Panel Decision for dispute CAC-ADREU-003034

Case number	CAC-ADREU-003034
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Domain names	carrentals.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	carrentals.co.uk, Mr Richard Game

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

FACTUAL BACKGROUND

The organization Roos IT filed an application to register the disputed domain name <carrentals.eu> on 07/12/2005. That application was supported by a Maltese trademark registration for “C&A&R&R&E&N&T&A&L&S”. The validation agent examined the application and the prior right, the application was accepted and the registration of the domain name allocated to Roos IT.

The Complainant, carrentals.co.uk Ltd., filed an application for the disputed domain name on 07/02/2006 supported in a right to the trade name “carrentals.co.uk”.

The Complainant then filed the present complaint against the decision of the Registry to allocate the domain name <carrentals.eu> to Roos IT. In addition to Roos IT and carrentals.co.uk Ltd., it is noted that there is a third applicant, Argusrentals (application filed on 07/02/2006), followed again by another application filed by carrentals.co.uk Ltm.

The Panel was duly appointed by the Czech Arbitration Court. However, due to imperative reasons, one of the panelists was replaced and a new decision deadline was set for March 1, 2007.

A. COMPLAINANT

Complainant's contentions are as follows:

“Factual:
1 RoosIT applied for over 100 .eu domains Including ‘carrentals’ and ‘australia’
2 when applying for ‘orange’ he even used his own registrar status, so conflict of interest
3 the applications were made using ‘bought’ trademarks from the Malta patent office, in format of C&A&R&R&E&N&T&A&L&S
4 dated in Nov and Dec'05 these were clearly made up and bought with sole intention of applying the .eu domains
5 most of time RoosIT applied using registrar company of one of his buddies in the Netherlands, including Spijkerman (they formed a gang, all applying on each others behalf)
6 Spijkerman then similarly applied for multiple names, using the registrar companies of his friends including RoosIT etc
Legal:
- we have valid prior rights via our company name to carrentals
- not just as our company name but as our global trading name (for 4 years now)
- the date of RoosIT's trademark application and the total lack of their trading business under the carrentals name confirms that they

have no legitimate rights to this name
- compounded by their obvious multiple attempts to register many key generic terms (including orange, australia, etc)
- using colleagues to try to disguise their application attempts as registers (of course applying through their own registrar would be an obvious conflict of interest instead of a poorly disguished one)
- the precedent of BARC&ELONA gives us faith we should win this case
- we could have bought a trademark from Malta or Denmark but decided not to as assumed fairness would prevail"

B. RESPONDENT

The Respondent contends that the Complainant's argument regarding Roos IT's bad faith is not relevant in this case, which is only about whether the Respondent has complied with the Regulations (Article 22(1)(b) of Regulation 874).

Regarding the interpretation of Article 11, the Respondent cites a number of .eu precedents in support of the idea that the applicant for a domain name based on a prior right including the special characters mentioned in that article, has unfettered choice among the three options given i.e. eliminate entirely, replace with hyphens, or, if possible, rewrite.

The precedents cited include ADR No. 1867 (OXFORD) and 2416 (TIMESONLINE).

The Respondent also discusses its disagreement with the interpretations of Article 11 of the Regulation 874 in the precedent cited by the Complainant. In particular, the Respondent states that "Pursuant to article 11 of the Regulation, 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 Regulation. If an applicant has done so, its application must be accepted, because the Applicant respected the requirements of the Regulation."

“For the sake of completeness” in its response, the Respondent also challenges the Complainant's rights to the domain name.

DISCUSSION AND FINDINGS

A) Legal grounds

Article 10.1 of Regulation 874: “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”.

Article 10.2: “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.

Article 11 Par. 2: “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: ~ @ # $ % ^ & * ( ) + = < > { } [ ] | \ / : ; ' , . ?

Article 14: "(…) Every applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question. (…)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 in accordance with the procedure (…)".

According to Articles 22 (1) (b) and 22 (11) of Regulation 874 a party is, following the decision by the Respondent to reject a domain name, entitled to initiate an ADR proceeding against the Registry on the grounds of non-compliance of that decision with Regulation 874 or with Regulation (EC) No 733/2002 (Regulation 733).

B) Discussion and findings

As a first point, the Panel notes that this dispute is brought pursuant to Articles 22 (1) (b) and 22 (11) of Regulation 874. Accordingly, the arguments of the Complainant regarding Roos IT's bad faith in the registration of the domain name <carrentals.eu> are not relevant. If the Complainant intends to pursue that avenue, a complaint pursuant to Articles 22(1)(a) and 22(11), first paragraph, should be filed. Therefore, the Panel dismisses Complainant's arguments concerning Roos IT's bad faith.

The core question of the present case relates to the correct interpretation of Article 11 of the Regulation 874 regarding "special

characters", and more specifically, if and how the ampersand ("&") should be reflected in a domain name when the prior right supporting the application includes that character.

There are a number of precedents dealing with this question and panels have taken a variety of views. However, it is possible to distinguish two main groups: those in favor of granting unfettered choice to the domain name applicant to delete or rewrite the ampersand –see above the precedents cited by the Respondent- and those that deny such choice –see above the precedent cited by the Complainant, among many others e.g. ADR No. 265 (LIVE), 394 (FRANKFURT), 475 (HELSINKI), 1717 (ARZT), 2185 (ANTWERP, ANTWERPEN), 2221 (REYKJAVIK), 1523 (COLOGNE) -.

The Panel agrees that one of the principal difficulties with the interpretation of Article 11 is that the list of special characters listed are accorded very different treatment in practice and no provision is made for this by the wording of the Article. The fact that Article 11 makes no such distinction has led some panels to consider that, in order to comply with the “registration of the complete name” requirement stated in Article 10.2, any of the options contemplated in the mentioned Article 11 are valid and it is for the applicant to make that choice. However, other panels have considered that the question does not have a straight answer and that each case should be decided on its own merits (on a case-by-case basis). In those situations, the role of the Respondent becomes critical and a number of decisions agree on the need that the Respondent assesses each domain name application to establish that the prior right provides enough coverage to support the domain name application.

The Respondent claims that its role does not go beyond assessing whether an applicant has chosen either of the three options available pursuant to article 11 of the Regulation. According to the Respondent, “if an applicant has done so, its application must be accepted, because the Applicant respected the requirements of the Regulation“.

However, Recital 12, together with Article 14 (paragraph 7), suggests that the Respondent needs to go beyond that and indeed verify that the prior right supports the domain name application. As stated in COLOGNE "[…] EURid has regularly assessed the “appearance” of a presented trademark against the domain name sought in accordance with the Regulation. For example with respect to figurative/composite trademarks, such an assessment is performed by EURid and its validation agent. Inevitably, EURid has been assessing special characters as well." The Regulation has established two mechanisms to correct EURid's decisions: an ADR procedure and the possibility to file court proceedings. These mechanisms should guarantee a proper interpretation of Article 11, in line with the purpose of the Regulations.

In the present case, the prior right supporting the application includes NINE ampersand symbols in a TEN-letter trademark. That in itself is enough evidence of the high significance of the ampersand in the prior right. Furthermore, this conclusion is strongly supported by the fact that the prior right supporting the application for the disputed domain name specifically states that

"Registration […] is subject to the following conditions: Registration gives right to the exclusive use of the word 'car rentals', only when this is used with the symbols '&', as shown on the mark."

According to those two factors, it is the view of the Panel that in this case, the ampersand symbols should have been rewritten. Therefore, the Panel considers that the mark C&A&R&R&E&N&T&A&L&S does not provide enough support for the application of the domain name <carrentals.eu> and finds that the Registry's decision does not comply with Article 10.2 of Regulation 874.

Regarding the transfer the domain name to the Complainant as the next applicant in the queue, the Panel is not prepared to make any finding in that respect and relies in the decision of the Registry in accordance with ADR Rule B11(c).

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	**Enrique Batalla**

DATE OF PANEL DECISION 2007-02-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

One of the principal difficulties with the interpretation of Article 11 is that the list of special characters listed are accorded very different treatment in practice and no provision is made for this by the wording of the Article. The fact that Article 11 makes no such distinction has led some panels to consider that any of the options contemplated in that article are valid and it is for the applicant to make that choice. However, other panels have considered that the question does not have a straight answer and that each case should be decided on its own merits (on a case-by-case basis).

In the present case, the Panel considers that the mark C&A&R&R&E&N&T&A&L&S does not constitute a valid right for the domain name application <carrentals.eu> and annuls EURID's decision.