Panel Decision for dispute CAC-ADREU-002293

Case number	**CAC-ADREU-002293**
Time of filing	**2006-07-24 15:09:17**
Domain names	**bat.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**British American Tobacco (Brands) Limited, Mr Julian Gibb**

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 that ADR panel is aware of

FACTUAL BACKGROUND

The Complainant was incorporated in England in 1998. The Complainant is a member company of the British American Tobacco international group of companies. British American Tobacco was formed in 1902, as a joint venture between the United Kingdom Imperial Tobacco Company and the American Tobacco Company. The company name was derived from the home bases of the two founding companies. British American Tobacco was listed on the London Stock Exchange in 1911. British American Tobacco has been known by the acronym BAT since its inception.
The Complainant is the proprietor of several national trade marks for BAT. The Complainant first applied for the domain name on 07/12/2005 at 11.08. Documents in support of the application were filed and were received by EURid on 23/12/2005, within the deadline set of 16/01/2006. The application submitted by BAT Geosystems at 11.04 on 07/12/2005 preceded the Complainant's application by 4 minutes. The application of BAT Geosystems was supported by Community trademark registration (CTM number 1955723) as a figurative mark (the "Prior Right Registration").

BAT Geosystems AB (hereafter "the Applicant") applied for the domain name BAT on December 7, 2005. The documentary evidence was received by the processing agent on 13 January 2006, which was before the 16 January 2006 deadline. The documentary evidence consisted of a Community trademark on the figurative sign BAT (Nr. 00001955723), registered in the name of the Applicant.
The validation agent found that the documentary evidence clearly demonstrated that the Applicant was the holder of a prior right on the name BAT. Consequently, the Respondent accepted the Applicant's application for the domain name BAT.

A. COMPLAINANT

The Complainant contends that the Registry's decision to accept the application by BAT Geosystems for the domain name conflicts with the Regulation (Commission Regulation (EC) No.874/2004) and the Sunrise Rules, and it should be annulled.

The Complainant contends that BAT Geosystems was not eligible to apply to register the domain name in the Sunrise period because of the provisions in Section 19 of the Sunrise Rules. Section 19(2) states that Documentary Evidence must clearly depict the name for which a Prior Right is claimed. It also states that where a Prior Right claimed to a name included in a figurative sign relied on by the applicant, the Prior Right will only be accepted if the word element is predominant and can clearly be separated or distinguished from the device element and provided that the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists (or the order in which those characters appear).

The Complainant contends that the Prior Right Registration does not clearly depict the BAT name due to the form of the second and third

characters in the mark which are a hyphen and a back-slash symbol. The Prior Right Registration appears to be a figurative sign for B-\T. Further, there is a reasonable possibility that the characters of the Prior Right Registration will be read as B-\T. Accordingly, the Complainant contends that the application for the domain name was accepted by the Respondent in contravention of Section 19 of the Sunrise Rules because the Prior Right is for a figurative mark which is likely to be read as B-\T.

In addition, Article 11 of the Regulation specifically states that where the name for which prior rights are claimed contain special characters, these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten. As such, the Prior Right Registration, which contains the special character '\', suggests that the more appropriate domain name is b-t.eu.

Finally, since the Complainant's application is in the queue for the domain name after that of BAT Geosystems, being the first and second place applications (both of which rely on the Prior Right Registration), and since the Complainant satisfies the registration criteria under the Regulation, the Complainant requests the Panel determine that the Complainant is eligible for the domain name and that the domain name is transferred or attributed to the Complainant.

B. RESPONDENT

The Applicant demonstrated that it was the holder of a prior right on the name BAT .The Applicant was the first applicant to apply for the domain name BAT. This fact is not disputed by the Complainant.
The Applicant submitted as documentary evidence a figurative trademark composed of the stylized letters BAT and the reference ®. Pursuant to section 19 (3) of the Sunrise, the validation agent correctly found that the reference ® could be eliminated and did not form part of the complete name for which the relevant prior right exists. This is not disputed by the Complainant.

The only question disputed by the Applicant is the form of the letter A in the BAT logo.

The validation agent found that the BAT logo clearly reads BAT, since the general impression of the word was apparent, without any reasonable possibility of misreading the characters or the order in which those characters appear. Meanwhile, the Complainant contends that the general impression of the BAT logo was not apparent since the stylized letter A should read as "a hyphen and a back-slash symbol".

The Complainant's interpretation of the trademark cannot be accepted. Indeed, the general impression of the BAT trademark clearly reads BAT. Otherwise, why would the Applicant named "BAT (emphasis added) Geosystems" have chosen this trademark as his logo. The mere fact the letter A is stylized for design purposes does not affect by any means the general impression of the sign. The word BAT is clearly apparent. It would therefore be unreasonable to treat the designed letter A as "a hyphen and a back-slash symbol" where the general impression given by the sign clearly reads BAT.

Regarding the Complainant's request for attribution of the domain name to the Complainant
With regard to the Complainant's request to have the domain name transferred to it, and merely for the sake of completeness, the Respondent would like to refer the Panel to article 11 (c) of the ADR Rules. Two conditions need to be met before the Panel may order the transfer of a domain name:

• The Complainant must be the next applicant in the queue for the domain name concerned; and
• The Respondent must decide that the Complainant satisfies all registration criteria set out in the Regulation.

Therefore, the Respondent must first assess, via the normal validation procedure, whether the Complainant's application satisfies the requirements of the Regulation.
Consequently, should the Panel consider that the Respondent's decision must be annulled; the Complainant's transfer request must be rejected.

DISCUSSION AND FINDINGS

Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") states that: "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".
Article 10 (2) of the Regulation 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 14 of the Regulation states, "The Registry shall register the domain name, on the first come first served basis, 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".
Section 19 (2) of the Sunrise Rules states, "A prior right claimed to a name included in figurative or composite signs (signs including

words, devices, pictures, logos, etc.) will only be accepted (i) if the sign exclusively contains a name or (ii) if the word element is predominant, and can be clearly separated or distinguished from the device element, provided that (a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the domain name applied for, in the same order as that in which they appear in the sign, and (b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear".
Section 19 (3) of the Sunrise Rules states, "For trademarks, the references “TM”, “SM”, “®” and the like do not form part of the complete name for which the relevant Prior Right exists".
Article 14 of the Regulation clearly states that the Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right.
It is not disputed by the Complainant that the Applicant was the first to apply for the domain name BAT.
The validation agent correctly found that the Applicant was the holder of a prior right on the name BAT, pursuant to article 10 (2) of the Regulation and section 19 (2) of the Sunrise Rules.
Based on these findings, the Respondent accepted the Applicant's application pursuant to article 14 of the Regulation.

Since the only question disputed by the Applicant is the form of the letter "A", the panel attributed maximum importance to this particular problem and the Complainant’s reasoning. By carefully reviewing the facts, the panel came to the following conclusion:

- BAT logo clearly reads BAT;
- The general impression of the word was apparent, without any reasonable possibility of misreading the characters or the order in which those characters appear;
- The registration was due to the Regulation.

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	**Martin Maisner**

DATE OF PANEL DECISION 2006-10-24

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contends that the Registry’s decision to accept the application of BAT Geosystems for the domain name conflicts with the Regulation (Commission Regulation (EC) No.874/2004) and the Sunrise Rules, and it should be annulled.
The Applicant demonstrated that it was the holder of a prior right to the name BAT. The Applicant was the first applicant to apply for the domain name BAT. The Complainant contends that the general impression of the BAT logo was not apparent since the stylized letter A should read as "a hyphen and a back-slash symbol.”
The Complainant's interpretation of the trademark was not accepted. Indeed, the general impression of the BAT trademark clearly reads BAT.
The panel decided that the Registration was dully awarded to the Applicant and that the Complaint has no grounds.
The Complaint was therefore denied.