Panel Decision for dispute CAC-ADREU-000127

Case number	CAC-ADREU-000127
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Domain names	bpw.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	BPW Bergische Achsen KG

Respondent

Organization / Name	EURid

FACTUAL BACKGROUND

Complainant filed the application for the domain name bpw.eu and was received by Respondent 7 December 2005. The Documentary Evidence was received by Respondent on 9 December 2005. Respondent rejected application. The ground on which the rejection was based on is that the Documentary Evidence did not prove the prior rights claimed by the Complainant. The rejection concerns the registration of a domain name within the first sunrise phase. This rejection is subject to dispute.

A. COMPLAINANT

Complainant is of the opinion that the rejection of the application for the domain name bpw.eu must be annulled as the prior rights claimed by the Complainant are fully existent and have been proved through the appropriate Documentary Evidence by the Complainant.
This was supported by the various statements Complainant has given on the cover sheet presented to Respondent where he declared in a legally binding way that he is the owner of the priority right presented by the official trade mark certificate and the Complainant's priority right is valid in accordance with the German law and all formalities and rules concerning the trade mark "BPW" have been fulfilled and finally that the attached copies were copies of the original document giving evidence of the trade mark "BPW".
The Complainant is the owner of the German national trademark "BPW" and only the trade mark owner can present its trade mark certificate to third parties. In the opinion of the Complainant all the requirements set by the EC Regulation No. 733/2002 and No. 874/2004 have been met by him. The rejection of the application by the Respondent shows a clear breach of Article 5 (1) (b) EC Regulation No. 733/2002 and the superior principle (11) of Commission Regulation No. 874/2004, namely the principle of first come first served. Furthermore the Respondent's decision conflicts with and states a breach of Article 12 (3) of Commission Regulation No. 874/2004 and Section 21.3 of the .eu Sunrise rules.

B. RESPONDENT

The Sunrise Rules that apply for all applications during the phased registration period in accordance with art. 3 (d) of the said Rules, provide under Section 13.2 that it is sufficient to submit as documentary evidence a copy of an official document issued by the competent trademark office indicating that the trademark is registered, such as a certificate of registration.

The Documentary Evidence must clearly evidence that the applicant is the reported owner of the registered trademark.

The extract from the certification on the registration of the trademark BPW under nr 897608 issued by the German Patent Office does not evidence that BPW Bergische Achsen KG is the reported owner of the registered trademark.

Where article 12 (3) of EC Regulation 874/2004 requires the request to register a domain name based on a registered trademark to include relevant information, while the Sunrise Rules require the documents to evidence that applicant is the reported owner of the trademark, the ownership of the trademark seems to be not only relevant, but even indispensable information so that the rules do not seem to set higher standards than do the Regulations.

Moreover, if a trademark certificate indeed can only be delivered to the trademark holder by a trade mark office, there is no evidence that this certificate is presented to the Respondent by that same holder. Also the Complainant has not presented any evidence of the reported ownership of the trademark, so that there was no question of any doubt of the evidence presented to the agent. The suggestion made by the complainant is therefore that it is up to the validation agent to produce evidence, quod non.

According to Section 21.3 of the Sunrise Rules the validation agent is not obliged, but permitted in its sole discretion, to conduct its own investigations into the circumstances of the application, the prior right claimed and the documentary evidence provided.

According to the Complainant the agent is therefore required to conduct its own investigation in cases where the prior right is indicated and such evidence is given to the agent. Such further investigation would have shown that according to German law only a trade mark holder could present such a trademark certificate and a quick online check carried out by the agent would also have shown the ownership if he was in any doubt of the evidence presented to him.

The Respondent can only confirm that the validation agent is indeed not obliged to conduct a further investigation. There is no reason to suggest that there are situations where the validation agent is obliged to do so, nonobstant the explicit wordings of the Rules.

Therefore the Respondent, upon notification of the finding by the validation agent that the Documentary Evidence does not substantiate a prior right on the domain name, has rejected the application.

DISCUSSION AND FINDINGS

The complaint of the Complainant as well as the Respondent's response was duly reviewed.

The purpose of the Regulation 874/2004 is, inter alia, to grant domain names during the Sunrise period on first come first served basis as properly claims Complainant provided that the applicant can demonstrate a right which is prior to his domain name application.

The last paragraph of Article 14 of Commission Regulation (EC) No 874/2004 provides that the Registry shall register the domain name, on first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with paragraphs 2-4 of the same article.
The paragraph 4 of Article 14 of the said Regulation provides 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.

In compliance with the Article 14 of Commission Regulation (EC) No 874/2004 the .eu Registration Policy and the Terms and Conditions, (.eu Sunrise Rules), that apply for all applications during the phased registration period in accordance with art. 3 (d) of the said Regulation provides under Section 13.2, inter alia, that the documentary evidence must clearly evidence that the applicant is the reported owner of the registered trademark.

In other words, where the prior right claimed is a trade mark, the burden of proof is on the applicant (Complainant) side, ownership evidence inclusive. This is clearly not in contrary to the principle of the first come first serve set in the Article 5 (1)

(b) EC Regulation No. 733/2002 as well as at (11) of Commission Regulation No. 874/2004.

In the sense of the above stated, there is no conflict between the Article 14 and the Article 12 (3) of the Commission Regulation No. 874/2004 or requirements set by those.

After review of the Documentary Evidence it is clear and in line with the statements of both parties of the dispute that the copy of the trade mark “BPW” presented to the Respondent during application process does not state the ownership rights to the trade mark. The unilateral statement of the Complainant is not the sufficient evidence as stated and requested at the Article 14 of Commission Regulation (EC) No 874/2004 as well as stated and requested at Section 13.2 of .eu Sunrise Rules.

Section 21.3 of .eu Sunrise Rules reads that the Validation Agent is not obliged, but it is permitted in its sole discretion, to conduct its own investigations into the circumstances of the Application, the Prior Right claimed and the Documentary Evidence produced.

Since the burden of proof was on the applicant (Complainant) who clearly failed to proof the ownership rights according to Section 21.3. of .eu Sunrise Rules it was on sole discretion of the Validation Agent to conduct its own investigation and it cannot be deemed as the breach of the Section 21.3 of .eu Sunrise Rules if he decided not to conduct any investigation.

Summarizing the above stated, I did not find the contested decision to reject the application of the Complainant made by the Respondent in conflict with any of the European Union Regulations.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) of the Rules, the Panel orders that

the Complaint is Denied

PANELISTS

Name	**Tomáš Borec**

DATE OF PANEL DECISION 2006-05-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant claimed that it has legally perfect evidenced its priority right in its application because according to German law only the trade mark owner can present its trade mark certificate to third parties and if the Respondent had any doubts he has to conduct an investigation. The Respondent unlawfully rejected the application for the domain name registration bpw.eu.

The Panel reviewed the arguments of Complainant as well as Respondent and found no breach of any of the European Union Regulations. The copy of the trade mark .BPW. presented to the Respondent during application process does not state the ownership rights to the trade mark. The unilateral statement of the Complainant is not the sufficient evidence as stated and requested at the Article 14 of Regulation 874/2004 as well as stated and requested at Section 13.2 of .eu Sunrise Rules.

The purpose of the Regulation 874/2004 is, inter alia, to grant domain names during the Sunrise period on first come first served basis as properly claims Complainant provided that the applicant can demonstrate a right which is prior to his domain name application. In this particular case Complainant did not demonstrated its prior right as required by the Regulation and .eu Sunrise Rules.

Since the burden of proof was on the applicant (Complainant) who clearly failed to proof the ownership rights according to Section 21.3. of .eu Sunrise Rules it was on sole discretion of the Validation Agent to conduct its own investigation and it cannot be deemed as the breach of the .eu Sunrise Rules if he decided not to conduct any investigation.

The Respondent correctly rejected the application in compliance with the Article 14 of Regulation No 874/2004 as well as Section 13.2 of .eu Sunrise Rules since the Complainant did not provided the sufficient trade mark ownership evidence. The Panel denied the complaint.