Panel Decision for dispute CAC-ADREU-000219

Case number	CAC-ADREU-000219
Time of filing	2006-03-21 18:20:13
Domain names	isl.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Institut Franco-Allemand de Recherches de Saint-Louis

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 apart from this ADR proceeding.

FACTUAL BACKGROUND

The complainant, Institut Franco-Allemand de Recherches de Saint-Louis is, the owner of the registered French trademark "ISL" (no. 95 579 353). The trademark was initially registered on 4 July 1995 and the registration is valid for a period of 10 years according to the French Trademark Law.

The application for renewal of the trademark was filed and paid for on 24 June 2005.

The complainant applied for registration of "ISL.eu" on 7 December 2005 (first sunrise period) and the deadline for the submission of documentary evidence was on 16 January 2006. The complainant filed such documentary evidence on 11 January 2006 – a certificate of the trademark ”ISL” under the registration number 95579353.

The Registry has taken the decision to reject the complainants application due to the lack of proof of the existence of the claimed trademark right.

A. COMPLAINANT

The complainant is owner of the registered French trademark "ISL" (no. 95 579 353). The trademark was initially registered on 04.07.1995. The application for renewal of this trademark was filed already on the 24.06.2005. Consequently, the trademark was renewed by the French Trademark Office (INPI).

The Registry has taken the decision to reject the complainant´s application due to the lack of proof on the renewal of registration of the trademark. This decision conflicts with European Union Regulations (Art.10 (1), 12 (3) and 14 of EU Regulation 874/2004/EC). Institut Franco-Allemand de Recherches de Saint-Louis is owner of a 'Prior Right' in terms of Art 10 (1) 874/2004/EC as it is owner of the registered French trademark "ISL" (no.95 579 353). This registered trademark is also valid since 04.07.1995.

The complainant applied for registration of "ISL.eu" on the 07.12.2005. Deadline for the submission of documentary evidence was the 16.01.2006. Section 13 (2) (i) of the "Sunrise-Rules" requires official documents as proof of trademark owner-ship. Official documents on the renewal (renewal certificate) by the French Trademark Office have not been available on the 16.01.2006 and are even now not available for the complainant and trademark owner due to a delay of the French Trademark Office. It has to be stressed that the renewal of the trademark has been applied for already on the 24.06.2005 by the French trademark attorneys. It must further be emphasized, that the renewal fee was paid by the French trademark attorneys in good time. Up to now, there is - as mentioned above - only available an

exhibit of the French ICIMARQUES-Database, stating the successful renewal. As a result of this, the Registry's decision, to reject the application due to a lack of proof of the renewal of the trademark registration was incorrect and infringed European Union Regulations, because there was no official document, such as a renewal certificate, available at the time of the deadline for documents (16.01.2006). The Registry had to take into account that an official document (Section 13 (2) (i) of the "Sunrise-Rules") might not have been available for the complainant at the time of the deadline for documents.

Furthermore, under French Trademark Law, the French trademark "ISL" (no. 95 579 353) was – hypothetically - still capable of being renewed until 31.01.2006. Thus, even after the deadline for documents (16.01.2006), a motion for renewal was still possible. Therefore, the Registry's rejection of the complainant´s appli-cation was incorrect as well., because the trademark was still capable of being renewed.

Due to these facts, the decision taken by the Registry has to be annulled.

Furthermore the complainant has requested the Czech Arbitration Court to require EURid to disclose the Documentary Evidence as defined in the Sunrise Rules.

B. RESPONDENT

Grounds on which the Registry rejected the application for the domain name ISL by the Institut Franco-allemand De Recherches de Saint-Louis.

Art. 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 provides that holders of prior rights 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, and that prior rights shall be understood to include, inter alia, registered national and community trademarks.

According to art. 12.3 of the same regulation the request to register a domain name based on a prior right shall include a reference to the legal basis in national or Community law for the right to the name, such as a trademark, as well as other relevant information, such as trademark registration number.

The .eu Registration Policy and the Terms and Conditions, referred to as the Sunrise Rules, that apply for all applications during the phased registration period in accordance with art. 3 (d) of the said Regulation, 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.

On December 7th, 2005, Institut Franco-allemand De Recherches De Saint-louis has filed an application for the registration of the domain name ISL on the ground of a registered trademark and has submitted in due time, this is on January 11th, 2006, as documentary evidence a certificate of the trademark ISL issued by the Institut National de la Propriété Industrielle, a competent trademark office, under registration number 95579353.

However, this document does certify that the trademark is valid for a renewable period of 10 years as of 12 April 1996, while no renewal certificate is submitted.

The Complainant argues that renewal certificates are not available due to a delay of the French trademark office and that the Registry should have taken into account that an official document might not have been available at the time of the deadline of the documents.

However, it is not clear to the Registry how it should have taken such unavailability into account. It could not validly have accepted the application, while no proof is submitted that a prior right exists on the date of application for the domain name.

Therefore the Registry, 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

This case raises the issue of the burden of proof showing the existence of a prior right suitable for obtaining registration of the corresponding domain name in the sunrise periods.

The Panel must stress that it finds it very unsatisfying that the Respondent, being EURid, upon the Complainants request in this ADR proceeding has not disclosed the Complainants documentary evidence as received by the Respondent.

However there seems to be a mutual understanding between the Complainant and the Respondent to the issue of what documentary evidence the Complainant had filed (in due time) – a trademark certificate but no renewal certificate.

Respondent argues that the documentary evidence only showed a certificate of the trademark "ISL" under the registration number 95579353.

The trademark certificate showing the Complainants initial prior right provided under this ADR proceeding by the Complainant shows in accordance with the Respondents arguments that:

“Registration is effective from the filing date of the application, for an indefinitely renewable period of ten years.”

The certificate furthermore states:

“Filed as of: 4th July 1995”

Under this ADR proceeding the Complainant has provided the Panel with evidences (among others) showing:

1. Application for renewal of the trademark “ISL”.
2. Invoice of the French Trademark Office (INPI) concerning the renewal fee.
3. Invoice of the Paris Trademark Attorneys concerning the renewal fees.
4. Extract of the French “icimarques”-database stating the renewal of the trademark “ISL” (no. 95 579 353).
5. Affidavit signed by a legal practitioner confirming the renewal of the trademark “ISL” and the legal position.

These evidences - together with the certificate of the initial trademark registration of “ISL” - are in the Panels opinion sufficient to show an existing prior right on which basis the domain name “ISL.eu” could and should have been awarded the complainant.

However, these evidences was – to the knowing of the Panel – not in due time provided as documentary evidence before PriceWaterhouseCoopers (the validation agent) and/or EURid (the Respondent), hence the application for the domain name “ISL.eu” was rejected as lack of proof of the prior rights existence.

The purpose of the Commission Regulation (EC) No. 874/2004 is, inter alia, to grant domain names during the sunrise periods on first come first served basis provided that the applicant can demonstrate a right which is prior to the domain name application.

Article 10 paragraph 2 in the said Regulations states:

“2. The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.”

The Panel is of the opinion that this clearly expresses the burden of proof of which an applicant shall prove that the right not only existed but also in fact exists according to the French Trademark law.

Article 14 in the said Regulation supports this interpretation.

The Panel must also refer to the said Regulation Article 12 paragraph 3 which states:

“3. The request to register a domain name based on a prior right under the 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 trademark registration number, information concerning publication in an official journal or government gazette, registration information at professional of business associations and chambers of commerce.”

Such other relevant information are in the Panels opinion – in a case where an official renewal certificate is not available – the above mentioned evidences provided under this ADR proceeding by the Complainant supported by the necessary explanation on how the French Trademark law functions.

Unfortunately to the Complainant the documentation and validation is not an issue for the Panel under an ADR proceeding.

The relevant documentary evidence must be submitted in due time to the validation agent (PriceWaterhouseCoopers) which hereafter examines the received material and notifies the Registry/Respondent (EURid) of its findings and conclusion.

Having failed to submit such relevant documentary evidence in due time the Panel - based on the presentation of the case under this ADR proceeding - finds that the rejection made by the Respondent of the Complainants application regarding the domain name “ISL.eu” was correct.

The above said the Panel concludes that the burden of proof of an existing prior right lies upon the applicant (Complainant) for a domain name under the sunrise periods and neither the validation agent nor the Registry/Respondent has any obligations to undertake further investigations of the (possible) existence of the prior right claimed in a situation as described under this ADR proceeding where there in the Panels opinion can be no doubt about what documentary evidence is sufficient.

The fact that the Complainant was in fact the holder of a sufficient (to obtain registration of the domain name “ISL.eu”) prior right cannot as the case is presented before the Panel lead to any other result.

One could argue that sympathy is overruled by the applicable Regulations serving among other purposes the (cost-effective) functionality of the phased registration and the principles hereof.

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	**Mikkel Gudsøe**

DATE OF PANEL DECISION 2006-06-20

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested the rejection made by the Respondent (EURid) to the Complainants application for the domain name “ISL.eu” under the sunrise periods.

Rejection was based on the fact that the Complainant in the, in due time, filed documentary evidence did not proof that the trademark - on which the application was based – was in fact existing, hereunder renewed in due time.

The Panel concluded that the prior right was in fact existing but found that such documentary evidence proving such was not in due time presented before the validation agent hence the Respondent had the right to deny the Complainants application as the burden of proof is the Complainants.