Panel Decision for dispute CAC-ADREU-000947

Case number	**CAC-ADREU-000947**
Time of filing	**2006-09-26 10:53:33**
Domain names	**infraplan.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Pool 91 Werbeagentur GmbH**

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 pending or decided legal proceedings in relation to the disputed domain name.

FACTUAL BACKGROUND

The Complainant launched a Complaint with the Czech Arbitration Court on April 20, 2006 to seek the annulment of EURid's Decision not to register the domain name <infraplan.eu> and the attribution of the domain name <infraplan.eu> to the Complainant. Following a payment check, the Czech Arbitration Court notified the Complainant on April 27, 2006 that the Complainant had not paid the fees due in accordance with the ADR Supplemental Rules and it requested the Complainant to pay the fees due within ten days of the date of the Notification and e-mail a copy of the payment transfer order to the Czech Arbitration Court.

The Complainant's authorized Representative provided copies of the transferring bank's correspondence with the Complainant on two occasions, confirming the transfer of the fees. As the first attempt to transfer the fees on April 5, 2006 did not reach the Czech Arbitration Court, the Complainant, upon notification of the return of the payment, immediately arranged for a retransfer of the fees on May 4, 2006 and requested an extension of the deadline of ten days to pay the fees.

On September 19, 2006, under the extraordinary circumstances the Czech Arbitration Court decided to open the case, although the fees had not been received at that time. On September 26, it was confirmed that the payment of the fees had taken effect.

The Czech Arbitration Court, after assigning as Time of Filing the date of September 26, 2006, requested EURid to verify a number of issues and to disclose the Documentary Evidence related to the disputed domain name on September 26, 2006.

On October 4, 2006 the Czech Arbitration Court stated that the ADR Proceeding should continue, because it was initiated within the Sunrise Appeal Period, despite the fact that the disputed domain name had been activated on May 28, 2006.

In response to Complainant's request to the Czech Arbitration Court to require EURid to disclose the Documentary Evidence as defined in the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereafter "Sunrise Rules"), the Respondent disclosed, inter alia, the Documentary Evidence on October 9, 2006.

On October 9, 2006 the Czech Arbitration Court notified the commencement of the ADR Proceeding, informing the Respondent that the Respondent's Response was to be submitted within 30 working days from the delivery of the notification.

The Respondent submitted a Response on November 17, 2006, which was acknowledged by the Czech Arbitration Court on November 20, 2006.

Following an invitation to serve as a Panelist in this dispute, the Panelist accepted the mandate and submitted a Declaration of Impartiality and Independence in due time. The Czech Arbitration Court duly notified the Parties of the identity of the Panelist appointed on November 21, 2006, in accordance with Paragraph B4(e) of the .eu Alternative Dispute Resolution Rules (hereafter "ADR Rules") and the date, by which a Decision on the matter was due, which was specified as December 18, 2006.

In the absence of a challenge of the Panelist's appointment by either Party according to Paragraph B5(c) of the ADR Rules, the Czech Arbitration Court forwarded the case file to the Panel on November 24, 2006.

Following the transmission of the case file to the Panel, the Complainant filed a non-standard communication on December 5, 2006, incorporating additional observations in the pending case for consideration by the Panel.

A. COMPLAINANT

The Complainant in its Complaint contends that the Complainant is the legitimate licensee of the owner of the trademark "Infraplan", registration No. 39857929, registered on March 29, 1999 at the German Patent and Trademark Office for classes 36 and 37.

The Complainant contends that the Complainant had no indication that the signed confirmation that the Complainant is the licensee of the trademark claimed as prior right and attached to the cover letter was not sufficient to prove the Complainant's right as a licensee. The Complainant contends that it is not clear from the cover letter that there must be evidence submitted other than with respect to the prior right claimed, since only the latter is explicitly mentioned in the cover letter. The Complainant also contends that the statement provided by the Complainant in the cover letter confirmed with the Complainant's signature has from an evidentiary point of view as much weight as a mutual signature under a license agreement. Therefore, the Complainant contends that the timely filed evidence is sufficient to prove the claimed prior right and the fact that the Complainant is a licensee of the owner of the claimed prior right.

The Complainant further contends that any decision of a state, interstate or other authority must consider the right to be heard, which necessarily includes the possibility of a notification informing a natural or a legal person applying for a right or property of an obvious mistake and the related possibility to correct such an obvious mistake. The Complainant contends that, if the evidence submitted in the Complainant's domain name application is not considered to be sufficient, the validation agent, but at least the Registry, should have recognized that the Complainant's filing was only a consequence of the unclear and ambiguous wording of the standard cover letter. Therefore, the Complainant contends that there was no wrong submission, but only, if at all, a partial submission of entirely correct documents. The Complainant contends that the term "finds" - as every decision of an official authority - requires a careful analysis and consideration of the facts presented to the validation agent and would have accordingly required in this specific case a notification to the Applicant indicating, for example, if this should be the reason for the rejection, a missing document.

As a result, the Complainant contends that the Respondent's decision to reject the domain name application conflicts with the European Union Regulations. Therefore, the Complainant seeks the remedies specified in Paragraph B11(c) of the ADR Rules.

B. RESPONDENT

The Respondent in its Response contends that the Complainant submitted Documentary Evidence consisting of a certificate of registration stating that the German trademark "Infraplan" is registered in the name of "Infraplan Gesellschaft für Infrastrukturplanung, Gewerbe- und Wohnbau mbH & Co. Betriebs KG". The Respondent contends that the Complainant did not submit Documentary Evidence substantiating that the Complainant was licensed by the owner of the trademark or that it was the same person as or the legal successor to the owner of the trademark. The Respondent contends that, based on the Documentary Evidence, the validation agent found that the Complainant did not demonstrate that it was the holder or the licensee of a prior right in the name "Infraplan" and that, therefore, the Respondent rejected the Complainant's application.

The Respondent contends that the Regulation and the Sunrise Rules clearly place the burden of proof on the Domain Name Applicant to substantiate that it is the holder or the licensee of a valid prior right. The Respondent contends that the Complainant failed to submit Documentary Evidence, which substantiates that the Complainant is the holder or the licensee of a valid prior right and that this failure cannot be remedied by the Complainant's unilateral statement contained in the cover letter.

The Respondent further contends that the Respondent and/or the validation agent were under no obligation to investigate into the circumstances of the domain name application.

Finally, the Respondent contends that the license agreement and the license declaration form submitted as Exhibit 2 to the Complaint were only submitted in the framework of this ADR Proceeding, did not form part of the Documentary Evidence submitted in the

framework of the domain name application and should, therefore, not be taken into account by the Panel, when assessing the Respondent's decision to reject the domain name application.

DISCUSSION AND FINDINGS

ISSUES

1. Timely initiation of the ADR Proceeding

Pursuant to Section 26(1) of the Sunrise Rules, the Domain Name Applicant may initiate an ADR Proceeding against a decision of the Registry within forty calendar days following that decision ("Sunrise Appeal Period").

In this particular case, the date of commencement of the Sunrise Appeal Period is March 16, 2006 and the Complainant launched a Complaint with the Czech Arbitration Court on April 20, 2006. The Czech Arbitration Court assigned as Time of Filing the date of September 26, 2006.

In the absence of a clear definition in the Sunrise Rules or the ADR Rules of what exactly amounts to a timely initiation of an ADR Proceeding and in light of the fact that the Complaint of April 20, 2006 was initiated within the time prescribed by Section 26(1) of the Sunrise Rules, the Panel finds that a fair treatment of the Complainant only dictates that the interpretation and approach to be followed is that the timely initiation of the ADR Proceeding should be examined on the basis of the date, on which the Complaint was initiated, irrespective of whether a later Time of Filing was assigned, after the expiry of the forty calendar days for the initiation of an ADR Proceeding against the decision of the Registry.

Therefore, the Panel finds that the Complaint was initiated properly within the prescribed time frame.

2. The Complainant's non-standard communication

Following the transmission of the case file to the Panel, the Complainant filed a non-standard communication on December 5, 2006, incorporating additional observations in the form of reference to case law and its relevance in the pending case for consideration by the Panel.

Paragraph B8 of the ADR Rules states: "In addition to the Complaint and the Response, the Panel may request or admit, in its sole discretion, further statements or documents from either of the Parties."

When exercising its discretion the Panel is, however, bound to observe procedural guarantees and Paragraph B7(b) reads: "In all cases, the Panel shall ensure that the Parties are treated fairly and with equality."

As the Respondent did not challenge the admissibility of the Complainant's non-standard communication and as the Complainant's non-standard communication does not bring forward new factual elements, the consideration of which could be prejudicial to the fair and equal treatment of both Parties in the framework of this ADR Proceeding, the Panel finds the non-standard communication to be admissible.

3. The relevant provisions

This Complaint arises in relation to the application and interpretation of primarily Regulation 874/2004, Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain (hereafter "Regulation 733/2002"), the Sunrise Rules, the Registration Terms and Conditions and is governed by the ADR Rules and the ADR Supplemental Rules.

According to Recital 12 of Regulation 874/2004, in order to safeguard prior rights recognized by Community or national law, a procedure for phased registration should be put in place with the purpose of ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights on a first-come, first-served basis, subject to validation of such rights on the basis of evidence provided by the Applicants. Article 12(2) of Regulation 874/2004 states: "[…] During the first part of phased registration, only registered national and Community trademarks, geographical indications, and the names and acronyms referred to in Article 10(3), may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in Article 10(1)."

The procedure to be followed for validation and registration of applications received during the Phased Registration Period is described in Article 14 of Regulation 874/2004. In particular, Article 14(1) states that "[a]ll 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" and Article 14(4) states that "[e]very applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question. […]" Article 14(7) provides that "[t]he relevant validation agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name. If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this." Finally, Article 14(10) sets out that "[t]he Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in the second, third and fourth paragraphs."

In order to be able to register a .eu domain name during the Phased Registration Period, the Domain Name Applicant needs to satisfy certain requirements set out in Section 3 of the Sunrise Rules.

Section 8(3) of the Sunrise Rules states: "The Applicant or its Document Handling Agent shall be required to:
(i) print out the Cover Letter generated on the web site of the Registry; […]
(iii) sign the Cover Letter;
(iv) enclose the relevant Documentary Evidence referred to in Chapter V; [Sections 10-20] […]"

Section 13(1) of the Sunrise Rules, entitled Registered Trade Marks, clearly states that where the prior right claimed is a registered trademark, it must be registered by a national trademark office, the Benelux Trade Marks Office, OHIM or be internationally registered and protected in at least one of the European Union Member States.

Section 13(2) of the Sunrise Rules specifies the Documentary Evidence to be submitted for registered trademarks and clearly states: "[…] In the foregoing cases, the Documentary Evidence must clearly evidence that the Applicant is the reported owner of the registered trade mark.
In case the Applicant is a licensee or transferee of a registered trade mark referred to in Section 13(1) above, Section 20 hereof shall apply."

Section 20(1) of the Sunrise Rules provides: "If an Applicant has obtained a licence for a registered trade mark referred to in Section 13(1)(i) above in respect of which it claims a Prior Right, it must enclose with the Documentary Evidence an acknowledgement and declaration form, a template of which is contained in Annex 2 hereto, duly completed and signed by both the licensor of the relevant registered trade mark and the Applicant (as licensee). If the Applicant is a sublicensee, it must enclose a second acknowledgement and declaration duly completed and signed by the ultimate owner of the registered trade mark concerned and the latter's licensee."

Sections 20(2) and 20(3) set out the documents to be submitted if an Applicant is the transferee of a prior right or if the Applicant 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.

The examination by the Validation Agent is set out in Section 21 of the Sunrise Rules, where it is specified:
"[…] 2. 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 and scanned by the Processing Agent (including the Documentary Evidence received electronically, where applicable) and in accordance with the provisions of these Sunrise Rules.
3. 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."

The results of the validation are to be communicated to the Registry in accordance with Section 22(1) of the Sunrise Rules.

Article 22 of Regulation 874/2004 concerns the ADR Procedure. It reads: "1. An ADR procedure may be initiated by any party where:
[…] (b) a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002.
[…]
5. The complaints and the responses to those complaints must be submitted to an ADR provider chosen by the complainant from the list referred to in the first paragraph of Article 23. That submission shall be made in accordance with this Regulation and the published supplementary procedures of the ADR provider.
[…]
11. […]
In the case of a procedure against the Registry, the ADR panel shall decide whether a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002.
[…]
The alternative dispute panel shall issue its decision within one month from the date of receipt of the response by the ADR provider. The

decision shall be duly motivated. The decisions of the panel shall be published.
[…]"

Therefore, in this particular case, it is imperative to examine, firstly, whether a prior right was claimed and, secondly, whether the Domain Name Applicant could substantiate that the Domain Name Applicant was the holder, licensee, transferee of the claimed prior right or was otherwise the same person as or the legal successor to the person indicated in the Documentary Evidence as being the holder of the prior right. It is only if Complainant has indeed satisfied all requirements as set out by the relevant European Union Regulations and has proven, in particular, the aforementioned issues at the time of the domain name application that the issue of whether Respondent erred in rejecting Complainant's application arises, as such a decision would conflict with Regulation 874/2004 or Regulation 733/2002.

4. Type of prior right claimed

Article 10 of Regulation 874/2004 reads: "1. Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply 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 and community trademarks, […].
2. 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.
[…]"

In terms of the first issue, whether a prior right was claimed, it can be seen in the Documentary Evidence disclosed by the Respondent in response to the Complainant's request that the Complainant submitted a copy of the official certificate of registration issued for the trademark "Infraplan" by the German Patent and Trademark Office, registration No. 39857929, registered on March 29, 1999 for classes 36 and 37. Since the Documentary Evidence disclosed by the Respondent has not been contested by the Complainant, the Panel is satisfied that the prior right claimed is a national trademark.

In terms of the second issue, whether the Domain Name Applicant could substantiate that the Domain Name Applicant was the holder, licensee, transferee of the claimed prior right or was otherwise the same person as or the legal successor to the person indicated in the Documentary Evidence as being the holder of the prior right, it is imperative to examine the evidence submitted.

5. Relationship between the Domain Name Applicant and the Holder of Prior Right

The Domain Name Applicant was Pool 91 Werbeagentur GmbH, while the trademark holder appears to be Infraplan Gesellschaft für Infrastrukturplanung, Gewerbe- und Wohnbau mbH & Co. Betriebs KG. The Documentary Evidence disclosed by the Respondent, which has not been contested by the Complainant, comprises a copy of the official certificate of registration for the trademark "Infraplan". In light of the disclosed Documentary Evidence, the Panel is satisfied that the Domain Name Applicant, i.e. the Complainant in this ADR Proceeding, in the framework of its domain name application submitted a copy of the official certificate of registration for the trademark "Infraplan".

However, the Domain Name Applicant-Complainant did not submit an acknowledgement and declaration form, a template of which is contained in Annex 2 to the Sunrise Rules, duly completed and signed by both the licensor of the relevant registered trade mark and the Applicant (as licensee), as required by Section 20.1 of the Sunrise Rules, nor did the Domain Name Applicant-Complainant submit any evidence that the Domain Name Applicant is the transferee or was otherwise the same person as or the legal successor to the person indicated in the Documentary Evidence as being the holder of the prior right.

A decision by the Registry can only be annulled if Complainant can prove that such a decision conflicts with the European Union Regulations and the burden of proof is clearly on the Domain Name Applicant to establish a valid prior right, on which it can rely at the time of the domain name application, pursuant to Article 14 of Regulation 874/2004. As the Documentary Evidence disclosed by the Respondent has not been contested by the Complainant, it is clear that the license agreement and the acknowledgement and declaration form of a license agreement did not form part of the domain name application and was only submitted in the framework of this ADR Proceeding. Therefore, the Registry's decision to reject the domain name application was made in the absence of these documents and should be examined in this respect. Had the Complainant submitted these documents as part of the Documentary Evidence in its domain name application, the issue would have been straightforward. But Complainant did not do so.

The Panel does not concur with the Complainant's view that the submission of a copy of the official certificate of registration for the trademark "Infraplan" discharges the Complainant's burden of proof for a number of reasons. First and foremost, as there is a clear discrepancy between the holder of the claimed prior right and the Domain Name Applicant, the Sunrise Rules clearly require the Domain

Name Applicant to submit further evidence to substantiate that the Domain Name Applicant is either the licensee or transferee of the claimed prior right or is otherwise the same person as or the legal successor to the person indicated in the Documentary Evidence as being the holder of the prior right. Secondly, the unilateral statement and confirmation by the Domain Name Applicant contained in the cover letter that the Domain Name Applicant is the licensee of the holder of the claimed prior right does not absolve the Domain Name Applicant from complying with the requirements set out by the Sunrise Rules, as also evident from Sections 13 and 20 of the Sunrise Rules, and such unilateral statement and confirmation cannot substitute an acknowledgment and declaration form of a valid license agreement between licensor and licensee. Thirdly, the obligations set out by the Sunrise Rules, inter alia to submit an acknowledgment and declaration form of a valid license agreement between licensor and licensee as Documentary Evidence, have been incorporated by reference in the cover letter. Item 6 of the cover letter signed by the Domain Name Applicant explicitly states: "The Rules, including the special terms that relate to the phased registration period, apply and have been read and approved without reservation by the Applicant. The Applicant has understood that any breach of the rules can invalidate the application for the domain name or result in the cancellation of the registration itself." The Complainant read and accepted the terms of the cover letter.

The Panel does not either concur with the Complainant's view that the validation agent or the Registry was under the obligation to notify the Domain Name Applicant of the insufficient nature of the submitted evidence, as a consequence of the fundamental right to be heard. It is true that, in abstracto, before a decision adversely affecting the rights of a party is adopted, there is an obligation to hear the addressee of the decision. Under the specific circumstances of this case, however, the Sunrise Rules applying to all phased registration period domain name applications clearly and unequivocally set out the documents to be submitted. The Sunrise Rules are incorporated by reference in the cover letter signed and submitted by the Complainant together with the invoked and supporting Documentary Evidence. Item 6 of the cover letter explicitly states the consequence of any breach of the rules, which can lead to the invalidation of the application or the cancellation of the registration. In other words, the Domain Name Applicant was informed of the applicable procedure and the consequences of not satisfying the relevant requirements.

Furthermore, it is clear from Section 21(3) of the Sunrise Rules that "[t]he 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." Therefore, the Validation Agent does not have an obligation to conduct own investigations in the circumstances of the domain name application, the prior right claimed and the Documentary Evidence produced and any examination is only a prima facie examination based on the evidence produced by the Domain Name Applicant. It is merely the Validation Agent's right to inquire into the circumstances of the domain name application, the prior right claimed and the Documentary Evidence produced in its sole discretion, which means that the Validation Agent alone can decide whether to exercise its discretion or not. In the present case, the Validation Agent did not exercise this right and the Panel holds that such decision was lawful, especially as the Sunrise Rules leave no doubt as to the Documentary Evidence to be submitted under these specific circumstances.

Section 22(1) reads: "The Validation Agent informs the Registry of its findings in accordance with Article 14 of the Public Policy Rules and in a manner agreed by them." Section 22(2) states: "The Registry registers Domain Names on a first come, first served basis where it finds that the Applicant has demonstrated a Prior Right in accordance with Section 2 hereof. […]" Pursuant to the communication of the Validation Agent's findings to the Respondent and in the absence of supporting evidence submitted by the Domain Name Applicant, the Respondent decided to reject the domain name application, as the Domain Name Applicant failed to substantiate that it is entitled to rely on the claimed prior right.

Section 8(7) of the Sunrise Rules clearly stresses: "[…] The Registry and the Processing Agent are not obliged to inform the Applicant of whether the Documentary Evidence has or has not met any or all of the requirements stated in this Section." Section 8(8) of the Sunrise Rules states: "No communication or acknowledgement from the Processing Agent and/or the Registry that Documentary Evidence has been received may be construed as implying that the information provided by (or on behalf of) the Applicant meets the conditions set out in this Chapter."

In concreto, the Complainant was given the full opportunity to submit a complete application, by reference to the requirements set out by the Sunrise Rules, and, thereby, to make its views known or be "heard" on the matter of the domain name application. The Complainant cannot reasonably expect the validation agent or the Registry to remind the Complainant once more of essential, required documents before rejecting the domain name application, especially as these documents are clearly set out by the Sunrise Rules incorporated by reference in the cover letter, which the Complainant read, accepted and signed. Under the current framework, such an obligation cannot reasonably be imposed on the validation agent or the Respondent.

According to Paragraph B11(d)(2), the Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves in ADR Proceedings, where the Respondent is the Registry, that the decision taken by the Registry conflicts with the European Union Regulations.

The Panel is satisfied that the Respondent's decision does not conflict with the European Union Regulations.

In the absence of evidence to conclude otherwise, the Panel has no choice, but to dismiss the Complaint.

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

Foteini Papiri

Dated: December 18, 2006

PANELISTS

Name	Foteini Papiri

DATE OF PANEL DECISION 2006-12-15

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested the Respondent's decision to reject the Complainant's application for the registration of the domain name <infraplan.eu> and sought the annulment of this decision and the attribution of the disputed domain name to the Complainant.

In respect of the prior right claimed and after examining the Documentary Evidence submitted by the Respondent in response to the Complainant's request, the Panel accepted that the prior right claimed is a national trademark.

The Panel was satisfied that the Documentary Evidence submitted by the Complainant to the Respondent was not sufficient in light of the Sunrise Rules applying to all phased registration period domain name applications and incorporated by reference in the cover letter read, accepted and signed by the Complainant. At the time of the domain name application, the Complainant failed to substantiate that the Complainant was the licensee of the holder of the claimed prior right, or that the Complainant was the transferee or was otherwise the same person as or the legal successor to the person indicated in the Documentary Evidence as being the holder of the prior right. The burden of proof lies with the Domain Name Applicant and supporting evidence to this effect cannot be presented as late as during this ADR Proceeding. The Panel was also satisfied that the validation agent or the Registry did not have an obligation to notify the Domain Name Applicant of the insufficient nature of the submitted evidence.

The Panel found that, according to Paragraph B11(d)(2) of the ADR Rules, the Complainant did not prove that the decision taken by the Registry conflicts with the European Union Regulations.