Panel Decision for dispute CAC-ADREU-002221

Case number	**CAC-ADREU-002221**
Time of filing	**2006-07-10 11:35:13**
Domain names	**reykjavik.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**City of Reykjavik, Reykjavik**

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 pending or decided legal proceedings in relation to the disputed domain name.

FACTUAL BACKGROUND

The Complainant launched a Complaint with the Czech Arbitration Court on July 3, 2006 to contest Respondent's decision to register the domain name <reykjavik.eu> in the name of Parknet BV. The Czech Arbitration Court, after assigning as Time of Filing the date of July 10, 2006, requested EURid to provide Registrar verification on July 10, 2006. In a non-standard communication of July 17, 2006, EURid provided Registrar verification and disclosed the Documentary Evidence in response to Complainant's request. On July 18, 2006, the Czech Arbitration Court notified the Complainant of Complaint deficiencies, and, subsequently, the Complainant filed an amended version of the Complaint on July 20, 2006.

On July 25, 2006 the Czech Arbitration Court notified the commencement of the ADR Proceeding, informing the Respondent that Respondent's Response was to be submitted within 30 working days from the delivery of the notification.

The Respondent submitted a Response on September 13, 2006, which the Czech Arbitration Court acknowledged the same day. As the Respondent in the Response elected to submit the dispute in this ADR Proceeding to a Panel consisting of three impartial and independent Panelists, the Respondent submitted proof of additional payment in a non-standard communication of September 14, 2006. On September 19, the Czech Arbitration Court notified the Complainant of Respondent's choice and invited the Respondent to indicate the names and contact details of three candidates in order of preference for appointment as Panelists.

The Respondent submitted a non-standard communication on September 20, 2006, incorporating reference to a .eu ADR Decision and its relevance to Respondent's arguments.

Following an invitation to serve as a Panel in this dispute, the three-member Panel accepted the mandate and submitted Declarations of Impartiality and Independence in due time. The Czech Arbitration Court duly notified the Parties of the identity of the Panelists appointed on September 22, 2006, in accordance with Paragraph B4(e) of the .eu Alternative Dispute Resolution Rules (hereafter "ADR Rules") and the date, by which a Decision on the matter was due, which was specified as October 14, 2006.

In the absence of a challenge of the Panelists' appointment by either Party according to Paragraph B5(c) of the ADR Rules, the Czech Arbitration Court forwarded the case file to the Panel on September 25, 2006.

A. COMPLAINANT

The Complainant in its Complaint and amended Complaint contends that the Domain Name Registrant registered a series of trademarks

in order to hinder the legitimate owners of the rights in the names from registering them as domain names and that a considerable number of registrations correspond to the names of major European cities.

The Complainant also contends that in relation to the disputed domain name <reykjavik.eu> the Respondent's decision to grant the domain name to the Domain Name Registrant is in conflict with Articles 10 and 11 of Regulation 874/2004, as the Registrant's domain name does not in fact correspond to a prior right and, in particular, the complete name of the prior right. The Complainant contends that the "reykja & vik" trademark cannot serve as the basis for applying for the domain name <reykjavik.eu> but only for the domain name <reykjaandvik.eu>. In this context, the Complainant contends that "[…] it is not permissible to eliminate the special character from the respective domain name, if a third party has prior rights in the remaining domain." The Complainant further contends that, as the special character incorporated in the registered trademark could easily be transcribed to "and", the Respondent should have rejected the domain name application.

The Complainant finally contends that the trademark "reykja & vik" "is not a word mark but only a figurative, a design trademark", in which case Section 19(2) of the Sunrise Rules sets out the conditions for invoking a prior right based on a figurative or composite sign. The Complainant contends that these conditions were not met in this particular case and that, therefore, the Respondent's decision to grant the domain name to Parknet BV is in conflict with the relevant Regulations.

All in all, the Complainant contends that Respondent's decision to allow the registration in the name of Parknet BV conflicts with the European Union Regulations. The Complainant, as a result, seeks the remedy specified in Paragraph B11(c) of the ADR Rules, i.e. the annulment of the decision taken by the Respondent.

B. RESPONDENT

The Respondent contends that the alleged bad faith on the part of the Domain Name Registrant is an issue that is properly put forward in ADR Proceedings against the Domain Name Registrant and not in ADR Proceedings launched against the Registry. The Respondent contends that the issue in ADR Proceedings against the Registry is whether the Registry's decision conflicts with the European Union Regulations.

The Respondent also contends that Respondent's decision to register the domain name in the name of Parknet BV does not conflict with Articles 10 and 11 of Regulation 874/2004. The Respondent contends that the Respondent did not violate the Regulation by accepting an application, where the Applicant chose freely between the three options listed in Article 11 of the Regulation. The Respondent contends that, as the Regulation does not command the Respondent to make a choice for the Applicant and as the Regulation did not intend to leave any discretion or interpretation to the Respondent insofar as the content of the prior rights is concerned, a task clearly reserved for national courts and the competent Trademark Offices, the Respondent did not act contrary to the Regulation. The Respondent contends that, if the Respondent had to refuse applications based in one of the three options listed in Article 11 of the Regulation in some specific cases, the Regulation (or at the very least, the Sunrise Rules) should have said so.

The Respondent contends that what the Respondent must do pursuant to Article 11 of the Regulation is to assess whether an Applicant has chosen any of the three options available. If an Applicant has done so, its application must be accepted. If an Applicant is alleged to have abused Article 11, ADR Proceedings against the Applicant/Registrant must be initiated.

The Respondent finally contends that the Applicant relied on a registered word mark, not on a figurative trademark, and that, therefore, Complainant's contentions based on Section 19(2) of the Sunrise Rules should be dismissed.

DISCUSSION AND FINDINGS

ISSUES

1. Language of the ADR Proceeding and submitted documents

The language of this ADR Proceeding is English. The Complainant filed the Complaint in English on July 3, 2006. The Complaint was accompanied by a copy of an extract from the official online database of the Benelux Trademark Office in Dutch for the trademark "reykja & vik". The amended Complaint filed on July 20, 2006 was accompanied by the same document. No translation of the document in English has been provided by the Complainant.

Following Complainant's request to the Czech Arbitration Court to require EURid to disclose the Documentary Evidence, the Respondent disclosed, inter alia, the Documentary Evidence on July 17, 2006. The Documentary Evidence disclosed is in the Dutch language and comprises the copy of an extract from the official online database of the Benelux Trademark Office for the trademark "reykja & vik". No

translation of the document in English has been provided by the Respondent.

Paragraphs 3(c) and 3(d) of the ADR Rules state: “(c) All documents including communications made as part of the ADR Proceeding shall be made in the language of the ADR Proceeding. The Panel may disregard documents submitted in other languages than the language of the ADR Proceeding without requesting their translation. Any communication by the Provider which, from its content, cannot be regarded as amounting to procedural documents (such as cover letters with which the Provider sends procedural documents or automatic system notifications generated by the Provider’s application) shall be made in the language of the ADR Proceeding or in English.
(d) The Provider and, after its constitution, the Panel by itself or upon the request of a Party, may order that any documents submitted in languages other than the language of the ADR Proceeding be accompanied by a translation in whole or in part into the language of the ADR Proceeding.”

The wording of the ADR Rules leaves discretion to the Panel to disregard documents in languages other than the language of the ADR Proceeding or to order the submission of translations for such documents. In this ADR Proceeding, it has not been deemed as necessary to order a translation of the copy of the official certificate of registration for the trademark “reykja & vik”, as it is clear from the document that the trademark “reykja & vik” was registered at the Benelux Trademark Office as a word mark (Woordmerk) on March 23, 2006 (Datum inschrijving) for goods or services in Nice class 22 with registration No. 0796430. Furthermore, the Complainant did not contest the Documentary Evidence disclosed by the Respondent nor did it request a translation of the document in the language of the ADR Proceeding.

2. Timely initiation of the ADR Proceeding

Pursuant to Section 26(1) of the Sunrise Rules, any interested party, other than the Domain Name Applicant, may initiate an ADR Proceeding against a decision of the Registry within forty calendar days following that decision (“Sunrise Appeal Period”).

In this particular case, the date of commencement of the ADR Sunrise Appeal Period was May 26, 2006 and the deadline was July 4, 2006. The Complainant launched a Complaint with the Czech Arbitration Court on July 3, 2006, to contest Respondent’s decision. The Czech Arbitration Court assigned as Time of Filing the date of July 10, 2006. On July 18, 2006 the Czech Arbitration Court notified the Complainant of deficiencies in the Complaint and on July 20, 2006 the Complainant filed an amended version of the Complaint.

In the absence of a clear definition in the Sunrise Rules or the ADR Rules of what exactly amounts to a timely initiation of an ADR Proceeding and in light of the fact that the Complaint of July 3, 2006 was initiated within the time prescribed by Section 26(1) of the Sunrise Rules, the Panel finds that a fair treatment of the Complainant only dictates that the interpretation and approach to be followed is that the timely initiation of the ADR Proceeding should be examined on the basis of the earliest date, on which the Complaint was initiated, irrespective of whether a later Time of Filing was assigned and an amended Complaint rectifying deficiencies was submitted at a later time point, after the expiry of the forty calendar days for the initiation of an ADR Proceeding against the decision of the Registry.

Therefore, the Panel finds that the Complaint was initiated properly within the prescribed time frame.

3. Admissibility of Respondent’s non-standard communication

The Respondent submitted a non-standard communication on September 20, 2006, incorporating reference to case law and its relevance for Respondent’s arguments.

Paragraph B8 of the ADR Rules states: “In addition to the Complaint and the Response, the Panel may request or admit, in its sole discretion, further statements or documents from either of the Parties.”

When exercising its discretion the Panel is, however, bound to observe procedural guarantees and Paragraph B7(b) reads: “In all cases, the Panel shall ensure that the Parties are treated fairly and with equality.”

As the Complainant did not challenge the admissibility of Respondent’s non-standard communication and as Respondent’s non-standard communication does not bring forward new factual elements, the consideration of which could be prejudicial to the fair and equal treatment of both Parties in the framework of this ADR Proceeding, the Panel finds the non-standard communication to be admissible.

4. Substantive issues

This Complaint arises in relation to the application and interpretation of primarily Regulation 874/2004, Regulation 733/2002, the Sunrise

Rules, the Registration Terms and Conditions and is governed by the ADR Rules and the ADR Supplemental Rules. The Complainant based the Complaint on three grounds and these will be examined in turn.

The Complainant's contentions in relation to the Domain Name Registrant's bad faith in registering the disputed domain name cannot form part of ADR Proceedings against the Registry. On the one hand, the Registry cannot be expected to defend a third party's intent and, on the other hand, a third party's intent cannot be the object of an ADR Proceeding, where the third party does not participate and has no possibility of rebutting the Complainant's contentions. If the Complainant wishes to raise the issue of bad faith on the part of the Domain Name Registrant, the proper route to do so would be through an Article 21 ADR Proceeding. In this ADR Proceeding, which is launched against the Registry pursuant to Article 22(1)(b) of Regulation 874/2004, the Panel has a different mandate, namely to ascertain whether the decision taken by the Registry conflicts with Regulation 874/2004 or with Regulation 733/2002. Therefore, the Panel dismisses this ground of complaint.

The Complainant's contentions in relation to the figurative or composite mark and the application of Section 19(2) of the Sunrise Rules cannot form part of this ADR Proceeding, as it is clear from the Documentary Evidence disclosed by both the Complainant and the Respondent that the application was granted on the basis of the word mark "reykja & vik" registered at the Benelux Trademark Office on March 28, 2006 for goods or services in Nice class 22, registration No. 0796430 and not on the basis of a figurative or composite sign. Therefore, the Panel dismisses this ground.

The main issue before the Panel, therefore, in terms of substance, is whether the prior right claimed by the Domain Name Applicant containing a special character was properly transliterated to the disputed domain name, so as to satisfy the requirement that the domain name needs to correspond to the complete name of the prior right claimed, and, as a result, whether Respondent's decision to accept the domain name application is in conflict with the European Union Regulations.

According to Recital 12 of Regulation 874/2004, in order to safeguard prior rights recognized by Community or national law, a procedure for phased registration should be put in place with the purpose of ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights on a first-come, first-served basis, subject to validation of such rights on the basis of evidence provided by the Applicants.

Article 10, entitled "Eligible parties and the names they can register" clearly states:
1. Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.
'Prior rights' shall be understood to include, inter alia, registered national and community trademarks […]
2. 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.
[…]"

In the event that the prior right comprises a special character, Article 10 is to be read in conjunction with Article 11, which sets out different transliteration options, so that the domain name can be deemed to correspond to the complete name for which the prior right exists. Article 11(2) and 11(3) read:
"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.
Special character and punctuations as referred to in the second paragraph shall include the following:
~ @ # $ % ^ & * ( ) + = < > { } [ ] | \ /: ; ' , . ?"

Therefore, in abstracto, the options given are, in essence, three:
1. the special characters shall be eliminated entirely from the corresponding domain name OR
2. the special characters shall be replaced with hyphens OR
3. if possible, the special characters shall be rewritten.

Certain special characters cannot be easily rewritten, e.g. ? (question mark), in which case only options 1 and 2 would come into play, but there are special characters that can easily be rewritten, e.g. & (the ampersand) as "and".

The purpose of Regulation 874/2004 is to allow holders of prior rights to secure rights in domain names corresponding to such prior rights and not to allow the holder of a prior right to acquire proprietary rights in a domain name that does not correspond in the best possible way to a claimed prior right.

In the present case, the Registrant did indeed have a prior right, the registered word mark "reykja & vik". As the ampersand can easily be

rewritten to “and”, the Registrant’s prior right gives rise to the domain name <reykjaandvik.eu>, rather than <reykjavik.eu>. In other words, in the view of the Panel the Regulation cannot be interpreted as allowing a hypothetical Registrant claiming a prior right in “reykja & vik” to be able to register the same domain name as a hypothetical Registrant claiming a prior right in “reykjavik” or indeed “Reykjavik”.

The Panel is aware of the difficult task that the Respondent has been called to carry out and it is equally aware of the complex and time-consuming process that has been the corollary of such a task. But ultimately, the Respondent is called to make an overall assessment, applying sound judgment in the fulfillment of its duties. The Regulation in Article 11(2) and 11(3), by enumerating three transliteration options, seeks to address different transliteration circumstances in abstracto, which may indeed arise in the course of a domain name application. In order to safeguard the correct application of the Regulation, the Respondent should grant the domain name that most suitably under the circumstances corresponds to the underlying prior right.

It is true, as the Respondent contends, that the Regulation did not intend to leave any discretion or interpretation to the Respondent insofar as the content of the prior rights is concerned, reserving this for national courts and the competent Trademark Offices. However, ensuring that the domain names applied for correspond in the best possible way and indeed mirror the underlying claimed rights is the responsibility of the Registry and such responsibility is to be exercised in concreto, taking into account the specific circumstances in a case-by-case approach. Although the option exists in abstracto to eliminate the special characters, accepting this route in concreto may have the effect of allowing a Registrant to contravene the spirit, aim and purpose of the Regulation.

In the present case, as the Applicant’s prior right “reykja & vik” gives rise to and can be rewritten as <reykjaandvik.eu>, it is the Panel’s view that the Respondent should have rejected the application for the domain name <reykjavik.eu>.

There are a growing number of decisions relating to geographical names. However, earlier decisions do not constitute precedents for the Panel, nor do they necessarily arise in identical or similar circumstances. Ultimately, the Panel’s mandate is to render a decision on the basis of the arguments advanced, as well as the evidence submitted by the Parties and the interpretation of the relevant Regulations and Rules in the specific circumstances that give rise to each dispute.

The remedy requested by the Complainant is annulment of Respondent’s decision concerning the disputed domain name <reykjavik.eu>.

DECISION

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

EURID's decision be annulled

Tuukka Ilkka Airaksinen
Antony Gold
Foteini Papiri

Dated: October 14, 2006

PANELISTS

Name	**Tuukka Ilkka Airaksinen**

DATE OF PANEL DECISION 2006-09-29

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested Respondent’s decision to allow the registration of the domain name <reykjavik.eu> in the name of Parknet BV on the basis of the registered trademark “reykja & vik”.

In respect of the Complainant’s contentions as to the Registrant’s bad faith, the Panel found that such grounds are properly brought forward in an ADR Proceeding against the Registrant pursuant to Article 21 and not in this ADR Proceeding that is launched against the Registry pursuant to Article 22(1)(b), where the Panel has a different mandate, namely to ascertain whether the decision taken by the Registry conflicts with Regulation 874/2004 or with Regulation 733/2002.

In respect of the Complainant’s contentions as to the application of Section 19(2) Sunrise Rules for figurative or composite signs, the Panel found that these cannot form part of this ADR Proceeding, as it is clear from the Documentary Evidence disclosed by both the

Complainant and the Respondent that the application was granted on the basis of the word mark “reykja & vik” registered at the Benelux Trademark Office on March 28, 2006 for goods or services in Nice class 22, registration No. 0796430 and not on the basis of a figurative or composite sign.

In respect of Complainant’s contentions that the Registrant does not have prior rights for the registration of the complete name of the prior rights claimed, the Panel found that, as the prior right claimed is the registered word mark “reykja & vik” and as the ampersand can easily be rewritten to “and”, the Registrant’s prior right gives rise to the domain name <reykjaandvik.eu>, rather than <reykjavik.eu>. Furthermore, the Panel found that the Regulation in Article 11(2) and 11(3), by enumerating three transliteration options, seeks to address different transliteration circumstances in abstracto, which may indeed arise in the course of a domain name application. In order to safeguard the correct application of the Regulation, the Respondent should grant the domain name that most suitably under the circumstances corresponds to the underlying prior right. Although the option exists in abstracto to eliminate the special characters, accepting this route in concreto may have the effect of allowing a Registrant to contravene the spirit, aim and purpose of the Regulation.

In the present case, as the Applicant’s prior right “reykja & vik” gives rise to and can be rewritten as <reykjaandvik.eu>, it is the Panel’s view that the Respondent should have rejected the application for the domain name <reykjavik.eu>. Therefore, the Panel decided to order the annulment of the Respondent’s decision.