Panel Decision for dispute CAC-ADREU-002450

Case number	**CAC-ADREU-002450**
Time of filing	**2006-07-25 12:03:03**
Domain names	**bestseller.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Aktieselskabet af 21. November 2001 Line Storgaard Lauridsen**

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 acknowledged by Panel

FACTUAL BACKGROUND

TV Products CZ s.r.o. (hereinafter “the Applicant”) applied for registration of the domain name “bestseller.eu” on December 7, 2005 at 11:02 A.M.

Aktieselskabet af 21. November 2001 Line Storgaard Lauridsen (hereinafter “the Complainant”) applied for registration of the same domain name “bestseller.eu” on December 7, 2005 at 11:13 A.M. and is the second applicant on the list for that domain name.

The validation agent received documents from the Applicant evidencing the application on January 12, 2006, before the January 16, 2006 deadline.

On the same day (January 12, 2006) the validation agent received documents from the Complainant evidencing its application.

The validation agent found that the documentary evidence sent by the Applicant substantiated its prior right to the name “BESTSELLER”, and so, on June 12, 2006 EURID (hereinafter “the Respondent”) decided to validate the Applicant's application.

The Complainant filed a Complaint against the Respondent’s decision. The Complaint was received by the Czech Arbitration Court (hereinafter “CAC”) by e-mail on July 20, 2006, with a hard copy received on July 26, 2006. The Complainant requested annulment of the Respondent's decision and requested attribution to the Complainant of the domain name “bestseller.eu”.

The formal date of the commencement of the ADR Proceeding was August 7, 2006.

A. COMPLAINANT

The Complainant claims that its application submitted to the Respondent on December 7, 2005 for the domain name “bestseller.eu” was based on the Complainant’s Prior Rights as holder of rights to the trademark “BESTSELLER”.

According to the Complainant, the Applicant, whose application for the same domain name was received first, did not meet the requirements for applying during the first phase of the Phased Registration Period, the “Sunrise I Period”, for 2 reasons:

1) Firstly, in its application the Applicant completed the field “Prior Right on” with its own name, “TV Products CZ s.r.o.” and not the name of the trademark “Bestseller”.

2) Secondly, the Applicant holds no registered trademark rights to “BESTSELLER”, while the Applicant holds a Czech registered trademark, “BESTSELLER HOME SHOP", as per Complainant's Exhibit 3.

In the brief entitled “Observation on Behalf of Complainant”, sent to the CAC on October 17, 2006 in accordance with Paragraph A2 (k) of the ADR Rules, the Complainant adds that in contradiction to Article 10 (1), Article 10 (2) and Article 14 of Commission Regulation 874/2004 of April 28, 2004 (hereinafter “Commission Regulation”) it appears that the Applicant’s application for the domain name “bestseller.eu” is based on the trademark “BESTSELLER HOME SHOP” and not on the trademark “BESTSELLER”.

B. RESPONDENT

The Respondent affirms that Article 10 of the Commission Regulation defines “prior rights” as to include, inter alia, registered national and community trademarks.

According to the Respondent, the Applicant submitted documentary evidence showing that it was the holder of a Czech registered trademark of the name “BESTSELLER” (n. 274675), valid at the time of application.

Thus, the Respondent was required to apply Article 14 of the Commission Regulation, the main principle of which consists of the Respondent's obligation to deal with applications in strict chronological order when it receives more than one claim for the same domain during the phased registration period.

The Respondent specifies that in the present case, the Applicant’s application was the first received for the domain name “bestseller.eu”. Pursuant to Section 21(2) of the Sunrise Rules, the validation agent found that the Applicant sufficiently demonstrated its prior right to the name "BESTSELLER", by means of the Czech trademark for the name “BESTSELLER” (n. 274675). Based on these findings, the Respondent decided to accept the Applicant's application, as instructed by article 14 of the Commission Regulation.

For these reasons, the Respondent asks the Panel to reject the Complaint.

DISCUSSION AND FINDINGS

Article 10 (2) of the Commission Regulation states that “the registration on the basis of a prior right shall consist of the registration of the complete name on which the prior right exists, as written in the documentation which proves that such a right exists”

Article 22 paragraph 1, b) of the Commission Regulation states that when an action is filed against the Registry (the Respondent), the Panel shall decide whether a decision taken by the Registry conflicts with this regulation or with Regulation (EC) no. 733/2002.

Section 11 (1) of the Sunrise rules states that during the first phase of the Phased Registration Period, only domain names that correspond to (i) registered Community or national trademarks or (ii) geographical indications or designations of origin may be applied for by the holder and/or licensee (where applicable) of the Prior Right concerned.

Section 21 (1) of the Sunrise Rules provides that the validation agent appointed by the Registry shall verify whether the requirement for the existence of a prior right to the name claimed by the Applicant in the application is fulfilled.

Based on the foregoing, the Panel intends deal separately with the Complainant's two claims.

1) Regarding the Complainant's first claim.
In the Opinion of the Panel, the fact that in its application the Applicant inserted its own name, “TV Products CZ s.r.o” instead of the name “Bestseller” in the field “Prior Right on” is not in itself sufficient to demonstrate that the Applicant did not meet the requirement for applying for the domain name “bestseller.eu”.

This Panel agrees with the Panel's decision in the case ADR n. 1711 (also see the case ADR n. 229): “the validation agent is allowed to correct obvious deficiencies in applications, when it is clear that the Applicant is a holder of a genuine prior right and has simply made a clear mistake in the information provided in the application.”

The only problem is to verify if the Applicant ” is a holder of a genuine prior right”, which is the subject of the Complainant's second claim .

2) Regarding the Complainant's second claim.

The Panel found that there was a clear contradiction between the documentary evidence submitted by the Applicant, which apparently showed that it was the holder of the Czech registered trademark “BESTSELLER” and the Complainant's declaration that the Czech registered trademark owned by the Applicant was “BESTSELLER HOME SHOP”.

In accordance with Article 7 (a) of the ADR Rules this Panel decided to conduct “ in its sole discretion, its own investigation on the circumstances of the case”.

In particular, the Panel ascertained from the official web site of the Industrial Property Office of the Czech Republic (http://isdvapl.upv.cz/pls/portal30/oz.OZFRM) that no one had ever registered a trademark with the name “BESTSELLER” in this Country.

On this web site, it appears that the Applicant was and is the holder of a Czech registered trademark to the name “BESTSELLER HOME SHOP” (registration number n. 274675).

The Czech trademark corresponding to number 274675, held by the Applicant, is thus “BESTSELLER HOME SHOP” and not “BESTSELLER” as it appears in the documentary evidence submitted by the Applicant. It is clear that the documentation submitted by the Applicant, considered sufficient by the validation agent to demonstrate the Applicant’s prior right to “BESTSELLER”, was incorrect.

Considering that Article 10 (2) of Commission Regulation provides that registration based on a prior right consists of registration of the complete name for which the prior right exists, if the Applicant had submitted the proper documentation, it could not have demonstrated any prior right to the name “BESTSELLER”.

As a consequence, the Applicant’s application had to be rejected.

In any event, considering that the validation agent, in accordance with Section 21 of the Sunrise Rules, shall examine whether the applicant has a prior right to the name “exclusively on the basis of a prima facie review of the first set of documentary evidence received and scanned by the Processing Agent (including the documentary evidence received electronically when applicable)” and “is not obliged but it is permitted in its sole discretion, to conduct its own investigation into the circumstances of the application, the prior right claimed on the documentary evidence produced” this Panel concludes that the decision of the Respondent, based on a prima facie review without a supplementary investigation, was wrong, but not incorrect.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the EURID's decision be annulled.

PANELISTS

Name	**Pietro Tamburrini**

DATE OF PANEL DECISION 2006-10-17

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant claims that its application submitted to the Respondent on December 7, 2005 for the domain name “bestseller.eu” was based on the Complainant’s Prior Rights as holder of rights to the trademark “BESTSELLER”.

According to the Complainant, the Applicant, whose application for the same domain name was received first, did not meet the requirements for applying during the first phase of the Phased Registration Period, the “Sunrise I Period”, for 2 reasons:
1) Firstly, in its application the Applicant completed the field “Prior Right on” with its own name, “TV Products CZ s.r.o.” and not the name of the trademark “Bestseller”.
2) Secondly, the Applicant holds no registered trademark rights to “BESTSELLER”, while the Applicant holds a Czech registered trademark, “BESTSELLER HOME SHOP”.

According to the Respondent, the Applicant submitted documentary evidence showing that it was the holder of a Czech registered trademark of the name “BESTSELLER” (n. 274675), valid at the time of application.

Regarding the Complainant's first claim this Panel agrees with the Panel's decision in the case ADR n. 1711 (also see the case ADR n.

229): “the validation agent is allowed to correct obvious deficiencies in applications, when it is clear that the Applicant is a holder of a genuine prior right and has simply made a clear mistake in the information provided in the application”. So the fact that in its application the Applicant inserted its own name, “TV Products CZ s.r.o” instead of the name “Bestseller” in the field “Prior Right on” is not in itself sufficient to demonstrate that the Applicant did not meet the requirement for applying for the domain name “bestseller.eu”.

Regarding the Complainant's second claim, in accordance with Article 7 (a) of the ADR Rules this Panel decided to conduct “ in its sole discretion, its own investigation on the circumstances of the case”.

In particular, the Panel ascertained from the official web site of the Czech Repubblic Industrial Property Office that no one had ever registered a trademark with the name “BESTSELLER” in this Country and that the Applicant was and is the holder of a Czech registered trademark to the name “BESTSELLER HOME SHOP” (registration number n. 274675). It is clear that the documentation submitted by the Applicant, considered sufficient by the validation agent to demonstrate the Applicant’s prior right to “BESTSELLER”, was incorrect.

Considering that Article 10 (2) of Commission Regulation provides that registration based on a prior right consists of registration of the complete name for which the prior right exists, if the Applicant had submitted the proper documentation, it could not have demonstrated any prior right to the name “BESTSELLER”. As a consequence, the Applicant’s application had to be rejected.

For all the foregoing reasons the Panel orders that EURID's decision be annulled.