Panel Decision for dispute CAC-ADREU-003709

Case number	**CAC-ADREU-003709**
Time of filing	**2006-11-08 13:23:35**
Domain names	**nationalbank.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**National-Bank AG**

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

Decided case: ADReu Case No. 1262 (nationalbank.eu).The Complainant's application to register the domain name nationalbank.eu was refused on the grounds that it had failed to submit sufficient documentary evidence in time.

FACTUAL BACKGROUND

The Complainant is an Aktiengesellschaft, established at Essen, Germany within the European Community and carries on a banking business under its registered trade name NATIONAL-BANK and it is also known by the public and the media as NATIONALBANK.

The Complainant is the owner of the following German registered trademarks:
NATIONAL-BANK (Wort/-Bildmarke), no. 39743866.4;
NATIONAL-BANK (Wort/-Bildmarke), no. 39743867.2;
N NATIONAL-BANK (Wort/-Bildmarke}, no. 0523619.9;
DAS ZEICHEN GUTER PARTNERSCHAFT. NATIONAL-BANK (Wort/-Bildmarke), no. 0523620.2;
N NATIONAL BANK (Wort/-Bildmarke) no. 30523621.0

The Complainant is also the proprietor of the domain name nationalbank.de registered with the German Registrar for the .de ccTLD.

On 7 December 2005, the Applicant filed an application under the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter the "Sunrise Rules") to register the domain name nationalbank.eu during Phase I of the Sunrise Period.

The Complainant's application was refused on the grounds that it had failed to submit sufficient documentary evidence in time. see ADReu Case No. 1262 (nationalbank.eu).

On 6 April 2006, LLTF applied for the domain name nationalbank.eu. LLTF based its application seeking priority under the Sunrise Rules on its claimed ownership of a Benelux trademark N&AT&IONALBANK.

The processing agent received documentary evidence from LLTF on 10 May 2006, which was before the 16 May 2006 deadline under the Sunrise Rules. LLTF was the next applicant in line for the domain name nationalbank.eu. The first application for the domain name had been rejected and the second application had expired. The validation agent concluded from a prima facie review of the documentary evidence furnished that LLTF was the holder of a prior right as defined in Commission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of .eu Top Level Domain and principles governing registration (hereafter "the Regulation") and on that basis, the Respondent accepted the LLTF's application.

Subsequently the Complainant carried out a search in the online registries of both the Benelux Office for Intellectual Property and the OHIM. The searches returned no results for the mark N&AT&IONALBANK.

In a non standard submission filed on 17 November 2006, the Complainant added that it could not find the trademark N&AT&IONALBANK relied upon as a prior right by LLTF in a search of the database maintained by the Benelux Office for Intellectual Property.

The Respondent then carried out similar searches itself, and concluded that the trademark certificate submitted as documentary evidence by LLTF had been forged.

Principal relevant provisions of the Regulations and Rules

Article 10 (1) of the Regulation states that only holders of prior rights which are recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts. (hereinafter the “Sunrise Period”)

Pursuant to article 14 of the Regulation, each claim of prior rights under article 10 must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists. Article 14 of the Regulation also inter alia places on an applicant the obligation to submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question.

Section 21(2) of the Sunrise Rules states that: “The Validation Agent examines whether the Applicant has a Prior Right to the name exclusively on the basis of a prima facie review of the first set of Documentary Evidence received and scanned by the Processing Agent (including the Documentary Evidence received electronically, where applicable) and in accordance with the provisions of these Sunrise Rules”.

Article 11 of the Regulation inter alia states that “[w]here 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 of the Regulation furthermore provides that "[t]he 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 set out in the second, third and fourth paragraphs".

Recital 11 of the Regulation states that “[t]he principle of first-come-first-served should be the basic principle for resolving a dispute between holders of prior rights during the phased registration. After the termination of the phased registration the principle of first come first served should apply in the allocation of domain names.”

Article 14 of the Regulation also clearly states that “[t]his examination of each claim in chronological order of receipt shall be followed until a claim is found for which prior rights on the name in question are confirmed by a validation agent.”.

Sub-section 27 (1) of the “Sunrise Rules states that "[i]f the ADR Proceeding concerns a decision by the Registry to register a Domain Name and the Panel or Panelist appointed by the Provider concludes that that decision conflicts with the Regulations, then, upon communication of the decision by the Provider, the Registry will decide whether or not to register the Domain Name in the name of the next Applicant in the queue for the Domain Name concerned, in accordance with the procedure set out in these Sunrise Rules".

Sub-section B.11 (c) of the ADR Rules lists the remedies that are available to a panel in an ADR proceeding. It provides that "[t]he main remedy available pursuant to an ADR Proceeding where the Respondent is the Registry shall be the annulment of the disputed decision taken by the Registry. The Panel may decide in appropriate cases that the domain name in question shall be transferred, revoked or attributed. However, with regard to any Registry decision relating to a prior right invoked during the phased registration period such measures of transfer and attribution will only be granted by the Panel if the Complainant is the next applicant in the queue for the domain name concerned and subject to the decision by the Registry that the Complainant satisfies all registration criteria set out in the European Union Regulations and to the subsequent activation by the Registry of the domain name in the name of the Complainant who is the next applicant in the queue".

A. COMPLAINANT

The Complainant seeks annulment of the Respondent's decision to allocate the domain name in dispute to LLTF, firstly because it alleges that LLTF lacked the required prior rights to qualify for priority during the Sunrise Period and secondly because the Complainant claims that the Respondent misinterpreted and misapplied the provisions of Article 11 of the Regulation. The Complainant also requests that the domain name in dispute be transferred to the Complainant.

With regard to its allegation that the Respondent lacked the necessary prior rights to satisfy the Sunrise Rules, the Complainant submits that it has carried out the above mentioned searches in the Benelux and OHIM registry databases and they have produced no result for LLTF'S claimed N&AT&IONALBANK trademark.

The Complainant further claims that even if LLTF was the owner of such a registered trademark, the Respondent had nonetheless misinterpreted and misapplied the principles set out in Article 11 of the Regulation, governing applications for domain names where the prior rights relied upon contain special characters in Article 11.

Article 11(2) of the Regulation states that "[w]here 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 characters and punctuations as referred to in the second paragraph shall include the following: ~ @ # $ % ^ & * ( ) + = < > { } | \ / : ; ' , . ?"

The Complainant submits that on a proper application of the principles in Article 11 to LLTF's application, the Respondent's decision should be annulled because the ampersand (&) in the claimed trademark should have been replaced with the word "and" or a similar word. In support of this argument the Complainant has cited a number of decisions of earlier panels in support of this submission viz. ADReu Case no. 398 (barcelona.eu), ADReu Case no. 256 (live.eu) and ADReu Case no. 394 – frankfurt.eu).

The Complainant also requested a decision that the domain name nationalbank.eu be allocated to the Complainant on the basis of its prior rights.

B. RESPONDENT

The Respondent agrees with the Complainant that its decision should be annulled because it has become clear that LLTF lacked the necessary prior rights on which it based its application. Following receipt of information in the Complaint and in the Complainant's subsequent non standard submission, the Respondent carried out searches itself and concluded that LLTF did not have the requisite prior rights. The Respondent alleges that the trademark certificate submitted as documentary evidence by LLTF was forged and the registrant was not entitled to the benefit of the Sunrise Rules.

As regards the Complainant's contentions based on article 11 of the Regulation, the Respondent submits that while this exercise is not strictly necessary because it alleges that the trademark certificate has been forged, the Respondent nevertheless set out a defence of its position regarding its interpretation and application of article 11 of the Regulation. The Respondent submits that where there is an ampersand (&) in the prior right relied upon, the proper application of the principles in Article 11 permits an applicant to eliminate the ampersand (&) from the domain name. In support of its position the Respondent cited a number of decisions of earlier panels viz. ADReu Case No. 188 (123.eu); ADReu Case No. 1867 (oxford.eu}, ADReu Case No. 2416 (timesonline.eu); ADReu Case No. 1996 (thinktank, think-tank), ADReu Case No. 3007 (campings.eu) ADReu Case No. 3085 (self-storage.eu).

Finally the Respondent submits that in the event that its decision to allocate the domain name to LLTF is annulled by this Panel, the Complainant's request of attribution of the domain name should be denied.

In this regard the Respondent refers to Article 14 of the Regulation, Section 27 (1) of the Sunrise Rules and Section B.11 (c) of the ADR Rules and submits that in such circumstances the domain name may only be attributed to one of the subsequent applicants after validation of their applications or, if there are no subsequent applicant, the domain name shall be released and registered pursuant to the first-come first-served principle.

The Respondent should not be directed to attribute the domain name to the Complainant. because the Respondent must first assess if all registration criteria have been met by the next applicants in the queue by means of the regular validation process.

The Respondent submits that in the present case there is no other applicant in the queue. Should the panel decide to annul its decision, the domain name shall be released and the Complainant will then have the right to apply for the registration according to the general principle of first-come first-served.

The Respondent submits that attributing the domain name to the Complainant at this stage would clearly violate the Regulation.

The Respondent points to the fact that the Complainant's application for the domain name has already been rejected and the Respondents decision to reject the Complainant's application has already been confirmed by a panel in ADReu Case No. 1262 (nationalbank.eu).

DISCUSSION AND FINDINGS

There are three discrete issues raised in this Complaint:

i. the allegation that the registrant of the nationalbank.eu domain name had no bona fide prior right upon which to ground its application during the Sunrise Period;
ii. the Complainant's submission that the Respondent misinterpreted and misapplied the provisions of Article 11 of the Regulation in granting the nationalbank.eu to LLTF based on claimed Prior Rights in the registration of the trade mark N&AT&IONALBANK;
iii. the Complainant's request for attribution of the disputed domain name in the event that this Panel should annul the decision to allocate the domain name to LLTF.

As regards, the allegation that LLTF had no bona fide prior rights upon which to ground its application for the nationalbank.eu domain name during the Sunrise Period, both the Complainant and the Respondent, having carried out searches, conclude that the LLTF did not own a registered trademark N&AT&IONALBANK as it claimed in its application.

This Panel must accept that conclusion reached by both parties on the basis of the Parties respective submissions and the evidence adduced by the Parties.

This Panel does not have the jurisdiction to decide whether the documentation submitted was a forgery as alleged by the Respondent and makes no finding in that regard. In any event this Panel could not make such a determination within the jurisdictional and procedural limitations of this procedure.

Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") states that only holders of prior rights which are recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts. Since, on the balance of probabilities, LLTF did not have the necessary prior rights to qualify as an applicant under the Sunrise Rules, it follows that the decision of the Respondent to allocate the domain name to LLTF should be annulled and this Panel directs accordingly.

In the light of the above finding, it is not necessary for this Panel to consider whether the Respondent misinterpreted and misapplied the provisions of Article 11 of the Regulation in granting the nationalbank.eu to LLTF based on claimed prior rights in the registration of the trade mark N&AT&IONALBANK.

This Panel notes the cases cited by both the Complainant and the Respondent in support of their respective positions. It is clear that panellists are divided on the interpretation of Article 11 and there are at least two schools of thought on the subject.

Turning finally to the Complainant's request for attribution of the disputed domain name, sub-section B 11 (c) of the ADR Rules provides inter alia that the main remedy available pursuant to an ADR Proceeding where the Respondent is the Registry, as in the present case, is annulment of the disputed decision.

Sub-section B 11 (c) further provides that a panel has jurisdiction in appropriate cases to direct that the domain name in question shall be transferred, revoked or attributed. That provision however goes on to restrict the jurisdiction of this Panel by expressly providing that with regard to any Registry decision relating to a prior right invoked during the phased registration period such measures of transfer and attribution will only be granted by the Panel if the complainant is the next applicant in the queue for the domain name concerned.

In the present case, the Respondent has stated that the Complainant is not next in the queue. The Complainant's request to have the domain name transferred to it must therefore be refused.

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	James Bridgeman

DATE OF PANEL DECISION 2007-02-11

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

On 7 December 2005, the Applicant filed an application under the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter the “Sunrise Rules”) to register the domain name nationalbank.eu during Phase I of the Sunrise Period.

The Complainant’s application was refused on the grounds that it had failed to submit sufficient documentary evidence in time. see ADReu Case No. 1262 (nationalbank.eu).

On 6 April 2006, LLTF applied to register the domain name nationalbank.eu. LLTF based its application seeking priority under the Sunrise Rules on its claimed ownership of the trademark N&AT&IONALBANK. It claimed that its trademark was registered in the Netherlands.

On 10 May LLTF furnished documentary evidence in support of its application and following a prima facie review of the documentation by the validation agent, the Respondent accepted LLTF's application.

Subsequently searches of the Benelux and OHIM trademarks databases by both the Complainant and the Respondent produced no result for the trademark N&AT&IONALBANK. The Respondent accepted that LLTF did not have the necessary prior rights required by article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation")

The Complainant raised three discrete issues:

i. the allegation that the registrant of the nationalbank.eu domain name had no bona fide Prior Rights upon which to ground its application during the Sunrise Period;
ii. the Complainant’s submission that the Respondent misinterpreted and misapplied the provisions of Article 11 of the Regulation in granting the nationalbank.eu to LLTF based on claimed Prior Rights in the registration of the trade mark N&AT&IONALBANK;
iii. the Complainant’s request for attribution of the disputed domain name in the event that this Panel should annul the decision to allocate the domain name to LLTF.

The Panel directed that the Respondent’s decision of the Respondent to allocate the domain name nationalbank.eu to LLTF be annulled, as article 10 (1) of the Regulation expressly states that only holders of prior rights which are recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts. LLTF had no qualifying prior rights.

The Panel did not need to consider the issues raised by both Parties in relation to the interpretation of Article 11 of the Regulation and in particular the question as to whether Article 11 permits an applicant to eliminate an ampersand (&) from a domain name in circumstances where there is an ampersand (&) in a prior right relied upon. The Panel noted that there are at least two schools of thought on the interpretation of that provision.

Finally the Panel rejected the Complainant’s request to have the domain name nationalbank.eu transferred to it. Sub-section B 11 (c) of the ADR Rules provides that a panel has jurisdiction in appropriate cases to direct that the domain name in question shall be transferred, revoked or attributed, That provision however goes on to restrict the jurisdiction of the panel by expressly providing that with regard to any Registry decision relating to a prior right invoked during the phased registration period such measures of transfer and attribution will only be granted by the Panel inter alia if the complainant is the next applicant in the queue for the domain name concerned. The evidence before the Panel is that the Complainant is not the next applicant for the domain name in the queue.

The Panel directed that the EURid decision to allocate the domain name nationalbank.eu to LLTF be annulled.