Panel Decision for dispute CAC-ADREU-002023

Case number	**CAC-ADREU-002023**
Time of filing	**2006-07-13 11:40:57**
Domain names	**openxchange.eu**

Case administrator

Name	**Eva Zahořová**

Complainant

Organization / Name	**open-xchange gmbh, open-xchange 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 any legal proceedings which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a licensee of a holder of the trade mark “open.xchange”. The Complainant applied on 27 January 2006 for the registration of the domain name “openxchange.eu”. As an evidence of the prior right to “openxchange” an official certificate of the respective trade mark office was submitted together with the License Declaration signed by both the holder of the respective trade mark (Open-Xchange Inc.) and the Complainant as the licensee.

EURid rejected Complainant’s application for registration of the disputed domain name due to fact that the domain name applied for did not consist of the complete name of the trademark which was submitted as documentary evidence.

A. COMPLAINANT

The Complainant argued that he met all requirements for the application and that the rejection of the application conflicts with EC 874/2004 Art. 14 (10), which provides, that "the Registry shall register the domain name ... if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in the second, third and fourth paragraphs". The Complainant requested the annulment of EURid’s decision and attribution of the domain name “openxchange.eu” to him.

B. RESPONDENT

The Respondent (EURid) argued that the validation agent understood the German trademark to include a hyphen between the "open" and "xchange" elements. The domain name however did not include such a hyphen. Therefore, the Complainant's application was rejected.

Only holders of prior rights are eligible to apply to register domain names during a period of phased registration provided that the prior right consist of the registration of the complete name for which the prior right exist as written in the documentation which proves that such a right exists. Where the name for which prior rights are claimed contains special characters, spaces or punctuations, these shall be eliminated entirely form the corresponding domain name, replaced with hyphens, or rewritten.

The only exceptions to the "complete name" requirement are restricted to spaces or special characters that may not be part of a domain name for technical reasons. The hyphen is not one of such special characters. Indeed, one of the possible options to replace a special character or a space is precisely to replace it with a hyphen, which demonstrates that the hyphen is not one of the special characters. Hyphens are therefore not excluded from domain names for technical reasons and should, pursuant to article 10 (2) of the Regulation, be part of the complete name for which the prior right exists.

To that regard, the Respondent referred to case 1262 (NATIONALBANK), where the Panel stated that hyphens can appear in domain names and so there is no need to provide special rules relating to them. This means that, according to the meaning of the Regulation, prior rights containing hyphen(s) can only be used to apply for domain names containing corresponding hyphen(s)".

DISCUSSION AND FINDINGS

Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (Public Policy Rules) 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 before general registration of .eu domain starts.

Article 10 (2) of the Public Policy Rules 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 Public Policy Rules states that 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.

The application for the registration of domain name “openxchange.eu” was based on German trademark registration (req.number 30466875.3). The Applicant provided the official certificate of the German Patent and Trade Mark Office together with the License Declaration as the Complainant was the licensee of the holder of the respective trade mark (the holder was company Open-Xchange Ing., U.S.A.)

According to the official certificate the wording of the trade mark is “open.xchange” (“dot” between the words “open” and “xchange”) and not “open-xchange” (“hyphen” between the words “open” and “xchange”) as expected by the EURid.

The respective trademark “open.xchange” therefore contains special character (punctuation) which should be eliminated entirely from the corresponding domain name, or replaced with hyphens, or, if possible, rewritten (see Article 11 of the Public Policy Rules). The trademark “open.xchange” therefore constitutes the prior right for registration of the domain name “openxchange” or “open-xchange” or “opendotxchange” - in the last case, the “dot” could be substituted by relevant synonyms (such as “point”) or translation in other languages. In this case, the Applicant decided to eliminate the “.” (the dot) entirely which is one of the equal ways how this special character could be transposed into the domain name.

Therefore, the ADR Panel is of the meaning that the Applicant has demonstrated a prior right in accordance with the procedure set out in the Public Policy Rules and the Registry (EURid) has been obliged to register the respective domain name applied for by the Applicant. The decision of the Registry (EURid) therefore conflicts with the Public Policy Rules and should be annulled.

DECISION

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

the EURID's decision be annulled.

PANELISTS

Name	**Petr Hostas**

DATE OF PANEL DECISION 2006-09-22

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Applicant as the licensee of the holder of the trade mark “open.xchange” applied for the registration of domain name openxchange.eu.

The Registry (EURid) rejected the application with the argument that the “hyphen” between the “open” and “xchange” words in the trademark is not a special character as stated in the Article 11 of the Public Policy Rules and it is not possible to eliminate the hyphen entirely to register the respective domain name. The Registry argued that hyphens are not excluded from domain names for technical reasons and should, pursuant to article 10 (2) of the Public Policy Rules, be part of the complete name for which the prior right exists. The Registry concluded, that the Applicant was entitled to apply for the registration of domain name “open-xchange.eu” on the basis of trade mark “open-xchange”.

The decision of the Registry is based on the misleading reading of the documentary evidence provided by the Applicant. The Applicant applied for the registration of domain name “openxchange.eu” on the basis of the registered trade mark “open.xchange” and not “open-xchange”. The documentary evidence (the official certificate of the German Patent and Trade Mark Office) is very clear in this point.

The respective trademark “open.xchange” contains special character (punctuation) which should be eliminated entirely from the corresponding domain name, or replaced with hyphens, or, if possible, rewritten, as required by Article 11 of the Public Policy Rules. In this case, the Applicant decided to eliminate the “.” (the dot) entirely which is one of the equal ways how this special character could be transposed into the domain name.

Therefore, the decision of the Registry (EURid) not to register the respective domain name was annulled.