Panel Decision for dispute CAC-ADREU-000774

Case number	**CAC-ADREU-000774**
Time of filing	**2006-04-14 09:39:15**
Domain names	**vogels.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Vogel's Holding B.V.**

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 proceeding related to the disputed domain name

FACTUAL BACKGROUND

1. History of the Request for Registration

1.1. On December 7, 2005, 11:49:46, the Complainant filed a request for the registration of the domain name <VOGELS.EU>, within the so-called Sunrise registration period.

1.2. On December 19, 2006 the Respondent received from the Complainant documentary evidence relating to its request of the disputed domain name, including an acknowledgement. According to such evidence, the Complainant's application was based on the registration of trademark based on the name "Vogel's" registered on November 10, 1988 before the Benelux Trademark Office under Classes 9 and 20 of the International Nomenclator.

1.3. On March 3, 2006, after having revised Complainant's documentary evidences, the respondent denied Complainant's application for registration of the disputed domain name. In the corresponding notification to the Complainant, issued on March 6, 2006, the Respondent based its decision on the fact that the "Vogel's" trademark on which the Complainant's application was based was not owned by it. On the contrary, after having reviewed the documentation supplied by the Complainant, the Respondent considered that such a trademark was actually owned by a Dutch Company named Vogel's Products, B.V. Therefore, taking into account the fact that the Complainant had not been able to successfully prove that it was the owner or it was an authorized licensee of the above-mentioned trademark, the Respondent decided to deny the Complainant's application.

2. History of the ADR Proceeding

2.1. On April 12, 2006 the Complainant filed before the Czech Arbitration Court (hereinafter, the "Court") a complaint (hereinafter, the Complaint) in English and selected this language as the one applying to the present dispute-resolution proceeding.

2.2. On April 14, 2006 the Court verified the payment of the fees corresponding to this proceeding and issued an official acknowledgement of receipt of complaint as well as required EURid to confirm the exactness of the technical information provided in the Complaint.

2.3. After having reviewed the Complaint, the Court identified a number of administrative deficiencies. Hence, no April 24, 2006 the Court notified the Complainant the existence of the said deficiencies, granting it a period for amending the above-mentioned deficiencies

which was foreseen to elapse on May 12, 2006. In the said communication, the Court warned the Complainant that should it be unable to file an amended version of the Complaint, the latest would be considered withdrawn.

2.4. The Complainant filed an amended version of the Complaint on May 9, 2006. This writ was accompanied by three annexes containing the following documentation: (i) a copy of a certificate of registration issued by the Netherlands Chamber of Commerce (Kamer van Koop Kandel Oost Brabant) corresponding to the Complainant; (ii) a copy of the certificate issued by the Benelux Trademarks Office (Benelux-Merkenbureau) on the registration of the Benelux trademark no. 0453071 "Vogel's" by the Complainant, with effects since November 10, 1988; and (iii) a copy of the certificate issued by the Benelux Trademarks Office (Benelux-Merkenbureau) on the registration of the Benelux trademark no. 0355684 "Vogel's" by a Dutch company named Vogel's Products B.V., with effects since October 10, 1978.

2.5. On May 10, 2006 the Court verified that the amended version of the Complaint did not contain any administrative deficiency and therefore proceeded to notify the Respondent the formal commencement of the proceeding. In this notification, the Respondent was granted with a 30-working days period for filing its response to the Complaint (hereinafter, the "Response").

2.6. On June 29, 2006 the Respondent filed its Response before the Court which was accompanied with an annex containing the documents originally filed by the Complainant in its application for the disputed domain name. After having verified the Response and having confirmed that it was not affected by any administrative deficiency, the Court did formally accept it.

2.7. On July 3, 2006 the Court invited Mr. Albert Agustinoy Guilayn (hereinafter, the Panel) to serve as the panel charged with deciding on the dispute to which this proceeding is referred.

2.8. On July 6, 2006 the Panel filed before the Court his statement of acceptance and declaration of impartiality and independence in order to decide o the dispute linked to this proceeding. Thus, on the same date the Court notified the appointment of the Panel indicating that a decision should be provided by July 30, 2006.

A. COMPLAINANT

3. The Complainant contends that the denomination corresponding to the disputed domain name was the same as the one included in the trademark registration certificate included in the documentary evidences filed before the Respondent. At this respect, the Complainant additionally considers that the Respondent when denying its application must have been confused by the documentary evidences filed in support of its application for registration of the disputed domain name. Indeed, such documentary elements included the reference to a trademark which was held by a company named Vogel's Products B.V. –which is a fully-owned subsidiary of the Complainant-. Nonetheless, such a trademark was based on another Benelux trademark owned by the Complainant and, thus, it was provided as a documentary evidence of the prior rights of the Complainant on the disputed domain name.

B. RESPONDENT

4. The Respondent contends that its decision rejecting the Complainant's application for registering the disputed domain name was based on the fact that, according to the documentary elements provided to it by the Respondent, the Complainant was not the actual owner of the alleged trademark. Therefore, under Article 10(1) of Regulation (EC) No. 874/2004, dated April 28, 2004 (hereinafter, "Regulation 874/2004"), the Respondent was obliged to reject Complainant's application as it had not shown that it was the owner of a prior right as required by Regulation 874/2004.

DISCUSSION AND FINDINGS

Taking into account the factual background described above, under the Panel's perspective the object of the dispute in this proceeding consists in determining whether, under the applicable regulations, the Complainant was entitled to register the disputed domain name during the Sunrise Period. In other words, the key element to decide on is if the Complainant holds, and was able to prove before the Respondent that held, a prior right that allowed it to access to such a registration.

At this respect, the applicable regulations must be taken into account as the key elements for deciding on this matter. In particular, Article 14 of Regulation 874/2004 (Validation and Registration of Applications Received during Phased Registrations) the following dispositions must be considered as specially relevant. Such an Article states: "All claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists". Moreover, this Article does also establish: "Every applicant shall submit documentary evidence that shows the he or she is the holder of the prior right claimed on the name in question".

In order to decide on the issue posed, the above-quoted dispositions must be complemented by Article 7(d) of .EU Alternative Dispute

Resolution Rules when, dealing with the general powers of the Panel, states the following: “The Panel shall determine in its sole discretion the admissibility, relevance, materiality and weight of the evidence”.

Hence, according to the evidences provided to the Panel by the Parties, the Panel has identified the following questions to be taken into account:

- When filing the documentary elements supporting its application, the Complainant indicated in the corresponding form that the trademark on which the application was based was effective in the Netherlands. Nonetheless, the attached certificate supporting this statement did not correspond to such a national trademark. On the contrary, the filing did contain a copy of a certificate dated June 3, 1999 of renewal of international trademark no. R538616 “Vogel’s” registered before the World Intellectual Property Organization by a Dutch company named Vogel’s Products B.V. under classes 9 and 20 of the International Nomenclator and having effects in the territories of Germany, Austria, Russian Federation, France, Hungary Italy, Portugal, Czech Republic, Slovaquia, Slovenia and Switzerland. According to the information included in the said certificate, the registration of this international trademark was based on the previous registration of the Benelux trademark no. 453071, with effects since November 10, 1988.

- After having carefully revised the documents filed by the Complainant and the online database of the Benelux Trademarks Office the Panel has been able to find out that the Complainant is indeed the holder of the above-mentioned Benelux trademark which is at present fully in force.

Taking into account these circumstances, the Panel has reached the following conclusions:

- The inclusion by the Complainant of a certificate of renewal of an international trademark owned by one of its subsidiaries –even if it was based on a Benelux trademark registration owned by it- does not seem the best documentary evidence in order to prove before the Respondent that it holds a prior right (as defined in Article 10(1) of Regulation 874/2004). On the contrary, whether due to a lack of actual knowledge of the rules governing the Sunrise period applying to .EU domain names, whether due to a lack of diligence in connection with the demonstration of its rights, a filing as described above seems far from being a useful tool for proving such rights and for collaborating with the Respondent in the process of validation of applications filed within the Sunrise period.

- Having made the previous statement, the Panel considers that denying the Complainant’s application on the grounds of considering that it does not hold a prior right does not seem an adequate solution in this case, taking into account the circumstances that have been given. Certainly, when reviewing the Complainant’s application, the Respondent should have been able to find out –as the Panel has made by means of the use of public means- that the Complainant was the owner of the trademark on which the international trademark alleged in the Complainant’s written application was based. This is said without prejudice of indicating again that the Complainant’s behavior vis-à-vis its application seems certainly questionable. Nonetheless, the Panel considers that, within the present proceeding, the Complainant has been able to prove much more clearly that when it filed its application for registering the disputed domain name that it holds a valid and enforceable prior right as required by Regulation 874/2004.

This approach is coherent with the criteria set out in other cases where the Respondent’s rejection of an application for registering a .EU domain name under the Sunrise period was based on the fact that the Complainants were unable to prove they actually held a valid and genuine prior right (see, for example decision dated June 6, 2006, case no. 00499, Grundfos A/S v. EURid or decision dated June 15, 2006, case no. 00376, Handys, Ltd. v. EURid).

On the contrary, in this case the Complainant has been able to prove that it holds a prior right allowing it to register the disputed domain name. In addition, even with significant and questionable limitations, the Panel considers that the Complainant offered sufficient elements to prove before the Respondent that it held rights to register the disputed domain name.

According to the criteria indicated in other decisions (see, for example, dec ision dated June 13, 2006, case no. 00396, Christian Riege v. EURid), an eventual decision against the Complainant would suppose a severe formalistic approach which seems to be far from the goals aimed by the regulations ruling the registration and Sunrise period applying to .EU domain names.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the EURID's decision be annulled

PANELISTS

Name	Albert Augustinoy

DATE OF PANEL DECISION 2006-07-14

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed the Complaint as a consequence of the rejection by the Respondent of its application for the domain name vogels.eu within the Sunrise Period.

The rejection by the Respondent was based on the fact that, according to the documentary evidence provided by the Complainant to the Respondent, the Benelux trademark on which the Complainant based its prior right on the domain name was not registered by it but by another Dutch company.

Alter having reviewed the documents provided by the Parties, the Panel has been able to find out that, due to the Complainant's questionable provision of evidences, the Respondent considered that the Complainant held no trademark that could support its application. Nonetheless, after having made the corresponding verifications, the Panel has been able to find out that the Complainant does indeed hold a valid trademark registration to support its application.

The Panel considers that a strict formalist approach in this case would not be a reasonable solution and would not follow the principles guiding the registration rules of .EU domain names.