Sentence arbitrale for dispute CAC-ADREU-000768

Case number	**CAC-ADREU-000768**
Time of filing	**2006-05-02 11:39:12**
Domain names	**delcam.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Mr. Brian K Hubbleday**

Respondent

Organization / Name	**EURid**

SITUATION DE FAIT

This Complaint arises out of the interpretation and application of Commission Regulation (EC) NO 874/2004 of 28 April 2004 (“Regulation 874/2004) and the .eu Registration Policy and Term and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter “the Sunrise Rules”).

The Complainant in the proceedings is Mr. Brian K Hubbleday, who as it appears from the nonstandard communication is an employee of Delcam plc. On December 7, 2005, the Applicant, Delcam plc applied to register the domain name “delcam.eu” during Phase I of the phased registration period. In the application Delcam plc stated that it is the holder of a prior right as it is the holder of Registered Community/International Trademark and presented a Trade Mark certificate that indicated that Delcam International Plc has been the holder of trade mark "delcam" from 09.02.1995 until 09.02.2005.

The Respondent refused to register the domain name “Delcam.eu” in the name of the Applicant during the Sunrise Period on the ground that the documentary evidence furnished did not substantiate that the applicant for the domain name is the holder of the prior right on the domain name.

A. PARTIE REQUÉRANTE

The Complainant has disputed the decision of the Respondent and stated that there had been a mistake on the sunrise application forms where the prior right was specified as "Delcam plc" instead of the trade mark "delcam".

After receiving the Response to the Complaint, the Complainant stated in nonstandard communication that they understand the reason for the rejection and presented together with nonstandard communication another Trade Mark certficate that indicated that the trademark "delcam" has been renewed and that the registration of trademark "delcam" is valid until 09.02.2015. The new Trade Mark certificate also indicates that the holder of trade mark "delcam" is Delcam Plc.

The Complainant does not criticize the decision of rejecting the application for registration of domain name "delcam.eu" nor argue that the Respondent violated applicable rules or regulations upon rejecting the application.

B. PARTIE DÉFENDANTE

The Respondent informed that it did not reject the Applicants application for mentioning "delcam plc" as prior right on the cover letter. The Respondent rejected the application because from the documentary evidence which the Respondent was provided with it appeared that the "delcam" trademark had expired and the Applicant did not appear the holder of the alleged prior right. The Respondent stated that as the Respondent was in no position to assess if the Applicant was actually the holder of a prior right in the "delcam" trade mark, it correctly rejected the application for "delcam.eu" domain name.

DÉBATS ET CONSTATATIONS

In consideration of the Factual Background and the Parties' Contentions stated above, I come to the following conclusion:

Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (Regulation) states that only holders of prior rights which are recognized 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. Delcam plc applied for the domain name before the deadline on 20 May 2006 and presented documentary evidence that should have proven that Delcam plc is the holder of a prior right in time. From there on it was up to the Respondent to decide whether to grant the requested domain name to the Applicant or not.

The Respondent has noted that it is up to the applicant to submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. Since the Applicant's application showed that the Applicant was not the holder of prior right at the time of the application, the Registry rejected the application. This is where the question about burden of proof rise. The Respondent quotes Article 14 (4) of the Regulation saying that the documentary evidence must clearly show that the applicant is holder of the prior right claimed on the name in question. The Respondent also notes that according to section 21 (3) of the Sunrise Rules agent is not obliged, but 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. Therefore the Respondent finds that there was no obligation for him to further investigate the matter.

The Panelist notes that in case no 00174 (DOMAIN) it has been stated that "… it is a fundamental principle of justice that, when granted such discretion, the Validation Agent is not exempted from the requirement to act reasonably." The Panelist agrees to the aforesaid principle and therefore it must be decided whether it would have been reasonable to expect from the Validation Agent and Respondent to further investigate the prior right claimed by Delcam plc.

The Panelist appreciates that although in the cover letter of the application "delcam plc" was stated as prior right instead of trade mark "delcam", the Respondent did not find this minor mistake to be a reason to reject the application.

The Panelist finds that it would not have been difficult for the Validation Agent to send an e-mail to the Applicant asking whether correct documentation was presented as the Trade Mark certificate added to the application obviously did not prove the Applicant's prior right. However considering that during the Sunrise period more than 100 00 applications were presented, it is not reasonable to expect that the Validation Agent would have contacted all applicants who have presented documents that do not prove that the applicant is the holder of prior right.

In several ADR proceedings (INSURESUPERMARKET 01194, ISL 00219, ULTRASUN 00541, NAGEL 00119, COLT 00294) the Panel has found that the burden of proof is with the applicant and found that the purpose of the ADR proceedings is not to correct the mistakes done by the applicants. Only in some cases (SCHOELLER 00253, CASHCONTROL 00431) where the names of the applicant and the trade mark owner have merely slightly differed the Panel has found that it would have been reasonable to clear the small doubts regarding the prior right and not to reject the application.

In the current matter it was obvious from the presented Trade Mark certificate that the trade mark "delcam" had been held by another company than the Applicant and that the trade mark had expired. Therefore the Panelist decides that it would not have been reasonable to expect that the Respondent should have carried out further investigation and the Respondent was entitled to reject the application after carrying out the prima facie review of the first set of documentary evidence provided by the applicant according to section 21.2 of the Runrise Rules

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	**Viive Naslund**

DATE DE LA SENTENCE ARBITRALE 2006-08-03

Summary

LE RÉSUMÉ EN ANGLAIS DE LA SENTENCE ARBITRALE SE TROUVE À L´ANNEXE 1

The Complainant contests the Respondent's decision of rejecting the domain name application for "delcam.eu" during the Sunrise Period.

According to the Respondent the application was rejected because from the documentary evidence which the Respondent was provided with it appeared that the "delcam" trademark had expired and the Applicant did not appear the holder of the alleged prior right.

As it was obvious from the Trade Mark register presented by the Applicant that the trade mark "delcam" had been held by another company than the Applicant and that the trade mark had expired the Panel decides that it would not have been reasonable to expect that the Respondent should have carried out further investigation and the Respondent was entitled to reject the application after carrying out the prima facie review of the first set of documentary evidence provided by the applicant according to section 21.2 of the Sunrise Rules.