Panel Decision for dispute CAC-ADREU-003007

Case number	**CAC-ADREU-003007**
Time of filing	**2006-09-13 09:43:05**
Domain names	**campings.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Recreatie Media B.V., Van Thiel**

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 that the Panel is aware of.

FACTUAL BACKGROUND

Day 1 of the first part of the phased registration period ('Phase I Sunrise') commenced at 11:00 CET on 7 December 2005. The first application to be received by the Respondent on that day for the disputed domain name 'campings.eu' (the 'Domain Name') was filed by Roos IT (the 'Applicant'). According to the Respondent's Sunrise WHOIS database, that application was received by the Respondent at 11:15:17.149 on 7 December 2005.

The Complainant filed a number of applications to register the Domain Name, the first of which, according to the Respondent's Sunrise WHOIS database, was received by the Respondent at 11:28:56.307 on 7 December 2005, some 13 minutes after the first application received by the Respondent for the Domain Name. This application is next in line after the Applicant's application for the Domain Name.

Documentary Evidence in support of the Applicant's application was received by the Respondent on 30 December 2006 (before the deadline for receipt of the validation documentation). On 4 August 2006, following an assessment of the Documentary Evidence by the Validation Agent, the Respondent (EURid, the .eu Registry) accepted the Applicant's application for Domain Name.

The Complainant, having submitted its own Documentary Evidence for its first, third and fifth applications (all in time), but having lost out to the Applicant, filed a Complaint against the Respondent with the Czech Arbitration Court on 13 September 2006.

On 21 September 2006, the Case Administrator at the Czech Arbitration Court sent a notification to the Complainant asking it to address a minor deficiency in the Complaint. This deficiency was addressed by the Complainant, and on 25 September 2006 the ADR proceedings were formally commenced.

On 8 November 2006, the Respondent submitted its Response to the Czech Arbitration Court, and elected to have the dispute decided by a three member panel. On 22 November 2006, having received all three Statements of Acceptance and Declarations of Impartiality, the Czech Arbitration Court appointed Steve Palmer (President), Dawn Osborne and Enrique Batalla as a three member panel.

A. COMPLAINANT

The Complainant contends the following:

The Complainant is a publishing company providing information relating to recreational activities via the internet.

The Complainant owns a registered Benelux trade mark for CAMPINGS (under number 0776726). The Complainant applied for the Domain Name on 7 December 2005 on the basis of this prior registered trade mark right.

RoosIT is a domain name grabbing company that has systematically registered dozens of trade marks for the sole purpose of obtaining .eu domain names during the Sunrise period. One of the trade marks the Applicant has registered is the Maltese registration for 'C&A&M&P&I&N&G&S'. The Applicant applied for the Domain Name on 7 December 2005 on the basis of this trade mark registration.

The Complainant contends that Eurid's decision to register the Domain name in the name of the Applicant is in conflict with the Regulations for the following reasons.

RoosIT has not demonstrated clearly that it owns a valid Prior Right in relation to the Domain Name. The Applicant's Maltese trade mark registration for 'C&A&M&P&I&N&G&S' is not a legitimate prior right for the Domain Name, as a result of the use of the ampersands in the trade mark. The Complainant states that, due to the use of the ampersands, the trade mark should be read and/or rewritten as 'candaandmandpandiandnandgands'.

The Complainant refers to Article 10(2) of Commission Regulation (EC) No 874/2004 ('Public Policy Rules') which states that 'registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists'. The Complainant then refers to Article 11 of the Public Policy Rules, entitled 'Special characters', which states:

'As far as the registration of complete names is concerned, where such names comprise a space between the textual or word elements, identicality shall be deemed to exist between such complete names and the same names written with a hyphen between the word elements or combined in one word in the domain name applied for.

Where the name for which prior rights are claimed contains special characters, spaces, or punctuations, these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten.

Special character and punctuations as referred to in the second paragraph shall include the following:

~ @ # $ % ^ & * ( ) + = < > { } [ ] | \ /: ; ' , . ?...'

The Complainant relies on several ADR decisions which have dealt with the ampersand issue and the interpretation of Article 11:

Case 00265 <LIVE.EU> Sunrise application based on 'LI & VE'
Case 00398 <BARCELONA.EU> Sunrise application based on 'BARC & ELONA'
Case 00735 <NICE.EU> based on 'NI & CE'.
Case 00394 <FRANKFURT.EU> based on 'FRANKF & URT'

The Complainant states that the panels in the cited cases have ruled that the words 'if possible' in Article 11, paragraph 2, mean that, within the three alternatives provided for in the provision, rewriting the symbols is the preferred option (i.e.'FRANKF & URT' should be rewritten as 'frankfandurt'). As such, eliminating the symbol or replacing it with hyphens are secondary options, only available when the symbol cannot be rewritten.

In the circumstances, the Complainant requests that the Panel annul Eurid's decision, and to transfer the domain name to Complainant.

B. RESPONDENT

Article 11, Public Policy Rules

The main issue for this panel to decide is whether the Respondent violated the Regulations, by accepting an application in circumstances where the applicant chose freely between the three options listed in Article 11. The Respondent contends that whilst the rules do not allow an applicant to apply for a domain name which contains special characters, Article 11 leaves an applicant with three options to comply: either to eliminate the special character entirely from the corresponding domain name, replace it with hyphens, or, if possible, rewrite it.

It is not always possible to rewrite special characters (e.g. '*' can be difficult to write) and where names contain such special characters, they can only be used as a prior right on a domain name if the special character has either been removed or replaced with a hyphen (effectively the three options have been reduced to two as a result). However, where names containing special characters, such as the

ampersand '&', which can be rewritten (e.g. AND, ET, UND, etc…), an applicant has all three options.

The Complainant argues that 'the words 'if possible' in Article 11, paragraph 2, mean that, within the three alternatives provided for in the provision, rewriting the symbols is the preferred option. In other words, eliminating the symbol or replacing it with hyphens are secondary options, only available when the symbol cannot be rewritten. '.

The Complainant cites four ADR decisions to support its contention (BARCELONA, NICE, LIVE and FRANKFURT). However, the Respondent respectfully disagrees with the Complainant's interpretation, and with the interpretation of Article 11 by the Panels in these four decisions. In ADR 394 BARCELONA, the Panel held that the words 'if possible' in Article 11 should be read as an obligation to rewrite the character when this is possible. The Respondent believes this interpretation to be erroneous, since it completely ignores the word 'or' before the words 'if possible' that clearly indicates an alternative choice in the three options.

The Respondent is not empowered to rule on the merits of a prior right. Only courts and competent Trade Mark Offices are empowered to rule on the merits of a trade mark (citing Case 1053 <SANTOS.EU>). The only duty of the Respondent is to assess whether an applicant has chosen either of the three options available pursuant to Article 11 of the Public Policy Rules. If an applicant is alleged to have 'abused' Article 11, ADR proceedings against the applicant/registrant himself must be initiated. However, the present proceedings only relate to the compliance of the formal decision of the Registry with the Regulations.

The Respondent quotes the conclusion reached by the Panel in ADR 1867 (OXFORD):

'In the Panel view, Respondent hasn't been unreasonable when it decided to validate Parknet application, notably because the elimination of the special character is indeed one of the possibilities created by article 11 and because the elimination of the '&' symbol is as good as another solution for that trade mark.

Of course, one can argue that the huge problem arisen from article 11 is well known; that Parknet registered a great number of trade marks with special characters and obviously circumvented the aim of article 11; that various decisions found against companies doing the same, etc.

Here again, the Panel sympathize with this, but it must insist on the fact that the verification process is about a specific application, made by a specific applicant, based on a specific prior right. All factual elements surrounding Parknet's application might be important for an article 20 revocation by Eurid, or for an article 21 procedure launched by the Complainant, and the Panel would certainly welcome these arguments in such procedures, but it has no power to consider them in this procedure in which it has a different mandate'.

Bad Faith

The cases cited by the Complainant contain allegations of bad faith and/or speculative or abusive registration. In the present case, the Complainant also tries to invoke the Applicant's bad faith. However, these proceedings are brought under Article 22 (1)(b) Public Policy Rules – where a decision taken by the Respondent may only be annulled when it conflicts with the Regulations. ADR proceedings based on alleged 'bad faith' of the applicant must be initiated against the domain name holder itself, pursuant to Articles 22(1)(a) of the Public Policy Rules. Such ADR proceedings are still open to the Complainant, where the Complainant will have ample opportunity to further establish its allegations of bad faith in a proceeding against the Applicant. In Case 1867 <OXFORD.EU>, the Panel stated that: 'There is little doubt, in the Panel view, that Complainant would easily win its case against actual domain name holder in an Article 21 [Article 22(1)(a)] procedure, but the mandate of the Panel in this procedure [Article 22(1)(b)] is different.'

Prior Right

The Complainant tries to demonstrate that it has a valid prior right on the name CAMPINGS, in the form of a Benelux trade mark registration. However, the Complainant relies upon a trade mark which cannot establish a prior right on the name CAMPINGS, since the trade mark is composed of the following alphanumerical characters: 'the most recreational website of Europe Campings.eu'. Under Article 10(2) Public Policy Rules and Section 19 of the Sunrise Rules, all alphanumerical characters found in the prior right must be included in the domain name applied for.

DISCUSSION AND FINDINGS

The Respondent in this case is Eurid (the .eu Registry) as this Complaint has been brought under Article 22(1)(b) of the Public Policy Rules. Accordingly, the Applicant of the Domain Name is not the Respondent in these proceedings (although the Complainant erroneously referred to the Applicant as the 'Respondent' during the course of its Complaint).

Under Article 22(1)(b) of the Public Policy Rules, an ADR proceeding against the Registry is limited to the question of whether or not the decision taken by the Registry conflicts with the Public Policy Rules or the .eu Regulation (together the 'Regulations'). The relevant provisions are detailed below. To find in favour of the Complainant in these Registry proceedings, the Panel must therefore find that the Applicant's Domain Name application, and the Respondent's decision to accept the application, were not in accordance with the Regulations.

The Domain Name in issue was applied for by the Complainant at the beginning (day 1) of Phase I Sunrise. Article 10(1) of the Public Policy Rules states 'Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of. eu domain starts…'Prior rights' shall be understood to include, inter alia, registered national and community trade marks…'.

The Sunrise Procedure operated on a first come, first served basis, as set out in Article 14 Public Policy Rules '…the Registry shall register the domain name, on the first come
first served basis, if it finds that the applicant has demonstrated a prior right…'. It was not within the Registry's remit, when assessing Documentary Evidence for the purposes of approving or rejecting a Sunrise application, to conduct an examination into the validity of a prior right in relation to other third party trade mark rights and not to decide who might be best entitled to a name. The Registry's job was simply to approve applications which are supported by correct Documentary Evidence for valid relevant prior rights, on a 'first come first served basis'.

In this case, the first application in the queue received by the Respondent for the Domain Name was from the Applicant (as detailed above). This application was duly approved by the Respondent following examination by PWC (Eurid's validation agent) of the Applicant's Documentary Evidence detailing its Maltese trade mark registration 'C&A&M&P&I&N&G&S'.

Article 10(2) of the Public Policy Rules provides that 'The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.' This Article sets out the principle that there must be identity between the domain name applied for and the prior right relied on. However, Article 10(3) must be read in conjunction with Article 11 of the Public Policy Rules, which notwithstanding the requirement for identity, allows for a trade mark which features 'special characters' to be converted into a form acceptable for domain name registration. Article 11 reads as follows:

'Special characters

As far as the registration of complete names is concerned, where such names comprise a space between the textual or word elements, identicality shall be deemed to exist between such complete names and the same names written with a hyphen between the word elements or combined in one word in the domain name applied for.

Where the name for which prior rights are claimed contains special characters, spaces, or punctuations, these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten.

Special character and punctuations as referred to in the second paragraph shall include the following:
~ @ # $ % ^ & * ( ) + = < > { } [ ] | \ /: ; ' , . ?'

In support of its case, the Complainant cites Case 394 <FRANKFURT.EU>. The panel in Case 394 reviews 2 similar cases which were decided previously (and which are also cited by the Complainant in this case), namely Cases 398 <BARCELONA.EU> (based on the mark BARC & ELONA) and 256 <LIVE.EU> (based on the mark LI & VE). The Panel in <FRANKFURT.EU> stated '…it appears that, in both decisions, the interpretation of the words 'if possible' is that, within the three alternatives provided for in Article 11 Par. 2, rewriting the symbols would be the preferred option. In other words, eliminating the symbol or replacing it with hyphens would be secondary options, only available when the symbol cannot be rewritten'. The Panel then went on to say 'Of all the signs mentioned in this Article, '&' and '+' are the ones for which a transcription is not only possible but, according to their meaning, is also the only logical way forward. As it is easily possible to transcribe '&' to 'and', EURid should, according to Article 11, have done so'. However, this panel disagrees with this interpretation of Article 11 paragraph 2, and rather prefers the view on this issue as put forward by the Panel in Case 1867 <OXFORD.EU>.

It is clear that the provision contained in Article 11 paragraph 2 allows an applicant, with special characters not accepted by the Domain Name System to comply with the Sunrise identity principle by altering their trade mark so as to either remove, replace with a hyphen, or

to rewrite the character(s) in question.

This Panel finds it very unfortunate that the wording of this provision has been exploited by various 'domain grabbers' applying for numerous '.eu' domain names (often in combination with trade mark registrations obtained through a fast track local trade mark registration system), particularly in view of the fact that one of the key aims of the Sunrise procedure was to address speculative and abusive registrations by allowing prior rights owners a temporary opportunity to register their names (Art 5 .eu Regulation).

However, it is clear to this Panel from the wording of Article 11, that there are three options available to an applicant and these are not presented in a hierarchical manner / order of preference. The words 'if possible' do not, in the view of this panel, serve to add any kind of positive obligation to rewrite a special character over and above the other two options (deletion or substitution with hyphens). It is the Panel's view that the presence of the words 'if possible' merely serves to highlight the fact that transcribing certain characters can be very difficult, if not impossible (e.g. '~ { }').

This Panel concludes that Article 11 paragraph 2 provides an applicant an unfettered choice to select any of the three options set out as available. If the transcription of a special character was intended to be the preferred option, and the other two options merely secondary, then this would and should have been expressly set out in the drafting of the Public Policy Rules. However, it was not.

Bad faith

The issue of the applicants' bad faith was raised by the Complainant, and also in the decisions cited by Complainant, and seemed to have influenced the Panel in at least one of those decisions (although the Panel in <LIVE.EU> expressly rejected the relevance of bad faith in Registry proceedings).

The Complainant submitted evidence which indicates that the Applicant has been engaged in widespread registration of trade marks and applications for corresponding .eu domain names – which feature popular everyday words. The Applicant has used the same tactic of inserting an ampersand '&' in between the letters of the words concerned, presumably to reduce the risk of a trade mark registry raising an objection on the basis of 'absolute grounds' (e.g. that the mark applied for is descriptive and/or generic). The Complainant submitted evidence of at least 50 examples the Applicant applying for .eu domain names on the basis of such prior national trade mark registrations, for example:

creditcards.eu / C&R&E&D&I&T&C&A&R&D&S
dating.eu / D&A&T&I&N&G
event.eu / E&V&E&N&T
video.eu / V&I&D&E&O

However, as Article 22(1)(b) Public Policy Rules states that an ADR proceeding against the Registry is limited to the question of whether or not the decision taken by the Registry conflicts with the Regulations. It is therefore this Panel's view that the 'bad faith' allegations advanced by the Complainant are not relevant to these proceedings and cannot assist the Complainant here. The issue of bad faith is however relevant for an Article 21 / 22(1)(a) Complaint which addresses 'Speculative and abusive registrations' (which may be a route the Complainant should consider); and/or may be relevant if the Respondent initiates its own Article 20 revocation procedure in respect of the Domain Name.

In the circumstances, and having considered all documents and facts in the case file, it is this Panel's finding that the Respondent's decision to accept the Applicant's application for the Domain Name was correct. The elimination of the ampersands from the Applicant's trade mark registration was permitted under Article 11 paragraph 2 of the Public Policy Rules. The Respondent's decision was not in conflict with the Regulations.

Complainant's prior right.

For the sake of completeness, whilst the Panel is not obliged to address whether or not the Complainant owned a valid prior right on the Domain Name under the Sunrise procedure, the Panel has decided to makes the following observations.

The Complainant states in its Complaint that it is '…the owner of the trademark CAMPINGS registered at the Benelux Trademark office under number 0776726 on 10 November 2005 in classes 9, 16 and 35' and attached a copy of this registration to its Complaint. The registration is for a figurative mark in colour, which consists of a picture of rabbit in a deck chair, and the following words: large letters 'Campings.eu'; and smaller letters 'the most recreational website of Europe'.

As stated above, Article 10(2) Public Policy Rules, states that the registration of a Domain Name on the basis of a Prior Right consists in the registration of the COMPLETE NAME for which the Prior Right exists, as manifested by the Documentary Evidence. It is not possible for an Applicant to obtain registration of a Domain Name comprising part of the complete name for which the Prior Right exists.

Article 12(1) of the Public Policy Rules required a detailed description of all the technical and administrative measures to be published to ensure the Registry used a proper, fair and technically sound administration of the phased registration period. These measures were set out in the Sunrise Rules. Section 19 of the Sunrise Rules states:

'2. Documentary Evidence must clearly depict the name for which a Prior Right is claimed. A Prior Right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos, etc.) will only be accepted if
(i) the sign exclusively contains a name, or
(ii) the word element is predominant, and can be clearly separated or distinguished from the device element, provided that
(a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the Domain Name applied for, in the same order as that in which they appear in the sign, and
(b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear.'

In light of the provisions of Article 10(2) of the Public Policy Rules and Section 19 of the Sunrise Rules, the Panel agrees with the Respondent that the Complainant's trade mark cannot be used as a prior right for the domain name 'CAMPINGS.EU' as it is composed of the following alphanumerical characters: 'Campings.eu the most recreational website of Europe'. Further, even if it were possible to ignore the less dominant wording within the Complainant's trade mark registration (namely '…the most recreational website of Europe'), and thus leaving behind the larger and more dominant element 'Campings.eu', the Complainant's trade mark could still not be used as a prior right for the Domain Name 'CAMPINGS.EU'. The 'eu' suffix element must not be ignored pursuant to Section 19(5) Sunrise Rules, which states that '…If an Applicant claims a Prior Right to a name that includes an internet top-level domain (such as, but not limited to, .com, .net or .eu), the complete name for which a Prior Right exists includes that domain suffix.'

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 2006-12-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

RoosIT, a business that has applied for numerous .eu registrations on the basis of trade marks for common words in the English language, applied for the domain name 'campings.eu' on 7 December 2005 on the basis of its Maltese trade mark registration for 'C&A&M&P&I&N&G&S'. This application was approved by the Respondent, EURid. The Complainant, which also applied for the domain name on 7 December 2005, is second in the Sunrise queue for 'campings.eu'.

The Complainant contended that RoosIT's Maltese trade mark registration for 'C&A&M&P&I&N&G&S' was not a legitimate prior right for the Domain Name and that it should be read and/or rewritten as 'candaandmandpandiandnandgands'.

Article 11 of the Public Policy Rules, entitled 'Special characters', states: '…Where the name for which prior rights are claimed contains special characters, spaces, or punctuations, these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten.' The Complainant contended that the words 'if possible' in Article 11, meant that, within the three alternatives provided for in the provision, rewriting the symbols is the preferred option (i.e.'FRANKF & URT' should be rewritten as 'frankfandurt'). As such, eliminating the symbol or replacing it with hyphens are secondary options, only available when the symbol cannot be rewritten. However, the Panel disagreed with this view.

The Panel found it unfortunate that the wording of this provision has been exploited by various 'domain grabbers' applying for numerous '.eu' domain names (often in combination with trade mark registrations obtained through a fast track local trade mark registration system), particularly in view of the fact that one of the key aims of the Sunrise procedure was to address speculative and abusive registrations by allowing prior rights owners a temporary opportunity to register their names (Art 5 .eu Regulation).

However, it was clear to the Panel from the wording of Article 11, that there are three options available to an applicant and these are not presented in a hierarchical manner / order of preference. The words ‘if possible’ do not, in the view of the panel, serve to add any kind of positive obligation to rewrite a special character over and above the other two options (deletion or substitution with hyphens). It was the Panel’s view that the presence of the words ‘if possible’ merely serves to highlight the fact that transcribing certain characters can be very difficult, if not impossible (e.g. ‘~ { }’).

The Panel concluded that Article 11 paragraph 2 provided an applicant an unfettered choice to select any of the three options set out as available. If the transcription of a special character was intended to be the preferred option, and the other two options merely secondary, then this would and should have been expressly set out in the drafting of the Public Policy Rules. However, it was not.

As part of its case, the Complainant had submitted evidence of ‘bad faith’, indicating that the Applicant has been engaged in widespread registration of trade marks and applications for corresponding .eu domain names – which feature popular everyday words. However, Article 22(1)(b) Public Policy Rules states that an ADR proceeding against the Registry is limited to the question of whether or not the decision taken by the Registry conflicts with the Regulations. It was therefore the Panel’s view that such ‘bad faith’ allegations were irrelevant to Registry proceedings and could not assist the Complainant.

The Panel found the Respondent’s decision to accept the Applicant’s application for the domain name 'campings.eu' to be correct and not in conflict with the Regulations. The elimination of the ampersands from the Applicant’s trade mark registration was permitted under Article 11 paragraph 2 of the Public Policy Rules.

Complaint denied.