Panel Decision for dispute CAC-ADREU-002707

Case number	CAC-ADREU-002707
Time of filing	2006-08-07 12:34:02
Domain names	ofama.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	OFAMA VIBRA OPOLE SP. Z O.O., KRZYSZTOF MATUSZEWSKI

Respondent

Organization / Name	EURid

FACTUAL BACKGROUND

The Complainant is Ofama Vibra Opole, a corporation trading in the European market as Ofama, duly incorporated in Poland.

The Complainant is the registered owner of Community Trademark No. 003669116 “Ofama” which was registered on 21 April 2006. The Complainant is also the owner of the domain names “ofama.com” and “ofama.pl”.

On 5 April 2006, the Complainant applied to register the .eu domain name “ofama.eu” during phase I of the phased registration period (Sunrise Period). The application was rejected because the domain name had been already assigned to Nexus Marcin Cwikla, whose application was dated 30 March 2006.

A. COMPLAINANT

The Complainant asserts summarily that it is entitled to the OFAMA name as:
- it is trading in the European market as OFAMA (also OFAMA VO);
- it has registered Community Trade Mark No. 003669116 in the form of the word OFAMA; and
- it has for several years been using the domains ofama.com and ofama.pl.

Furthermore, the Complainant asserts that the possible registration of the Community domain ofama.eu for an other applicant company may violate its trademark rights on the OFAMA sign and give rise to confusion and to the possibility of unfair competition.

Finally, the Complainant asserts that the Applicant has not until now traded under the name OFAMA.
The Complainant argues that the Respondent's decision should be annulled and the domain name OFAMA be attributed to the Complainant.

B. RESPONDENT

The Respondent submits that during the Sunrise Period, three applications were received for the OFAMA domain name:
- Ofama Sp. z o.o. on 13 December 2005: upon examination of the documentary evidence, the Respondent rejected this

application;
- Nexus Marcin Cwikla on 30 March 2006: upon examination of the documentary evidence, the Respondent deemed that the Applicant was the licensee of a valid trademark on the OFAMA name, and hence accepted this application; and
- Ofama Vibra Opole spolka z o.o. (hereafter "the Complainant") on 5 April 2006: as the application of the previous applicant in the queue had been accepted, the Respondent did not examine the Complainant's application.

The Respondent argues that it first received the application made by Nexus Marcin Cwikla on 30 March 2006 and accepted the domain name application because the documentary evidence demonstrated that the Applicant held a prior right on the OFAMA name.

DISCUSSION AND FINDINGS

The Complainant does not argue that the application of Nexus Marcin Cwikla should have been rejected as a result of a violation of other provisions of the Public Policy and/or the other rules that apply to .eu domain name registration.

The gist of the Complainant's arguments revolves around the rights that the Complainant asserts that it holds on the OFAMA domain name.

Although it may very well be that the Complainant has rights on the OFAMA domain name, this is in casu not relevant.

According to Article 14(10) of the Regulation, the Respondent must 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 must only determine whether the first applicant in line for a given domain name has demonstrated that it is the holder of a prior right at the time of the application.

Consequently, the Regulation does not require a comparison to be made of the seniority of the prior rights invoked by other applicants further down the queue. Nor does the Regulation require the Registry to conduct investigations into whether the applicant used the trademark.

In the present case, the Respondent first received the application made by the Applicant on 30 March 2006. Deciding that the documentary evidence demonstrated that the Applicant held a prior right on the OFAMA name, the Respondent accepted the domain name application.

Accordingly, the Respondent accepted the first valid application. Hence, pursuant to Article 14(10) of the Regulation, the Respondent could not examine the application of the next in line. (Case No. 451, fidia.eu).

The Respondent correctly applied Article 14 of the Public Policy and was correct in rejecting the application for the Domain Name made by the Complainant and in accepting the application for the domain name made by Nexus Marcin Cwikla.

Although it provides no proof whatsoever thereof, the Complainant also asserts that Nexus Marcin Cwikla did not trade under the OFAMA name prior to its domain name application, and that the Respondent should therefore have rejected the Applicant's domain name application.

However, for the purposes of this ADR proceeding, it is not relevant whether or not Nexus Marcin Cwikla used the OFAMA sign prior to its domain name application.

The purpose of this ADR proceeding is merely to decide whether the Respondent's decision to accept the previous domain name application conflicted with the Regulation. Pursuant to Article 14 of the Regulation, the Respondent shall register a domain name if the applicant has demonstrated that it holds a prior right on the name applied for.

Hence, there is no legal basis whatsoever for the Registry to additionally verify whether an applicant has used the prior right prior to its domain name application. (Per incidens, the Community Trade Mark “Ofama” was registered on 21 April 2006, after the Complainant's application for the domain name “ofama.eu”).

For the same reasons as under D., the Complainant's argument that the registration of the OFAMA domain name for Nexus Marcin Cwikla would violate the Complainant's trademark rights and give rise to confusion and to the possibility of unfair competition, cannot be upheld.

Indeed, it is not up to the Registry to assess whether the registration of the OFAMA domain name would violate any laws or third party rights.

As to the validity of the Complainant's arguments, this is something to be decided between the Complainant and the Applicant before a competent Court, but not in an ADR procedure between the Complainant and the Registry.

In the circumstances the decision of the Respondent should be confirmed and the Complainant's requests rejected.

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	**Enzo Fogliani**

DATE OF PANEL DECISION 2006-10-31

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is the holder of a Community trademark (OFAMA) which was registered on 26 April 2006, two weeks after the Complainant had filed an application for the domain name ofama.eu. The application was, however, rejected by the Registry because the domain name had already been assigned to another Applicant.

The Panelist found that Respondent correctly applied Article 14 of the Public Policy. As a result of the “first come, first served” principle set forth in Article 14(10) of the Public Policy, the Respondent was not required to consider or investigate any prior third party rights when assessing documentary evidence of an applicant's prior rights pursuant to Article 14(7) of the Public Policy.