Panel Decision for dispute CAC-ADREU-002180

Case number	**CAC-ADREU-002180**
Time of filing	**2006-07-24 12:56:27**
Domain names	**lotterie.eu, irc.eu, nba.eu, slotmachines.eu, t-shirt.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**M. Oomens**

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 other legal proceedings involving the disputed domain names.

FACTUAL BACKGROUND

On 19/1/2006, RoosIT filed and application to register domain name LOTTERIE. The Documentary Evidence was submitted on 8/2/2006.

On 19/1/2006, RoosIT filed and application to register domain name IRC. The Documentary Evidence was submitted on 10/2/2006.

On 19/1/2006, RoosIT filed and application to register domain name NBA. The Documentary Evidence was submitted on 8/2/2006.

On 20/1/2006, RoosIT filed and application to register domain name SLOTMACHINES. The Documentary Evidence was submitted on 8/2/2006.

On 9/12/2005, Business4Sure Holding BV filed and application to register domain name T-SHIRT (RoosIT was named in the Application as the Registrar and Registrar Technical Contact). The Documentary Evidence was submitted on 12/1/2006.

All above Applications were based on Prior rights arising of trademark registrations.

All above Applications were filed after filing applications for identical trademarks (after the date referred to in Benelux trademark law as ‘depot’), but before the date of their registration (in Benelux trademark law referred to as ‘inschrijvings’).

All above Applications were rejected by the Registry due to lack of Prior rights at the moment of filing the Applications.

Although it is not entirely clear from the statement “Domain name validation should result in an accepted status,” the Panel assumes that the Complainant seeks annulment of the decisions rejecting above Applications.

A. COMPLAINANT

The Complainant contends that the decision of the Registry violated Regulations (EC) No 733/2002 and (EC) No 874/2004.

The Complaint contains numerous explanations of the Complainant’s view on the registration procedure, institutions involved and ways in which the procedure should have been better carried out. Most of all, the Complainant stresses the need for transparency of the registration procedure and namely of registration policies. The Complainant also comments the composition of the Panel and requirements for appointment of Panelists.

The Complainant also challenges independence and impartiality of the Panel in case of BARCELONA.EU.

The Complainant recapitulates the history of registration of the disputed domain names. As there was some confusion at the Complainant about requirements for the Sunrise registration procedure, namely in the effect of rights arising of trademarks, Complainant tried to contact the Registry and to acquire more detailed information. The Complainant argues that his questions towards the Registry and the Validation Agent were not properly answered. Consequently, the Complainant stresses the fact that he was not certain about the requirements of the registration procedure and argues that this uncertainty and its consequences are not accountable to him but to the Registry and the Validation Agent.

The Complainant explains his interpretation of legal regulatory framework of 'Dutch National Trademarks' and stresses the existence of two dates of registration, i .e. 'depot' and 'inschrijvings.' In the view of the Complainant, the date of filing the application, i.e. 'depot,' is to be considered according to the 'Dutch trademark law' as the date from which Prior Rights can be claimed in terms of the Regulations and Sunrise Rules.

The Complainant argues his right for registration during the Sunrise period also by giving examples of domain names that were registered during the Sunrise period upon Prior Rights established at the date of 'depot.' The Complainant argues that the Registry and the Validation Agent granted registration of some other domain names upon Prior Rights arising at the date of 'depot,' and so his Applications should have been handled equally.

In an additional statement to his Complaint submitted via Nonstandard Communication, the Complainant supports his arguments regarding interpretation of date of 'depot' and 'inschrijvings' by a reference to WIPO UDRP Case No. 2000 – 1068.

The Complainant argues that the registration policy of the Registry and the Validation Agent during the assessment of Sunrise applications changed and such change was not communicated to the public.

The Complainant expresses the opinion that the use of 'inschrijvings' as the date of establishment of Prior Rights is also unfair in terms of the applicable Regulations, because its setting depends on more or less uncertain administrative circumstances of the trademark registration procedure.

At the end of the Complaint, the Complainant stresses his right to register disputed domain names in Sunrise period through ad-hoc registering identical trademarks.

B. RESPONDENT

The Respondent is euRID. The Respondent contends that the decision to reject the disputed Applications conformed to applicable Regulations and the Sunrise Rules.

The Respondent recapitulates the history of the Applications. The Respondent states that the Validation Agent concluded that the documentary evidence did not demonstrate that the Benelux trademark relied upon by the Applicants had been registered on the date of the respective Applications and, therefore, did not establish that the Applicants were the holders of Prior Rights valid at the time of the respective Applications.

The Respondent argues that Prior Rights claimed during the Sunrise Period should have materially existed no later that at the moment of filing the Applications. To support this argument, the Respondent refers to previous Panel decisions No. 01125, No. 1275, No. 876, No. 1710, No.1886, No. 1612, No. 1518 and No. 404.

The Respondent also argues that the Complainant's interpretation of legal effect of 'depot' and 'inschrijving' is incorrect. In the view of the Complainant, the Benelux trademark registration has its effect in terms of applicable Regulations at the date of registration, i.e. 'inschrijving'. To support this argument, the Respondent refers to Article 3 of the Uniform Benelux Trademark Act, to previous Panel Decision No. 1680 and subsequently to doctrinal interpretation in article of W. Bettink published in Mediaforum 2001-2, p. 43. In particular, the Respondent stresses the similarity of the present dispute and the Case No. 1680.

Consequently, the Respondent contends that since the respective trademarks relied upon by the Applicants were not yet registered on the day of the application, the Respondent correctly rejected the Applications.

In response to reference to cases when the Respondent in cooperation with the Validation Agent registered domain names upon Prior Rights demonstrated at the date of 'depot,' the Respondent argues that his decision must only be evaluated with regards to the

applicable rules and regulations. The Respondent stresses that the only object of the ADR proceedings is to determine whether the Respondent's decision to reject the Complainant's Application conflicts with the applicable Regulations. The legality of the Respondent's decision may not be assessed based on previous applications dealt with by the Validation Agent and/or the Registry. At this point, the Respondent refers to Article 22(1) of the Regulation (EC) No. 874/2004, to the Panel decision No. 1711 and subsequently to the decision of the Court of First Instance No. T-123/04.

Consequently, the Respondent requests the Panel to deny the Complaint.

DISCUSSION AND FINDINGS

Before the Panel proceeds to the discussion of the merits, it seems appropriate to make following two general remarks to the Complaint and its content:

- The Panel shares the opinion that broad public discussion over domain procedures, registration policies and related issues is desired and welcome. In this respect, the Complainant raises in his Complaint many interesting questions. However, most of them do not fall into the scope of .eu ADR procedure and into the jurisdiction of the Panel. Thus, pursuant to Article 22(1b) of the Regulation (EC) No. 874/2004), the Panel is entitled to solve only one of questions raised by the Complainant, i.e. whether disputed Decisions of the Respondent were in compliance with applicable Regulations.
- Although the design of various .eu domain processes including .eu ADR was inspired by generic TLD procedures governed by UDRP and related documents (see Paragraphs 16 and 17 of Preamble to Regulation (EC) No 874/2004), the Registry, the Validation Agent and the Panel are all bound only by applicable Regulations and other applicable sources of the European law. Thus, there is no need to legally reason or argue inconsistence between interpretations adopted in UDRP processes and .eu ADR as they are both based on different legal grounds.

As the evidence submitted partly by the Complainant and the Respondent is not disputable between the Parties, the Panel can base its decision on following facts:

- The Application for the domain name LOTTERIE was filed on 19/1/2006 in the Sunrise period (Documentary Evidence was submitted on 8/2/2006). The Application was based on Benelux trademark registration no. 0789833 filed on ('depot') 19/1/2006 and registered on ('inschrijvings') 25/1/2006.
- The Application for the domain name IRC was filed on 19/1/2006 in the Sunrise period (Documentary Evidence was submitted on 10/2/2006). The Application was based on Benelux trademark registration no. 0792686 filed on ('depot') 19/1/2006 and registered on ('inschrijvings') 10/2/2006.
- The Application for the domain name NBA was filed on 19/1/2006 in the Sunrise period (Documentary Evidence was submitted on 8/2/2006). The Application was based on Benelux trademark registration no. 0789836 filed on ('depot') 19/1/2006 and registered on ('inschrijvings') 25/1/2006.
- The Application for the domain name SLOTMACHINES was filed on 20/1/2006 in the Sunrise period (Documentary Evidence was submitted on 8/2/2006). The Application was based on Benelux trademark registration no. 1100979 filed on ('depot') 19/1/2006 and registered on ('inschrijvings') 26/1/2006.
- The Application for the domain name T-SHIRT was filed on 9/12/2005 in the Sunrise period (Documentary Evidence was submitted on 12/1/2006). The Application was based on Benelux trademark registration no. 1095337 filed on ('depot') 8/12/2005 and registered on ('inschrijvings') 12/12/2006.
- All above Applications were rejected due to nonexistence of Prior Rights at the moment of their filing.

As all disputed decisions on rejection of the above Applications have the same grounds, the Panel will consider them all together. In particular, the dispute between Parties arose due to their different interpretations of legal effect of filing the Benelux trademark application and its registration in terms of Regulation (EC) No. 874/2004. The task of the Panel is mainly to assess whether Prior rights defined in Chapter IV of Regulation (EC) No. 874/2004 were established by the Benelux trademark at the moment of filing the trademark application, i.e. on the date of 'depot,' or at the moment of trademark registration, i.e. on the date of 'inschrijving'. Consequently, the Panel will assess whether the disputed Applications were based on existing Prior rights or not.

The same interpretational question as in this case was, moreover between the same Parties, solved in former decision of the Panel No. 01680. The Panel ruled that "[a]ccording to this Benelux Trademark Law, an exclusive right to a trademark is only acquired by a trademark registration (Article 3). It is not because article 12 of the Benelux Trademark Law provides for the possibility for an applicant to recover reasonable damages between the time of the publication of the application and the time of the registration, that this article transforms a trademark application into a trademark registration."

The argumentation presented in the Panel decision No. 01680 is consistent, properly reasoned and in accordance with doctrinal

interpretation. Thus, any possible change would have to be reasoned either by a change in applicable law or by dissimilar circumstances of the case. As the Panel sees no change in applicable National or EC law and there are no significant differences between factual circumstances of the former and the present case, there is no reason to interpret the applicable law (both of EC and Netherlands/Benelux) differently.

Consequently, the Panel stands on opinion that Prior rights in terms of Article 10 (1) of the Regulation (EC) 874/2004 are by the Benelux trademark law first established according to Article 3 of the Benelux Trademark Act at the date of the registration ('inschrijving') of the trademark.

The Panel is aware of the fact that there were some domain names registered during the Sunrise Period upon the 'depot' of Benelux trademark applications. Such decisions were, however, not taken by the Panel but by the Registry. As there is no dependence or institutional relation between the Registry and the Panel, the Panel can not be bound by any previous praxis of the Registry, the Validation Agent or other subjects involved in domain procedures. In the view of the Panel, the praxis recognizing the date of 'depot' as the date of existence of Prior Rights was incorrect and, as noted by the Complainant, such incorrectness was recognized and corrected during the Sunrise period even by the Validation Agent and the Registry themselves.

When the Complainant, calling for former partial praxis of the Registry, argues by his right of equal treatment, it should be noted that such right is claimable only in cases when its exercise is in accordance with the applicable law. In other words, when some mistake occurs in application of law, it is inappropriate to claim its repetition and argue by the principle of equality.

Summing up relevant facts and legal arguments, the Panel concludes that at the moment of filing the Applications for the disputed domain names, there were no existing Complainant's Prior rights in terms of Article 10(1) of the Regulation (EC) 874/2004. Article 12(2) states that: "During the first part of phased registration, only registered national and Community trademarks, geographical indications, and the names and acronyms referred to in Article 10(3), may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in Article 10(1)". Thus, the Respondent's decisions rejecting the Applications are to be seen as correct and the only possible conclusion to be drawn ad hoc from above discussion and findings is dismissal of the Complaint.

As obiter dictum, the Panelist feels a need to shortly respond to final challenging statement made by the Complainant and to add a partial comment on legality of such registrations of trademarks that are done in order to secure prior rights for registering domain names. As contended by the Complainant in his final statement, there is nothing illegal on registering trademarks purely in order to claim prior rights in domain registration. However, the trademark law and law of domain names should be interpreted not just from their words but also with regards to their aims and goals.
It is definitely not a goal of any of national trademark laws to protect use of generic terms. Consequently, it should not be the aim of the trademark law to enable priority registration of generic terms as domain names.
As technical limits of domain names prohibit use of specific characters, there is a possibility to register trademarks that are because of inclusion of characters such as ~, @, & and others not considered by the trademark law as generic (and thus allowed to be registered), but when claimed in domain processes, they result, like in the present case, in fact in protection of generic terms.
Although there can be seen different opinions whether such [ab]use of technical limits of domain names is fair or not, there is no doubt that when not prohibited by the law, such practice is not to be considered as illegal. However, this way of taking legal advantage of technical limitations is due to its contradiction to nature and aims of applicable laws to be seen as an activity in fraudem legis, i.e. circumambulating the law. Thus, there is on one hand no legitimate reason to prosecute or sanction such activities, but on the other hand, we see also no legitimate reasons for extended legal protection of their outcomes.

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	Radim Polcak

DATE OF PANEL DECISION 2006-10-05

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant requested annulment of decisions rejecting Applications for registration of domain names IRC, LOTTERIE, NBA, SLOTMACHINES and T-SHIRT.

All disputed Applications were filed in Sunrise period and were based on Benelux trademarks. All Applications were filed after filing applications for Benelux trademarks, but before their registration.

The Panel held consistently with its former decisions that Benelux trademarks establish Prior rights in terms of Article 10 (1) of the Regulation (EC) 874/2004 not earlier than at the moment of registration.

Consequently, the disputed Applications were not based on relevant Prior rights and their rejection was in accordance with applicable Regulations.

The Complaint is denied.