Panel Decision for dispute CAC-ADREU-003085

Case number	CAC-ADREU-003085
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Domain names	self-storage.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Selfstorage-Dein Lager Lagervermietungsgesmbh

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

The Panel is not aware of any other legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant operates several storage facilities in Austria, Germany and Switzerland under a word-device trademark SELFSTORAGE and also operates a website under the domain names www.selfstorage.at, www.selfstorage.de and www.selfstore.ch.
Business4Sure Holding BV ("the Applicant") applied for the domain name self-storage.eu on December 13, 2005, based on the Benelux trademark registration No 783 022 “¿ SELF & STORAGE ?". The processing agent received the documentary evidence on January 12, 2006, which was before the January 22, 2006 deadline.

The Applicant was the next applicant in line for the domain name <self-storage.eu> (after the application by the first applicant had been rejected) and the validation agent concluded from the documentary evidence that the Applicant was the holder of a prior right. Therefore, the Respondent accepted the Applicant's application.
The Complainant applied for the disputed domain name on February 7, 2006, during the phased registration period (“Sunrise II”), based on its prior rights of the non-registered trademark as defined by Austrian law.

A. COMPLAINANT

The Complainant argues that the Applicant does not hold a registered trademark “¿ SELF & STORAGE ?" and refer to a computer printout from Saegis, not showing this registration. Complainant therefore concludes that the Applicant has no prior right in the meaning of Article 10 (1) para 2 of the Commission Regulation (EC) No 874/2004.

It is also argued that the Respondent's decision to grant the domain name to the Applicant conflicts with article 11 of the Regulation. The Complainant argues that article 11 of the Regulation leaves only one option to the applicant, which is to rewrite the ampersand. The Complainant cites five ADR decisions to support its contention (BARCELONA, LIVE, FRANKFURT, NICE and HELSINKI). The Complainant states that the Applicant’s trademark should have been rewritten as SELFANDSTORAGE.eu.

According to the Complainant, it is obvious that the Applicant has tried to abuse the phased period system, by creating a distinctive trademark of the descriptive word “selfstorage” simply by adding question marks and the ampersand.

The Complainant requests the Panel to annul the Respondent's decision and to attribute the domain name to the Complainant.

B. RESPONDENT

Respondent starts with explaining the grounds on which the application for the disputed domain name was accepted (see further above

under Factual Background).
Respondent reminds that it is not in position to defend another's good faith and that pursuant to Article 22 (1) b of the Regulation, a decision taken by the Respondent may only be annulled when it conflicts with the Regulation. ADR proceedings pursuant to Article 22(1) (a) of the Regulation 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.

Respondent confirms that the Applicant is the holder of a Benelux registered trademark on the device trademark composed of the alphanumerical characters "¿ SELF & STORAGE ?", whis is established by the documentary evidence received within the deadline by the validation agent (a copy of the Certificate of Registration was filed to the case on September 29, 2006). The validation agent found that the "¿ SELF & STORAGE ?" logo clearly reads "¿ SELF & STORAGE ?", since the general impression of the characters was apparent, without any reasonable possibility of misreading the characters or the order in which those characters appear.

The Respondent thereafter discuss the interpretation of article 11 of the Regulation, and contends that the said article 11 primarily means that the applicant may not claim a prior right where the name contains special characters. Therefore, article 11 leaves three options for the applicant to still comply with the Regulation and apply for a domain name on the basis of a name containing a special character. The applicant may either eliminate the special character entirely from the corresponding domain name, replace it with hyphens, or, if possible, rewrite it.

Some special characters are not possible to rewrite, leaving the applicant with only two options, wheras others – such as the ampersand – can be rewritten and thus the applicants claimimg such names have all three options.

The Respondent concludes that since the Applicant demonstrated that it was the holder of a registered trademark and removed the special characters from the domain name applied for (which is one of the options offered by article 11), the Respondent correctly accepted its application.

DISCUSSION AND FINDINGS

The Complainant claims to have non-registered trademark rights to the word SELFSTORAGE in Austria. The Panel concludes that this may well be the fact, however this dispute does not regard whether or not the Complainant has prior rights to the disputed domain name, nor shall the Panel judge on the allegations of the Applicant having applied for the domain name in bad faith. The ADR proceedings based on alleged “bad faith” of the applicant must be initiated against the domain name holder itself, pursuant to Article 22(1)(a) of Regulation.

As this case is presented to the Panel, the Panel is limited to decide on whether the Respondents (EURid) decision to register the disputed domain name is in conflict with the provisions of the Regulation, in particular Article 11.

The Applicant is the owner of the Benelux trademark registration No 783 022 “¿ SELF & STORAGE ?". A copy of the Certificate of Registration has been provided by the Respondent as a part of the documentary evidence in this case. The application for this trademark was filed on December 13, 2006 and the mark was registered the same day, through the expedited registration system provided by the BENELUX-Merkenbureau. The owner of the trademark is Business4Sure Holding BV, Roelofarendsveen, Netherlands.

The Applicant applied for the domain name on 13 December 2005, and filed the documentary evidence before the 22 January 2006 deadline.

The said registered trademark is a word/logo mark. Like the validation agent, the Panel finds that the logo clearly reads "¿ SELF & STORAGE ?”.

Article 11 of the Regulation states that: "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: ~ @ # $ % ^ & * ( ) + = < > { } [ ] | \ / : ; ' , . ?".

As concluded in ADR Case No 188 (123.eu), No. 1867 (oxford.eu), No. 2416 (timesonline.eu), and others, the applicant claiming names with ampersands has one more option to choose from than the applicants claiming names containing special characters than cannot be rewritten.

The Regulation does not command the Respondent to make to make a choice for the Applicant. It is true that no where in the Regulation it is provided that the Respondent in some specific cases has to refuse applications based on one of the three options listed in article 11

of the Regulation. The Regulation solely obliges the Respondent to verify whether the Applicant is the holder of a prior right correctly translated into a domain name pursuant to any of the three options listed in article 11.

In the present case, the Applicant's mark contains question marks and the ampersand. The Applicant used the first translitteration alternative for the question marks and the second alternative for the ampersand, as stated in Article 11.

The Panel therefore concludes that the Respondent, accepting the translitteration and registering the domain name, has complied with the Regulation.

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

The Complainant operates several storage facilities in Austria, Germany and Switzerland under a word-device trademark SELFSTORAGE.

The Applicant applied for the domain name self-storage.eu on December 13, 2005, based on the Benelux trademark registration "¿ SELF & STORAGE ?". After validation, it was concluded from the documentary evidence that the Applicant was the holder of a prior right and the Respondent accepted the application.

The Complainant applied for the disputed domain name on February 7, 2006, during "Sunrise II", based on its prior rights of the non-registered trademark as defined by Austrian law.

The Panel notes that it is limited to decide on whether the Respondents (EURid) decision to register the disputed domain name is in conflict with the provisions of the Regulation, in particular Article 11 stating that: "Where the name for which prior rights are claimed contains special characters… these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten."

The Panel concludes that it is up to the applicant, claimimg a prior right including any of the said special charcters, to choose freely between these three options and the Regulation does not intend to leave some discretion to the Respondent insofar as the content of the prior rights is concerned. In this case, the Applicant used the first translitteration alternative for the question marks and the second alternative for the ampersand, as stated in Article 11.

The Panel therefore concludes that the Respondent has complied with the Regulation.