Panel Decision for dispute CAC-ADREU-004681

Case number	**CAC-ADREU-004681**
Time of filing	**2007-11-27 17:03:56**
Domain names	**prague.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Hlavní město Praha**

Respondent

Organization / Name	**Traffic Web Holding BV, B.H.M. Van der Heijden**

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

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FACTUAL BACKGROUND

The Complainant is a public body, and it is responsible for governing a particular geographical territory, namely Prague, the Capital of Czech Republic.
The Complainant exercised its prior rights resulting from the prior right of public entity through an application for the prague.eu domain name dated December 7, 2005.

The Complainant is the owner of the Czech national combined trademarks „PRAHA PRAGUE PRAGA PRAG“, registration No. 256197 and 256198, with the priority right from December 3, 2002. The Complainant exercised its prior rights resulting from the trademark through an application for the prague.eu domain name dated December 22, 2005.

The Respondent is the current registrant of the ”prague.eu” domain name. The Respondent is a Dutch company. It is the registered owner of Benelux combined trademark with wording „PR & AGUE“, No. 0781238, registered for the product group „base metals“.

The Respondent applied for the disputed domain name on December 7, 2005. The basis of the Respondent’s application on this date was that it possessed a prior right within the meaning of Commission Regulation (EC) Nº 874/2004 of 28 April 2004 (“Regulation 874”). The prior right was the registered national trademark for the PR & AGUE trademark.

The disputed domain name was registered to the Respondent on April 18, 2006.

A. COMPLAINANT

The Complainant’s submissions in its Complaint can be summarized as follows:

1. The Respondent is engaged in selling domain names and during the Sunrise period, it filed an application for registration of a number of domain names, inter alia, to the names of prominent world cities based on the prior right resulting from the Benelux trademarks formed by the names of cities, containing an embedded „&“ character or spaces between the individual letters of the names.

The Complainant filed two applications for registration of the prague.eu domain name in the first stage of Sunrise, on the basis of the right of a public entity within the meaning of Article 10 of the Commission Regulation No. 874/2004 and on the basis of the trademark. The Complainant’s application, however, was not reviewed since the prague.eu domain name had been granted to the Respondent whose application had been received earlier by the Registry.

2. The Complainant is a public entity according to Czech law within the meaning of Article 10(1) and (3) of the Commission Regulation No. 874/2004.

3. Article 10 states that the domain name registration of a public body may consist of the acronym which is generally used for it;

4. The Complainant is, inter alia, the owner of the Czech national combined trademarks „PRAHA PRAGUE PRAGA PRAG".

5. The prague.eu domain name, particularly its part corresponding to the distinguishing root of the second-level domain, is identical or confusingly similar to the name in respect of which the right (as specified and described in accordance with the paragraph B(1)(b)(9) of the ADR Rules) is recognized or established by Community law (in case of the name of a public entity) and national law (in case of the „PRAHA PRAGUE PRAGA PRAG" trademark). This designation is formed by the name of the capital of the Czech Republic in various language versions (PRAHA – in the Czech and Slovak language, PRAGUE – in the English and French language, PRAGA – in the Italian, Spanish and Portuguese language and PRAG – in the German language). The Complainant uses these trademarks on all papers in the common contact with citizens, in its presentations, etc;

6. The Respondent did not use, prior to notification of the dispute, the domain name in connection with offer of goods or services related to the name of the city of Prague (Praha, Prag, Praga) nor to offer goods or services related in any way to goods for which the BENELUX trademark „PR & AGUE" was registered. The website in the prague.eu domain shows links containing information about the city of Paris. The Respondent has never manufactured, sold nor offered on the website in the prague.eu domain base metals for which its trademark „PR & AGUE" is registered. Thus the purpose of the registration of the domain was clearly to prevent the rightful entities from registration within the meaning of Article 21(3)(b)(i) of the Commission Regulation No. 874/2004.
As far as the Respondent's registrations are concerned, the lack of good faith has been already found in many ADR Proceedings (e.g. cases No. 3170 "budapest.eu", No. 386 "stockholm.eu", No. 475 "helsinki.eu", No. 3230 "cork.eu", No. 735 "nice.eu", No. 2970 "zakopane.eu", or No. 1255 "liechtenstein.eu"). The existence of bad faith in case of registering a higher number of domains corresponding to names to which there exist rights of third parties was confirmed also by the decision in the case No. 1584 "ksb.eu". The prague.eu domain name was registered and is used by the Respondent clearly in bad faith.

7. The Respondent changed the language of ADR from English to Dutch in the course of the registration. The Complainant believes that the subsequent change of the language occurred intentionally, its purpose being to complicate the procedures of third-party entities within the framework of the ADR Proceeding. The Complainant points out to the fact that there was no reason for the Respondent to change the language of ADR from English to Dutch. The Respondent had already participated in a number of ADR Proceedings regarding domain names registered in the above said manner, some of which had proceeded in English. The web pages of many Internet domains of the Respondent are also made in English (see annexes to the request to change the language of Proceedings). Therefore it is obvious that the Respondent has a good command of the English language. Also the website in the prague.eu domain is in English. It follows from the decision No. 2429 rendered in the case ericpol.eu that abuse of the ADR rules, lying in selection of a less available language of the ADR Proceeding in order to complicate the ADR Proceeding, may serve as evidence of the bad faith of the domain holder.

B. RESPONDENT

1. Respondent is a company that develops and manages a network of websites, portals and generic domain names, for creating its own web projects. It is explicitly not Respondent's intention to sell domain names. The objective is to develop each and every domain name and portal into a full-fledged website or portal. Complainant's claim that Respondent would be "a company engaged in selling domain names" is both untrue as unsubstantiated;

2. Complainant further bases its claim on a figurative trademark in which the words: "PRAHA PRAGUE PRAGA PRAG" are comprised. This trademark, however, cannot be a valid Prior Right either. According to Section 19 (2) of the Sunrise Rules, all alphanumeric characters of a figurative trademark have to be included in the domain name. This means that the trademark would only be a valid prior right for the domain name "prahapraguepragaprag.eu".;

3. Respondent has registered the Domain Name, based on its valid Benelux trademark. Consequently, Respondent has a right to the Domain Name.

4. Furthermore, Respondent makes a legitimate, non-commercial and fair use of the Domain Name. Respondent uses the Domain Name for a non-commercial network of portal websites containing information about different countries and cities. A similar network by the name "Plaats.nl" ("place.nl") has existed for a long time in The Netherlands. Plaats.nl contains more than a 1.000 Dutch place-names, amongst which are cities like Zaandam, Drachten and tourist places like Slagharen. When an internet user for example enters the domain name www.zaandam.nl, he will find a website of Plaats.nl containing information about Zaandam. Plaats.nl is broadly considered as a

successful and impartial source of information, and has about a million page views a month.

5. Article 21 paragraph 3 under a, b, c, d, and e of the Regulation states the circumstances in which bad faith is assumed. In short, the Article states that bad faith is present, when the registration or use infringes on the other party's right. Consequently, bad faith must be directed at the other party. Here, this is absolutely not the case. Respondent registered the Domain Name to include it in its network of portal websites.

6. The fact that Respondent also applied for registration of names of other cities and countries, does not show any bad faith either. In fact, it shows the contrary. Respondent did register a large number of these domain names, since Respondent's intention was to set up a network of websites about these cities and countries. By registering the domain names, Respondent merely worked towards its legitimate goal.

7. Regarding the change of language of the Registration Agreement, Respondent has already stated in its "response concerning the request of a change of the language of the ADR Proceeding" that its Registrator accidentally had failed to change the standard language on the registration form (English) to the Dutch language. This administrative error was later restored. Consequently, the change of language did not have anything to do with this proceeding, nor can be explained as a sign of bad faith.

DISCUSSION AND FINDINGS

The Complainant is a local authority of the City of Prague, Czech Republic.
On December 7, 2005 and on December 22, 2005, the Complainant filed two applications for the domain name "prague.eu" ("Domain Name") under the Sunrise Rules. The Complainant based its first application upon on a prior right covered by Article 10 (3) of the Regulation No. 874/2004 and the second one based on trademark prior right ("Complainant's Prior Right").
On December 7, 2005 but earlier in that day, the Respondent also filed an application for the Domain Name under the Sunrise Rules. Respondent's application was based on an expedite Benelux trademark registration, which was filed on November 30, 2005 and obtained on December 2, 2005, for the word "PR & AGUE" under Class 6 for "base metals" ("Respondent's Prior Right").
The Respondent obtained the registration of the Domain Name since he was the first applicant in line. The Complainant was the second applicant in line.

The Respondent alleges that he uses the Domain Name as part of a network of non-commercial portals which provides information about cities and countries worldwide, including Prague.
The Complainant contends, inter alia, that the Respondent's registration of the Domain Name is speculative and abusive and he requests the transfer of the Domain Name.
The ADR Panel is of the opinion that Complainant had the right to apply for the Domain Name during the Sunrise Period.
The ADR Panel discussed the argument of Respondent that PRAGUE is not the official name of Complainant - it is the English translation of PRAHA. In that extent it can be raised the question whether or not a right to the name PRAGUE is recognized by national or community law.
The ADR Panel can confirm that the right to the name is based on Article 13 of the 1993 Constitution of the Czech Republic (Article 13 of the Constitutional Law no.1/1993 Coll. states "the capital of the Czech Republic is Praha" in Czech: "Hlavním městem České republiky je Praha") as well on the 2000 Law on the Capital city Praha (Law no. 131/2000 Coll.) which derogates the 1990 Law on the Capital city Praha (Law no. 418/1990 Coll.). The name of the Complainant is then recognized by Czech law within the Czech legal system.
The Panel holds the opinion that the translation in English is also the complete name of Complainant. As English is a language which is widely spoken in the EC and also worldwide, PRAGUE has been the English name for PRAHA since long, and the minimum requirement of article 21 of Regulation (EC) No. 874/2004 is similarity and not identity, the Panel believes that PRAGUE and PRAHA are confusingly similar as meant in Article 21(1) of Regulation (EC) No. 874/2004.

ADR Panel is of the opinion that the Domain Name is confusingly similar to Complainant's Prior Right.

Consequently, it should be established if the Respondent registered the Domain Name without rights or legitimate interest in the name "prague", or if he registered the Domain Name or used it in bad faith (Article 21 (1) (a) and (b) of the Regulation No. 874/2004).

The ADR Panel notes that the present ADR case shows particular similarities with three other cases against the Respondent in which an ADR Panel has already rendered a decision (namely Cases No. 03170 "budapest.eu", No. 00475 "helsinki.eu" and No. 03230 "cork.eu".

The ADR Panel is of the opinion that it is sufficiently demonstrated that the Respondent used Respondent's Prior Right with the intention and the purpose to obstruct the registration by Complainant during the Sunrise period as a eu-domain name.

The ADR Panel's decision is based on the following grounds: (i) the application of the Respondent's Prior Right has been filed only on

November 30, 2005 on the basis of the expedite Benelux trademark application procedure; (ii) the said procedure resulted in the registration of the Respondent's Prior Right dated December 2, 2005; (iii) the Respondent applied for the Domain Name on December 7, 2005 which was the first possible day of the registration (i.e. five day after the registration of Respondent's Prior Right); (iv) the Respondent fails to demonstrate any use of Respondent's Prior Right to the Domain name registration; (v) the Respondent registered several other names of mainly geographical terms, including city names, for which it registered trademarks shortly before the start of the Sunrise Period in order to apply for the corresponding .eu-names during the Sunrise Period; (vi) Respondent's Prior Right has not been registered for portal services for which the Respondent claims to be using Domain Name (the ADR Panel notes that the Domain Name is not yet used by Respondent), instead it has been registered for "base metals"; (vii) notwithstanding the fact that the Respondent registered Respondent's Prior Right for "base metals", the Respondent argues that he uses the Domain Name in good faith because he provides objective information for the city of Prague (which is apparently not the case), however the use of the Domain Name in good faith would mean that the Respondent would use the Domain Name to offer base metals, or he would have made actual preparation to do so and the ADR Panel understands that the Respondent never had the intention to do so;

Therefore the ADR Panel concludes that the Respondent registered and used the Domain Name in bad faith as meant in Article 21 (1) (b) of the Regulation No. 874/2004.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name PRAGUE be transferred to the Complainant

PANELISTS

Name	**Vojtěch Trapl**

DATE OF PANEL DECISION 2008-03-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed two applications for the domain name “prague.eu” ("Domain Name") under the Sunrise Rules. The Complainant based its first application upon on a public body prior right and the second one based on trademark prior right ("Complainant's Prior Right").
The Respondent also filed an application for the Domain Name under the Sunrise Rules. Respondent's application was based on an expedite Benelux trademark registration, for the word "PR & AGUE" under Class 6 for "base metals" ("Respondent's Prior Right").
The Respondent obtained the registration of the Domain Name since he was the first applicant in line. The Complainant was the second applicant in line.
The Respondent alleges that he uses the Domain Name as part of a network of non-commercial portals which provides information about cities and countries worldwide, including Prague.
The Complainant contends, inter alia, that the Respondent's registration of the Domain Name is speculative and abusive and he requests the transfer of the Domain Name.
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The Panel holds the opinion that the translation in English is also the complete name of Complainant. As English is a language which is widely spoken in the EC and also worldwide, PRAGUE has been the English name for PRAHA since long, and the minimum requirement of article 21 of Regulation (EC) No. 874/2004 is similarity and not identity, the Panel believes that PRAGUE and PRAHA are confusingly similar as meant in Article 21(1) of Regulation (EC) No. 874/2004.

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Consequently, it should be established if the Respondent registered the Domain Name without rights or legitimate interest in the name "prague", or if he registered the Domain Name or used it in bad faith (Article 21 (1) (a) and (b) of the Regulation No. 874/2004).

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Therefore the ADR Panel concludes that the Respondent registered and used the Domain Name in bad faith as meant in Article 21 (1) (b) of the Regulation No. 874/2004.

For all the forgoing reasons, the Panel orders that the Domain Name is transferred to Complainant.