Panel Decision for dispute CAC-ADREU-002194

Case number	CAC-ADREU-002194
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Domain names	petrom.eu

Case administrator

Name	Kateřina Fáberová

Complainant

Organization / Name	PETROM S.A., PETROM

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

none

FACTUAL BACKGROUND

Complainant is the owner of the PETROM trademark, registered in, among other jurisdictions, Hungary (as "PETROM The Essence of Movement" under 165 603), and the CTM (as "P PETROM Member of OMV Group" under 4697835). In both cases, PETROM is the dominant word in the trademark.

Though not legally relevant for this case, it can be noted that a party related to the Complainant, OMV Solutions GmbH, filed a sunrise application for the domain name PETROM on December 7, 2005. This application was for some reason rejected by EURid on March 3, 2006.

On March 22, 2006, Kurt Janusch applied for a sunrise application for the domain name PETROM.EU based on Benelux Trademark Registration No. 1107088, the word mark pet & rom [hereinafter "PET & ROM"], applied for on March 20, 2006, and registered on March 22, 2006 for "telecommunications" in class 38. Mr. Janusch timely filed the documentary evidence, and EURid registered the domain name in the name of Mr. Kurt Janusch.

As part of the factual background, it should be noted that the Complainant has pointed out that the ADR proceeding was started on July 24, 2006 and that Respondent was given 30 working days in which to file a timely response. According to the Complainant, the Response was received on September 19, 2006, and was thus late. The ADR Provider (CAC) has informed the Panel that the Response was received on September 13, 2006, which was within the deadline according to the agreed upon procedures, taking into account holidays in Belgium.

A. COMPLAINANT

In essence, the Complainant alleges that the registrant Kurt Janusch might have rights in PET & ROM, but that does not give rights in PETROM, and, accordingly, Respondent EURid should not have registered the domain name PETROM.EU in the name of Kurt Janusch. Complainant asserts two bases: firstly that the domain name was registered in bad faith and for speculative reasons. Secondly, on the basis of the PET & ROM registration, Registrant could have registered “PETANDROM” or “PETUNDROM” or ‘PETETROM” but he cannot apply for the “PETROM “, as this is not the "complete name" or "identical" as required by Arts. 10 and 11 of EC Regulation 874/2004.

Complainant requests that EURid's decision to register the domain name PETROM.EU be annulled.

B. RESPONDENT

Complainant has asserted two issues: that Respondent EURid should not have registered the domain name in the name of the Respondent 1) because the Respondent was in bad faith, and 2) because the domain name was not identical to the right on which the sunrise application was based.

As regards the bad faith claim, the Respondent wishes to stress that pursuant to article 22 (1) b of the Regulation, a decision taken by the Respondent may only be annulled when it conflicts with the Regulation. Pursuant to article 22 (1) (a) of the Regulation, bad faith must be assessed in the context of an ADR proceeding against the domain name holder itself, not against the Registry (see in particular ADR decisions Nr. 00532 URLAUB, 00382 TOS, 00191 AUTOTRADER, 00335 MEDIATION, 00685 LOTTO, 1239 PESA and 01317 FEE).

As regards the identity claim, the Respondent's task pursuant to article 11 of the Regulation is merely to assess whether an applicant has chosen any of the three options available, namely 1. deleting the ampersand; 2. replacing the ampersand with a hyphen; or 3. rewriting the ampersand. If an applicant has chosen one of the three possibilities, its application must be accepted. Here the registrant elected the first option, namely deleting the ampersand.

DISCUSSION AND FINDINGS

The main principle in Art. 10(2) of EC Regulation 874/2004 is that there must be identity ("complete name") between the prior right and the domain name. The exception to this identity principle is the case of special characters, including ampersands. According to Art. 11(2) of EC Regulation 874/2004, these special characters "shall be eliminated . . . replaced with hyphens or rewritten." (our emphasis). The purpose of this rule was to give the opportunity for owners of trademarks like

Bang & Olufsen, Proctor & Gamble, Ben & Jerry's

to get

bangolufsen.eu, proctorgamble.eu, benjerrys.eu
bang-olufsen.eu, proctor-gamble.eu, ben-jerrys.eu
bangandolufsen.eu, proctorandgamble.eu, benandjerrys.eu
bangetolufsen.eu, proctoretgamble.eu, benetjerrys.eu
bangundolufsen.eu, proctorundgamble.eu, benundjerrys.eu
etc.

at their own chosing without coming astray of the identity principle.

Said in another way, EURid would have erred if they had rejected say, bangolufsen.eu, on the basis of a word mark registration for BANG & OLUFSEN on the ground that the domain name was not identical to the trademark.

The issue is not whether PET & ROM is identical to PETROM. At issue is whether EURid erred in accepting the applicant's elmination of the ampersand in the trademark PET & ROM in the application for petrom.eu.

PET is a common word and ROM has a computer-related meaning. PETROM appears as a coined name. The combination of PET & ROM to PETROM is not an equation where the sum is greater than two parts. In this respect PETROM is distinguished from case 398 BARCELONA, where the prior right was the ampersand trademark BARC & ELONA. There the sum of the two parts was greater than the individual parts, in that the combination is a well-known city and the bad faith is obvious. That is not the case with PETROM.

The panel notes that there is nothing to hinder the Complainant to bring an ADR proceeding against the registrant Kurt Janusch based on violation of Art. 21 of EC Regulation 874/2004, where the bad faith of the registrant would be at issue. In the instant case against the registry, however, the issue is only whether the registry erred in accepting an application for PETROM based on PET & ROM. The majority finds that EURid did not err in this regard. Consequently the complaint is denied.

Dissent (Massimo Cimoli):
The minority of the Panel considers that the issue is whether EURid erred in accepting the contested domain name given that PET & ROM (the applicant’s registered trademark) is not identical, in the perception of the average internet user, to PETROM. The latter is perceived as an invented word while the former comprises two different words such as PET and ROM (two totally unrelated words with different meaning and possibly expressed in different languages: English and German).
The minority believes that PETROM, phonetically as well as visually and conceptually, is not identical to PET & ROM and it would not be perceived as two words together but rather as just an invented word.
In order to maintain the identicality rule the requested domain name should have easily be rewritten, for example as PETANDROM or

PETUNDROM or PET-ROM.

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	**Tuukka Ilkka Airaksinen**

DATE OF PANEL DECISION 2006-10-10

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

This is an "ampersand case" brought against the registry. EURid registered the domain name PETROM.EU on the basis of a trademark registration for PET & ROM. Because both elements PET and ROM had common meanings, and the combination did not create a recognised name, the Panel was able to distinguish this case from another "ampersand case", case 398 BARCELONA (where the trademark had been BARC & ELONA). Accordingly, the majority of the Panel found that EURid did not err in registering PETROM.EU on the basis of a trademark registration for PET & ROM, and dismissed the complaint. The majority noted that there appeared to be nothing to hinder Complainant in bringing an ADR proceeding against the registrant.

The minority believes that PETROM is different from PET & ROM and that it would be perceived by the average internet user as one invented word rather then the union of PET & ROM, therefore in order to maintain the identicality principle (one of the fundamental principles of the sunrise periods) EURid shoud have rejected a sunrise request for a domain name that is not identical to the registerd trademark.