

Panel Decision for dispute CAC-ADREU-000404

Case number **CAC-ADREU-000404**

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Domain names **odyssey.eu**

Case administrator

Name **Josef Herian**

Complainant

Organization / Name **Mr Robin Patrick Doveton**

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

None that the Panel is aware of.

FACTUAL BACKGROUND

The Complainant filed an application (the 'Application') to register the disputed domain name 'odyssey.eu' (the 'Domain Name') which, according to the Respondent's Sunrise WHOIS database, was received by the Respondent at 11:05:29.777 on 7 December 2005, being day 1 of the first part of the phased registration period ('Phase I Sunrise') which commenced at 11:00 CET on that day. The Complainant's Application was the first to be received by the Respondent for the Domain Name.

Documentary Evidence in support of the Complainant's Application was received by the Respondent on 12 January 2006 (4 days before the deadline for receipt of the validation documentation).

On 25 February 2006, following an assessment of the Documentary Evidence by the Validation Agent, the Respondent (EURid, the .eu Registry) rejected the Complainant's Application for Domain Name.

On 6 April 2006, the Complainant filed his Complaint with the Czech Arbitration Court. On 13 April 2006, the Case Administrator at the Czech Arbitration Court sent a notification to the Complainant asking him to address a number of deficiencies in his Complaint. On 18 April 2006, the deficiencies were addressed by the Complainant, and an Amended Complaint was filed in accordance Paragraph B2(b) of the ADR Rules. On 24 April 2006 ADR proceedings were formally commenced.

On 9 June 2006, Respondent submitted its Response to the Czech Arbitration Court. On 13 June 2006, the Respondent provided the Czech Arbitration Court with a copy of the Documentary Evidence filed by the Complainant in support of his Application. The copy of the Documentary Evidence was entered into the case file in this Complaint. On 14 June 2006, having received the Statement of Acceptance and Declaration of Impartiality, the Czech Arbitration Court appointed Steve Palmer as a single member panel. On 17 June 2006, the case file was transmitted to the Panel.

A. COMPLAINANT

The Complainant contends the following:

Paragraph 16 of the preamble in Regulation (EC) No. 733/2002 (the '.eu Regulation') states 'The adoption of a public policy addressing speculative and abusive registration of domain names should provide that holders of prior rights recognised or established by national and/or Community law and public bodies will benefit from a specific period of time (a 'sunrise period') during which the registration of their domain names is exclusively reserved to such holders of prior rights recognised or established by national and/or Community law and public bodies.'

The Complainant has a 'prior right' by means of having a Community Trade Mark ('CTM') registration in his name, under number 4354701, and with a priority date of 25 April 2005. The CTM is registered for the word mark ODYSSEY in Class 38 for 'The operation of search engines; telecommunications and telecommunications services, (e.g. e-mail services and those provided for the internet); providing user access to the Internet

(service providers); operating of search engines'. As evidence of his CTM registration, the Complainant attaches to his Complaint a print out dated 26 March 2006 from the online CTM database of the Office for Harmonization in the Internal Market (the 'OHIM').

The Complainant's prior right relates to an Internet business and therefore the Complainant has an extraordinary interest in the domain name.

In order to dispel concerns that the Complainant might be involved in the abusive registration of domain names, the Complainant attaches a document detailing a plan for the 'Design of an Internet Organisation'. The Complainant states that operations of his Odyssey Search Engine have already commenced under the Universal Resource Locator <http://www.odyssey.es>.

The Application was made by a natural person resident within the European Community, in accordance with Article 4(2)(b)(iii) of the '.eu Regulation'. The Complainant, although a South African national, resides in London. The Complainant refers to a number of documents to substantiate his status as a UK resident, including his UK residence permit.

In the circumstances, the remedy sought by the Complainant is the annulment of the decision of the Respondent to reject his Domain Name Application, and the attribution of the Domain Name to the Complainant.

B. RESPONDENT

The Respondent contends the following:

The Documentary Evidence supplied by the Complainant did not prove that he owned a registered trade mark. Article 10 (1) of Commission Regulation (EC) No 874/2004 ('Public Policy Rules') states that only the holder of a prior right is eligible to be granted the corresponding domain name. The Public Policy Rules provides that registered national or Community trade marks may be considered as a prior right. This article is reflected in Section 13(1)(ii) of the Sunrise Rules, which expressly provides: 'A trade mark application is not considered a prior right'. The Documentary Evidence submitted by the Complainant only includes details of a trade mark application, and provides no proof of the actual and subsequent registration of the trade mark.

According to Section 21.2 of the Sunrise Rules, the Registry is only obliged to examine the Documentary Evidence provided. Indeed, article 14(4) of the Regulation states that it is up to the applicant to substantiate that he holds a prior right. The applicant must do this by submitting Documentary Evidence which would allow the Registry to assess whether the applicant holds a prior right. The Complainant failed to submit Documentary Evidence showing that he is the holder of a prior right as he only submitted proof that he applied for a trade mark. Pursuant to section 21.3 of the Sunrise Rules there is no obligation for the Registry to conduct its own investigations concerning the prior right claimed (e.g. verify whether the trade mark application has been registered since its application).

For the reasons mentioned above, the Registry was correct in rejecting the Complainant's Application.

The Complaint must be dismissed.

DISCUSSION AND FINDINGS

To find in favour of the Complainant, the Panel must find that the Complainant's Application was in accordance with the Regulations, and that the Respondent's decision to reject the application was not in accordance with the Regulations. The Complainant requests that, in accordance with Section B(11)(c) of the ADR Rules, the disputed decision be annulled, and the Domain Name 'odyssey.eu' be attributed to the Complainant, being the first in the queue for the Domain Name.

Following a decision by the Respondent (the Registry, EURid) to reject a domain name, a party is entitled to initiate an ADR proceeding against the Registry on the grounds of non-compliance of that decision with the Regulations (Article 22(1)(b) Public Policy Rules). Under Article 22(11) of the Public Policy Rules, an ADR proceeding against the Registry is limited to the question of whether or not the decision taken by the Registry conflicts with the Public Policy Rules or the .eu Regulation (together the 'Regulations'). The relevant provisions are detailed below.

The Domain Name in issue was applied for by the Complainant at the beginning (day 1) of Phase I Sunrise. The purpose of the phased registration period is set out in Recital 12 of the Public Policy Rules '...to safeguard prior rights recognised by community or national law.' Article 12 of the Public Policy Rules sets out 'Principles for phased registration' and states that under Phase I Sunrise '...only registered national and Community trademarks, geographical indications, and the names and acronyms referred to in Article 10(3), may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in Article 10(1).'

Article 10(1) of the Public Policy Rules states '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 understood to include, inter alia, registered national and community trademarks...'. Article 10(2) then provides that '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 principal obligations of the Registry regarding its decisions to register or to reject .eu domain names during the phased registration period are set out in Article 14 of the Public Policy Rules which states: '...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...The relevant Validation Agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name. If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this...'

Paragraph 4 of Article 14 of the Public Policy Rules makes it clear that it is up to the domain name applicant to substantiate ownership of the prior right. Further, the Panel in case 00127 <BPW.EU> states '...where the prior right claimed is a trade mark, the burden of proof is on the Applicant's (Complainant) side...'

Article 12 (1) of the Public Policy Rules requires Respondent to publish a detailed description of all the technical and administrative measures that it shall use to ensure a proper, fair and technically sound administration of the phased registration period. These measures have been set out in the Sunrise Rules.

Section 11 of the Sunrise Rules states: '1. During the first phase of the Phased Registration Period, only Domain Names that correspond to...(i) registered Community or national trade marks... may be applied for by the holder and/or licensee (where applicable) of the Prior Right concerned...3. The Applicant must be the holder (or licensee, where applicable) of the Prior Right claimed no later than the date on which the Application is received by the Registry, on which date the Prior Right must be valid, which means that it must be in full force and effect.'

Section 13(1)(i) of the Sunrise Rules relating to 'Registered Trade Marks' states: 'Where the Prior Right claimed by an Applicant is a registered trade mark, the trade mark must be registered by a trade mark office in one of the member states, the Benelux Trade Marks Office or the Office for Harmonisation in the Internal Market (OHIM), or it must be internationally registered and protection must have been obtained in at least one of the member states of the European Union.'

Section 13(1)(i) of the Sunrise Rules relating to 'Registered Trade Marks' specifically states: 'A trade mark application is not considered a Prior Right.'

Section 13(2) of the Sunrise Rules relating to 'DOCUMENTARY EVIDENCE FOR REGISTERED TRADE MARKS' states '...it is sufficient to submit the following Documentary Evidence for a registered trade mark... an extract from an official (on-line) database operated and/or managed by the relevant national trade mark office, the Benelux Trade Marks Office, the OHIM or the WIPO... the Documentary Evidence must clearly evidence that the Applicant is the reported owner of the registered trade mark.'

By signature of a cover letter attached to his Documentary Evidence, dated 8 January 2006 and addressed to PricewaterhouseCoopers in Belgium (the Respondent's appointed Validation Agent), the Complainant represented and warranted that he had, on the date of the Domain Name Application, a legally valid prior right. The Complainant's Documentary Evidence was filed within the 40 day deadline and contained an extract from the OHIM database (a form of Documentary Evidence permitted under Section 13(2) Sunrise Rules). However, it is clear from the Panel's review of the Documentary Evidence, that the OHIM database extract supplied by the Complainant failed to substantiate a legally valid prior right for the reasons set out below.

The extract from the OHIM's database (dated 3 January 2006) supplied with the Complainant's Documentary Evidence details the status of his CTM application as 'Application published'. Further, the OHIM database extract also details the date of publication of the CTM application as being 26 September 2005. Under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ('CTMR'), and in particular Article 42 CTMR, there is a provision for a 3 month CTM 'opposition' period from date of publication of the application in the Community Trade Mark Bulletin, during which time a CTM application may be opposed on the relative grounds for refusal (which grounds are set out in Article 8 CTMR). It is only following this 3 month period, and where no notice of opposition has been filed (or all oppositions have been rejected), that a CTM application may proceed to registration, on payment of the registration fee (Article 45 CTMR). Accordingly, as the publication date was 26 September 2005, then at the precise date of the Domain Name Application, 7 December 2005, the Complainant's CTM application would still have been in the 3 month opposition period - and could not have been considered by the Validation Agent to be a valid registered right that was in full force and effect.

Further, it is clear from the OHIM database printout dated 26 March 2006, annexed to the Complainant's Complaint, that the Complainant's CTM application did not reach registration until 6 February 2006, virtually 2 months after the date of the Application in dispute.

The Complainant states in his Documentary Evidence that he had a 'prior right commencing on the day of the application for the trade mark' and he states in his Complaint that his CTM application has a 'priority date' of 25 April 2005 (the Panel understands this latter statement to be, in fact, referring to his CTM application filing date of 25 April 2005 - and not to a 'priority date' which, in trade mark practitioners' language, refers to the possibility of obtaining a filing date earlier than the date on which an application was actually filed). However, Article 9(3) CTMR makes it clear that the exclusive rights conferred on the proprietor of a CTM (i.e. to prevent third parties not having the proprietor's consent from using a sign identical or similar to it, in the course of trade, in certain circumstances) only prevail from date of publication of the registration of the CTM. As such, a CTM is only considered in full force and effect once it has reached registration.

The Panel acknowledges that technically, there is some scope for argument that a CTM application, before reaching registration, may provide the applicant with some 'rights'. For example, certain rights to 'reasonable compensation' exists from the date of publication of a CTM application. However, this is conditional upon subsequent grant, and further, '...the court may not decide upon the merits of the case until the registration has been published'. Another argument that may be put forward to support the contention that a CTM application creates some 'rights', is that a CTM application is an 'earlier right' that can be used as the basis of an opposition against a later CTM application. However, once again, this is conditional upon the earlier application proceeding to registration (Article 8(2)(b) CTMR).

Notwithstanding the scope for argument that a CTM application may confer upon an applicant some 'rights' (albeit contingent), these ADR proceedings are limited to the question as to whether or not the decision taken by the Respondent is in conflict with the Regulations; and it is clear to the Panel that, under the Regulations, a CTM application is not to be considered a valid 'prior right' on a domain name application filed during Phase I Sunrise. To have been accepted as a valid prior right under the Regulations, the Complainant's CTM would have to have been 'registered' on or before the Domain Name Application date. Article 12(2) of the Public Policy Rules makes it clear the prior right should be registered - it states: 'During the first part of phased registration, only registered national and Community trademarks, geographical indications, and the names and acronyms referred to in Article 10(3), may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in Article 10(1)'.

Further, the wording of the Sunrise Rules is very clear: Section 11 '1. During the first phase of the Phased Registration Period, only Domain Names that correspond to...(i) registered Community or national trade marks... may be applied for by the holder and/or licensee (where applicable) of the Prior Right concerned...3... The Applicant must be the holder (or licensee, where applicable) of the Prior Right claimed no later than the date on which the Application is received by the Registry, on which date the Prior Right must be valid, which means that it must be in full force and effect.' Further, Section 13(1)(i) of the Sunrise Rules relating to 'Registered Trade Marks' specifically states: 'A trade mark application is not considered a Prior Right.'

As a result, although the filing date for the Complainant's CTM application pre-dates the Domain Name Application date of 7 December 2005, the Panel finds that this does not assist the Complainant, and the fact that the Complainant's CTM application had not reached registration on or before the Application date meant that it was not a valid prior right for the purposes of validation of the Domain Name Application under Phase I Sunrise.

In addition to the OHIM database printout, the Complainant also submitted with his Documentary Evidence some papers indicating that a payment for the registration of his CTM application had been transmitted to the OHIM on 20 December 2005. However, the does not assist the Complainant, not least because the payment request post dates the Domain Name Application date of 7 December 2005.

Having reviewed the Documentary Evidence supplied by the Complainant, and having considered all other documents in the case file in this Complaint, it is this Panel's finding that the Respondent's decision to reject the Complainant's Application for the Domain name was the correct decision to make, and that it was not in conflict with the Regulations. The fact that the Complainant had a pending Community Trade Mark application with an earlier filing date than the Domain Name Application date, but which proceeded to registration after the Domain Name Application date, does not assist the Complainant.

Following the rejection by this Panel of the Complaint on the basis that the Complainant failed to substantiate a valid prior right, the Panel can see no need to address the Complainant's contention that he satisfied the eligibility requirements for .eu registration (in that he states he is a 'natural person resident within the community' in accordance with Article 4(2)(b)(iii) of the .eu Regulation). In any event, this point was not contested by the Respondent.

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	Steve Palmer
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DATE OF PANEL DECISION 2006-07-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed an application to register the disputed Domain Name 'odyssey.eu' on day 1 of the .eu phased registration period. He then submitted Documentary Evidence to the Validation Agent within the 40 day deadline.

The Complainant provided evidence of his application for a Community Trade Mark ('CTM') for the word ODYSSEY in Class 38 which pre-dated the Domain Name filing date. However, the Complainant's CTM application had not reached registration by the filing date of the Domain Name Application. As such, the evidence of the Complainant's CTM application was insufficient to substantiate a valid prior right for the purpose of

validation of the Domain Name Application. The fact that the Complainant's CTM application has reached registration since the Domain Name application date is irrelevant.

The Panel agrees with the Respondent's decision to reject the Complainant's Application for the Domain Name as the Registrant failed to substantiate a valid prior right. Article 12 of the Public Policy Rules makes it clear that, in the cases such as this, the prior right in question must have been a registered trade mark.

The Respondent was correct in rejecting the Complainant's Domain Name Application, and its decision was not in conflict with the Regulations.

The Complaint is denied.
