

Panel Decision for dispute CAC-ADREU-000954

Case number CAC-ADREU-000954

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Domain names gmp.eu

Case administrator

Name Tereza Bartošková

Complainant

Organization / Name von Gerkan Marg und Partner

Respondent

Organization / Name EURid

FACTUAL BACKGROUND

The complainant challenges the rejection of the eu.domain name GMP on the part of EURid for understanding that EURid has not specified the reasons for the rejection of the domain name, for considering that one cannot see from EURid's standard E-Mail on which grounds the rejection was based on and for considering as well that he has proven sufficiently the priority right on which the domain name application was based on.

A. COMPLAINANT

The Complainant argues that it is properly licensed to use the GMP trademark to apply for the corresponding domain name. The Complainant enclosed a licence agreement with its Complaint in support of its claim. Moreover, the Complainant argues that it is internationally known under the name GMP. Therefore, it should have been granted the domain name. The Complainant argues that, contrary to the rule set forth in section 13 (2) ii of the Sunrise Rules, courts in the European Union accept that an extract from the DEMAS database contains the same information as an extract from an official trademark register. Moreover, in the event the Panel would agree that an extract of the DEMAS database may not be accepted as documentary evidence, the Registry should have consulted an official trademark register pursuant to section 21 (3) of the Sunrise Rules. The Registry would then have seen that the extract of the DEMAS database contained correct information. The Registry would then have had to grant the domain name GMP to the Complainant.

B. RESPONDENT

1. An extract from a commercial database will be disregarded

The Complainant does not dispute that it submitted an extract of a commercial database. Moreover, it appears from the complaint that the Complainant is well aware of the rule provided by section 13 (2) ii of the Sunrise Rules which states that extracts from commercial trademark databases are not acceptable as documentary evidence even if they reproduce exactly the same information as the official extracts. What the Complainant seems to be getting at is that this rule is too strict and should not have been applied in the case at hand. However, article 3 (d) of the Regulation states that the request for domain name registration shall include an undertaking from the applicant that it shall abide by all terms and conditions for registration. To that regard, the cover letter which the Complainant submitted with its application states that: 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 existence of these rules is further approved by article 12 (1) of the Regulation. Moreover, these rules have been published on the Registry's website pursuant to article 12 (1) 3 of the Regulation. Therefore, these rules cannot be disregarded and should be applied by the Panel. In case n° 00119 (NAGEL), the Panel also agreed that each applicant is not only bound to the Regulation, but also to the Registry's rules (which are published on its website). Therefore, the Complainant is bound by the Sunrise Rules. Its failure to comply to section 13 (2) ii of the Sunrise Rules is one of the reasons why the Complainant's application was rejected.

2. The documentary evidence did not prove that the Complainant was licensed to use the GMP trademark

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 applicant must not necessarily be the actual owner of a prior right in the corresponding domain name, it may be licensed by the actual owner to use the prior right in applying for the corresponding domain name. Whereas in the first situation the documentary evidence must only consist of the evidence of the prior right, the second situation requires the applicant to submit a licence declaration in addition to the evidence of the prior right. This licence declaration must be signed by the actual owner of the trademark pursuant to section 20 (1) of the Sunrise Rules. However, the documentary evidence did not contain such a licence declaration. The licence agreement enclosed to the Complaint was submitted for the first time to the Registry at the stage of the present ADR proceedings. The documentary evidence only contained the extract of the DEMAS database.

3. A company/trade name may only be used in the second phase of the sunrise period

The Complainant's application was filed on December 7, 2005. December 7, 2005 is the starting date of the first part of the sunrise period. During this period only registered trademarks, geographical indications and the names and acronyms referred to in Article 10 (3) of the Regulation will be accepted as prior rights. A company name will only be accepted as a prior right when the application was filed during the second phase of the sunrise period. Therefore, the Complainant's reference to its company name is not relevant in the case at hand.

4. The Registry must not further examine an application

The Complainant's understanding of section 21 (3) of the Sunrise Rules is incorrect. Indeed, whereas the Complainant argues that this section requires the validation agent/Registry to make further examinations into the application, the section itself clearly states that further examination is not an obligation. The reason for not requiring the Registry to do so is clear: pursuant to article 14 (4) of the Regulation, the burden of proof is on the applicant to show that he has a prior right. In case n° 00127 (BPW), the Panel agreed that: Section 21.3 of .eu Sunrise Rules reads that 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 burden of proof was on the applicant (Complainant) For the reasons mentioned above, the Complaint must be rejected.

DISCUSSION AND FINDINGS

1. Regulation on documentary evidence

The Complainant does not dispute that it submitted an extract of a commercial database. Moreover, it appears from the complaint that the Complainant is well aware of the rule provided by section 13 (2) ii of the Sunrise Rules which states that extracts from commercial trademark databases are not acceptable as documentary evidence even if they reproduce exactly the same information as the official extracts. What the Complainant seems to be getting at is that this rule is too strict and should not have been applied in the case at hand.

As EURid's response to the complaint remarks, it is proper to affirm that article 3 (d) of the Regulation states that the request for domain name registration shall include an undertaking from the applicant that it shall abide by all terms and conditions for registration.

To that regard, the cover letter which the Complainant submitted with its application states that:

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.

In this sense, the Panel agrees with EURid's argument that the existence of these rules is further approved by article 12 (1) of the Regulation. Moreover, these rules have been published on the Registry's website pursuant to article 12 (1) 3 of the Regulation.

And so it is accurate to affirm that these rules cannot be disregarded and must be applied by the Panel.

EURid's reference to case n° 00119 (NAGEL), in which the Panel also agreed that each applicant is not only bound to the Regulation, but also to the Registry's rules (which are published on its website) is quite appropriate so as to make clear that the Complainant is bound by the Sunrise Rules. Its failure to comply to section 13 (2) ii of the Sunrise Rules is reason enough for this Panel so as to reject the Complainant's application.

2. Documentary evidence intending to prove that the Complainant was licensed to use the GMP trademark

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. Indeed, 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 applicant must not necessarily be the actual owner of a prior right in the corresponding domain name, it may be licensed by the actual owner to use the prior right in applying for the corresponding domain name. Whereas in the first situation the documentary evidence must only consist of the evidence of the prior right, the second situation requires the applicant to submit a licence declaration in addition to the evidence of the prior right. This licence declaration must be signed by the actual owner of the trademark pursuant to section 20 (1) of the Sunrise Rules.

As EURid's decision points out, the documentary evidence provided by the Complainant did not contain such a licence declaration. Certainly, the licence agreement enclosed to the Complaint was submitted for the first time to the Registry at the stage of the present ADR proceedings. Instead, the documentary evidence only contained the extract of the DEMAS database.

3. The use of a company/trade name during the sunrise period

The Complainant's application was filed on December 7, 2005.

December 7, 2005 is the starting date of the first part of the sunrise period.

During this period only registered trademarks, geographical indications and the names and acronyms referred to in Article 10 (3) of the Regulation will be accepted as prior rights. A company name will only be accepted as a prior right when the application was filed during the second phase of the sunrise period.

Consequently, it is right to affirm that the Complainant's reference to its company name is not relevant in the case at hand.

4. The Registry's obligation to examine an application

Indeed, whereas the Complainant argues that section 21 (3) of the Sunrise Rules requires the validation agent/Registry to make further examinations into the application, the section itself clearly states that further examination is not an obligation. The reason for not requiring the Registry to do so is clear: pursuant to article 14 (4) of the Regulation, the burden of proof is on the applicant to show that he has a prior right. Therefore, the Panel understands that the Complainant's understanding of section 21 (3) of the Sunrise Rules is erroneous.

Not in vain EURid brings case n° 00127 (BPW) up, in which the Panel agreed that:

Section 21.3 of .eu Sunrise Rules reads that 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 burden of proof was on the applicant (Complainant).

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	Berta Ramos Palenzuela
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DATE OF PANEL DECISION 2006-07-14

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

1. Regulation on documentary evidence

Although it seems that for the Complainant it's not so relevant to meet each and every requirement established by the corresponding rules regarding documentary evidence, the Panel considers that said rules are not arbitrary; instead they are binding for all without exclusion. And therefore since the rule provided by section 13 (2) ii of the Sunrise Rules stating that extracts from commercial trademark databases are not acceptable as documentary evidence even if they reproduce exactly the same information as the official extracts, the latter cannot be disregarded and must be applied by the Panel. Any eventual breach of said rule must be rejected. So it's done with the Complainant's application since he delivered extracts from commercial trademark databases and not official extracts.

2. Documentary evidence intending to prove that the Complainant was licensed to use the GMP trademark

Article 10 (1) of the Regulation states that only the holder of a prior right is eligible to be granted the corresponding domain name. 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 applicant must not necessarily be the actual owner of a prior right in the corresponding domain name, it may be licensed by the actual owner to use the prior right in applying for the corresponding domain name. In the case herein, the applicant should have submitted a licence declaration in addition to the evidence of the prior right, signed by the actual owner of the trademark pursuant to section 20 (1) of the Sunrise Rules. But instead said licence declaration was missing; the documentary evidence only contained the extract of the DEMAS database.

3. The use of a company/trade name during the sunrise period

The Complainant's application was filed on December 7, 2005, the starting date of the first part of the sunrise period.

During this period only registered trademarks, geographical indications and the names and acronyms referred to in Article 10 (3) of the Regulation will be accepted as prior rights. A company name will only be accepted as a prior right when the application was filed during the second phase of the sunrise period.

Consequently, the Panel considers that the Complainant's reference to its company name is not relevant in the case at hand.

4. The Registry's obligation to examine an application

The Complainant argues that section 21 (3) of the Sunrise Rules requires the validation agent/Registry to make further examinations into the application. But the section itself clearly states that further examination is not an obligation. Section 21.3 of the Sunrise Rules reads that 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 burden of proof therefore is on the applicant.

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint is Denied.
