Panel Decision for dispute CAC-ADREU-001914

Case number	**CAC-ADREU-001914**
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Domain names	**fzero.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Nintendo of Europe GmbH**

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, either pending or decided, which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, Nintendo of Europe GmbH, filed an application for the registration of the domain name FZERO.EU based on the German trademark registration F-ZERO. The documentary evidence was submitted on time. However, the applicant rather than submitting a copy of the F-ZERO German trademark registration sent a copy of the F-ZERO French trademark registration.

EuRid rejected the application for the registration of FZERO.EU due to the fact that according to the Commission Regulation (EC) No 874/2004 of 28 April 2004, a trademark registration for F-ZERO cannot support the registration of the domain name FZERO.EU. The Complainant did not demonstrate that it was the holder or the licensee of a prior right on the name FZERO. Furthermore, the validation agent concluded that the Complainant's application did not comply with the Sunrise Rules as the application incorrectly mentioned Germany as the country in which the Complainant claimed to have a prior right whereas the trademark submitted as documentary evidence was registered in France.

Based on the findings of the validation agent, the Respondent rejected the Complainant's application for the domain name FZERO.EU and the Complainant initiated this ADR proceeding.

A. COMPLAINANT

The Complainant is a member of the Nintendo group of companies. Nintendo is one of the major players in the interactive entertainment industry.

Nintendo of Europe GmbH is the administrative headquarter of Nintendo in Europe. It is duly incorporated in Germany and, therefore, within the European Union. Accordingly, the Complainant is eligible to register a .EU domain name according to Regulation (EC) No. 733/2002 Article 4[2][b][i].

The Complainant’s parent company, Nintendo Co., Ltd., Japan, has registered the trademark F-ZERO in several countries, among others in Germany and in France. In Germany there is the trademark registration number 398 33 763, application dated 17 June 1998. In France there is the French trademark registration number 98 736 359, application dated 10 June 1998.

The Complainant has licensed the above trademark registrations from Nintendo Co., Ltd.. Accordingly, the Complainant as the licensee of a prior right pursuant to Regulation (EC) No. 874/2004 Article 10 is eligible to apply for the domain name FZERO.EU during the first part of phased registration, Regulation (EC) No. 874/2004 Article 12[2].

The Registry has rejected Complainant's application for the registration of the domain name FZERO.EU on the grounds that the application submitted referred to the German trademark registration of F-ZERO as the prior right, but contained a copy of the French trademark registration of F-ZERO as documentary evidence.

The Registry's decision is in conflict with Regulation (EC) No. 874/2002 for the following reasons:

a) According to Regulation (EC) No. 874/2004 Article 10 and Article 12[2] the applicant must be the holder or the licensee of a prior right. Such prior right can be a registered national or Community trademark. The Complainant is the licensee of the German trademark F-ZERO as well as of the French trademark F-ZERO. The documentary evidence submitted did not refer to the German right as stated in the application, but it did prove the French trademark right, which is also a valid prior right according to Regulation (EC) No. 874/2004 Article 10.

In the light of the foregoing, (i) Nintendo Co., Ltd. owns the German trademark F-ZERO; (ii) the Complainant proved the existence of the French F-ZERO trademark; and (iii) the Complainant also proved that it has licensed the French trademark F-ZERO from Nintendo Co., Ltd.. Therefore, despite the reference in the application and the documentary evidence are not consistent, both the trademark referred to in the application and the one submitted as documentary evidence, constitute prior rights of the Complainant according to Regulation (EC) No. 874/2004 Article 10.

Accordingly, regardless of the inconsistency described above, the application (including the documentary evidence) provided all information required to prove prior rights. The inaccuracy was a formal one, it did not affect the validity and the sufficiency of the information. The Registry could have decided on the basis of the application without running the slightest risk of rendering an inaccurate decision. It was obvious from the application documents that the Complainant is the owner of a prior right.

Even if the Panel would come to the conclusion that the Registry's rejection of Complainant's application was justified at the time of the decision, the Registry's rejection must be overruled nevertheless. The Complainant is aware of the fact that the documentary evidence concerning the German trademark registration could be considered new evidence. Yet, the Panel has to take such new evidence into account to correct a decision taken by the registry if it conflicts with the Regulations (EC) No. 733/2002 or No. 874/2004. Section B[1][b][16] of the ADR rules stipulates the submission of evidence concerning the rights upon which the Complainant relies. Contrary to other provisions of the ADR rules (such as Sections B[1][b][7], [8] or [10]), the applicability of Section B[1][b][16] is not limited to complaints against a domain name holder, i.e., it applies to complaints against the Registry for the unjustified rejection of an application. According to Section B[11][c] the Panel shall decide the complaint on the basis of the statements and documents submitted. It follows that applications, which do not fulfill all requirements can be "amended" in the ADR proceeding by submitting new evidence. The Panel then reviews the merits of the complaint on the basis of the documentation submitted.

In view of the above, since the Complainant proved that it is generally eligible for the registration of a .EU domain name and that it is the licensee of the F-ZERO trademark in Germany as well as in France, the Registry's decision rejecting the registration of the domain name FZERO.EU is in conflict with the EC Regulations.

Therefore, EuRid's decision must be annulled according to Section B[11][c] of the ADR rules and the domain must be registered in Complainant's name.

B. RESPONDENT

Article 10 (1) of Commission Regulation (EC) No 874/2004 states that only holders of prior rights which are recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.

Article 10 (2) of the Regulation 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.

Article 11 of the Regulation states that: "As far as the registration of complete names is concerned, where such names comprise 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 character and punctuations as referred to in the second paragraph shall include the following: ~ @ # $ % ^ & * ( ) + = < > { } [ ] | \ /: ; ' , . ? ".

Section 3 (1) of the Sunrise Rules states that an application will only be considered complete when the applicant provides the Respondent with the country in which the prior right is claimed. The Complainant applied for the domain name FZERO on 7 December 2005. The processing agent received the documentary evidence on 5 January 2006, which was before the 16 January 2006 deadline. Based on the documentary evidence received, the validation agent concluded that the Complainant did not demonstrate that it was the holder or the licensee of a prior right on the name FZERO. Furthermore, the validation agent concluded that the Complainant's application did not comply with the Sunrise Rules as the application incorrectly mentioned Germany as the country in which the Complainant claimed to have a prior right whereas the trademark submitted as documentary evidence was registered in France.

Based on the findings of the validation agent, the Respondent rejected the Complainant's application for the domain name FZERO.

The Panel should dismiss the Complaint for the following reasons.

The trademark F-ZERO cannot serve as a prior right on the domain name "FZERO" (without an hyphen). Pursuant to article 10 (2) of Regulation (EC) No 874/2004, 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. This means that all alphanumerical characters contained in the prior right (including hyphens, if any) must be present in the domain name applied for. Certain characters may not be part of a domain name for technical reasons. These special characters are listed in article 11. The hyphen is not one of such special characters. Indeed, one of the possible options to replace a special character is precisely to replace it with a hyphen.

Hyphens are therefore not excluded from domain names for technical reasons and should, pursuant to article 10 (2) of Regulation (EC) No 874/2004, be part of the complete name for which the prior right exists. Consequently, a prior right consisting of the trademark "F-ZERO" (with an hyphen) may only serve as basis for the application the domain name "F-ZERO" (with an hyphen) and not "FZERO" (without an hyphen). As a result, the Respondent correctly rejected the Complainant's application.

In case 1262 (NATIONALBANK), the Panel addressed the same issue by deciding that: "In the Panel's view this is not an omission as the purpose of Article 11 is to set out how prior rights should be treated when they contain characters that, for technical reasons, cannot be reflected in domain names. Hyphens can appear in domain names and so there is no need to provide special rules relating to them. This means that, when applying Article 10(2), which provides that the complete name for which the prior right exists must be reflected in the domain name applied for, Article 11 is not relevant in this particular case. According to the meaning of Regulation (EC) No 874/2004, prior rights containing hyphen(s) can only be used to apply for domain names containing corresponding hyphen(s)".

Furthermore, the Respondent notes that its application was not in line with section 3 (1) of the Sunrise Rules. The cover letter, which the Complainant submitted with its application states that the Sunrise Rules, including the special terms that relate to the phased registration period, apply and have been read and approved without reservation by the Applicant. The Applicant has understood that any breach of the Sunrise Rules can invalidate the application for the domain name or result in the cancellation of the registration itself. This statement is included in the cover letter pursuant to article 3 (d) of Regulation (EC) No 874/2004, which states that the request for domain name registration shall include an undertaking from the requesting party that it shall abide by all terms and conditions for registration, including the policy on the extra-judicial settlement of conflicts.

The existence of these rules is further approved by Article 12 (1) of Regulation (EC) No 874/2004. Moreover, these rules have been published on the Respondent's website pursuant to article 12 (1) 3 of the Regulation. Therefore, these rules cannot be disregarded and should be applied by the Panel.
Therefore, the Complainant is bound by the Sunrise Rules. Its failure to comply with the Sunrise Rules was another valid reason why the domain name application was rejected.

According to case 954 (GMP), "As EURid’s response to the complaint remarks, it is proper to affirm that article 3 (d) of the Regulation states that the request for domain name registration shall include an undertaking from the applicant that it shall abide by all terms and conditions for registration. To that regard, the cover letter, which the Complainant submitted with its application states that: The Rules, including the special terms that relate to the phased registration period, apply and have been read and approved without reservation by the Applicant. In this sense, the Panel agrees with EURid’s argument that the existence of these rules is further approved by article 12 (1) of the Regulation". The Respondent finally refers the Panel to a non-exhaustive list of cases where the Panel decided that the Respondent's decision was correct to reject an application for non-compliance with the Sunrise Rules: cases 119 (NAGEL), 404 (ODYSSEY), 954 (GMP), 1710 (PARLOPHONE, EMI, EMIMUSIC, EMIRECORDS, ANGEL, THERAFT).

The new documents submitted by the Complainant may not be taken into consideration. Pursuant to Article 14 of Regulation (EC) No 874/2004, the Respondent may only accept, as documentary evidence, documents that are received by the validation agent within 40 days from the submission of the application for the domain name. In the present case, the 40 days period ended on 16 January 2006.

The Complainant launched its complaint on 22 June 2006 and submitted new documents attached to this complaint. Those documents may not serve as a basis to asses whether the Complainant is the holder of a prior right, since those documents are submitted more than four months after the end of 40 days period set forth by the Regulation.

Moreover, Article 22 (1) b of Regulation (EC) No 874/2004 states that a decision taken by the Respondent may only be annulled when it conflicts with the applicable rules and regulations. This verification is the only task for the Panel in these proceedings, which may not in any case serve as a "second chance" or an additional round providing applicants an option to remedy their defective applications that were rejected during the Sunrise Period (see cases Nr. 551 (VIVENDI) and Nr. 810 (AHOLD)). In other words, as decided in case Nr. 1194 (INSURESUPERMARKET), "[t]he ADR procedure is not intended to correct domain name applicants' mistakes". Indeed, it has been consistently reaffirmed by numerous Panels that only the documents, which the Respondent examined at the time of validation of the application may be relied upon by the Panel to evaluate the conformity of the Respondent's decision with the applicable rules and regulations. (see notably cases Nr. 294 (COLT), Nr. 954 (GMP) and Nr. 01549 (EPAGES)). Therefore, the Complainant's contentions that "the applications, which do not fulfil all requirements can be 'amended' in the ADR proceeding by submitting new evidence" must be rejected.

In any case, the Complainant is wrong in arguing that the new documents submitted for the first time in the framework of the present ADR proceeding would correct its application. Indeed, the Complainant only provides trademarks registrations for the name "F-ZERO" (with a hyphen), which may never serve as a prior right for the domain name "FZERO" (without an hyphen) as explained here above.

For all the reasons mentioned above, the complaint should be dismissed.

DISCUSSION AND FINDINGS

In order to make a decision in the case at issue, the Panel must first examine whether under the applicable regulations, the registration for the trademark F-ZERO may support the registration of the domain name FZERO.EU during the phased registration period.

If according to the applicable regulations, the F-ZERO trademark supports the registration of the domain name FZERO.EU, the Panel must then examine whether the fact that the applicant based its application for the registration of the domain name FZERO.EU on a German trademark registration, but sent as documentary evidence a French trademark registration, constitutes a ground to deny the registration of the domain name at issue.

If it does, the Panel should lastly examine whether the evidence of the German trademark registration enclosed with the Complaint - and therefore well after the expiration of the 40 days term to file the documentary evidence in support of the domain name application, provided for by Article 14 of EC Regulation No. 874/2004 of 28 April 2004 - should be taken into consideration for the purpose of granting the requested domain name.

According to Article 10(2) of EC Regulation No. 874/2004 of 28 April 2004, "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".

According to Article 11of EC Regulation No. 874/2004 of 28 April 2004, "[A]s far as the registration of complete names is concerned, where such names comprise 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 character and punctuations as referred to in the second paragraph shall include the following: ~ @ # $ % ^ & * ( ) + = < > { } [ ] | \ /: ; ' , . ?
Without prejudice to the third paragraph of Article 6, 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".

It is clear from the above, and in particular from the sentence "[i]n all other respects, the domain name shall be identical to the textual or word elements of the prior right name", that except for the very specific cases mentioned in Article 11 of EC Regulation No. 874/2004, the domain name applied for during the phased registration period must be identical to the word elements of the prior right name.

The applicant based its request for the registration of the domain name FZERO.EU on the German trademark registration F-ZERO (despite the fact that the applicant sent as documentary evidence the French trademark registration F-ZERO). In all instances, the applicant owns prior rights over the name F-ZERO and not over FZERO. Article 11 of EC Regulation No. 874/2004 does not contemplate

the possibility that where there exists the right to a name with a hyphen, the hyphen shall be deemed eliminated from the corresponding domain name. This possibility is provided for only for the special characters mentioned in the same Article 11.

The rationale behind the provision of Article 11 of EC Regulation No. 874/2004 is to ensure to holders of prior rights over names containing characters that cannot be reproduced in a domain name, the possibility to reflect their prior rights in .EU domain names during the phased registration period. However, this possibility is an exception to the general rule that domain names applied for during the phased registration period must be identical to the corresponding prior right names. Because a hyphen is not among those special characters that cannot be reproduced in a domain name, in the event of an earlier right consisting of word elements separated by a hyphen, there is no reason to depart from the general rule that during the phased registration period domain names must be identical to the prior right name.

The aforementioned circumstance is also indirectly confirmed by Section 11 of the Sunrise Rules, which provides that 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 (...)".

It is apparent from the above that if figurative signs may constitute prior rights for the purpose of registering .EU domain names during the phased registration period, provided that all word elements, including hyphens, are reflected in the domain names, the same principle must apply for word marks. Indeed, as mentioned above, Article 11 of EC Regulation No. 874/2004 provides that "[A]s far as the registration of complete names is concerned, where such names comprise 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 (...). 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".

Since the F-ZERO trademark cannot support the registration of the domain name FZERO.EU, the Panel does not need to assess the other circumstances highlighted by the Complainant in order to reverse EuRid's decision to reject the request of registration of the FZERO.EU 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	**Angelica Lodigiani**

DATE OF PANEL DECISION 2006-10-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant applied for the domain name FZERO.EU based on a F-ZERO German trademark registration but submitted as documentary evidence a copy of the F-ZERO French registration.

EuRid rejected the application based on the findings of the validation agent that: (i) a trademark F-ZERO (with a hyphen) cannot support the registration of the domain name FZERO.EU (without a hyphen); and (ii) the application did not comply with the Sunrise Rules because it incorrectly mentioned Germany as the country in which the Complainant claimed to have a prior right whereas the trademark submitted as documentary evidence was registered in France.

The Panel finds that according to EC Regulation No. 874/2004 of 28 April 2004 and the Sunrise Rules, the domain name applied for during the phased registration period must be identical to the word elements of the prior right name, unless for limited exceptions. Said exceptions only deal with prior right names containing special characters that cannot be reproduced in a domain name. A hyphen is not among those special characters. Thus, the German and/or French trademark registration F-ZERO could have served as the basis for the registration of the domain name F-ZERO.EU and not of FZERO.EU.

For the above-mentioned reason the Panel denies the Complaint.