Panel Decision for dispute CAC-ADREU-000317

Case number	**CAC-ADREU-000317**
Time of filing	**2006-03-21 09:10:59**
Domain names	**lumena.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Tomasz Wendt, Legal Counsel**

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 pending or decided legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is the Polish company Lumena sp. z o.o., owner of the Polish trademark LUMENA, applied for on 18 July 1991, and renewed until 18 July 2011. The Complainant is also registered under the name Lumena sp. z o.o. in the Polish Commercial Register since 1987.

The Complainant challenges EURid's decision to grant the domain name LUMENA.EU, to Mr. Aristides Safarikas, who filed the relevant application on 7 December 2005. The domain name application was based on the prior Benelux registration No. 584558 for trademark LUMENA, filed on 25 January 1996 and granted on 25 November 2006, expiring on 25 January 2006. The relevant abstract of the Benelux Trademark Office refers to Alfastar Benelux SA as the owner of the LUMENA Benelux registration, but the Applicant, submitted a Declaration of a Transfer of a Prior Right duly signed by Alfastar Benelux SA and Aristides Safarikas.

The Complaint was filed on 21 March 2006 in English, which is the language of the proceeding, but the relevant Annexes are in Polish and in French, thus not in the appropriate language. The Complainant did not submit an English translation for these documents.

The Respondent failed to submit a Response within the given deadline. The Respondent sent a NonStandard Communication containing the reasons why the Complaint should be rejected after the notification of Panel appointment, a few days before the Provider sent the documents relating to this ADR proceeding to the appointed Panelist.

A. COMPLAINANT

The Complainant requests that EURid's decision concerning the registration of the domain name LUMENA.EU be annulled for the following reasons:

1) EURid granted the registration of LUMENA.EU to Alfastar Benelux S.A., to which the right of the registered trademark does not belong.

2) The registration of the disputed domain name is speculative and abusive and damages the Complainant. The registration of LUMENA.EU is in bad faith, according to Article 21 of EC Regulation No. 874/2004, because in the time period between the filing of the application for the registration of the disputed domain name and the date of registration of said domain name, the Benelux trademark registration for LUMENA expired and was not further renewed.

The Complainant requests that the domain name LUMENA.EU be transferred to him.

B. RESPONDENT

The Respondent did not file any response within the requested deadline. However, on 2 June 2006, the Respondent filed a "Nonstandard Communication" pursuant to Paragraph A2 (k) of the ADR Rules, stating the following.

EURid granted the registration of the disputed domain name to the Applicant, Mr. Aristides Safarikas in compliance with Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004. The Applicant sent the documentary evidence in support of the domain name application to the Validation Agent on time. As the documentary evidence consisted of a Benelux trademark registered by Alfastar Benelux SA and a licence declaration regarding this Benelux trademark between Alfastar Benelux SA and the Applicant, the Registry accepted the application for the domain name LUMENA.

Bad faith is not a valid reason to revoke the domain at issue because the Validation Agent is not called to ascertain whether the application for the registration of a domain name .EU during the Sunrise Period is in bad faith. Moreover, the Registrant's bad faith is not among the grounds to be taken into consideration in ADR proceedings against EURid as the Applicant is not a party to such proceedings.

With regard to the alleged expiry of the LUMENA Benelux trademark registration, the Panel in the similar case n° 340 (POMPADOUR) stated that: "The Panel cannot follow the opinion of Respondent that Complainant would have had to provide documents, proving that the trademark was not expired, i.e. an extension notice issued by the German Patent and Trademark Office."

Moreover, the Benelux Trademark registry indicates that the trademark has a "grace period" status (Annex 1). Indeed, article 10 of the Benelux Trademark Act provides for a grace period of 6 months when the holder does not pay the renewal fee in time. When the holder of the trademark pays the renewal fees during the grace period, the trademark is restored retroactively. The grace period for the LUMENA trademark has not expired yet .

For these reasons, the Registry's decision to accept the Applicant's application does not breach the EC Regulations.

Finally, with regard to the request that the domain name be granted to the Complainant, Article 11(c) of the ADR Rules states that the domain name can only be transferred "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." As the documentary evidence submitted by the Complainant still has not been considered by the Registry, the Complainant's transfer request cannot be accepted. Only the Registry may validate a domain name. Moreover, the Complainant did not submit any documentary evidence in support of its request.

For all the aforesaid reasons the Complaint must be dismissed.

DISCUSSION AND FINDINGS

Before entering into the merits of the case, the Panel needs to address the following two preliminary issues:

A. The admissibility of the documents accompanying the Complaint, filed in a language other than the one of the ADR proceeding.

B. The admissibility of the Respondent's Nonstandard Communication filed on 2 June 2006, well after the deadline to file a Response and some days after the appointment of the Panel for this ADR proceeding.

Concerning the Complainant's submission of documents in a language different from that of the ADR proceeding, Article 22(4) of the EC Regulation No. 874/2004 states that "unless otherwise agreed by the parties, or specified otherwise in the registration agreement between the registrar and domain name holder, the language of the administrative proceeding shall be the language of that agreement. This rule shall be subject to the authority of the panel to determine otherwise, having regard to the circumstances of the case".

Paragraph A3(a) of the ADR Rules provides that the language of the ADR proceedings must be one of the official EU languages. Under Paragraph A3(c) of the ADR Rules, All documents including communications made as part of the ADR proceeding shall be made in the language of the ADR proceeding. The Panel may disregard documents submitted in other languages than the language of the ADR proceeding without requesting their translation. Under Paragraph A3(d) of the ADR Rules, the Panel by itself or upon the request of a Party, may order that any documents submitted in languages other than the language of the ADR proceeding be accompanied by a translation in whole or in part into the language of the ADR proceeding.

Finally, under Paragraph B1(d) of the Supplemental ADR Rules, all relevant parts of the documents submitted as part of the Complaint,

including any annexes and schedules submitted in languages other than the language of the ADR proceeding must be accompanied by a translation into the language of the ADR proceeding. Documents or their parts not submitted in the language of the ADR proceeding shall not be taken into account by the Panel.

In principle, there is a contraddiction between Paragraph B1(d) of the Supplemental ADR Rules and Paragraph A3(d) of the ADR Rules. While the Supplemental ADR Rules provide that the Panel shall not take into account documents or their parts not submitted in the language of the ADR proceeding, the ADR Rules provide the Panel with the discretionary power to request the party to file translations of the documents supplied in a language other than that of the ADR proceeding. However, Paragraph A1(a) of the Supplemental ADR Rules provides that the Supplemental Rules "may not derogate from either the ADR Rules or the European Union Regulations". Therefore, in case of conflict between the ADR Rules and the Supplemental ADR Rules, the former prevail.

As a consequence, the Panel is entitled to request the Complainant to supply the English translations of the Annexes to the Complaint, namely a copy of the certificate of registration from the Polish Patent and Trademark Office of the Complainant's trademark LUMENA, an extract from the Polish Patent and Trademark Office, an extract from the Benelux Trademark Office of the trademark LUMENA on the basis of which the application for the registration of the disputed domain name was filed, and a copy of the Statement of Incorporation of the Complainant. However, the Panel does not feel necessary to request the translations of the aforementioned documents, because they do not bear any relevance in the present proceedings for the reasons that would be better clarified below. As a consequence, and in compliance with A3(c) of the ADR Rules, the Panel will disregard the Annexes to the Complaint.

The second preliminary question concernes whether the Panel should admit, and therefore consider, the Respondent's Nonstandard Communication filed on 2 June 2006, well after the deadline to file a Response and some days after the appointment of the Panel for this ADR proceeding.

Article 22(8) of the EC Regulation No. 874/2004 provides that the Respondent shall submit a response to the Provider within 30 days of the date of receipt of the Complaint.
If the Respondent does not submit a Response, the Provider shall notify the parties of the Respondent's default. The Provider shall send to the Panel for its information and to the Complainant, the administratively deficient Response submitted by the Respondent (Paragraph 3(g) of the ADR Rules). The Respondent can challenge the Provider's notification of the Respondent's default within a specific time period.

In the case at issue, the Respondent did not submit a Response within the requested deadline and on 25 May 2006, the Provider notified the Respondent's default. The Respondent did not challenge the notification of his default as he could have done under Paragraph 3(g) of the ADR Rules. Accordingly, the Respondent recognized that he did not file his Response within the deadline.

Under Paragraph 10(a) of the ADR Rules, in the event that a party does not comply with any of the time periods established by the ADR Rules, the Panel shall proceed to a decision on the Complaint and may consider this failure to comply as grounds to accept the claims of the other party.

On 2 June 2006, i.e., after the Notification of Appointment of Panelist, which occurred on 31 May 2006, the Respondent submitted a NonStandard Communication, pursuant to Paragraph A2(k) of the ADR Rules, the contents of which are reported above.

Under Paragraph 7(d) of the ADR Rules, the Panel has full discretionary powers to determine the admissibility, relevance, materiality and weight of the evidence.

In the Panel's view, the contents of the NonStandard Communication that the Respondent submitted on 2 June 2006, cannot be taken into consideration. As a matter of fact, the Respondent's communication contains the grounds on which the Compliant should be rejected. These grounds should have been specified in the Response the Respondent omitted to file within the given deadline. Although Paragraph A2(k) of the ADR Rules does not specify what should be intended as a "communication in an ADR Proceeding", it is clear that the contents of said communication cannot equal those of a Response, for which the ADR Rules provide specific provisions and specific deadlines.

In the Panel's view, communications under Paragraph A2(k) of the ADR Rules are communications other than those the Procedural Rules specifically regulate.

The Respondent's NonStandard Communication is an attempt to circumvent the provisions of EC Regulation No. 874/2004 and of the ADR Rules, stating that the Respondent must provide his Response within a given deadline and that, in case of failure, the Panel shall draw such inferences he deems appropriate.

Should the Panel take into consideration the contents of the Respondent's NonStandard Communication, the Panel would violate the duty provided for by Paragraph 7(b) of the ADR Rules, to treat the parties fairly and with equality. Indeed, the Panel would allow the Respondent to defend his position by describing the grounds on which the Response is based, despite the Respondent failed to comply with the deadline specifically designed to mention the aforesaid grounds. The Panel would thus grant the Respondent a second opportunity, and would violate the provision of the ADR Rules that in case of failure to comply with any of the time periods, the Panel should proceed to a decision on the Complaint.

For all the aforesaid reasons, the Panel will not take into consideration the contents of the Respondent's NonStandard Communication filed on 2 June 2006 and will decide this ADR on the sole basis of the Complaint.

The Complainant requests that the Respondent's decision to award the domain name LUMENA.EU to Alfastar Benelux S.A. be annulled and that the challenged domain name be transferred to the Complainant.

According to the Complainant, "EURid registered the disputed domain for the entity (Alfastar Benelux S.A., Brussels, Belgium ...), to which the right of the registered trademark does not belong".

The Panel emphasises that EURid granted the registration of the domain name LUMENA.EU to Mr. Aristides Safarikas and not to Alfastar Benelux S.A.. Accordingly, although it is true that there is a discrepancy between the domain name holder, Mr. Aristides Safarikas, and the trademark registrant, in addition to the trademark registration Mr. Aristides Safarikas submitted in support of his application for the registration of the disputed domain name a Declaration of a Transfer of a Prior Right that he signed as the transferee along with Alfastar Benelux S.A. as the transferor, in compliance with the relevant provisions of the Sunrise Rules.

Therefore, the Panel dismisses the first ground of the Complaint.

The Complainant further requests the revocation of the registered domain name because it is a speculative and abusive registration made in bad faith pursuant to Article 21 of EC Regulation No. 874/2004. According to the Complainant, between the time of the application for the registration of LUMENA.EU and the registration of the domain name, the trademark registration cited as a basis of the domain name registration expired. Alfastar Benelux S.A. did not provide for the renewal of said registration and therefore the request of registration of LUMENA.EU was made in bad faith.

According to Article 22 of EC Regulation No. 874/2004, while "in a procedure against a domain name holder, the ADR panel shall decide that the domain name shall be revoked if it finds that the registration is speculative or abusive as defined in Article 21", in a procedure against the Registry, the ADR panel shall decide whether a decision taken by the Registry conflicts with EC Regulation No. 874/2004 or with EC Regulation No. 733/2002.

Hence, in a procedure against EURid, the Panel must not evalute whether the Registrant registered the domain name in bad faith, according to Article 21 of EC Regulation No. 874/2004. Rather, the Panel must evalute whether EURid' s decision to register the disputed domain name, conflicts with EC Regulation No. 874/2004 or with EC Regulation No. 733/2002.

EC Regulation No. 874/2004 does not require the validation agent or EURid to exclude the domain name applicant's bad faith as a pre-condition to grant a domain name registration. Article 14 of EC Regulation No. 874/2004 provides that "the Registry shall register the domain name, on the first come fist 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". Accordingly, the validation agent and EURid must only verify that the requested domain name is based upon a 'Prior Right' complying with the requirements of the applicable EC Regulations.

Therefore, the Complainant's alleged registration of the domain name LUMENA.EU in bad faith under Article 21 of EC Regulation No. 874/2004 is not a valid ground in a proceeding against EURid (See also Case No. 0265 Microsoft B.V. v. EURid).

For the purposes of this ADR proceeding, the Panel will now assess whether EURid registration of the disputed domain name based upon a trademark registration in force at the time of the filing of the LUMENA.EU application, but not renewed before the granting of the relevant domain name registration, conflicts with EC Regulation No. 874/2004 or with EC Regulation No. 733/2002.

The Panel does not find anywhere in the EC Regulations that a .EU domain name applied for during the phased registration cannot rely on a registered trademark that was in force at the time of the filing of the relevant application and sending of the related documentary evidence, but which expired before EURid's effective domain name registration. On the contrary, Article 10(1) of EC Regulation No. 874/2004 states that "holders of prior rights recognised or established by national and/or Community law and public bodies shall be

eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts. 'Prior rights' shall be deemed to include, inter alia, registered national and Community trademarks ...".

It appears from the above that a trademark registered at the time of the filing of an application for a .EU domain name registration is a 'Prior Right' under EC Regulation No. 874/2004. The fact that the trademark registration may have expired before EURid effectively granted the domain name registration is not considered in EC Regulation No. 874/2004 or No. 733/2002.

In the Panel's view, the lack of consideration in EC Regulations of the possible expiration of a trademark registration before the granting of the corresponding domain name registration entails that what effectively matters is that the trademark registration be valid at the time of the application of the .EU domain name (and the documentary evidence sent to the validation agent must show that the trademark is effectively registered).

In the Panel's opinion, taking a different view would unduly impair the domain name applicant's right to the domain name registration during the phased period. The domain name applicant 's position cannot be affected by the time the validation agent and EURid employ to validate the documentary evidence and process the domain name application. This is a circumstance, which is beyond the domain name's applicant control, and which cannot prejudice his/her rights to the registration of the domain name, once he/she has complied with the requirements set forth in the applicable EC Regulations.

For all the reasons mentioned above, the Benelux trademark LUMENA was a 'Prior Right' in accordance with the applicable provisions of Article 14 of EC Regulation No. 874/2004. Therefore, in granting the registration of the domain name LUMENA.EU to Mr. Aristides Safarikas, EURid did not violate the applicable EC Regulations.

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	**Angelica Lodigiani**

DATE OF PANEL DECISION 2006-06-23

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant requested the revocation of the domain name LUMENA.EU and the transfer of the domain name to him based on the following reasons:

A. EURid granted the domain name to an entity to which the corresponding earlier trademark registration does not belong.

B. The domain name was applied for in bad faith because the holder relied on a trademark registration which, although valid at the time of the filing of the relevant application and sending of the documentary evidence to the validation agent, expired before EURid effectively granted the domain name registration. Therefore, the applicant requested the registration of the domain name in bad faith pursuant to Article 21 of EC Regulation No. 874/2004.

The Panel dismisses the Complaint because:

A. Although from the extract of the Benelux trademark office's database the trademark upon which the domain name registration was requested appears in the name of a different entity, the applicant filed a Declaration of a Transfer or a Prior Right, attesting to the transfer of the trademark registration to the domain name's holder.

B. Bad faith under Article 21 of EC Regulation No. 874/2004 is not a valid ground upon which basing an ADR proceeding against EURid. Moreover, EURid's decision to grant the disputed domain name to the current domain name holder is not in conflict with the applicable EC Regulations. A trademark, which was registered at the time of the filing of the relevant domain name application is a valid 'Prior Right' under the meaning of the applicable EC Regulations regardless of the fact that the domain name holder did not renew the registration after the filing of the application of the domain name and submission of the documentary evidence to the validation agent but before EURid granted the domain name registration.