applicant is de facto a holder of a genuine prior right and has simply made a clear mistake in the information provided in the application.

Based on the documentary evidence the validation agent received, he was able to determine that the applicant Eircom Ltd was the true holder of a prior right, which was identical to the domain name it had applied for. The valid right and its identity to the applied domain name were clear and evident from the documentary evidence the applicant provided to the validation agent.

Based on the foregoing, the Panel finds that the decision made by the Respondent to grant the domain name to Eircom Ltd was justified and rejects the Complaint with respect to the domain name <eircom.eu>.

AIRCO.EU

The Article 12 (2) of the Commission Regulation (EC) 874/2004 very clearly provides that “During the first part of phased registration only registered national and Community trademark may be applied as domain names.” The Sunrise Rules reflect the same rule with no exceptions.

The Complaint applied for the domain name <airco.eu> during the first phase of the phased registration period, i.e. the Sunrise I period, based on its application for the Benelux trademark AIR&CO. At the time of filing the application the trademark was not yet registered, but instead only an application for a trademark registration.

Based on the foregoing, the Panel finds that the decision made by the Respondent to reject the application made by the Complaint was justified and rejects the Complaint with respect to the domain name <airco.eu>.