Panel Decision for dispute CAC-ADREU-000865

Case number	**CAC-ADREU-000865**
Time of filing	**2006-04-21 09:22:24**
Domain names	**hi.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Koninklijke KPN N.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 other legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant entitled “Koninklijke KPN N.V.” (hereinafter KPN) is a telecom provider having its statutory seat in Hague, in the Netherlands. On June 27, 1998, the Complainant's corporate name was changed from "Koninklijke PTT Nederland N.V." into "Koninklijke KPN N.V." The name change was effected by an amendment of the articles of association. The articles were changed by a deed whose copy is attached to the complaint.

On January 18, 2006 the Respondent (EURid) received its application for “HI.EU” domain name in the first part of phased registration (Sunrise Phase I) within the meaning of Articles 10 et seq. of the REGULATION (EC) 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). To support the existence of its prior rights, i.e., a Benelux trademark “HI” No. 597311 applied for on January 23, 1996 and registered originally in the name of “KONINKLIJKE PTT NEDERLAND N.V.”, it submitted in time (on January 30, 2006) a certificate of the aforementioned trademark registration dated June 2, 1997. The Respondent rejected the complainant’s application on March 7, 2006. The complaint is directed against that respondent’s decision.

A. COMPLAINANT

The Complainant first gives an explanation regarding its name change outlined above. It asserts that the Benelux “HI” trademark was originally registered in the name of "Koninklijke PTT Nederland N.V." (hereinafter PTT). The Benelux Trademark Office issued a formal proof of registration document, which was sent to the registrant PTT. A copy of this official document is attached to the Complaint.

As the trademark was legally due to expire on January 23, 2006, the Complainant submitted a request for renewal to the Benelux Trademark Office, which confirmed reception of the request. The confirmation of receipt was attached to the complaint. The confirmation of receipt explicitly states on the top of the page, that the information on the confirmation sheet is identical to the information filed and documented about the trademark and its holder in the Benelux Trademark Register. Therefore, on the date the Benelux Trademark office received the request for renewal of the trademark hi, the trademark had registration number 0597311, and the trademark holder was Koninklijke KPN N.V. The date the request for renewal was received is August 2, 2005. The request for renewal was granted. Annexed to the complaint is a copy of the trademark registration from the online trade mark register of the Benelux Trademark Office which also shows the new expiry date of January 23, 2016, as well as the date the renewal was officially published: January 20, 2006.

The Registry’s decision to reject Complainant’s application for hi.eu could be based on two arguments, both of them are refuted below:

1. If EURid decided to reject the application because the registrant mentioned on the extract from the Benelux Trademark Register (PTT) was supposedly not the same as the applicant (KPN), this decision is based on a false assumption. PTT changed its name into KPN in 1998, and KPN is therefore holder of the trademark.
2. If the domain application was rejected because the evidence for renewal of the trademark was not submitted, this is simply because KPN had not received it yet. The certificate was not published until January 20, 2006. After publication a certificate of renewal was sent to KPN afterwards. A copy of this certificate is attached to the complaint. As KPN had to submit its documentary evidence for hi.eu before January 27, 2006 it did not submit a copy of the certificate of renewal at that time for the simple reason that it had not received the certificate yet. The trademark was due to expire on January 23, 2006, so the right was valid on the application date of December 7, 2005. The registration is now valid until January 2016.

[There are several discrepancies in dates mentioned in this part of the complaint with which will be dealt in the next section of this decision.]

The Complainant considers the Respondent's decision unjust and it requests annulment of that decision and transfer of the domain name HI.EU to it.

In its Non-Standard Communication dated July 19, 2006, the Complainant states that given the fact that the Respondent has not complied with the deadline for submission of its response, the Panel should disregard the EURid's response to the complaint. Moreover, the Panel should consider EURid's failure to comply as a ground to accept the Complainant's claim: attribution of the domain name hi.eu to Koninklijke KPN N.V.

B. RESPONDENT

The Respondent neither filed the response within the prescribed deadline nor challenged the notification of default. But on June 28, 2006, it submitted a Non-Standard Communication according to Paragraph A2 (k) of the .eu Alternative Dispute Resolution Rules (hereinafter ADR Rules), where it presents its position why the complaint should be dismissed.

The Respondent quotes pertinent provisions of Regulation 874/2004 and The .eu Registration Policy and the Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter Sunrise Rules) for the reasoning of rejection of Complainant's application. It submits that the Registry concluded from its examination of the documentary evidence that the Complainant was not the actual owner of the HI trademark. The Complainant submitted an extract from the Benelux Trademark Register in support of its application. This extract mentioned a different company as the owner of the HI trademark and the Registry therefore rejected the Complainant's application.

The Respondent asserts that the Complainant failed to submit an official document showing the name change with its application according to Section 20 (3) of Sunrise Rules. Therefore, the Registry could not have known that the Complainant was indeed the same entity as the entity mentioned in the extract of the Benelux Trademark Register.

With respect to the deed annexed to the complaint, the Respondent argues that the Complainant failed to submit such a document with its application. Section 21 (2) of the Sunrise Rules clearly states that only the first set of documentary evidence received by the Registry shall be examined. Consequently, the Complainant should have proved with the first set of documents that it is the holder of a prior right in the name HI. The Complainant should thus have provided the Registry with the deed at the time of the application, not for the first time in the framework of the present ADR proceedings. This deed, , which moreover does not appear to be an official document, should thus be disregarded by the Panel.

DISCUSSION AND FINDINGS

1. Respondent's default to submit a response
Before the Panel commences examining merits of this case, it must first deal with the preliminary question, which is Respondent's default to file the response to the complaint within given deadline.

Pursuant to Article 22 (8) of Regulation 874/2004 together with paragraph B3 (a) of the ADR Rules the respondent shall submit a Response to the Provider within thirty working days of the date of the delivery of the Complaint. As it has been indicated above, the Respondent neither submitted its response within the aforementioned time period nor challenged the notification of default from the Czech Arbitration Court.

Paragraph B3 (f) of the ADR Rules states that "if a Respondent does not submit a Response or submits solely an administratively deficient Response, the Provider shall notify the Parties of 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."

According to paragraph B8 of the ADR Rules, it is solely up to the Panel's discretion whether or not to admit further statements or documents from either of the parties in addition to the complaint or the response.

It is obvious that the Respondent's Non-Standard Communication of June 28, 2006 is an administratively deficient response. In the light of paragraph B3 (f) of the ADR Rules, the Panel will use it purely for its information and other than that will not take it into consideration while deciding this case.

Within the meaning of Article 22 (10) of Regulation 874/2004 and paragraph B10 (a) of ADR Rules, in a case of failure of any party to respond within the prescribed deadlines, the Panel may consider to accept the claims of the counterparty.

2. Analysis of Complainant's arguments
First, the Panel points out that the notification of rejection of the complainant's application dated March 7, 2006, whose English translation is attached to the complaint, is not supported by any concrete ground why the application was not accepted. In that notification, there is only a brief statement that the sent documentary evidence was insufficient to prove the existence of claimed prior right. Therefore, the Complainant brings two possible grounds of refusal of its application by the Respondent that are examined below. Even though it is possible to determine what was the motivation of EURid's decision in this case, the Panelist is of opinion that the Respondent should have reasoned its decision in more detail to allow the Complainant to precisely challenge that decision in an ADR proceeding.

2.1 Difference in name of the applicant and trademark proprietor due to a name change
The Complainant alleges that if the Respondent's decision is based on the ground that the registrant mentioned in the extract from the Benelux Trademark Register (PTT) was supposedly not the same as the applicant (KPN), this decision is based on a false assumption because in 1998, PTT changed its name into KPN and KPN is therefore holder of the trademark.

To decide on the Complainant's assertion, legal and factual issues must be examined:

Article 10 (1) of Regulation 874/2004 provides that holders of prior rights 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 that prior rights shall be understood to include, inter alia, registered national and community trademarks.

Pursuant to Article 14 (4) of Regulation 874/2004, every Applicant shall submit documentary evidence that shows that he or she is the holder of prior right claimed on the name in question and this documentation shall be submitted to the Validation Agent within forty days from the submission of an application for the domain name.

It is also worth mentioning that the Sunrise Rules apply to all applications during Sunrise Period by virtue of Article 3 (d) of Regulation 874/2004 under which the request for domain name registration shall include an undertaking from the Applicant that it shall abide by all terms and conditions for registration. Thus, the Applicant (Complainant) is also bound by the Sunrise Rules.

The Complainant states that it is the owner of Benelux "HI" trademark. Hence within the meaning of Article 14 (4) of Regulation 874/2004, it had to provide documentary evidence that shows that it is the holder of the prior right claimed on the name in question. Section 13 (2) of Sunrise Rules further clarifies that the documentary evidence must clearly evidence that the Applicant is the reported owner of the registered trademark. The burden of proof in that respect lies with the Applicant (Complainant) who must prove existence of the prior right. This conclusion is consistent with opinion in case No. 00127 (BPW) reiterated in subsequent decisions, for instance, 00232 (DMC) or 00294 (COLT).

On January 30, 2006, the Validation Agent received the Complainant's documentary evidence consisting of a certificate of "HI" trademark registration No. 597311 issued by the Benelux Trademark Office. This submitted documentary evidence, which was disclosed by EURid upon the request of the Czech Arbitration Court during the ADR proceeding, shows that the name of the "HI" trademark applicant is "KONINKLIJKE PTT NEDERLAND N.V." and its address being Stationsweg 10, 9726 AC Groningen, the Netherlands. The name of the organization applying for "HI.EU" domain name is "Koninklijke KPN N.V." with address Postbus 3000, 2500GA Den Haag, Netherlands.

As indicated in previous paragraph, the name of the trademark owner and the domain name Applicant vary substantially. There is only one initial word "Koninklijke" identical together with the identifier "N.V.", The remaining word elements are different ("PTT Nederland" x "KPN"). Complainant argues that this is due to its name change occurred in June 1998.

But Sunrise Rules contain pertinent provision dealing, inter alia, with that type of situation, i.e., a name change of the Applicant and its prove. Section 20 (3) of Sunrise Rules provides that "If, for any reasons other than as are referred to in Section 20(1) and 20(2) hereof, the Documentary Evidence provided does not clearly indicate the name of the Applicant as being the holder of the Prior Right claimed (e.g. because the Applicant has become subject to a name change, a merger, the Prior Right has become subject to a de iure transfer, etc.), the Applicant must submit official documents substantiating that it is the same person as or the legal successor to the person indicated in the Documentary Evidence as being the holder of the Prior Right." This provision was an object of a short discussion in Case No. 00253 (SCHOELLER), where the Panelist states "It is a moot point as to whether this section places the onus on the Applicant to submit official documents at the time of the filing of the application or whether these official documents may be requested/supplied at a later date." But in that case none of the situations, such as, name change, merger etc. were at issue. In the Panelist's point of view in the present case, the Applicants must submit this official documents together with documentary evidence for claiming their prior rights on condition that the event (name change, merger etc.) took place prior to submission of the documentary evidence. This conclusion is supported by the wording of Section 21 (2) of Sunrise Rules under which "the Validation Agent examines 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 received..." Thus, if the Applicants furnished the official documents anticipated in Section 20 (3) of Sunrise Rules after submitting documentary evidence for their prior rights, they would not be taken into account during the registration process. Logically, It would not be appropriate to file them prior to documentary evidence either.

In this stage, the Panel, considering the Complainant's burden of proof with respect to its prior rights, concludes that the Respondent could not have been aware of the name change on the part of the Complainant without having at its disposal any pertinent document proving that fact. Therefore, it did not err in its decision to reject the Complainant's application.

However, the Complainant attached to its complaint several documents for the purpose of showing the occurrence of the name change and ownership of "HI" trademark. All annexes to the complaint were made in Dutch followed by their translation into language of the ADR proceeding, being English. The documents are the following:
1. Notification of rejection of Complainant's application dated March 7, 2006, which was previously mentioned at the beginning of point 2.
2. The deed from June 27, 1998 by its virtue were amended the articles of association and due to that also the Complainant's corporate name from "Koninklijke PTT Nederland .N.V." into "Koninklijke KPN N.V.".
3. The certificate dated June 2, 1997 of Benelux "HI" trademark registration No. 597311 – this certificate includes identical information as the one submitted to the Validation Agent described above.
4. Benelux Trademark Office's confirmation of receipt of a request for renewal the "HI" trademark – it, inter alia, contains registration details that are recorded in Benelux Trademark Register. The trademark applicant is "Koninklijke KPN N.V." and its address Maanplein 55, 2516 CK The Hague, the Netherlands. Renewal application date is August 2, 2005.
5. Copy of trademark registration from on-line trademark register of the Benelux Trademark Office – the information regarding the trademark applicant are the same as in previous document. The renewal's publication date is January 20, 2006 and expiration date January 23, 2016.
6. Certificate of renewal dated January 20, 2006 – this document confirms again that the name of the applicant is "Koninklijke KPN N.V.".

From the relevant documents presented by the Complainant, it is apparent that it is the proprietor of Benelux "HI" trademark No. 597311. In that context, the Panel must determine whether these documents may be admitted as evidence substantiating prior rights. Paragraph B11 (a) of the ADR Rules states that a Panel shall decide a complaint on the basis of the statements and documents submitted. This provision perfectly fits especially in a concept of disputes between a domain name holder and a third person, where the parties may enclosed with their submissions any materials that they feel to prove their claims. But in cases, where domain names are applied for in Sunrise period, their registration process is subject to specific rules prescribing also required documents for substantiating prior rights, including the deadline within which they must be submitted. The ADR proceeding cannot substitute the validation and registration process governed by these rules. If the Panel admitted the documents filed by the Complainant, it would put it self into a role of quasi-validation or registration entity which would go beyond its powers. This is in compliance with the statement in the preceding text of the ADR Rules that "The interpretation and application of these ADR Rules will be done in the light of the EU legal framework which will prevail in case of conflict." In Case No. 00219 (ISL), the Panel mentions that "Unfortunately to the Complainant the documentation and validation is not an issue for the Panel under an ADR proceeding." and in Case No. 00119 (NAGEL) and subsequently in Case No. 00894 (BEEP) is stated "If there would be exceptions in favour of the Applicant, allowing additional submissions of evidence after the forty day period, it would affect the legitimate expectancy of the next Applicant in the queue for the domain name in question and conflict with the "first-come-first-served" principle set out in Article 14 of the Commission Regulation (EC) No 874/2004."Therefore, the Panel is of opinion that the documents provided by the Complainant within the ADR proceeding cannot constitute a basis for annulment of the Respondent's decision which does not breach any of the EU Regulations in question.

2.2 Not-submitting a renewal certificate
The Panel comes to a conclusion that lack of submission of renewal certificate of "HI" trademark is not at issue in this case. Under Section 11 (3) of Sunrise Rules, “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.” The Complainant applied for “HI.EU” domain name on January 18, 2006 and its trademark would expire on January 23, 2006. Thus, its trademark was valid on the date (January 18, 2006) on which the Registry received that application.

The Complainant – probably by an accident – states that the due date for filing the documentary evidence was January 27, 2006 when in fact it was February 27, 2006. It points out that its right was valid on the application date of December 7, 2005. To check the correctness of these dates, the Panel had made its own investigation in WHOIS database and found out that the Complainant applied for the “HI.EU” domain name on December 7, 2006 but this application expired because the documentary evidence was not received by the Processing Agent within 40 calendar days following the date of receipt of the application by the Registry. The next application was filed on January 18, 2006 whose rejection is subject of this ADR proceeding. There are a few more other applications from different Applicants for that domain name in the queue.

3. Conclusion
By virtue of Article 22 (1) (b) of Regulation 874/2004 in connection with paragraph (11) of the same article of that Regulation, the ADR panel is entitled only to decide whether a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) 733/2002.

The Panel had carefully considered all facts of this case and did not find any breach of the aforesaid Regulations on the part of the Respondent. The Panel cannot speculate why the Complainant did not submit the relevant documents proving its name change and existence of its prior right during the validation and registration process; the Complainant does not explain that. The situation might have been entirely different for the Complainant if, for example, it mentioned information regarding its name change in the application or it submitted with the documentary evidence at least the deed attached to the complaint and despite of that, the Respondent would reject its application. Unfortunately, it did not happen.

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	**Radim Charvat**

DATE OF PANEL DECISION 2006-08-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant changed its corporate name from “Koninklijke PTT Nederland N.V.” into “Koninklijke KPN N.V.” in June 1998. It filed an application for “HI.EU” domain name in Sunrise Phase I based on Benelux “HI” trademark originally applied for and registered in the name of “Koninklijke PTT Nederland N.V.” . As documentary evidence, it submitted a certificate of the aforementioned trademark registration (dated June 2, 1997) where the name of the trademark applicant was “Koninklijke PTT Nederland N.V.”. The Complainant challenges the Respondent’s (EURid’s) decision to reject its domain name application and requests annulment of that decision and transfer of the domain name HI.EU to it.

1. Respondent’s default to submit a response
The Respondent neither filed the response within the prescribed deadline nor challenged the notification of default. On June 28, 2006, it submitted a Non-Standard Communication according to Paragraph A2 (k) of the ADR Rules where it presents its position why the complaint should be dismissed.
In the light of paragraph B3 (f) of the ADR Rules, the Panel used that administratively defficient response purely for its information and other than that did not take it into consideration when deciding this case.

2.Analysis of Complainant’s arguments
First, the Panel points out that the notification of rejection of the complainant’s application is not supported by any concrete ground why the application was not accepted. In that notification, there is only a brief statement that the sent documentary evidence was insufficient

to prove the existence of claimed prior right. Therefore, the Complainant brings two possible grounds of refusal of its application by the Respondent that are examined below. Even though it is possible to determine what was the motivation of EURid's decision in this case, the Panelist is of opinion that the Respondent should have reasoned its decision in more detail to allow the Complainant to precisely challenge that decision in ADR proceeding.

2.1 difference in name of the applicant and trademark proprietor due to a name change
The Complainant alleges that if the Respondent's decision is based on the ground that the registrant mentioned in the extract from the Benelux Trademark Register was supposedly not the same as the applicant, this decision is based on a false assumption because in 1998, it changed its name and "Koninklijke KPN N.V." is therefore holder of the trademark.
Considering the Complainant's burden of proof with respect to its prior rights and wording of relevant provisions governing registration of .eu domain names in Sunrise Period, the Panel concludes that the Respondent could not have been aware of the name change on the part of the Complainant without having at its disposal any pertinent document proving that fact. Therefore, it did not err in its decision to reject the Complainant's application.
The Complainant also attached to its complaint several documents from which it is apparent that it is the proprietor of Benelux "HI" trademark. In cases where domain names are applied for in the Sunrise period, their registration process is subject to specific rules prescribing also required documents for substantiating prior rights including the deadline within which they must be submitted. The ADR proceeding cannot substitute the validation and registration process governed by these rules and therefore, the Panel is of opinion that the documents provided by the Complainant within the ADR proceeding cannot constitute a basis for annulment of the Respondent's decision which does not breach any of the EU Regulations in question.

2.2 not-submitting a renewal certificate
The Panel comes to a conclusion that lack of submission of renewal certificate of "HI" trademark is not at issue in this case. The Complainant's trademark was valid on the date on which the Registry received that application which is compliant with Section 11 (3) of Sunrise Rules.

3. Conclusion
The Panel had carefully considered all facts of this case and did not find any breach of Regulation (EC) 874/2004 or Regulation (EC) 733/2002 on the part of the Respondent.

The Panel rejected the complaint.