Panel Decision for dispute CAC-ADREU-002671

Case number	CAC-ADREU-002671
Time of filing	2006-08-22 10:07:59
Domain names	selex.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	FINEMCCANICA S.P.A., Ms. Angela Tornatora, in house lawyer

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

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

1. The Complainant is Finmeccanica SPA, an Italian company. The Complainant states in the Complaint that it is the proprietor of Italian trade mark no.977912 for the word mark SELEX.

2. On 7 December 2005, the first day of the .eu domain name Sunrise Period, both the Complainant and Selex PROmotion Group a.s. (the current registrant of <selex.eu> (the "Domain Name") (the “Registrant”)) made applications for registration of the Domain Name.

3. The Registrant made its application 6 minutes before the Complainant and that application was successful. The Complainant’s application was therefore unsuccessful.

4. During the first phase of the Sunrise Period limited types of prior rights (as defined in Article 10 of Commission Regulation (EC) No.874/2004 (the “Public Policy Rules”)) could be relied upon for the purposes of a .eu domain name application. The Registrant would appear at the relevant times to be the owner of Czech registered trade mark number 238725, in the name SELEX. However, the Sunrise WHOIS Database entry for the Domain Name appears to state that the prior right relied upon by the Registrant is a national trade mark registered in the Czech Republic for the mark “SELEX PROmotion GROUP a.s.”.

5. On 26 August 2006 the Complainant commenced these ADR proceedings against the Registry (i.e. EURid), seeking to annul EURid’s decision to register the Domain Name in the name of the Registrant and to obtain transfer of the Domain Name to the Complainant. On 17 October 2006 I, Matthew Harris, was appointed as the panelist in this matter having filed the necessary Statement of Acceptance and Declaration of Impartiality and Independence.

A. COMPLAINANT

1. In its original Complaint, the Complainant contends as follows:

(a) From the information in the Sunrise WHOIS Database (which according to the second paragraph of section 7.3 of the .eu Registration Policy During the Phased Registration Period (“Sunrise Rules”) is the only point of reference for verifying whether the Processing Agent received Documentary Evidence), the Complainant assumed that the Domain Name was granted to the Registrant on the basis of a prior right in the name: Selex PROmotion Group a.s.

(b) This is not a valid prior right to justify the registration of the Domain Name. The Registrant did not have the right to obtain the Domain Name because they have a prior right only in the complex trade mark Selex PROMotion Group a.s. The decision to allow the Registrant's application is in violation of the identicality principle which is one of the fundamental principles of the .eu domain name system and is established by art. 19.2 of the Sunrise Rules. If a prior right is in a trade mark composed of more than one word, it is not possible to obtain multiple domain names on the basis of parts of the trade mark, therefore the Registrant should have requested and obtained only the domain name: <selexpromotiongroup.eu>.

(c) There is no possibility of checking the documents filed by the Registrant and of assessing on what basis the Respondent's decision was taken. The Complainant requires the Respondent to "discover" all the documents and to have the right to withdraw the Complaint in case the documents satisfy the formalities on prior rights.

(d) The Complainant is the owner of the word mark SELEX and is second in the queue, and asks the Panel to annul the Respondent's decision and to grant the Domain Name to the Complainant.

(e) If the information in the WHOIS database regarding the "prior rights" of Selex PROmotion Group a.s. is wrong, the Complainant should still prevail because: if it was a clerical mistake, it should have been corrected by the Respondent; if it was an error made by the Registrant in its request, then that mistake justifies rejection of the request itself. The entire system is based on accurate and reliable information, especially with regard to the sunrise prior rights that give the trade mark owner an absolute advantage, and thus extra care should be taken by the applicant and by the Respondent.

2. On 30 August 2006 EURid provided the verification submitted by the Registrant in connection with its application. The Complainant then made further contentions in a Nonstandard Communication on 5 September 2006, as follows:

(a) There was a serious discrepancy in the Registrant's application between the "name for which a prior right is claimed" (i.e. Selex PROmotion Group a.s.) and the Domain Name, whereas the Complainant filed its application without irregularities and deserves to be the owner of the Domain Name.

(b) The Respondent has consistently refused applications where there were discrepancies in the title to or name of the owner of the prior right or (as in this case) where there is a difference between the right claimed in the application and the domain name requested. Even if this is a case of a clerical error the Respondent should have refused the application as it did in many similar instances of clerical error. The disputed decision has to be annulled in order to maintain consistency in the Respondent's decisions and because the prior right claimed is different to the Domain Name.

(c) The Complainant relied upon the information published on the WHOIS database to file the Complaint.

B. RESPONDENT

1. The Respondent contends as follows:

(a) The Respondent's decision does not conflict with the Public Policy Rules or the Sunrise Rules. The Registrant was first in the queue for the registration of the Domain Name. The Registrant submitted documentary evidence on 13 January 2006 (before the 16 January 2006 deadline). The documentary evidence consisted of proof of trade mark number 23857 "SELEX", registered with the Czech Patent and Trademark Office, under the Registrant's name. The validation agent found that the Registrant had sufficiently demonstrated that a prior right existed regarding the application for the Domain Name and notified the Respondent accordingly, pursuant to Article 14 of the Public Policy Rules. Based on these findings, the Respondent decided to accept the Registrant's application, as instructed by Article 14 of the Public Policy Rules.

(b) Various Panels have previously addressed the situation where the applicant for a domain name wrote its name in the 'Prior Right on the name' field of the application form. In ADR 229 (CITY, KICKBOXING, CRAWLER, BLUE), the Panel decided that: "the fact that an applicant may have filled in the "Prior Right on" field in an electronic form with the name of the applicant organisation and not with the name of the prior right (trade mark) would not lead to a conflict with the above mentioned Regulations as in the substantive documentation submitted during the validation process the name of the trade mark for which the prior right exists and for which the identical domain name is applied for is mentioned". The same reasoning was followed by the Panel in ADR 1711 (AIRCO, EIRCOM).

(c) In two other decisions with similar facts to the present case - ADR 328 (LASTMINUTE) and ADR 1881 (LIBER) - the Panel found that the validation agent had been entitled to use discretion to conduct a limited investigation of the prior right and that it had been legitimate to allow the application despite the incorrect entry in the "prior right on" field in the application form.

(d) Section 27(1) of the Sunrise Rules states that "If the ADR Proceeding concerns a decision by the Registry to register a Domain Name and the Panel or Panelist appointed by the Provider concludes that that decision conflicts with the Regulations, then, upon communication of the decision by the Provider, the Registry will decide whether or not to register the Domain Name in the name of the next Applicant in the queue for the Domain Name concerned, in accordance with the procedure set out in these Sunrise Rules". Section 11(c) of the ADR Rules lists the remedies that are available to the Panel and states that "with regard to any Registry decision relating to a prior right invoked during the phased registration period such measures of transfer and attribution will only be granted by the Panel if the Complainant is the next applicant in the queue for the domain name concerned and subject to the decision by the Registry that the Complainant satisfies all registration criteria set out in the European Union Regulations and to the subsequent activation by the Registry of the domain name in the name of the Complainant who is the next applicant in the queue". Therefore, if the Panel decides that the Respondent's decision conflicts with the Public Policy Rules, the Respondent should not be ordered to grant the domain name to the Complainant. Rather, the Respondent must first assess if all registration criteria have been met by the next applicant in the queue.

DISCUSSION AND FINDINGS

1. The Respondent in this case is EURid and for ease of understanding, I will refer to it by its name in this decision.

TREATMENT OF APPLICANT'S NON-STANDARD SUBMISSION

2. Prior to considering the substance of the Complaint, it is necessary to consider whether any notice should be taken of the Complainant's Non-standard submission on 5 September 2006. This document appears to have been filed in direct response to the disclosure by EURid on 30 August 2006 of the verification material filed by the EURid in relation to this Application. It would appear that the Complainant was not entitled to see this material until after it had filed its Complaint (an issue that I comment upon in greater detail at the end of this decision). Therefore, it was not until after 30 August 2006 that it was in a position to form a considered view on whether EURid and/or its validation agent had correctly accepted the Registrant's application.

3. In the circumstances not to take notice of the Complainant's additional submissions in this regard would be unfair. I therefore exercise the discretion granted to me under Section B8 of the .eu ADR Rules to admit this further communication.

WHAT NEEDS TO BE SHOWN

4. These are proceedings that have been brought against the Registry, EURid, not the current Registrant. They have been brought under Article 22(a) of the Public Policy Rules and therefore my task is to consider whether EURid's decision in this case conflicted with the Public Policy Rules and Regulation (EC) No.733/2002 (together the "Regulations").

5. Whilst compliance with the Regulations is key, for the reasons that I explain in greater detail in my earlier decision in B V Meubelfabriek Gebroeders van der Stroom te Culemborg v EURid Case No. 02150 <dutchoriginals.eu>, I believe that it is also legitimate to take into account the provisions of the Sunrise Rules insofar as they fall within the scope of Article 12(i) of the Public Policy Rules and do not conflict with the provisions of the Regulations.

RELEVANT PUBLIC POLICY AND SUNRISE RULES

6. Article 10(1) deals with a party's eligibility to apply for a domain name during the sunrise period. It is clear from the documentary evidence disclosed by the Respondent, that the Registrant was the proprietor of a national trade mark registered in the Czech Republic for the name SELEX (i.e. a name identical to the Domain Name without the suffix <.eu>).

7. Article 10(2) requires the domain name to consist of the "complete name for which the prior right exists, as written in the documentation which proves that such a right exists". The requirement is for the domain name to match the name as it appears in the documentary evidence and not to the name as it appears in the application. In this case the Domain Name (without the suffix <.eu>) does exactly match the trade mark appearing in the documentary evidence provided by the Registrant to the Validation Agent. The requirements of Article 10(2) have been complied with.

8. Article 14 provides that the applicant must submit "documentary evidence that shows that he or she is the holder of the prior right claimed". What is meant by the phrase "prior right claimed" are at the heart of the dispute between the parties in this case?

9. There would appear to be two possibilities. Either (a) one adopts a formalistic approach and takes the prior right claimed to be either that which is stated to be the prior right in the initial application or that which actually appears in the box on the form submitted with an applicant's subsequent verification material; or (b) one instead looks at the whole of the material that has submitted by the applicant and forms a substantive view of what was intended by the applicant in that case.

10. Little further guidance on which approach is to prevail is to be found elsewhere in the Regulations or Sunrise Rules. The closest that the Sunrise Rules gets to addressing this issue is Section 10(1). This refers to the "Prior Right claimed by the Applicant in the Application" and it is reasonable clear from the way that "Application" is defined in the Sunrise Rules that this refers to the initial application submitted to EURid prior to the filling of validation documentation.

11. I have not been provided with a copy of the original application in this case (only the applicant validation material). However, I assume for the purposes of this decision that the prior right claimed in the original application was the same as that identified as the prior right in the form that the applicant submitted with its verification documentation i.e. "Selex PROmotion Group a.s."

THE CORRECT APPROACH

12. It seems to me that in a case such as this a substantive rather than formalistic approach should prevail. The overall approach of Article 14 of the Public Policy Rules appears to me to be quite clear. It is for the Applicant to prove that it is entitled to the Doman Name claimed.

13. That it not to say that all clerical errors can be ignored. Sometimes an Applicant may fail to prove its entitlement as a result of such an error. For example there have been a number of ADR cases in which the details of the applicant and the details of the holder of the prior right as shown in the documentary evidence did not match. In such cases where these differences resulted in a real doubt as to whether the applicant does in fact have the relevant prior right, panels have held that EURid was right to reject an application on that basis (see for example B V Meubelfabriek Gebroeders van der Stroom te Culemborg v EURid Case No. 02150 <dutchoriginals.eu>).

14. However, this is no such failure in this case. When one looks at the material provided to EURid and its Validation Agent prior to the grant of the Doman Name as a whole there is no real ambiguity. The Applicant has applied for the Doman Name as part of phase 1 of the Sunrise period. This is not a case that can be said to involve a geographical indicator and the Applicant is not a public body. The only right that could be relied upon by the Applicant is a registered trade mark right that is identical to the Doman Name applied for. Evidence of such a trade mark has been provided. In the circumstances it is obvious what is intended and that a clerical error has been made on the relevant form.

15. I do not think that I should be forced to reach some different conclusion by reason of a narrow reading of Section 10 of the Sunrise Rules. Assuming that the initial application identified the prior right as "Selex PROmotion Group a.s.", anyone looking at the initial application would have been quite aware that something was amiss. Either the Applicant was relying upon a right which was not identical to the Doman Name claimed, in which case that application would fail at the verification stage, or there was simply an error on the form. That ambiguity was resolved upon receipt of the verification material. At that stage, it was clear exactly what the "prior right" really claimed by the Applicant had been all along.

16. I am reinforced in my view that this is the correct approach to take in this case by the four ADR decision that EURid refers to in its Response. In each of those cases applicants for domain names had inserted information other than the names in which the relevant prior rights existed into the "prior right" field in the application (including in some cases the full legal name of the application). In each of these cases, the Panel decided that the error did not put EURid's decision to accept the application on the basis of the substance of the validation material that had been filed in conflict with the Public Policy Rules.

17. I therefore reject the Complainant's request that the Panel annul the decision in relation to the Registrant's original application.

WHOIS INFORMATION

18. Although I have rejected the Complainant's Complaint, I confess that I have a degree of sympathy with the Complainant's actions in this case. It was in a difficult position when deciding whether or not to bring this Complaint. On viewing the Sunrise WHOIS Database it saw that the prior right relied upon by the Registrant was apparently "SELEX PROmotion GROUP a.s.". There was no indication that the documentary evidence had shown that the Registrant did have the relevant prior right in the name SELEX. It was, therefore, clear from this that something was amiss.

19. The Complainant asserts that there was no possibility of checking the documents filed by the Registrant and of assessing on what basis the Respondent's decision was taken. I do not know whether the Complainant in this case attempted to obtain clarification from EURid in advance of commencing these proceedings. However even if it did, it seems likely on the basis of Section 9(5) of the Sunrise Rules that the Respondent would not have provided a copy of the Registrant's documentary evidence. There is also the decision of the panel in Kane International Ltd v EURid CAC Case No. 370 <kane.eu>, in which it was held that there were limited circumstances in which

EURid is “entitled to provide documentary evidence to third parties”. In the circumstances, it could be said that the Complainant had little choice but to commence these proceedings in order to establish the true position.

20. This is far from an ideal state of affairs and I suspect that in large part it was avoidable. First, it might have been avoided if the WHOIS material had accurately reflected the right which EURid appears to have concluded was the relevant prior right in this case. The Sunrise WHOIS Database is the only resource provided for third parties to obtain information in relation to the history of applications during the Sunrise Period. It is therefore important that it is accurate. If EURid believes that the right claimed by the applicant was different from that which was on an initial application form, then it should ensure that this information is changed to reflect its conclusion in this respect.

21. Second, it seems to me that in a case such as this it would be sensible for the potential complainant to raise the issue with EURid in advance and for EURid to respond sensibly to that query. I am not suggesting that EURid should have to respond to merely speculative enquiries, nor that in response to a query that it should have to disclose the validation material filed. However, where (as here) there is an obvious discrepancy in the records, I do not believe that it places an unfair and excessive burden on EURid to briefly explain that discrepancy (and where necessary correct the records in question). Even if this did not avoid ADR proceedings entirely it would at least streamline the ADR process and might avoid the need for a Complainant to submit a supplementary submission once it had seen EURid’s Response.

DECISION

For all the foregoing reasons, the Panel rejects the Complaint.

PANELISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2006-11-13

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant brought proceedings against EURid alleging that the EIRid’s decision to grant the Domain Name <selex.eu> to the Registrant should be annulled and the Domain Name should be transferred to the Complainant.

The Registrant was the first applicant for the Domain Name during the Sunrise Period and had incorrectly entered its full company name (which included but was not identical to the Domain Name) in the “Prior Right” field of the application form. The Complainant maintained that it was the second applicant for the Domain Name during the Sunrise Period, that it was the proprietor of an Italian registered trade mark comprising the word SELEX, and that it had filled out its application form correctly.

The Respondent stated that, since the documentary evidence proved that the Registrant was the proprietor of a Czech registered trade mark comprising the word SELEX, the decision to grant the Domain Name to the Registrant had been correct.

The Panel held:

(1) The Complaint could only succeed if the Complainant showed that the Respondent’s decision to grant the Domain Name to the Registrant conflicted with the Public Policy Rules and Regulation (EC) No.733/2001.

(2) At the heart of the dispute was the interpretation of the phrase “prior right claimed” in Article 14 of the Public Policy Rules. There were two possible approaches:

(i) A formalistic approach which took the prior right to be the words claimed in the initial application or the form submitted with the validation material; or

(ii) An approach which involved looking at the material submitted by the Applicant as a whole in order to form a substantive view of what was intended by the Applicant in any particular case.

(3) The substantive approach was to be preferred in a case such as this. It was clear looking at the material submitted by the Applicant as a whole, what was the prior right actually relied upon by the Applicant. This appeared to be the approach adopted by EURid in this respect. Accordingly the Complaint was rejected.

(4) Notwithstanding EURid's conclusions as to the prior right relied upon by the Applicant in this case, this was not the prior right recorded on the Sunrise WHOIS Database. This was unfortunate. It was important that this database accurately reflected what EURid had determined the prior right to be in any particular case. If it had done so in this case, these ADR proceedings might have been avoided.

The Panel rejected the Complaint.