Panel Decision for dispute CAC-ADREU-000814

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Case administrator

Name	Josef Herian

Complainant

Organization / Name	PT.COM - COMUNICAÇÕES INTERACTIVAS, S.A.

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, at the best knowledge of the Panel.

FACTUAL BACKGROUND

On December 7, 2005, Mrs. Dolores REBELO (hereinafter: "Mrs. REBELO") filed an application for the domain name <telepac.eu> (hereinafter: "Domain Name"). The application was made under the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter: "Sunrise Rules").

Mrs. REBELO based her application on the Portuguese registered trademark "TELEPAC PORTUGAL", applied for on June 11, 1981 and registered under No. 212.040 on November 21, 1988 for class 38 (i.e. telecommunications and transmission and data communication) (hereinafter: "Prior Right").

Mrs. REBELO transmitted all the required documents in due course and well before the deadline of January 16, 2006.

Mrs. REBELO's application for the Domain Name was the first in a queue of applications for the Domain Name.

The Documentary Evidence provided by the Mrs. REBELO consisted of a copy of the Original Certificate of Registration of the Prior Right, issued by the Portuguese Trademark Office (hereinafter: "I.N.P.I."), on 21 November 1988, containing the name of the trademark, the name of the original trade mark applicant (i.e. CORREIOS E TELECOMUNICAÇÕES DE PORTUGAL), the filing date, as well as the registration date, the services for which the trade mark was applied for, and several endorsements of assignments and changes of name of the owner of the trade mark.

The endorsements show that there has been (i) a first change of name of the owner of the Prior Right, namely from CORREIOS E TELECOMUNICAÇÕES DE PORTUGAL to TELECOM PORTUGAL S.A., registered on November 18, 1993; (ii) a second change of name of the owner of the Prior Right, namely from TELECOM PORTUGAL S.A." to "PORTUGAL TELECOM S.A.", registered on June 21, 1995; (iii) an assignment of the Prior Right from PORTUGAL TELECOM S.A. to TELEPAC SERVIÇOS DE TELECOMUNICAÇÕES S.A., registered on April 27, 1998; and (iv) an assignment of the Prior Right from TELEPAC SERVIÇOS DE TELECOMUNICAÇÕES S.A. to TELEPAC II COMUNICAÇÕES INTERACTIVAS S.A., registered on June 30, 2000.

The Documentary Evidence also contained a copy of the official receipt, dated April 18, 2005, regarding the assignment of the Prior Right from TELEPAC II COMUNICAÇÕES INTERACTIVAS S.A. to PT.COM, S.A. – COMUNICAÇÕES INTERACTIVAS, Complainant and actual owner of the Prior Right.

The Documentary Evidence was filed in the Portuguese language, with an certified translation into English.

On March 9, 2006, Mrs. REBELO received a notification from the Registry informing that the application to the Domain Name had been rejected, due to the fact that the Documentary Evidence did not constitute sufficient ground to guarantee the Prior Right claimed.

Complainant does not agree with the decision of the Registry and filed a Complaint under the .eu Alternative Dispute Resolution Rules (hereinafter: "ADR Rules"). Complainant requests the annulment of the rejection decision taken by the Registry and the attribution of the Domain Name to Mrs. REBELO.

On May 19, 2006, Respondent filed its Response to Complaint as provided under § B3 of the ADR Rules, acknowledging that the Validation Agent has made a mistake since the Prior Right had not yet expired and the name of the owner of the Prior Right had been changed.

A. COMPLAINANT

Complainant contends that the decision to reject the application for the Domain Name conflicts with the European Regulation (EC) of the Parliament and the Council No 733/2002 of 22 April 2002 on the implementation of the .eu Top Level Domain (hereinafter: "Regulation 733/2002") and with the Regulation (EC) of the Commission No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration (hereinafter: "Regulation 874/2004").

According to Complainant, the Documentary Evidence proves the existence of "the right under the law by virtue of which the domain name exists", as provided by the EC Regulation 733/2002 and the Regulation 874/2004.

Moreover, Complainant contends that the Prior Right, consisting of the words "TELEPAC PORTUGAL", fully complies with the provisions of Article 10.2. of the Regulation 874/2004 and corresponds exactly to the complete name for which the Prior Right exists. According to Complainant, the term "PORTUGAL" cannot be considered as being a part of the trademark. In this respect, Complainant refers to Article 78º, §4° of the Portuguese Industrial Property Code of August 24, 1940 (hereinafter: "P.I.P.C."), which was applicable at the time of application for and registration of the Prior Right. According to Article 78°, §4° of the P.I.P.C., trademarks related to national products must include the term "PORTUGAL".

Complainant also draws the attention to the fact that they are the actual owner of the Prior Right and that the Documentary Evidence clearly proves that the Prior Right has been transferred to them.

Complainant also contends that the Prior Right had to be renewed by May 21, 1999, as lack of renewal would have lead to the expiration of the Prior Right. As a consequence, the assignment of the Prior Right to Complainant could not been registered in 2000. However, Documentary Evidence shows that the assignment has been registered.

Provided the above, Complainant concludes:

- According to Whereas (12) of the Regulation 874/2004, "(…) The Registry should ensure that validation of the rights is performed by appointed validation agents. On the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name".

- Article 14 of the Regulation 874/2004 provides: "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".

- According to Chapter V, Section 10 of the Sunrise Rules, "The Validation Agent examines Documentary Evidence for identical Domain Names in the order in which Applications are received by the Registry, in accordance with the procedure set forth in Article 14 of the Public Policy Rules and whether the Applicant has a Prior Right to the name exclusively on the basis of a prima facie review of the first set of Documentary Evidence".

Complainant contends that, given the above, the Validation Agent is obliged to verify "whether the requirement for the existence of a prior right to the name claimed by the Applicant in the Application is fulfilled on the basis of a prima facie review". Or, in other words, the application must be based on "the evidence that is sufficient to raise a presumption of fact or to establish the fact in question unless rebutted".

According to Chapter V, Section 21.3. of the Sunrise Rules, "The Validation Agent is not obliged, but it 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".

Complainant contends that the Validation Agent's decision to reject the application for the Domain Name by Mrs. REBELO, conflicts with Regulation 733/2002 and Regulation 874/2004 and requests the annulment of that decision and the attribution of the Domain Name to Mrs. REBELO.

B. RESPONDENT

Respondent contends that the rejection of the application for the Domain Name was based on the following legal grounds:

- Article 10.1. of the Regulation 874/2004 stating that that "holders of prior rights which are 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

- Article 10.2. of the Regulation 874/2004 providing "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".

Respondent contends that shall be considered as a Prior Right, a registered national or Community trademark which has not yet expired.

As regards the application by Mrs. REBELO for the Domain Name, Respondent acknowledges that Mrs. REBELO applied for the Domain Name on December 7, 2005 and that the Documentary Evidence, including a licence declaration, was submitted before the deadline of January 16, 2006.

Moreover, Respondent admits that the Validation Agent has made a mistake. Respondent acknowledges also that it clearly results form the Documentary Evidence that the Prior Right had not yet expired and that the name of the owner of the Prior Right had been changed.

In its Response to Complaint, Respondent does not request the Panel to dismiss nor to sustain the Complaint.

DISCUSSION AND FINDINGS

Article 22.11. of the Regulation 874/2004 provides that in case of a procedure against the Registry, the ADR panel shall decide whether a decision taken by the Registry conflicts with the Regulation 874/2004 or with the Regulation 733/2002.

It results from the Case File that, during the application procedure for the Domain Name, EURid's model declaration "Licence Declaration of a Registered Trade Mark (.eu Phased Registration)", duly complete, dated and signed by all involved parties, has been submitted in due time. According to this declaration, Licensor (i.e. Complainant), authorises Licensee (i.e. Mrs. REBELO) to apply during the Sun Rise period for the Domain Name in accordance with the ADR Rules and acknowledges that the Domain Name shall be registered in the name of Licensee.

An ADR procedure may be initiated by any person or entity by submitting a Complaint (Article 22.1. of the Regulation 874/2004 and § B.1 (a) of the ADR Rules). In the present case, the Complaint has been submitted by Complainant, owner and Licensor of the Prior Right. Complainant thus has a legitimate interest to request the annulment of the decision of Respondent to reject the application of Mrs. REBELO, Licensee, for the Domain Name and that the Domain Name is attributed to Mrs. REBELO.

Article 10.1. of the Regulation 874/2004 provides that "Holders of prior rights recognized or established by national (…) law (…) shall be eligible 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 (…) trademarks."

Article 10.2. of the Regulation 874/2004 reads as follows: "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 such a right exists."

As Respondent pointed out correctly, only a registered national or Community trademark which has not yet expired shall be considered as a Prior Right mentioned in Article 10.1. of the Regulation 874/2004.

In this respect, there is no discussion between Complainant and Respondent regarding the submission in due time of the Documentary Evidence relating to the Prior Right.

Respondent acknowledges that Mrs. REBELO applied for the Domain Name on December 7, 2005 and that the Documentary Evidence, including a licence declaration, was submitted before the deadline of January 16, 2006.

Moreover, Respondent admits that the Validation Agent has made a mistake. Respondent acknowledges also that it clearly results form the Documentary Evidence that the Prior Right had not yet expired and that the name of the owner of the Prior Right had been changed.

In its Response to Complaint, Respondent does not request the Panel to dismiss nor to sustain the Complaint.

It results from the Response to Complaint submitted by Respondent that Respondent acknowledges that the Prior Right has been renewed in time and, as a consequence, has not yet been expired.

In its Response to Complaint Respondent also acknowledges that Complainant is the owner of the Prior Right.

As a result, the Panel finds that the decision to reject the application by Mrs. REBELO, Licensee of the Prior Right, and legitimate applicant according the "Licence Declaration of a Registered Trade Mark (.eu Phased Registration)", as provided by Chapter V, Section 20.1. of the Sun Rise Rules, conflicts with Regulation 874/2004 and/or with the Regulation 733/2002.

In its Complaint, Complainant contends also that, notwithstanding the fact that the Prior Right consists of the words "TELEPAC PORTUGAL", the Domain Name fully complies with the provisions of Article 10.2. of the Regulation 874/2004 and that the Domain Name corresponds exactly to the complete name for which the Prior Right exists. According to Complainant, the term PORTUGAL cannot be considered as being a part of the trademark. In this respect, Complainant refers to Article 78º, §4° of the Portuguese Industrial Property Code of August 24, 1940 (hereinafter: "P.I.P.C."), which was applicable at the time of application for and registration of the Prior Right. According to Article 78°, §4° of the P.I.P.C., trademarks related to national products must include the term "PORTUGAL".

The Panel notes that Respondent invokes article 10.2 of the Regulation 874/2004 as one of the legal grounds for its decision to reject the application by Mrs. REBELO for the Domain Name, but does further in its Response to Complaint not explain nor motivate its decision to reject the application by Mrs. REBELO for the Domain Name on this ground. As a consequence, the Panel concludes that Respondent does not longer persist in its argumentation in this respect.

Moreover, the Panel refers in this respect to Chapter V, Section 19.3. of the Sun Rise Rules, stating "For trade marks, the references "TM", "SM", "®" and the like do not form part of the complete name for which the relevant Prior Right exists.". From the wording of Chapter V, Section 19.3. results that the enumeration of the "references" mentioned herein is not exhaustive.

As proved by Complainant, and not contested by Respondent, the inclusion of the term "PORTUGAL" was mandatory for trade marks related to national products/services. As results from the Case File, this was the case for telecommunications and data communication at the time the initial trade mark holder applied for the Prior Right. Therefore, the Panel finds that the inclusion of the word "PORTUGAL" in the Prior Right can be considered as a reference that does form part of the complete name for which the relevant Prior Right exists.

As a result, the Registry should have accepted Mrs. REBELO's application for the Domain Name in accordance with Article 14 of the Regulation 874/2004 which states: “The Registry shall register the domain name, on the first come, first served basis, if it finds that the applicant has demonstrated a prior right”.

Given the above, and since the sole object and purpose of an ADR Proceeding against the Registry is to verify whether the relevant decision by the Registry conflicts with the Regulation 874/2004 and/or with the Regulation 733/2002, the Panel unanimously concludes that the rejection by Respondent of the application for the Domain Name by Mrs. REBELO conflicts with the aforementioned Regulations.

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 and the domain name <telepac.eu> be transferred to the Applicant, Mrs. Dolores REBELO.

PANELISTS

Name	**Isabelle Leroux**

DATE OF PANEL DECISION 2006-08-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Complainant is licensor of the Portuguese trademark "TELEPAC PORTUGAL" (hereinafter: “Prior Right”). During the Sunrise Period, licensee (i.e. Mrs. Dolores REBELO, hereinafter: “Mrs. REBELO”) applied for the domain name <telepac.eu> (hereinafter: "Domain Name").

The Registry rejected the application for the Domain Name essentially because he found that the trademark was expired and that only a registered national or Community trademark which has not yet expired can be considered as a prior right mentioned in Article 10.1. of the Regulation 874/2004.

Complainant contends that the decision of the Registry to reject the application for the Domain Name is in conflict with the EC Regulations on .eu domain names.

As regards the initiating of an ADR procedure, the Panel finds such procedure may be initiated by any person or entity by submitting a Complaint (Article 22.1. of the Regulation 874/2004 and § B.1 (a) of the ADR Rules). In the present case, the Complaint has been submitted by Complainant, owner and licensor of the Prior Right. Complainant thus has a legitimate interest to request the annulment of the decision of Respondent to reject the application for the Domain Name by Mrs. REBELO.

The Panel notes that Respondent admits that the Validation Agent has made a mistake and that Respondents acknowledges that it clearly results form the Documentary Evidence that the Prior Right had not yet expired and that the name of the owner of the Prior Right had been changed.

Moreover, in its Response to Complaint, Respondent does not request the Panel to dismiss nor to sustain the Complaint.

Respondent initially also contended that the conditions of article 10.2 of the Regulation 87/2004 were as not met. However, in its Response to Complaint Respondent did not explain nor motivate its decision in this respect. Therefore, the Panel concludes that Respondent does not longer maintain this ground for rejection.

Moreover, the Panel refers in this respect to Chapter V, Section 19.3. of the Sun Rise Rules, stating "For trade marks, the references "TM", "SM", "®" and the like do not form part of the complete name for which the relevant Prior Right exists.". From the wording of Chapter V, Section 19.3. results that the enumeration of the "references" mentioned herein is not exhaustive.

As proved by Complainant, and not contested by Respondent, the inclusion of the term "PORTUGAL" was mandatory for trade marks related to national products/services. As results from the Case File, this was the case for telecommunications and data communication at the time the initial trade mark holder applied for the Prior Right. Therefore, the Panel finds that the inclusion of the word "PORTUGAL" in the Prior Right can be considered as a reference that does form part of the complete name for which the relevant Prior Right exists.

As a result, the Registry should have accepted Mrs. REBELO's application for the Domain Name in accordance with Article 14 of the Regulation 874/2004.

Given the above, and since the sole object and purpose of an ADR Proceeding against the Registry is to verify whether the relevant decision by the Registry conflicts with the Regulation 874/2004 and/or with the Regulation 733/2002, the Panel unanimously concludes that the rejection by Respondent of the application for the Domain Name by Mrs. REBELO conflicts with the aforementioned Regulations. Therefore, the Panel orders that the EURid's decision be annulled and the domain name <telepac.eu> be transferred to the Applicant, Mrs. Dolores REBELO.