Panel Decision for dispute CAC-ADREU-002084

Case number	**CAC-ADREU-002084**
Time of filing	**2006-07-04 14:39:10**
Domain names	**ssangyong.eu, suzuki.eu, stop.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Depmarc**

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 has not been informed about other legal proceedings regarding the disputed domain names.

FACTUAL BACKGROUND

1. STOP.EU

The Dutch company Depmarc (hereafter “the Complainant”) has requested annulment of a decision made by the Respondent, EURid, regarding the domain name “STOP.EU”.

The domain name “STOP.EU” is registered in the name of another Dutch company LBL Trading.

LBL Trading has applied for the domain name on 8 December 2005, during the Sunrise period, on the basis of its Benelux trademark STOP which was filed on 8 March 1996 in relation to several telecommunication goods and services of classes 9, 35, 37, 38 and 42. The Benelux trademark of LBL Trading is registered under number 0587296.

The Complainant filed an application for the domain name “STOP.EU” based on its Benelux trademark ST&OP, for which the documentary evidence was duly provided.

However, since LBL Trading had already filed an earlier application, which was later accepted, the Complainant’s application could no longer lead to the registration of the domain name “STOP.EU”.

2. SUZUKI.EU and SSANGYONG.EU

The Complainant has requested annulment of a decision made by the Respondent, EURid, regarding the domain names “SUZUKI.EU” and “SSANGYONG.EU”.

The Complainant applied for the registration of these domain names by virtue of the prior rights resulting from the Benelux trademarks “SU&Z. UKI” and “S.SAN & G.YONG”.

The applications for these trademarks were filed on January 26 and 27, 2006.

The trademarks were not registered until January 30, 2006 and February 3, 2006.

The applications for the domain names were made on January 27 and 28, 2006.

The Respondent rejected the Complainant's applications because at the time of application the trademarks were not yet registered (they were mere applications).

A. COMPLAINANT

1. STOP.EU

On March 14, 2006, the Complainant started an application process for the domain name "stop.eu", based on its Benelux trademark "ST&OP".

In the course of May 2006, the domain name was attributed to LBL Trading, who applied for the domain name on 8 December 2005.

However, LBL Trading made an error in its application for the domain name that should have led to the refusal of attribution of the domain name. When applying for the domain name, LBL Trading entered into the "prior right on name" field "LBL Trading" and not "STOP".

EURid should have rejected the application because article 10 § 2 of EC Regulation 874/2004 stipulates 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 provides that such right exists. In this case, the prior right is not LBL Trading but STOP.

According to the Sunrise Rules and a EURid newsflash, inaccuracies in field "prior right on name" can not be rectified. EURid would also have written in another case, that applications for domain names in the sunrise-period can not be corrected, except by sending in a new application.

Because of the clear violation by EURid of the applicable regulations and because of the breach of general principles of proper administration, the Complainant holds EURid responsible for damages suffered by him (-inter alia- legal costs and costs of the ADR-procedure).

2. SUZUKI.EU

On January 28, 2006 the Complainant initiated an application process for the domain name "SUZUKI.EU". It had already filed for the Benelux trademark "SU&Z. UKI", on January 27 2006. From that moment the Complainant had a prior right to the trademark "SU&Z. UKI". Unlike trademark jurisdictions where a right to a trademark can only be exercised after registration, according to the Complainant, the Benelux Trademark Act stipulates in article 12 (A sub 4) that one has a right to a trademark after is has been duly filed.

This is confirmed by a UDRP Decision of the WIPO Arbitration and Mediation Centre in the case Pierre van Hooijdonk –vs- S.B. Tait regarding the domain name "pierrevanhooijdonk.com" (Case No. 2000 – 1068).

The official "rules for .eu Domain Name Applications during sunrise" as issued by the validation agent support this point of view because unregistered trade marks are recognized as potential prior rights.

EURid has already attributed many domain names on the basis of trademarks that were duly filed but not yet registered.

3. SSANGYONG.EU

The same arguments as those set out for the domain name SUZUKI.EU apply here. On January 27, 2006 the Complainant initiated an application process for the domain name "SSANGYONG.EU". It had already filed for the Benelux trademark "S.SAN & G.YONG", on January 26, 2006 and therefore the Complainant believes that it was entitled to the registration of the domain name SSANGYONG.EU.

B. RESPONDENT

1. STOP.EU

Article 3 of the Regulation states that mistakes on the request for a domain name application must be material for the domain name application to be rejected. In this case, the cover letter contains all the information required for the domain name application.

Article 14 of the Regulation states that the validation agent must assess the documentary evidence when determining whether there is a prior right to the domain name. What the Respondent must compare are the domain name and the documentary evidence. A mistake in the "prior right on name" field can possibly be corrected.

Respondent refers to the very similar ADR case No 1711 (AIRCO, EIRCOM) that was already pronounced against this Complainant.

2. SUZUKI.EU and SSANGYONG.EU

Section 11 (3) of the Sunrise Rules states that the applicant must be the holder (or licensee, where applicable) of the prior right claimed no later than the date on which the application is received by the Respondent, on which date the prior right must be valid, which means that it must be in full force and effect.

Section 13.1(ii) of the Sunrise Rules expressly provides that a trademark application shall not be considered to be a prior right.

The Complainant applied for the domain name SSANGYONG on January 27, 2006 and for the domain name SUZUKI on January 28, 2006. EURid received both sets of documentary evidence on February 15, 2006, which was before the March 8 and 9, 2006 deadlines.

The Complainant's trademarks were only registered on January 30 and February 3, 2006. The validation agent concluded that the Complainant's documentary evidence only demonstrated that he held a trademark application on the S. SAN & G. YONG and SU& Z. UKI names on the dates of domain name application (January 27 and 28 2006,) and not a registered trademark as required by article 10(1) of the Regulation. Therefore, the Respondent rejected the Complainant's application.

In case No 1711 (AIRCO, EIRCOM) the panel came to the same findings, in a nearly identical case where the Complainant was also a party.

DISCUSSION AND FINDINGS

1. STOP.EU

The Panel follows the reasoning of the Panel in the case No 1711 regarding “AIRCO.EU” and “EIRCOM.EU”.

In this case, the Panel found that the intention behind the Commission Regulation (EC) 733/2002 on the implementation of the .eu Top Level Domain and the Commission Regulation (EC) 874/2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration, as is evident from the recitals of the said regulations, has been to allow holders of legitimate and genuine prior rights to register domain names, which correspond to their proprietary rights.

The Article 19(2) of the Commission Regulation (EC) 874/2004 provides 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 documentation which proves that such a right exists.” The Article 14 of the same Regulation provides that “Every applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question.”

In accordance with the Section 21(1) of the Sunrise Rules, EURid shall verify whether the official requirements for the documentary evidence and the requirement for the existence of a prior right to the name claimed by the applicant in the application are fulfilled. The Section 21(3) goes on to provide that the validation agent is permitted to conduct its own investigations into the circumstances of the application, the prior right claimed and the documentary evidence produced.

As a result, the validation agent must be allowed to correct obvious deficiencies in applications, when it is clear from the evidence submitted that the applicant is de facto the holder of a genuine prior right and has simply made a clear mistake in the information provided in the application.

It appears that LBL Trading had misunderstood the meaning of the “prior right on name“ field in the application and although it was a true holder of a legitimate and genuine right, had mistakenly provided wrong information on the application field.

Once the documentary evidence was reviewed by the validation agent, the agent was able to determine that the applicant was the true holder of a prior right, which was identical to the domain name it had applied for.

Based on the foregoing, the Panel finds that the decision made by the Respondent to grant the domain name to LBL Trading was

justified and rejects the Complaint with respect to the domain name “STOP.EU”.

2. SUZUKI.EU and SSANGYONG.EU

Article 12(2) of the Commission Regulation (EC) 874/2004 clearly provides that “During the first part of phased registration only registered national and Community trademarks (…) may be applied as domain names by holders or licensees of prior rights (…).”

The Sunrise Rules Section 13.1(i) provide further that “Where the Prior Right claimed by an Applicant is a registered trademark, the trademark must be registered by a trademark office in one of the member states, the Benelux Trade Marks Office or the Office of the Harmonization in the Internal Market (OHIM), or it must be internationally registered and protection must have been obtained in at least one of the member states of the European Union.” Section 13(1)(ii) provides that “A trademark application is not considered a prior right.”

The Complainant applied for the domain names “SUZUKI.EU” and “SSANGYONG.EU” during the first phase of the Sunrise Period, based on its applications for the Benelux trademarks “SU&Z. UKI” and “S.SAN & G.YONG”. At the time of the domain name applications the corresponding trademarks were not yet registered; they were merely applications for trademarks.

The mere fact that the trademark applications later resulted in registrations does not influence the decision of EURid because section 11.3 of the Sunrise Rules clearly states that “the Applicant must be the holder (…) of the prior right claimed no later than the date on which the Application is received by the Registry”, i.e. on January 27 and 28, 2006. The Trademarks were subsequently registered, via the expedited registration procedure of the Benelux Trademark Office, on January 30 and February 3, 2006.

The Complainant refers to the Benelux Trademark Act, where it is provided that Benelux Trademarks protect their proprietors as from the trademark application. The Complainant does, however, not refer to the Benelux Trademark Act as it was applicable on January 27-28, 2006, but refers to the previous version of the Benelux Trademark Act that was amended so that a Benelux trademark now only offers protection once it is registered (the Benelux Trademark Act applicable on January 27-28 2006 was amended once more since September 1, 2006, but the principle of protection once the mark is registered remains the same – See article 2.19 of the Benelux Treaty regarding Intellectual Property).

UDRP Decisions that are rendered under the old Benelux Trademark Act are not relevant to decide this case which must be decided on the basis of the Act applicable at the date of the domain name applications. If other .eu ADR decision have held otherwise, they should not be followed.

Based on the foregoing and in line with the decision No 1711 in the case of “AIRCO.EU” and “EIRCOM.EU”, the Panel finds that the decision made by the Respondent to reject the applications made by the Complainant was justified. The Panel rejects the Complaint with respect to the domain names “SUZUKI.EU” and “SSANGYONG.EU”.

3. COSTS

There is no basis in the Regulations or in the ADR Rules pursuant to which the Panel can order the Registry to pay the costs of this procedure or can order any measure such as finding that EURid should be held liable for breach of the general principles of proper administration (cf. also decision No 1711 in the case of “AIRCO.EU” and “EIRCOM.EU”).

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	Tom Joris Jan Heremans

DATE OF PANEL DECISION 2006-09-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

STOP.EU

The Claimant alleges that the domain name “STOP.EU” was not correctly registered because the Applicant made a mistake when filling out the field “prior right on name“. The applicant filled out his name LBL Trading, rather than filling out “STOP”.

It appears from the documentary evidence (that was correctly submitted) that the applicant was the true holder of a prior right (the Benelux Trademark STOP), which was identical to the domain name the applicant had applied for.

Based on the foregoing, the Panel found that the decision made by the Respondent to grant the domain name to LBL Trading was justified and the Panel rejected the Complaint with respect to the domain name “STOP.EU”.

SUZUKI.EU and SSANGYONG.EU

The Complainant applied for these domain names on the basis of two Benelux trademark applications. The marks were filed before the application of the corresponding domain names but were only registered by the Benelux Trademark after the application of the domain names.

The Commission Regulation (EC) 874/2004 and the Sunrise Rules all clearly provide that the Prior Right claimed by an Applicant must be a registered trademark, not a trademark application. Also the Benelux Trademark Act applicable at the date of the application of the domain names provides that a trademark must be registered before it offers protection.

The Panel rejects the Complaint with respect to the domain names “SUZUKI.EU” and “SSANGYONG.EU”.

COSTS

There is no basis in the Regulations or in the ADR Rules pursuant to which the Panel can order the Registry to pay the costs of this procedure.