Panel Decision for dispute CAC-ADREU-000894

Case number	**CAC-ADREU-000894**
Time of filing	**2006-04-26 11:17:57**
Domain names	**beep.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Richard Canten**

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

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

On December 7, 2005, the Complainant filed a request for registration of the domain name <beep.eu> in the name of “BEEP! Easy mobile tickets”.

On December 23, 2005, the Respondent received documentary evidence consisting of an extract from the Benelux Trademark Office indicating that the word BEEP is registered in the name of “Imtech ICT Consultancy B.V.”.

Any other document, such as a license agreement or declaration between the Complainant and the registered owner of the trademark was not submitted.

The Respondent rejected the request for registration on the grounds that the documentary evidence submitted by the Complainant did not show that the Complainant was the owner or the licensee of the BEEP trademark.

The Complainant filed a Complaint which was received by e-mail on April 25. The Czech Arbitration Court (“CAC”) notified the Complainant on May 3, 2006 that a signed hardcopy of the Complaint was missing and that the registrar with whom the disputed domain name was registered had to be identified. On May 9, 2006, CAC received the Complaint in hardcopy and after the compliance review, CAC declared that the formal date of the commencement of the ADR proceeding was May 9, 2006.

The Respondent submitted a Response on June 28, 2006.

On July 4, 2006 CAC appointed Johan Sjöbeck as panellist.

A. COMPLAINANT

The Complainant requests that the Registry’s decision to deny Complainant the domain name <beep.eu> according to paragraph B11(c) of the ADR rules shall be annulled.

The Complainant applied for the domain name during Sunrise in the name of BEEP! Easy Mobile Tickets B.V. The application was rejected because the submitted evidence was insufficient. One crucial document was missing by mistake and the Complainant requests to set this straight my means of this ADR proceeding.

The word BEEP is registered as a trademark for the Benelux in the name of Imtech ICT Consultancy B.V.

The Complainant BEEP! Easy Mobile Tickets B.V. is a subsidiary of Imtech ICT Consultancy B.V. which is the sole shareholder of BEEP! Easy Mobile Tickets B.V.

Imtech ICT Consultancy wanted its subsidiary BEEP! Easy Mobile Tickets to apply for the domain name <beep.eu>. BEEP! Easy Mobile Tickets had to submit evidence to EURid in order to support its claim to a Prior Right. It submitted evidence that Imtech ICT Consultancy was the owner of the trademark BEEP.

However, due to an internal mistake, the license declaration form was not included with the evidence. The application was rejected by the validator because the license declaration was missing. By initiating this ADR, the Complainant wishes to repair the mistake that it made when submitting the evidence and requests that EURid's decision is annulled and that the domain name <beep.eu> is granted to BEEP! Easy Mobile Tickets.

B. RESPONDENT

The Respondent contends as follows:

The applicant must not necessarily be the actual owner of a Prior Right in the corresponding domain name. The applicant may be licensed by the actual owner to use the Prior Right in applying for the corresponding domain name. Pursuant to article 12(2) of the Regulation licensees of a trademark owner may also apply for the corresponding domain name.

Section 20(1) of the Sunrise Rules states that if an applicant has obtained a license for a registered trademark in respect of which it claims a Prior Right, it must enclose with the documentary evidence an acknowledgement and declaration form duly completed and signed by both the licensor of the relevant registered trademark and the applicant (as licensee).

Article 10(1) of the Regulation states that only the holder of a Prior Right is eligible to be granted the corresponding domain name. It is therefore of great importance that the Registry is provided with all information that allows it to assess if the applicant is the holder of a Prior Right. Pursuant to article 14(4) of the regulation, the documentary evidence must clearly show that the applicant is the holder of the Prior Right claimed on the name in question.

The Complainant had submitted only an extract from the Benelux Trademark Office in support of its application. This extract mentioned a different company as the owner of the BEEP trademark. The documentary evidence did not prove that the Complainant was the owner or licensee of the BEEP trademark. The Respondent argues that it is very clear that the actual owner of the BEEP trademark did not apply for the domain name <beep.eu> and that there was no license declaration with the application. Since the Complainant is not the owner of the BEEP trademark and since the Complainant failed to submit a license declaration with its application, the Registry concluded that the Complainant was not the holder of a Prior Right and therefore rejected the Complainant's application.

According to article 22(1)b of the Regulation, an ADR procedure may be initiated by any party where a decision taken by the Registry conflicts with the Regulation or with Regulation (EC) No 733/2002. The mistake was made by the Complainant and not by the Registry. The Complainant itself blames on an "internal mistake" when submitting the application. The Registry's decision was correct and may not be annulled as a result of an error made by the Complainant.

The license declaration should have been provided at the time of the application, not in the ADR proceeding and thus, the panel should disregard the license declaration and reject the Complaint.

DISCUSSION AND FINDINGS

It is an uncontested fact in this case that the Complainant, BEEP! Easy Mobile Tickets B.V., submitted a trademark extract from the Benlux Trademark Office for the trademark BEEP when applying for the domain name <beep.eu> during the Sunrise period. The submitted trademark extract indicates that the owner of the trademark is Imtech ICT Consultancy B.V.

Furthermore, it is also an uncontested fact that the Complainant failed to submit a license declaration when applying for the domain name <beep.eu> during the Sunrise period due to an "internal mistake" by the Complainant.

Having the above in mind, the question is whether the Registry's decision to reject the Complainant's application for the domain name <beep.eu> was correct or not.

The purpose of the Commission Regulation (EC) No 874/2004 is to grant domain names during the Sunrise period on first come first served basis provided that an applicant can demonstrate a right which is prior to the domain name application. According to paragraph 4 of Article 14 of the said Regulation, every applicant shall submit documentary evidence that shows that he or she is the holder of the Prior Right claimed in question and if such documentary evidence has not been received within forty days from the domain name application, the application for the domain name shall be rejected.

Furthermore, according to the .eu Registration Policy and the Terms and Conditions for Domain Name Applications made during the Phased Registration Period ("Sunrise Rules") under Section 13.2 it states that the documentary evidence must clearly evidence that the Applicant is the reported owner of the registered trademark and in case the Applicant is a licensee of a registered trademark, a license declaration signed by both the licensor of the trademark and the applicant (as licensee) must be enclosed, according to Section 20.1.

Therefore, where the Prior Right claimed is a trademark, the burden of proof regarding ownership and license declaration is placed on the Applicant (Complainant) of the domain name. EURid and the validation agent have to rely upon the documentary evidence submitted by the Applicant and from the submitted evidence in the present case, it was clear that the Applicant of the domain name <beep.eu> was not the same company as the owner of the trademark BEEP. Thus, the Complainant failed to submit the relevant evidence regarding the license declaration within the forty day period set out in Article 14.

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. Consequently, the license declaration submitted by the Complainant in this ADR proceeding cannot be admitted as evidence substantiating a Prior Right.

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	**Johan Carl Sjöbeck**

DATE OF PANEL DECISION 2006-07-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested a decision by the Registry to reject the request to register the domain name <beep.eu> during the Sunrise period. The Applicant and the registered owner of the submitted trademark were not identical and due to an "internal mistake" the Complainant failed to submit a license declaration within the forty day period. The Registry rejected the domain name due to insufficient substantiation of a Prior Right.

The license declaration indicating that the Complainant was a licensee should have been submitted within the forty day period. The license declaration submitted by the Complainant in the Complaint cannot be admitted as evidence substantiating a Prior Right.