Panel Decision for dispute CAC-ADREU-001977

Case number	**CAC-ADREU-001977**
Time of filing	**2006-06-26 10:49:40**
Domain names	**smartgames.eu, toyplanet.eu**

Case administrator

Name	**Eva Zahořová**

Complainant

Organization / Name	**SMART INDUSTRIES NV, VANDOREN**

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

N/A

FACTUAL BACKGROUND

The Complainant is both a Dutch company SMART INDUSTRIES NV and a natural person Mr. Vandoren. The Complainant is an owner of two Benelux trademarks No. 0786752 (SMARTGAMES) and No. 0620987 (TOYPLANET) respectively. The issue of the dispute is whether the application was properly filed even if filed in both names Mr. Rolf Vandoren and at the same time organization – SMART INDUSTRIES NV. The Complainant(s) discussed the issue whether the application form is proper to secure the correct application to be filed. The application was denied.

The Respondent/EURid/validation agent concluded from examination of documentary evidence that the Complainant did not appear to be the owner of the “SMARTGAMES” and “TOYPLANET” trademarks and therefore the application was rejected.

The Complainant seeks the attacked decision to be annulled and the domain names transferred to Mr. Rolf Vandoren.

A. COMPLAINANT

The Complainant asked the annulment of EURid’s decision and registration of domain names – subject of disputes – in the name of Mr. Rolf Vandoren. The Complainant was rather surprised by the statement of EURid that the documentary evidence that was received did not sufficiently prove the right claimed by the Applicant. The Complainant argued that both himself as a natural person Rolf Vandoren as well as his company called SMART INDUSTRIES NV have all rights to be entitled to get the disputed domain name in the Sunrise Period. The Complainant also proved its relationship between Mr. Vandoren as CEO of SMART INDUSTRIES NV and other companies in the group.

The Applicant/the Complainant argued that he was confused by the application form as to the request of the name of the field, the position of the field, etc. The Complainant only in its Complaint realized that the Registration Policy provides that “where no name of a company or organization is specified, the individual requesting registration of the domain name will be considered the registrant; if the name of the company or the organization is specified, then the company or organization is considered the registrant”. The Complainant further argued that the Registration Policy is a document with a lower legal level than EC Regulations. EC Regulations in General and Recital 12 of Regulation No. 874/2004 in particular, is very clear on the purpose of the Sunrise Period. Phased registration should take place in two phases, with the aim of ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights.

The Complainant argued that there is no doubt that the Complainant (Mr. Vandoren) is the owner of the trademark, had the intention to protect his trademark by registering corresponding domain names under the Sunrise Period, has been confused by several elements in (and around) the registration form, made (just) a formal mistake in the application but revealed his clear and constant intention by a lot of other means. The Complainant also argues that Mr. Vandoren and SMART INDUSTRIES BV (NV) are to be treated as one organization for the purpose of Article 4 (2) b of EC Regulation No. 733/2002.

The Complainant sent later to the Panel so called Nonstandard Communication (on September 5, 2006) in which he further pointed out similar decision in “CRUX” case (.eu ADR No. 00642). In this Nonstandard Communication the Complainant mainly had taken over the arguments of the

other Panel from the case No. 00642 in favour of the Complainant.

B. RESPONDENT

The Respondent commented mainly on the grounds on which he has rejected the application for the domain names “SMARTGAMES.eu” and “TOYPLANET.eu” by SMART INDUSTRIES NV.

Article 10 (1) of the Commission Regulation (EC) No. 874/2004 of 28 April 2004 states that only holders of prior rights which are recognized or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration.

The validation agent concluded from its examination of the documentary evidence attached to the application that the Complainant did not appear to be the owner of the “SMARTGAMES” and “TOYPLANET” trademarks as the name of the holder of the trademark mentioned in the documentary evidence differed from the name of the Applicant.

A request for the application of a domain name made during the Sunrise Period must contain the information listed in Section 3 (1) of the Sunrise Rules. Section 3 (1) (i) of the Sunrise Rules states that where no name of a company or organization is specified, the individual requesting registration of the domain name is considered the Applicant; if the name of the company or the organization is specified, then the company or organization is considered the Applicant.

The Sunrise Rules are essential for the application procedure. Indeed, millions of applications have been submitted on a very short term and the validation can only be managed if strict rules are complied with. When assessing the documentary evidence, it is not possible for the validation agent to determine what the intent of an applicant is.

The Respondent further argued that relevant question is not whether an applicant is the holder of a prior right, but whether an applicant proves to the validation agent that it is the holder of a prior right.

The Respondent also stressed that under Section 21 (3) of the Sunrise Rules, the validation agent is not obliged, but it is permitted in its sole discretion, to conduct its own investigations into the circumstances of the application.

The Respondent concluded that the Complainant and Mr. Vandoren are not one and the same. There can be no doubt that the Complainant and Mr. Vandoren are not the same and the Respondent see, from a legal point of view, both as separate persons.

There is also a discussion about motivation of the Respondent on its decision. The Respondent said that there is no obligation to motivate a decision to reject an application which is also clear from Article 22 (1) b of the Regulation. The decision itself must conflict with the rules, not the alleged lack of motivation of the decision. The present ADR proceedings therefore must deal with the merits of the Respondent’s decision.

DISCUSSION AND FINDINGS

1. All procedure requirements for .eu dispute resolution (ADR) were met.

2. The main question for the decision is whether the Complainant was the appropriate person to apply for the domain names and whether the applicant natural person Mr. Vandoren or its company SMART INDUSTRIES NV had to be the Applicant.

The issue really is whether the formalistic approach overrules the general principle of fairness and justice; in other words, whether the correct or non-correct filing of an application is a decisive element in granting the rights.

3. The Panel/the Panelist fully understands both general arguments of the parties. It is understandable from the Complainant’s side that the application form and the unclear legal terms used in it may cause troubles in filing the application. In fact, the application form can in many cases lead (it was proven also in other .eu ADR cases) to confusion on different issues and the Panel/the Panelist is strongly of the opinion that it is not an issue of the smart, experienced or non-experienced user of the information technologies.

The Panel/the Panelist also respects the arguments of the Respondent that the validation agent is obliged to strictly follow the rules and in thousands of applications it is not possible to do a deep investigation and assessment of all documentary evidence or even have very long lasting and administratively very demanding proceedings.

4. The Panel/the Panelist strongly believe that one of the aims of .eu ADR disputes is to review and verify and in some cases correct the mistakes of the registry which were done also thanks to the administrative proceedings which is really not perfect as no single proceedings can be.

5. The Commission Regulation (EC) No. 874/2004 clearly states in its Recitals para (12) that one of the aims is ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights. In this case the prior rights are presented by the valid registered trademarks in Benelux.

The same Recital of the said Commission Regulation stress that validation agent should assess the right which is claimed for a particular name.

6. Also Section 21 of the Sunrise Rules shall be taken into consideration. This Section does not impose an obligation on the Validation Agent but a right in its sole discretion (!) to conduct its own investigations into the circumstances of the application, the prior right claim and the documentary evidence produced. The Panel/the Panelist is of the opinion that the validation agent is always obliged to clarify the issues where they are not clear from the application and which are important for the decision itself. It is beyond any doubts that it was within the rights and capacity of the Respondent to ask the Complainant for explanation of the application as to the names of the Applicant (natural person or the company) and the Panel/the Panelist is of the opinion that the Respondent should have proceed with appropriate due diligence to clarify this issue.

7. The Panel/the Panelist therefore came to the following conclusions:

a) The Panel/the Panelist is of the opinion that the justice shall always rule over the formalistic approach and technical means of communication.

b) The Panel/the Panelist is of the opinion that one of the role of ADR is to verify the application procedure and correct any unfair mistakes which may happen by non-perfect technical means or speed-up proceedings in communication.

c) It was proven that the Complainant (with only one formal mistake) applied in the Sunrise Period for domain names “SMARTGAMES” and “TOYPLANET”. It was also proven that the Complainant/the Applicant had that time and still has all prior rights as they are recognized by the appropriate rules based on the Benelux trademarks No. 0786752 and No. 0620987.

d) It was proven also from public sources that the trademarks are used in the business of the Complainant.

e) It was proven by the Complainant and from public sources that the Complainant satisfied the general criteria for registration set out in § 4 (2) (b) of Regulation (EC) No. 733/2002.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 of the ADR Rules and B11 of the ADR Rules, the Panel/the Panelist orders that

i) the EURID’s decision is annulled; and

ii) the domain names “SMARTGAMES.eu” and “TOYPLANET.eu” shall be registered in the name of the Complainant, i.e. Mr. Rolf Vandoren, registered address Kwikstaartstraat 46, B-2170 Merksem, Belgium.

PANELISTS

Name	**Vit Horacek**

DATE OF PANEL DECISION 2006-09-14

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant requested annulment of EURid’s decision of two domain names: “SMARTGAMES.eu” and “TOYPLANET.eu” and registration of domain names in the name of Mr. Rolf Vandoren. The Complainant, when applying for domain name registration, did not file properly the application form as to the identification of the Applicant confusing a natural person with company SMART INDUSTRIES NV and therefore the application was rejected by the Respondent. The main question for the decision was whether the Complainant was the appropriate person to apply for the domain names and whether the applicant natural person Mr. Vandoren or its company SMART INDUSTRIES NV had to be the Applicant. It was proven that the Complainant (with only one formal mistake) applied in the Sunrise Period for disputed domain names. It was also proven that the Complainant/the Applicant had at time of application prior rights as they are recognized by the appropriate rules based on the Benelux trademarks corresponding to the domain names. The Panel/the Panelist was of the opinion that the justice shall always rule over the formalistic approach and technical means of communication, i.e. non-perfect application form shall not cause the prior rights of the Applicant to be denied. The Panel/the Panelist finally decided to annual the EURid’s decision and ruled that the domain names “SMARTGAMES.eu” and “TOYPLANET.eu” shall be registered in the name of the Complainant.