Panel Decision for dispute CAC-ADREU-002423

Case number	**CAC-ADREU-002423**
Time of filing	**2006-08-03 12:27:11**
Domain names	**ieg.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**IEG - Independent Equity GmbH, Rene Griemens**

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 in not aware of any other legal proceedings pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

Avebury Contractors (“the Applicant”) registered the trade mark “i&g” with the Benelux Trade Mark Office on 13 December 2005. The Applicant used this registration to assert a prior right acc. to article 10 (1) of the Commission Regulation (EC) No 874/2004 of 28 April 2004 and applied for the registration of the domain name “ieg.eu” during the period of phased registration.

INDEPENDENT EQUITY GMBH ("the Complainant") uses the sign IEG. Its registration as a Community trade mark was applied for one year earlier, on 30 November 2004. It was registered on 20 March 2006.

The Complainant raises several allegations against the decision of EURid to register ieg.eu for the Applicant, claiming its “better right” to the domain name, bad faith registration by the Applicant and the lack of use of the mark "i&g” by the Applicant.

The Complainant therefore requests the Panel to annul the Respondent's decision and to transfer the domain name to the Complainant.

A. COMPLAINANT

The Complainant argues that the trade mark relied upon by the Applicant as a prior right, does not exist.

The Complainant argues that the trade mark submitted by the Applicant “i&g” can not serve as a prior right for the name IEG, since “i&g” is not equivalent to IEG, which could constitute a right for the domain name ieg.eu, in any of the EU languages.

The Complainant also argues that the Applicant did not use the trade mark in public and that the application was made in bad faith. It is also argued that the right derived from the Community trade mark “IEG” is superior to the Applicant’s right.

B. RESPONDENT

The Respondent refuses the allegations of the Complainant of non-existence of the trade mark, bad faith of the Applicant, non public use of the trade mark and superior rights of the Complainant. It argues that the Regulation does not require the Respondent to verify the bad faith of the Applicant, the public use of the trade mark or the superior rights of the Complainant.

With regard to the argument raised by the Complainant that the trade mark submitted by the Applicant “i&g” can not serve as a prior right for the name IEG, since “i&g” is not equivalent to IEG in any of the EU languages, the Respondent argues that "e" is equivalent to "&" in Italian/Portuguese. Since according to the Regulation special characters, like “&” can be rewritten and all EU languages are to be taken

into account, the Applicant was legitimate to apply for the domain name.

DISCUSSION AND FINDINGS

The Applicant registered the trade mark “i&g” with the Benelux Patent Office only a few days before applying for the registration of the domain name ieg.eu during the Sunrise Period. Although there is no evidence of the genuine and extensive use of the signs IEG or I&G by Avebury Contractors anywhere in the EU, nothing proves the contrary.

In case no 2088 (PRIXARCDETRIOMPHE) the Panel decided that the registered Benelux Trade mark is to be accepted in the Sunrise Period, if nothing different is stated on the registration deed. Therefore, the “i&g” Benelux trade mark registration has to be accepted as a valid trade mark registration.

The Complainant argues that the Applicant applied in bad faith for the domain name "ieg.eu", since the mark "i&g" is not used by Avebury Contractors in public.
The Regulation does not require the Respondent to verify the good faith of the Applicant, as the Respondent is not in a position to defend another's good faith. However, it is the Complainant’s right to initiate another ADR proceeding against the Applicant based on bad faith allegations pursuant to Article 22(1)(b) of the Regulation.

The Respondent, acting on the base of the Regulations (in particular art. 10 and 14 of the Commission Regulation (EC) No 874/2004), decided to register ieg.eu for Avebury Contractors, notwithstanding the fact that “IEG” is different from “I&G”. It justifies that “&” was replaced by “E”, which means “and” in Italian and Portuguese. None of these two languages are Avebury Contractor’s country of origin language (English), nor Benelux’s trade mark office languages (French, Dutch, English), but nothing in the Regulation prevents parties to use other EU languages.
On the contrary, recital 7 of the Preamble provides that “The Registry policy should promote the use of all the official languages of the Community.”

The Complainant further argues that the Applicant did not oppose IEG’s CTM registration and therefore accepted its “superior rights” to the brand “IEG”. This argument can not be accepted as both trade marks are different (they are both figurative marks with a significantly different graphic). Moreover, they were also registered in different classes for different services (classes 36 and 39), which, together with their graphical difference, allows both of them to exist on the market without the risk of confusion for the average consumer.

The Complainant’s argument of its “superior right” to the domain name is not accepted by the Panel. There is nothing such as a "superior right". The Regulation uses the notion of “prior right” and applicants were either equipped with a prior right - and therefore were able to apply for sunrise registration, or were not. There is nothing surprising in the situation that several companies have a prior right to a domain name, but none of these rights is superior to the others. The general rule of “first come, first serve” applies in such a situation.

Taking all above into account and particularly the fact that the Panel’s task is not to decide whose prior right is “superior”, but if the Respondent acted according to the law and applicable rules when deciding on domain name assignment during the Sunrise Period, the Complainant’s request has to be 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	**Enrique Batalla**

DATE OF PANEL DECISION 2006-11-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Applicant registered the trade mark “i&g” with the Benelux Trade Mark Office. The Applicant used this registration to assert a prior right acc. to article 10 (1) of the Commission Regulation (EC) No 874/2004 of 28 April 2004 and applied for the registration of the domain name “ieg.eu” during the period of phased registration.

The Complainant argues that the trade mark submitted by the Applicant “i&g” can not serve as a prior right for the name IEG, since “i&g”

is not equivalent to IEG, which could constitute a right for the domain name ieg.eu.

The Complainant also argues that the Applicant did not use the trade mark in public and that the application was made in bad faith. It is also argued that the right derived from the Community trade mark “IEG is superior to the Applicant’s right.

The Panel decided that the Regulation does not require the Respondent to verify the good faith of the Applicant, as the Respondent is not in a position to defend another's good faith. Furthermore, Respondent correctly held that “&” can be translated as “e” in Italian and Portuguese, and that the Applicant was not limited to use a translation to prove a prior right, in the language of country of origin or the language of the registering trade mark office.

The Panel took the view that the Respondent acted according to the law and applicable rules when deciding on domain name assignment during the Sunrise Period and therefore the Complainant’s request has to be denied.