Panel Decision for dispute CAC-ADREU-002422

Case number	**CAC-ADREU-002422**
Time of filing	**2006-07-24 13:02:44**
Domain names	**auctions.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Handys Ltd.**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

The Complainant submitted application for the domain name auctions.eu on 7 December 2005, i.e. on the commencement day of the Sunrise period. The applicant based its application on a Benelux trademark application filed on 5 December 2005.

The Complainant submitted the documentary evidence on 13 January 2006, which was before the deadline of 16 January 2006.

The documentary evidence showed that the Complainant's trademark was registered on 14 December 2006, which was after the time that the domain name application based on the trademark was filed. Consequently, the Respondent rejected the application.

A. COMPLAINANT

The Complainant's main argument is that because the Benelux trademark law retroactively grants protection to registered trademarks as of their filing date, and as the trademark was registered before its validation, the Complainant had at the time of filing of the domain name application a valid trademark right to the Benelux trademark AUCTIONS.

The Complainant also asserts that the Sunrise rules are in conflict with the Commission Regulations 874/2004 and 733/2002 as the Sunrise rules limit the prior rights eligible for a Sunrise registration more than the Regulations do.

Finally the Complainant contends that because the Respondent has accepted the domain name textmessaging.eu under similar conditions, in the name of equitable considerations the Complainant's application should be accepted as well.

B. RESPONDENT

The Respondent basically states that because the Complainant did not hold a valid trademark registration at the time of filing of the domain name application, the Complainant was not eligible for a Sunrise registration.

The Respondent also refers to decisions in ADR 1566 AIRLINETICKETS, CREDITREPORT and ADR 376 FUTBOL,

CHEAPTICKETS, where the parties were the same, the factual elements were the same and the complaint was in relevant aspects the same.

DISCUSSION AND FINDINGS

Article 10(1) of the Regulation 874/2004 states that holders of prior rights are eligible to register domain names during the phased registration period. Second paragraph of the same article defines a prior right as, inter alia, a registered national trademark.

In this case it is clear that on the date of submitting the domain name application the Complainant's Benelux trademark was not yet registered. It is also undisputed that once registered, a Benelux trademark is considered effective as from the filing date. The question is, therefore, whether the fact that Benelux trademarks are granted protection retroactively means that the Complainant held a valid prior right within the meaning of the Regulation at the time of filing of the domain name application.

The Panel's answer to this question is in the negative. It is indeed an established principle of trademark laws in various jurisdictions that a registration confers exclusive rights to the mark as of the filing date. However, this "backdating" is done only at the date of registration, not before. Therefore, at the time of filing of the domain name application the Complainant did not hold exclusive rights to the trademark AUCTIONS.

Rather, on 7 December 2005, the Complainant only had a priority right to the trademark AUCTIONS. Such a right is not acknowledged by the Regulation.

It must therefore be assessed whether the fact that at the time of validation the Complainant held a trademark registration in force from 5 December 2005, means that the domain name should have been granted to the Complainant.

Article 10(1) of the Regulation states that "Holders of prior rights … shall be eligible to apply…" and paragraph two defines a prior right as a registered trademark. In other words, the Regulation defines that the application can only be filed by the owner of a trademark registration.

The Panel agrees with the Panel in ADR 1566 in that the decisive point for evaluating the applicant's rights is not the time of validation, but the time of application and that validation is only a "snap-shot" view of the applicant's rights at the time of filing of the application. The decisive time is therefore the filing of the domain name application, not the time of its validation.

Because a trademark application is clearly not a prior right within the meaning of the Regulation, it is unnecessary to proceed to analyze whether the Sunrise rules are in conflict with the Regulation.

The Complainant also contends that the Respondent has granted the domain name textmessaging.eu under similar circumstances. The Respondent has not disputed this claim.

The Panel agrees with the Complainant in that the Respondent should not make inconsistent decisions. However, it is a fact of life that mistakes do happen. If the domain textmessaging.eu was in fact granted in error, it is of no relevance to these proceedings. This Panel is only bound by the Regulation and not by prior decisions of one of the parties. This Panel agrees with the panel in ADR 1711 that the existence of unjust decisions made in error does not mean that the Respondent would be obliged to repeat such errors.

Finally, the Complainant had also requested for an interim decision to stay the of the decision by the Repondent whereby the domain name was registered for another applicant. In view of the clear nature of this Complaint, the Panel did not see it necessary to issue an interim decision.

For the above reasons, the Complaint is denied.

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 2006-10-11

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed a Benelux trademark application on 5 December 2005 and an identical domain name on 7 December 2005. The Complainant's trademark was registered on 14 December 2006 and the Complainant submitted the documentary evidence on 13 January 2006.

The Complainant argued that because Benelux trademarks are registered retroactively as of their filing dates, the Complainant held a valid trademark right to the domain name.

However, the Panel found that at the time of filing of the domain name application, the Complainant did not hold a registered trademark and thus the Complainant did not have prior rights to the domain name within the meaning of the Commission Regulation 874/2004.