Panel Decision for dispute CAC-ADREU-002416

Case number	CAC-ADREU-002416
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Domain names	timesonline.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Times Newspapers Limited

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 related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, Times Newspapers Limited, is the publisher of The Times (first published in 1785) and The Sunday Times (first published in 1821) newspapers.

The internet editions of the Complainant were first launched on January 1, 1996 and timesonline.co.uk houses both The Times and The Sunday Times online editions.

R.M. Peddemors ("the Applicant") applied for the domain name timesonline.eu on March 4, 2006, based on the Benelux trademark registration No 792678 TIMESON&LINE (word). The processing agent received the documentary evidence the same day and the validation agent concluded from the documentary evidence that the Applicant was the holder of a prior right. Therefore, the Respondent accepted the Applicant's application.

The Complainant did not apply for the domain name <timesonline.eu> during the Sunrise Period.

A. COMPLAINANT

The Complainant states that The Times and The Sunday Times newspapers are two of the world’s most well-known publications. The Times sells over 4 million copies per week in the UK alone, with over 180,000 sales per week in Europe. The Sunday Times is the UK’s leading Sunday national newspaper with sales of 1.3 million per publication.

The Complainant’s web site under <timesonline.co.uk> houses both The Times and The Sunday Times online editions, and is claimed to be one the UK’s most successful online publishing sites with over 60 million monthly page views. Apart from the online editions, the site also offers a large variety of services such as podcasts, archive service, reader comments and blogs, dedicated children’s section, property finder, listings, RSS feeds, interactive job section, audio digest and online tv (streaming of current news, entertainment and events). The Complainant spent over 1 million euros in marketing the site in the last financial year.

The Complainant owns a number of other similar domain names, such as thetimesonline.co.uk, online-times.co.uk, the-times-online.co.uk, thetimes-online.co.uk, the-timesonline.co.uk, timesonline.biz, times-online.biz, times-online.eu, timesonline.info, times-online.info, timesonline.net, times-online.net, timesonline.tv and wwwtimes-online.co.uk. Complainant further claims to have a number of registered or pending trademarks, such as THE TIMES, TimesOnline, SUNDAY TIMES, The Times, THE TIMES EUROPE, THE EUROPEAN TIMES BY THE TIMES, THE SUNDAY TIMES and Times Media.

The Complainant argues that the Respondent should not have granted the registration of the disputed domain name in any event, and that the Applicant has applied for the domain name in bad faith. Complainant refers to the fact that the Applicant has registered several other newspaper-related trademarks such as ECON&OMIST (Economist), OBSER&VER (Observer) and FINANCI&ALTIMES (Financial Times), without any legitimarte business related to them. Complainant concludes that the Applicant registered those trademarks with the sole intention of applying for corresponding .eu domain names in bad faith.

The Complainant call into question the grounds for the Applicant's sunrise registration, as Complainant has not found any Benelux trademark registration for TIMES&ONLINE, and claims that a previously applied mark TIMESON&LINE has been rejected although it appear in the Benelux registry under No 0792678.

It is also argued that the wrong application of the conversion requirement under article 11 of regulation 874/2004 has been applied, and that the Applicant should have applied for <timesandonline.eu> rather than <timesonline.eu>. The Complainant refers to the fact that under Article 11, the special character "&" has to be (i) eliminated entirely from the corresponding domain name, (ii) replaced with hyphens, or if possible, (iii) rewritten. The Complainant, referring to ADR Case No 00265 (LI&VE) and ADR Case No 00394 (FRANKF&URT), states that there must be identically between the domain name applied for and the corresponding trademark and concludes that there are "aurally, phonetically, visually and conceptually" differences between the Applicants registered trademark and the disputed domain name.

The Complainant request that the Panel issue a decision that the domain name <timesonline.eu> is annulled.

B. RESPONDENT

The Respondent refers to Article 10, 11 and 14 of Commission Regulation (EC) No 874/2004 of 28 April 2004 ("the Regulation") and states that:

i) the Complainant is not in position to try to establish that it is the holder of prior rights in the sense of the Regulation, since the Complainant did not apply for the domain name TIMESONLINE during the Sunrise Period

ii) the Complainant spends an extremely large portion of its complaint, trying to establish the Applicant's bad faith, but ADR proceedings based on alleged "bad faith" of the applicant must be initiated against the domain name holder itself, pursuant to Article 22(1)(a) of Regulation

iii) 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

iv) the case at hand must therefore only deal with the compliance of the Respondent's decision with the Regulation, in particular article 11, and not with the Applicant's alleged bad faith registration.

The Respondent thereafter discuss the interpretation of article 11 of the Regulation, and contends – with reference to ADR Case No. 188 (123.eu) and ADR Case No. 1867 (OXFORD) - that whereas an applicant may not claim a prior right where the name contains special characters, article 11 leaves three options for the applicant to still comply with the Regulation and apply for a domain name on the basis of a name containing a special character. The applicant may either eliminate the special character entirely from the corresponding domain name, replace it with hyphens, or, if possible, rewrite it. The Respondent

Some special characters are not possible to rewrite, leaving the applicant with only two options, wheras others – such as the ampersand – can be rewritten and thus the applicants claimimg such names have all three options.

The Respondent further comments on the two ADR Cases cited by the Complainant, stating it disagreement with the said decisions. Respondent conbcludes that if it had to refuse one of the three options listed in article 11 of the Regulation in some specific cases, the Regulation should have said so. The Regulation does not command the Respondent to make a choice for the applicant following simply its judgement or more complexly a principle of interpretation derived from trademark law. Therefore, the Respondent's decision may not be annulled for non compliance with the Regulation.

DISCUSSION AND FINDINGS

The Panel concludes that the Complainants trademarks THE TIMES and TIMESONLINE are indeed well known (although there are no supporting evidence filed with the complaint) and that the disputed domain name is confusingly similar and identical with the said

trademarks. Should this case have been directed the Applicant as the Respondent pursuant to Article 22(1)(a) of the Regulation, with the possibilities mentioned in Article 21 for the Complainant to show its own prior rights and establish its allegations of bad faith, the outcome would likely, in the Panel view, be in favour of the Complainant.

However, as this case is presented to the Panel, the Panel is limited to decide on whether the Respondents (EURid) decision to register the disputed domain name is in conflict with the provisions of the Regulation, in particular Article 11.

As noted above, the Applicant is the owner of the Benelux trademark registration No 792678 TIMESON&LINE. A copy of the Certificate of Registration has been provided by the Respondent as a part of the documentary evidence in this case. The application for this trademark was filed on February 3, 2006 and the mark was registered on February 10, 2006, through the expedited registration system provided by the BENELUX-Merkenbureau. The owner of the trademark is a Mr Raymond M. Peddemors from Arnhem, Netherlands.

The Applicant applied for the domain name on March 4, 2006 and filed the documentary evidence well before the April 13, 2006 deadline.

Article 11 of the Regulation states that: "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: ~ @ # $ % ^ & * ( ) + = < > { } [ ] | \ /: ; ' , . ?".

One member of the Panel is of the view that the choice of option included in Article 11 should supported by the alleged prior right. In other words, a prior right holder for "COL & OGNE" cannot claim rights to "COLOGNE" (Case no.1523); or a prior right holder for "reykja & vik" cannot claim rights to "REYKJAVIK" (Case no. 2221). Otherwise, the main requirement of the Sunrise period i.e. the existence of a prior right (Article 10 Regulation 874), would not be complied with. Also, this Panelist considers that, in accordance with Article 14, the Respondent "must assess whether or not the desired domain name in the application for registration constitutes a complete name for which prior rights exist." (see further reasoning in Case no. 1523 COLOGNE).

In view of that Panelist, the present case, even if it is recognized that it is not as clear as the cases mentioned above, still deserves the same response since the domain name application "timesonline.eu" cannot be supported by the prior right "timeson&line".

However, the majority of the Panel concludes that it is up to the applicant, claimimg a prior right including any of the said special charcters, to choose freely between these three options.

In this procedure, the applicant may – by mistake or by purpose – create a domain name which infringes upon a third party's right. The registration system is however not created to put the burden of such legal validation on the Respondent (EURid), and the Regulation does not intend to leave some discretion to the Respondent insofar as the content of the prior rights is concerned. Such disputes must be filed against the actual domain name holder.

In the present case, the Applicant's mark contains the ampersand. The Applicant used the first translitteration alternative, stated in Article 11, and eliminated this special character entirely.

The majority of the Panel therefore concludes that the Respondent, accepting the translitteration and registering the domain name, has complied with the Regulation.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel (by majority) orders that the Complaint is Denied.

PANELISTS

Name	**José Checa**

DATE OF PANEL DECISION 2006-10-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is the publisher of The Times and The Sunday Times newspapers. The Complainant's web site timesonline.co.uk

houses the online editions of these newspapers, and is claimed to be one the UK's most successful online publishing sites. The Complainant did not apply for the domain name <timesonline.eu> during the Sunrise Period.

The Applicant applied for the domain name timesonline.eu, based on the Benelux trademark registration TIMESON&LINE. After validation, it was concluded from the documentary evidence that the Applicant was the holder of a prior right and the Respondent accepted the application.

The Panel notes that it is limited to decide on whether the Respondents (EURid) decision to register the disputed domain name is in conflict with the provisions of the Regulation, in particular Article 11 stating that: "Where the name for which prior rights are claimed contains special characters… these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten."

One member of the Panel is of the view that the choice of option included in Article 11 should be supported by the alleged prior right and concludes that a prior right holder for TIMESON&LINE cannot claim rights to TIMESONLINE. Accordingly the Respondent must assess whether or not the desired domain name in the application for registration constitutes a complete name for which prior rights exist.

The majority of the Panel concludes that it is up to the applicant, claimimg a prior right including any of the said special charcters, to choose freely between these three options and the Regulation does not intend to leave some discretion to the Respondent insofar as the content of the prior rights is concerned.

The majority of the Panel therefore concludes that the Respondent has complied with the Regulation.