Panel Decision for dispute CAC-ADREU-003614

Case number	CAC-ADREU-003614
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Domain names	mario.eu

Case administrator

Name	Tomáš Paulík

Complainant

Organization / Name	Nintendo of Europe GmbH

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 of which the Panel is aware

FACTUAL BACKGROUND

1. The Complainant is Nintendo of Europe GmbH, a member of the international Nintendo group of companies. It applied for the domain name mario.eu ("the Domain Name") on 7 December 2005. It provided documentary evidence in support of that application by 13 January 2006, within the Phased Registration Period.
2. The documentary evidence submitted by the Complainant in support of its application consisted of a Licence Declaration for a Registered Trade Mark, between Nintendo Co., Limited and the Complainant in respect of the trade mark MARIO, registered in Germany. EURid, the Respondent, rejected the application on the basis that the documentary evidence received did not demonstrate the claimed prior right in the application itself, which referred to a national registered trade mark protected in Malta.
3. The Complaint seeking the annulment of EURid's decision was filed on 24 October 2006. The formal date of commencement of the ADR proceedings was 13 November 2006. The Respondent responded on 9 January 2007.
4. On 9 January 2007 Robert Elliott was appointed panelist in the matter ("the Panel"), having filed the necessary Statement of Acceptance and Declaration of Impartiality and Independence.

A. COMPLAINANT

5. The Complainant confirms its eligibility to register an .eu domain name, as a corporation duly incorporated in Germany, being the administrative headquarters of Nintendo in Europe. Nintendo itself is a worldwide leader in the creation of interactive entertainment, manufacturing and trading hardware as well as software for video game systems.
6. The Complainant refers to the registration of the trade mark MARIO by its parent company Nintendo Co., Limited, Japan, in several countries, including the registration of the German trade mark MARIO for a range of goods and services in classes 9 and 28. The Complainant is the licensee of Nintendo Co., Limited, Japan. The Complainant therefore contends that it is the licensee of a prior right according to Article 10 of Regulation (EC) No. 874/2004 ("the Regulation").
7. The Complainant argues that EURid's decision to reject its application is in conflict with the Regulation. It says that it and its Registrar have conducted a thorough investigation as to the evidence submitted, but have not been able to find any reference to a Maltese trade mark in the submitted documentation. The instructions given by the Complainant to its Registrar referred to the German trade mark as a prior right, which was in line with the evidence subsequently submitted.
8. The Complainant contends that the documentary evidence submitted proved a German trade mark as a valid prior right according to Article 10 of the Regulation. It says that, according to its investigation, its application duly indicated the German trade mark registration as a prior right, which was subsequently proved by the documentary evidence submitted, and therefore the application complied with the Regulation, and with the Sunrise Rules.
9. Further, the Complainant contends that, even if the prior right had been wrongly indicated as a Maltese right, there would only have

been a minimal inconsistency between the prior right claimed and the evidence submitted, which would not justify the rejection of the Domain Name. The Complainant contends that a prima facie review of the documentary evidence submitted would itself show that the Complainant owned a valid prior right to the name for which it requested registration. It was therefore not necessary for the validation agent, or the Registry to engage in any investigation of the prior right claimed, because it was obvious through the evidence provided that the Complainant is the Licensee of a prior right according to the Regulation.
10. The Complainant refers to three ADR cases, ADI (no. 830), PRIXARCDETRIOMPHE, GRANDSTEEPLE (no. 2088) and F-ZERO (no. 1912). In those cases the Registry's decisions to reject applications on the grounds of inconsistencies between the prior right indicated and the evidence submitted were overturned, on the basis that a too formalistic approach had been adopted, which contravened the spirit of the Phased Registration, as provided for by the Regulation. Each of those cases concerned facts analogous to this case, indeed the F-ZERO case concerned the same Complainant and the same Registrar, with the application referring to a German trade mark but the documentary evidence being a copy of a French trade mark registration. In this case, the Complainant contends that indicating the wrong territory in respect of the prior right claimed in support of the domain name application is a minor mistake, without material consequences. The Complainant therefore contends that the Registry's conclusion that the Complainant was not the owner or licensee of a valid prior right was unreasonable.

B. RESPONDENT

11. The Respondent, EURid, says that even if the Complainant gave instructions to its Registrar to apply for the registration of the Domain Name by claiming a prior right in the form of a national registered trade mark protected in Germany, this is not what the Registrar actually claimed in the application received by the Respondent. The information produced in the Respondent's WHOIS database shows that the Complainant claimed a prior right in the form of a national registered trade mark protected in Malta.
12. As this contention by the Respondent appeared to be in contradiction of the evidence apparently relied upon by the Complainant, the Panel, by way of a request for a Further Statement in accordance of paragraph B.8 of the ADR Rules asked the parties as to whether it is possible to recreate the application. In response to that request for a Further Statement, the Respondent has reproduced the XML message received from the Complainant's Registrar on 7 December 2005, which corresponds to the data visible on the WHOIS database. This makes it clear that the application did, indeed, designate Malta as the Prior Right Country. In addition, the Respondent has confirmed that the data in such fields is unchangeable following receipt. The Complainant has now accepted in response that its Registrar was mistaken in mentioning the wrong territory.
13. By reference to Section 5.3 of the Sunrise Rules, the Respondent says that it may not be held responsible for negligence or mistakes made by the Registrars. Section 5.3 of the Sunrise Rules states that "the Registry, Validation Agents and the Government Validation Points are not party to the agreement between the Applicant and his Registrar or to the agreement between the Applicant and his Document Handling Agent and therefore cannot incur any obligation or liability under these agreements". The Respondent refers to a number of decided ADR cases, including 4M (no. 393), ISABELLA (no. 984), TECNO-CENTER (no. 2756) and BORMIO (no. 2983), which make it clear that a mistake made by the Registrar is not a reason for overturning a decision on a domain name application.
14. The Respondent further contends that the burden of proof is on the Complainant to establish the claim to prior right. In particular, Article 14 of the Regulation states that "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 Respondent emphasises the use of the expression "the prior right claimed" in that Article.
15. Article 12(3) of the Regulation states that "The request to register a domain name based on a prior right under Article 10(1) and (2) shall include a reference to the legal basis in national or Community law for the right to the name, as well as other relevant information, such as trade mark registration number, information concerning publication in an official journal or government gazette, registration information at professional or business associations and chambers of commerce". The Sunrise Rules contain provisions that implement Article 12(3), and in particular Section 3(1) states that "An Application is only considered complete when the Applicant provides the Registry, via a Registrar, with at least the following information…: (ix) the country in which the Prior Right claimed is protected".
16. The Respondent contends that Article 12(3) of the Regulation and Section 3(1) of the Sunrise Rules are of great importance for the functioning of the Sunrise period, and the equitable attribution of the domain names that these texts aim at providing. The "prior right country" entry in the WHOIS database, and the information contained in it, may well be of interest to other possible applicants for the same domain name, and might even lead the next applicant in the queue to initiate fruitless ADR proceedings if the validation agent were not to reject the prior application on the basis that it submitted incorrect information.
17. In this case, the Respondent says that the validation agent correctly applied the requirements in the Regulation and the Sunrise Rules, by finding that the documentary evidence did not establish the claim to prior right or, in other words, that the Complainant did not meet its burden of proof.
18. The Respondent refers, in particular, to TECNO-CENTER (no. 2756) which was concerned with incorrect information sent by an applicant's Registrar, and which could not be checked by any third party interested in the same domain name. The application referred to an Italian trade mark (which had not in fact been registered), but the supporting documentation demonstrated a registered German trade mark. In the case of a substantial error committed by the domain name applicant the Panel's role is to check whether the Respondent has complied with the Regulation. The Respondent also refers to ISL (no. 219) and PLANETINTERNET (no. 1627) which equally confirm that any sympathy for an applicant is secondary to the functionality of the phased registration effected through the Regulation and the

Sunrise Rules.

DISCUSSION AND FINDINGS

19. The Panel considers that the Further Statement provided by the Respondent has conclusively established that there was a mistake made by the Registrar in submitting the application for the Domain Name, which appears to be accepted by the Complainant. The Complainant's instructions to the Registrar referred to and relied upon the Complainant's status as a licensee of the German registered trade mark MARIO. The paperwork provided in support of the application confirmed that status. However, in submitting the application, the Registrar designated Malta as the territory for which the prior right was claimed.
20. Therefore, the Panel considers that its task is essentially restricted to deciding: firstly, whether the fact that the mistake was by the Complainant's Registrar is relevant; secondly, whether the nature of the mistake is such that it is only of "minimal" consequence, and therefore that the validation agent adopted a too formalistic approach which contravened the spirit of the phased registration as provided for by the Regulation; and thirdly whether it is relevant that the validation agent could, by reference to the documentary evidence supplied, have satisfied itself that the Complainant was the holder of a prior right in respect of Germany, even if that did not coincide with the country identified in the application itself.
21. As regards the first question, the Panel sees no reason to depart from the previous ADR decisions relied upon by the Respondent, namely that the Registrar acts on behalf of the applicant and the applicant is responsible for any mistakes. Any default by the Registrar in carrying out its instructions should be taken up as between the Complainant and the Registrar, and is not a reason for overturning the Respondent's decision.
22. As regards the question of the nature of the mistake, there have already been conflicting decisions reached by other Panels in previous cases. The ADR decisions relied upon by the Complainant (ADI (no. 830), PRIXARCTRIOMPHE, GRANDSTEEPLE (no. 2088) and F-ZERO (no. 1912)) effectively concluded that this kind of mistake was not material. The Panel in the TECNO-CENTER (no. 2756) case relied upon by the Respondent took the opposite view, and decided that the error was substantial. It is clearly unsatisfactory that different Panels have reached different views on very similar facts. This may well indicate that the question is a "borderline" one, and one where sympathy for the applicant has to be balanced against non-compliance with the applicable rules.
23. In this case, although sympathetic to the Complainant, the Panel does not consider that the mistake is a "minimal inconsistency". An applicant is directed to provide details of the country in which the Prior Right claimed is protected, under Section 3(1) of the Sunrise Rules, which in turn implement Article 12(3) of the Regulation in that respect. The WHOIS database maintained by the Respondent, which is searchable by third parties, reproduces that information. If the information is incorrect, that mistake will not be apparent to any third party. It is certainly conceivable, as the Respondent suggests, that any such third party could be induced to act on the basis of that information in a way which it would not otherwise do (in particular in relation to whether or not to consider initiating its own ADR proceeding). In the Panel's view, any ruling which overturns a decision by the Respondent to reject an application on the grounds that such decision had been too formalistic, should be confined to very clear cases (such as those relating to obvious typographical errors, or the technical inability to fill in the whole of an applicant's corporate name in the field in question). In the Panel's view, this is not such a case. The Panel therefore respectfully disagrees with the contrary conclusions which the Panelists reached in the ADR decisions ADI (no. 830), PRIXARCDETRIOMPHE, GRANDSTEEPLE (no. 2088) and F-ZERO (no. 1912). In particular, the Panel considers that the potential position of other would-be applicants must be taken into consideration when deciding whether the inconsistency is minimal (rather than having to "stand back" from such considerations, as the Panelist observed in PRIXARCDETRIOMPHE, GRANDSTEEPLE (no. 2088)). Therefore, the Panel respectfully agrees with the conclusion of the Panelist in TECNO-CENTER (no. 2756) that the mistake is "not minor and affects substantially the basis of the request".
24. Finally, as to the supposed ability of the Respondent to form a view on the basis of the documentary evidence provided that there was a valid prior right (but in respect of Germany, rather than Malta), the Panel agrees that the Respondent's role is to assess the material before it, on the basis of the application submitted on behalf of the Complainant. There was clearly a discrepancy between the documentary evidence supplied, and the prior right country claimed. The Respondent, through its validation agent, has a discretion to conduct its own investigations into the circumstances of the prior right claimed under Section 21(3) of the Sunrise Rules, but is not obliged to do so. In this case, it appears that the validation agent did not make such enquiries, but instead concluded, correctly, that the documentary evidence supplied did not match the prior right country claimed. Therefore, the Respondent rejected the application correctly, and the Panel sees no reason to overturn that decision.

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	**Robert Elliott**

DATE OF PANEL DECISION 2007-01-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant challenged EURid's decision to refuse to register the disputed domain name mario.eu. EURid refused to register the disputed domain name, on the basis that the evidence received by EURid did not demonstrate the prior right claimed. The evidence received by EURid showed that the Complainant was the licensee of a German registered trade mark MARIO. However, the application submitted on behalf of the Complainant by its Registrar mistakenly referred to the prior right country as Malta. It appears that this was clearly the Registrar's mistake.

The Panel concluded that: the mistake by the Registrar was a matter as between the Complainant and its Registrar, and not a reason for overturning EURid's decision; a mistake as to the prior right country in an application was a material one, which justified EURid's decision to refuse the application, in particular given that the prior right country field is searchable by third parties in the WHOIS database and might be relied upon, and; it was not for EURid to overlook the discrepancy between the documentary evidence filed, and the prior right country claimed.

Therefore, EURid was correct in its decision to refuse registration, and the Complaint was dismissed.