Panel Decision for dispute CAC-ADREU-001812

Case number	**CAC-ADREU-001812**
Time of filing	**2006-06-22 14:37:07**
Domain names	**aaaauto.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**AAA AUTO a.s., JUDr. Dalibor Elledr**

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 pending legal proceedings.

FACTUAL BACKGROUND

The contested domain name was applied for during the first Sunrise period by Ultimo Sport GMBH. The application was based on the Benelux trademark “AAAAUTO” n°0781463 registered on December 5, 2005 by Kurt Janusch which authorised the Applicant to apply for the disputed domain name as licensee.

The Complainant applied for the contested domain name on February 14, 2006. The Complainant is the owner of the International trademark “AAAAUTO” n° 822292 duly extended in Benelux and registered on October 29, 2003. The Complainant requests the transfer of the contested domain name.

A. COMPLAINANT

The Complainant alleges that the disputed domain name is based on a trademark which conflicts with its registered trademark. The Complainant is the owner of a prior trademark registration for “AAA AUTO” and contends that therefore the subsequent Applicant’s trademark is not valid, concluding that the applicant should not have been entitled to register the disputed domain name on the basis of such a non valid trademark.

Moreover the Complainant contends that the Applicant is not the owner of the prior right on which the disputed domain name is based, highlighting the fact that the registered owner is Kurt Janusch and not Ultimo Sport GMBH.

The Complainant states that the disputed domain name is a speculative and abusive registration within the meaning of article 21 of the Regulation indicating that the Applicant has no right or legitimate interest since the Complainant is commonly known by the domain name and operates in many European countries and concluding that the disputed domain name was thus applied for in bad faith. As a supporting evidence of such a statement, the Complainant highlights that the word “auto” is well understood as meaning “car” or “automobile” in many European countries and the applicant is not active in the automobile field. The Complainant owns many domain names “AAAAUTO” in various ccTLD and informs the Panel that the trademark “AAAAUTO” is well-known.

The Complainant furthermore indicates that the disputed domain name was registered in breach of the article 3 of the Regulation highlighting the fact that the Applicant must declare that “to its knowledge the request for domain name registration is made in good faith and does not infringe any rights of third party” since the Applicant must have been aware of the Complainant’s well-known trademark.

The Complainant requests the transfer of the disputed domain name.

B. RESPONDENT

The Respondent points out that the application of the disputed domain name was based on a Benelux trademark which constitutes a valid prior right in light of the article 10 of the Regulation.

The Applicant has produced documentary evidence to be a legitimate licensee of the trademark's owner and pursuant to the article 12.2 of the Regulation was therefore entitled to apply for the disputed domain name.

With reference to the validity of the Applicant's prior right, the Respondent highlights that has no authority to rule on the validity of a registered trademark. Thus, pursuant to article 14 (4) of the Regulation, the Respondent shall register the domain name on the first-come-first-serve basis if it finds that the applicant has demonstrated a registered prior trademark right.

In light of article 22 of the Regulation, the Complaint must be based on EU regulations. Hence according to the Respondent, article 21 of the Regulation "Speculative and abusive registrations" does not apply in a procedure directed against the Registry. There is no legal ground in the Regulation for the Registry 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.

The Respondent therefore concludes that the ADR procedure should have been initiated against the Applicant.

DISCUSSION AND FINDINGS

The article 10.1 of the Regulation 874/2004 (herein "the Regulation") states that "holders of prior rights recognised or established by national law (…) 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 (…) trademarks … ".

In light of the evidence attesting that the Applicant is the legitimate licensee of the trademark's owner, the Panel finds that the Applicant was entitled to apply for the domain name according to the Article 12.2 of the Regulation as also decided in a number of prior cases. See for instance case n. 00495 Tessa Strong v. EURid (Stemcell), where the Panel held in a similar situation that: "… To the extent, Bureau Gevers has enclosed a copy of the trademark license agreement (according to the template required by the Sunrise Rules), this Panel understands that Bureau Gevers is sufficiently entitled to apply for the domain name <stemcell.eu>".

With reference to the issue of the prior trademark rights of the Complainant, the Panel notes that the domain names are registered on a "first-come-first-served" basis. This principle also applies during the first Sunrise period according to the article 14 of the Regulation and Section 2.1 of the Sunrise rules. The Panel therefore finds that the Respondent correctly applied this principle by registering the domain name of the Applicant which was the first to be filed with the Registry on the basis of a valid trademark registration certificate and of a lawful licence agreement duly signed by both parties.

The Panel finds that the Registry and the validation agent are only empowered to apply the rules regarding the registration of domain names and therefore have no authority to rule on the validity of a registered trademark. As stated i.a. in case N. 00449 Dr Massimo Introvigne v. EURid (Candy) " … Respondent's arguments regarding the lack of competence to valuate the validity of a trademark shall be supported by this Panel. Nothing in the Regulation nor in other related legal provisions may attribute the Registry the ability to determine whether a trademark is valid or not. Solely the relevant trademark offices or the competent judicial bodies may solve such question." . Along these lines it was also held in the cases N. 00761 Stefan Tegelkamp v. EURid (Nobilia), case N. 00451 Dr Massimo Introvigne v. EURid (Fidia), case N. BARVY A LAKY HOSTIVAŘ, a.s. v. EURid (BL), Case N. 00210 Bernd Single v. EURid (Bingo).

As to the issue of the alleged abusive and speculative registration of the domain name by the Applicant, the Panel concurs with the majority view that the Respondent is not in charge of assessing whether the application for a disputed domain name is made in bad faith or not since there is no obligation under the Regulation for the Registry to ascertain the bad faith of the applicant. As stated in case n° 00012 Eurostar (U.K.) Limited v. EURid (Eurostar), the Panel also agrees that "… With respect to a question whether or not the validation agent or the Registry are also obliged, before the decision on the registration of the domain name, to examine whether or not the application has been made in good faith, the Panel concluded that the Registry is not obliged to make such an assessment".

Furthermore, in the Panel's view, the present case could possibly entail a procedure against the domain name holder but certainly not against EURid as also stated in case n° 00210 Bernd Single v. EURid (Bingo); therefore, in a case of alleged speculative and abusive registration, ADR proceedings should be initiated against the domain name holder and not the Registry.

Along the same lines should also be considered the last issue raised by the Complainant about the interpretation of article 3 (c) of the Regulation according to which the Applicant must declare that “to its knowledge the request for domain name registration is made in good faith and does not infringe any rights of a third party”. The Panel finds that the claim of the Complainant about the Applicant’s false declarations, falls outside the scope of the verification that should be conducted by the Respondent and therefore it is an issue that could only be raised in an ADR procedure initiated against the holder of the contested domain name.

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	Luca Barbero

DATE OF PANEL DECISION 2006-09-30

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contends that the Applicant is not the owner of the prior right on which the domain name is based and thus he could not apply for the disputed domain name, the Complainant is the owner of a an trademark registered earlier than the Prior Right on which the registration is based and that the Applicant applied for the disputed domain name without rights or legitimate interest and in bad faith.

The Panel finds that the Applicant is the legitimate licensee of a trademark’s owner. The Applicant was therefore entitled to apply for the disputed domain name pursuant to article 12.2 of the Regulation.
As to the validity of the Applicant’s prior right, the Panel finds that the Registry correctly applied the “first-come first-served” principle registering the first valid application duly filed with the Registry on the basis of a registered trademark and based on a valid licence agreement.

With reference to the alleged abusive and speculative registration of the domain name by the Applicant, the Panel finds that the Registry has no authority to ascertain if the application for a disputed domain name was made in bad faith nor if the applicant has made a false statement insofar as to the infringing of any prior rights of a third party is concerned. In these instances the ADR procedure should be initiated against the domain name holder.

In view of the above, the Complaint is denied.