Panel Decision for dispute CAC-ADREU-001867

Case number	**CAC-ADREU-001867**
Time of filing	**2006-06-19 13:25:14**
Domain names	**oxford.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**The Chancellor Masters & Scholars of the University of Oxford, t/a Oxford University Press, Ms Jo Marks**

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

None

FACTUAL BACKGROUND

The Complainant is “The Chancellor Masters & Scholars of the University of Oxford, t/a Oxford University Press”.

The Complainant first applied for the Domain Name on 07/12/2005 but, owing to an administrative error, it did not provide the Documentary Evidence supporting its application within the stated deadline. Thus, this application expired.

The Complainant applied again for the same Domain Name on 22/03/2006 (“the Second Application”) under the name Oxford University Press.

The Complainant applied again on 05/04/2006 (“the Third Application”) under the name The Chancellor, Masters & Scholars of the University of Oxford, t/a Oxford University Press. (It must be stressed that based on Complainant’s explanation, ‘Oxford University Press’ on the one side, and The ‘Chancellor, Masters & Scholars of the University of Oxford, t/a Oxford University Press’ on the other side, are one and the same).

Sadly enough for Complainant, in the intervening period between the expiration of the First Application and the making of the Second and Third Applications, Parknet, a Dutch company, applied for the Domain Name. Parknet’s application was supported by a Benelux trade mark registration for “OXF & ORD”. This trade mark was applied for on 28/2/06 and granted on 2/3/06. In other words, the trade mark was applied for and obtained during the Sunrise period.

The Complainant explains that it tried (directly or through its lawyers) to get in touch with Parknet without any success. The Complainant’s solicitors have written to Parknet twice to discuss the transfer of the Domain Name to the Complainant. A letter was sent on 18 April 2006 and an email was sent on 12 June 2006. The email was copied to Parknet’s Registrar. Copies of these communications are at Annex 6 of the Complaint. On June, 15th, Parknet’s Registrar contacted the Complainant’s solicitor by email and the Complainant’s solicitor telephoned Mr R. B. of the Registrar and explained that the Complainant was intending to file urgently a Complaint in relation to the Domain Name because there was an appeal deadline of 17 June 2006. Mr R. B. said that ‘Mr Parknet’ did not speak very good English but that he could act as a go-between. However, Mr Broekman advised that in the time available he would not be able to seek any instructions from ‘Mr Parknet’. Complainant explains that in the circumstances, it has been left with no choice but to file this Complaint.

Whois database shows that 7 different applications has been made for this domain name.

The first 4 applications expired.

Application #5 is in the name of Parknet's.

Application #6 is in the name of Oxford University Press Ltd.

Application #7 is in the name of The Chancellor Masters & Scholars of the University of Oxford, t/as Oxford University Press.

A. COMPLAINANT

The Complainant contends that the Registry's decision to accept Parknet's application for the Domain Name conflicts with the Regulation and should be annulled.

In the Complainant's view, Parknet was not eligible to apply to register the Domain Name in the Sunrise period because it is not the holder of a Prior Right as required under Article 10(1) of the Regulation. Article 10(2) of the Regulation stipulates that a registration based on a Prior Right must be for the complete name for which the Prior Right exists. The Complainant contends that the application for the Domain Name was accepted by the Respondent in contravention of both Articles 10(1) and 10(2) because the Prior Right (if it validly exists at all) is for "OXF & ORD" and not for the Domain Name.

The Complainant underlines that it is well aware that under Article 11 of the Regulation, where the name for which a Prior Right is claimed contains special characters, these shall be eliminated entirely, replaced with hyphens, or, if possible, rewritten, but the Complainant contends that the Respondent should not automatically accept any of the three options provided for in Article 11 of Regulation in an application for a domain name, but should make an assessment of whether the particular option chosen is appropriate in light of the .eu domain name applied for and the Prior Right supporting that application. The Complainant contends that the only logical option was for the Respondent to rewrite the "&" character of the trade mark "OXF & ORD" as and for the word "and" (or the corresponding word in another language). Thus, to the extent that Parknet's trade mark registration for "OXF & ORD" is valid (and no admission is made in that respect), the Prior Right is for "OXF & ORD" or for "OXFANDORD" or for "OXF AND ORD", and not "OXFORD", the subject name of the Domain Name. In support of it's view, the Complainant refers to decisions 00398 ("BARC & ELONA"), 00394 ("FRANK & FURT") and 00265 ("LI&VE").

The Complainant requests the Panel to determines that it is eligible for the Domain Name, and to order the transfer of it because Complainant's second application is next in the queue after Parknet's.

B. RESPONDENT

[Note of the Panel: it must be stressed that respondent is not Parknet. Respondent is Eurid.]

The Respondent first observe that both Complainant and Panels in the three cases cited by the Complainant, are procedure where the domain name holder's bad faith and/or speculative or abusive registration were at stake.

The Respondent recalls that pursuant to article 22 (1) b of the Regulation, a decision taken by the Respondent may only be annulled when it conflicts with the Regulation. The ADR proceedings based on alleged "bad faith" of the applicant must be initiated against the domain name holder itself, pursuant to Article 22(1)(a) of Regulation.

Then, respondent gives its view on the interpretation of article 11 of the Regulation.

Respondent contends that article 11 of the Regulation primarily means that the applicant may not claim a prior right where the name contains special characters. Therefore, article 11 leaves three options for the applicant to still comply with the Regulation and apply for a domain name on the basis of a name containing a special character. The applicant may:

- either eliminate the special character entirely from the corresponding domain name,
- replace it with hyphens,
- or, if possible, rewrite it.

In Respondent's view, when it is not possible to rewrite special characters (e.g. the special character * cannot be easily rewritten), the applicant using article 11 looses the third possibility ("Names containing such special characters can thus only be used to claim a prior right on a domain name without the special character or with an hyphen instead of the special character"). When it is possible to rewrite it, the domain name holder benefits of three possibilities as decided in case 188 (123.eu) where: "The Panelist considers that in fact,

there are three, not two, options which the Respondent can adopt when dealing with the reworking or otherwise of special characters, namely: 1. delete the special character; 2. replace the special character with hyphens; or 3. rewrite the special characters".

Respondent respectfully disagrees with other interpretations of article 11, notably with decisions 00398 (“BARC & ELONA”), 00394 (“FRANK & FURT”) and 00265 (“LI&VE”). “The Regulation does not command the Respondent to make a choice for the applicant following simply its judgement or more complexly, a principle of interpretation derived from trademark law. If the Respondent had to refuse one of the three options listed in article 11 of the Regulation in some specific cases, the Regulation (or at the very least, the Sunrise Rules) should have said so. Therefore, the Respondent's decision may not be annulled for non compliance with the Regulation”.

As a summary of its position, Respondent states that “What the Respondent must do pursuant to article 11 of the Regulation is to assess whether an applicant has chosen any of the three options available. If an applicant has done so, its application must be accepted. If an applicant is alleged to have abused article 11, ADR proceedings against the applicant/registrant himself must be initiated.”

Eventually, concerning the measures that Complaint is asking for (i.e., transfer of the domain name), Respondent recalls that two conditions need to be met before the Panel may order the transfer of a domain name (- the Complainant must be the next applicant in the queue for the domain name concerned; - and the Respondent must decide that the Complainant satisfies all registration criteria set out in the Regulation). Consequently, it is Respondent view that, should the Panel consider that the Respondent’s decision must be annulled, the Complainant's transfer request must be rejected.

DISCUSSION AND FINDINGS

This procedure is a Sunrise Appeal, and not a so-called “article 21” procedure in which the Complainant has to prove Domain Name holder’s absence of right or legitimate interest, or Domain Name holder’s bad faith.

Complainant has persuasively argued that it was first incorporated in England by Royal Charter in 1357, and subsequently incorporated under the Oxford & Cambridge Act 1571 (13 Eliz C29). Oxford University Press (“OUP”) is a department of The Chancellor, Masters and Scholars of the University of Oxford (“the University”) and is not a separate legal entity from the University. “Oxford University Press” is a trade name of the Complainant used in relation to its diverse publishing program and on-line materials. OUP has been operating as a publisher since 1668 and claims to be now the largest university press in the world. OUP publishes over 4,500 new books a year, has a presence in over 50 countries, and employs some 4,800 people worldwide.

As far as Complainant’s trade mark is concerned, Complainant has persuasively argued (and proved, notably with a Declaration of Roger Boning, former Chief Financial Officer of OUP, in support of Motion for Summary Judgment in the case of Babowal & Associates, Inc v University of Cambridge Local Examination Syndicate and Others in the United States District Court for the Northern District of California, San Jose Division; Case No C-00-20140 JF-RS) that the OXFORD mark was first used in around 1675 as an imprint on books produced by the University.

Also, the Complainant has satisfactorily proven that it is the owner of several national trade marks for OXFORD (notably Community Trade Mark number 504589 in Community Member States which was registered on 29/5/00).

As a conclusion of this first part, the Panel is satisfied that Complainant has a prior right in the sense of the sunrise period.

Having underlined this, the Panel must also recall that EC Regulation created a phased registration system (the Sunrise period):

- Whose philosophy is not “when two persons claim a prior right on the same domain name, who is best entitled to this name?”

- But whose philosophy is “when two persons claim a prior right on the same name, who was the first to apply?”

All members of the Panel express their sympathy for Complainant’s position. The Complainant is without any doubt a very serious candidate in a system where “the best person entitled to have the name” gets it.

But, the .eu system is far from this. Priority is given to the first applicant. Art. 11 (c) of the ADR Rules clearly provides that there are two conditions that must be met before the Panel may order the transfer of a domain name:

- The Complainant must be the next applicant in the queue for the domain name concerned.
- The Respondent must decide that the Complainant satisfies all registration criteria set out in the Regulation.

As a fact, the Panel must admit that Parknet comes before the Complainant in the List.

(To be noted: facts would have been very different without the administrative error of the Complainant who first applied for the Domain Name on 07/12/2005 but, owing to an administrative error, did not provide the Documentary Evidence supporting its application within the stated deadline).

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This said, the first applicant doesn't always get the name. Regulation has created a verification process whose purpose is not, again, to check if the applicant is "a good person" for that name, but to assess whether or not the applicant has a "prior right".

In the Panel view, Parknet trade mark is a valid one; the trade mark as such is not at stake.

The problem arises from the transliteration of that name into a domain name.

This is where article 11 of Regulation 874/2004 is important.

The Panel can't accept the position of the Complainant because it would imply that, in the interpretation and verification of the application of article 11 by an applicant, Respondent should take into consideration other applications made by other applicants, the fame of the name, or factual information implying third parties.

These elements are important in a procedure where bad faith is an issue, not in a procedure where the prior right (or the transliteration thereof) is at stake.

There is little doubt, in the Panel view, that Complainant would easily win its case against actual domain name holder in an article 21 procedure, but the mandate of the Panel in this procedure is different. (As reminded in 00449 CANDY, "… the sole object and purpose of an ADR proceeding against the Respondent is to verify whether the relevant decision adopted by the Respondent conflicts (or not) with the provisions of the Regulation).

Neither can the Panel accept the position of Eurid of absolute non-intervention in the verification of the transliteration. This is going much too far. Even in the limited scope of article 11, Eurid (and/or the verification agent) also has obligations.

Eurid's general duty in the verification process has been expressed in 00642 (CRUX):

"Reference is made, among others, to Recital 12 of the Regulation 874/2004, under which the aim of the registration process is to ensure that holders of prior rights have appropriate opportunities to register names on which they hold prior rights. It further follows from this recital that validation agents should assess rights claimed for a particular name properly. Reference is further made to Article 14 of the Regulation No 874/2004, under which the validation agent should examine the application.

Under Sunrise Rules, Article 21.3, the validation agent may, at his own discretion, conduct investigation into the circumstances of the respective application.

The Panel appreciates the high number of application received and processed by the Respondent, and the Panel also understands the tendency of the Respondent to apply those automated processes as mentioned in the Respondent's response to the Complaint. The respective legal provisions cited above put the Respondent under clear legal obligation to examine the application (Art. 14 of the Regulation 874/2004) and to assess the respective right of the applicant (recital 12 of the Regulation 874/2004.

In the opinion of the Panel, these obligations to "examine" and to "assess" are clearly in conflict with the absolute idea of an uncompromised automated process."

(End of quote)

In the Panel view, Respondent hasn't been unreasonable when it decided to validate Parknet application, notably because the elimination of the special character is indeed one of the possibilities created by article 11 and because the elimination of the "&" symbol is as good as another solution for that trademark.

Of course, one can argue that the huge problem arisen from article 11 is well known; that Parknet registered a great number of trademarks with special characters and obviously circumvented the aim of article 11; that various decisions found against companies doing the same, etc.

Here again, the Panel sympathize with this, but it must insist on the fact that the verification process is about a specific application, made by a specific applicant, based on a specific prior right. All factual elements surrounding Parknet's application might be important for an article 20 revocation by Eurid, or for an article 21 procedure launched by the Complainant, and the Panel would certainly welcome these arguments in such procedures, but it has no power to consider them in this procedure in which it has a different mandate.

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	Thomas Johann Hoeren

DATE OF PANEL DECISION 2006-09-13

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Panel recall that EC Regulation created a phased registration system (the Sunrise period):

- Whose philosophy is not "when two persons claim a prior right on the same domain name, who is best entitled to this name?"
- But whose philosophy is "when two persons claim a prior right on the same name, who was the first to apply?"

All members of the Panel express their sympathy for Complainant's position. The Complainant is without any doubt a very serious candidate in a system where "the best person entitled to have the name" gets it. But, the .eu system is far from this. Priority is given to the first applicant, and as a matter fact, the Panel must admit that Parknet comes before the Complainant in the List.

This said, the first applicant doesn't always get the name. Regulation has created a verification process whose purpose is not, again, to check if the applicant is "a good person" for that name, but to assess whether or not the applicant has a "prior right".

In the Panel view, Parknet trade mark is a valid one; the trade mark as such is not at stake.

The problem arises from the transliteration of that name into a domain name and this is where article 11 of Regulation 874/2004 is important.

The Panel can't accept the position of the Complainant because it would imply that, in the interpretation and verification of the application of article 11 by an applicant, Respondent should take into consideration other applications made by other applicants, the fame of the name, or factual information implying third parties.

These elements are important in a procedure where bad faith is an issue, not in a procedure where the prior right (or the transliteration thereof) is at stake.

There is little doubt, in the Panel view, that Complainant would easily win its case against actual domain name holder in an article 21 procedure, but the mandate of the Panel in this procedure is different. (As reminded in 00449 CANDY, "… the sole object and purpose of an ADR proceeding against the Respondent is to verify whether the relevant decision adopted by the Respondent conflicts (or not) with the provisions of the Regulation).

Neither can the Panel accept the position of Eurid of absolute non-intervention in the verification of the transliteration. This is going much too far. Even in the limited scope of article 11, Eurid (and/or the verification agent) also has obligations.

In the Panel view, Respondent hasn't been unreasonable when it decided to validate Parknet application, notably because the elimination of the special character is indeed one of the possibilities created by article 11 and because the elimination of the "&" symbol is as good as another solution for that trademark.

Of course, one can argue that the huge problem arisen from article 11 is well known; that Parknet registered a great number of trademarks with special characters and obviously circumvented the aim of article 11; that various decisions found against companies doing the same, etc.

Here again, the Panel sympathize with this, but it must insist on the fact that the verification process is about a specific application, made by a specific applicant, based on a specific prior right. All factual elements surrounding Parknet's application might be important for an article 20 revocation by Eurid, or for an article 21 procedure launched by the Complainant, and the Panel would certainly welcome these arguments in such procedures, but it has no power to consider them in this procedure in which it has a different mandate.