Panel Decision for dispute CAC-ADREU-000989

Case number	**CAC-ADREU-000989**
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Domain names	**trigano.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**TRIGANO**

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 Complainant has attached an annex with teh Decision of teh Court of Appeals of Paris on 21/11/2003.

FACTUAL BACKGROUND

The Complainant is Trigano and is represented by Mrs. Marie-Helene FEUILLET. Both the Complainant and the authorised representative have the same postal address is France. The domain name in question is 'TRIGANO'.

The Complainant challenges EURid's decision concerning the allocation of the domain name. According to the Complainant, one of the applicants is not the current co-owner of the French registered trade mark 'TRIGANO' no. 1390939 claimed as the prior right for the registration of the disputed domain name under the pre-registration period Sunrise I.

The Complaint was filed on 27 April 2006 in French, which was the official language at the time, along with the relevant Annexes, which were in French as well. On 9th May 2006, English was chosen as the official language of the proceedings and, therefore, the Complaint was amended on 9th May 2006; similarly, two out of the three relevant Annexes were translated into English.

The Respondent failed to submit a Response within the given deadline. The Respondent sent a Non-Standard Communication after the notification of Panel appointment, a few days before the Provider appointed the Panellist containing the reasons why the Complaint should be rejected. On 18th July 2006, the Provider appointed the selected Panellist and on the same day the Provider received his Statement of Acceptance and Declaration of Impartiality and Independence. Finally, on 21st July 2006 the case file was transmitted to the ADR Panel.

A. COMPLAINANT

The Complainant contends that one of the applicants is not the current co-owner of the TRIGANO trade mark. The Complainant argues that one of the persons which are mentioned on the trade mark extract which was submitted as documentary evidence, Mr. Gilbert Trigano, deceased on 4th February, 2001. The Complainant argues that, Mrs. Simone Sabah, his widow is not the co-owner of the TRIGANO trade mark pursuant to French succession law.

Under article L 714-7 of the French Intellectual Property Code (IPC), any transfer or modification of rights under a registered mark shall be entered in the French Register of Marks in order to have effect against others in accordance with the procedure stated under articles R 714-4 and R 714-5 of the IPC.

From the date on the trade mark 'TRIGANO' n 1390939 as extracted from the PLUTARQUE database, it is clear that the transfer of its co-ownership was not entered in the French National Register of Marks neither on 7th December 2005, date of application of demand of

registration of the disputed domain name, neither on 10th January 2006, date of receipt of the documentary evidence by Eurid. Consequently, it has no effect against others, and in particular against Eurid.

Therefore, according to the Complainant, Eurid's decision of registration of the disputed domain name is null and void for defect in the real identity of one of the current co-owners of the registered trade mark claim as prior right and in the real identity of one of the authorised co-applicants.

Consequently, the Complainant requests Eurid's decision of registration of the domain name TRIGANO to be revoked.

B. RESPONDENT

The Respondent failed to file a response within the requested time frame. However, on 27th April 2006, the Respondent filed a "Non-Standard Communication" pursuant to paragraph A2 (k) of the ADR Rules, stating the following:

It is undisputed in the case at hand that the documentary evidence submitted to the Respondent consisted of a validly registered trade mark, which mentioned both Applicants. What the Complainant appears to be saying is that the validation agent should have further examined if these Applicants were still alive. However, the Respondent asserts that under section 21(3) of the Sunrise Rules, the validation agent is not obliged, but 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 Respondent claims that it should be clear that the validation agent must only examine the documentary evidence submitted by the Applicants. He quotes case no. 541 (ULTRASUN) whereby it was agreed that:

"Accordingly, in the Panel's view the validation agent's failure as to investigate the ownership of the prior right in question does not conflict with the .eu implementation Regulation of the Public Policy Regulation. The Complainant submits that the validation agent should have conducted an investigation pursuant to Section 21.3 of the Sunrise Rules to satisfy itself as to ownership of the prior right. However, the Panel is of the view that such an investigation is discretionary on the part of the validation agent and by no means mandatory. This interpretation is consistent with previous .eu ADR decisions including case No. 127 (BPW) and case No. 294 (Mitsubishi Motors). Further, Section 21.2 of the Sunrise Rules makes it clear that the validation agent is to carry out a prima facie review of the first set of the documentary evidence received from the applicant to establish whether a prior right exists…"

The Respondent claims that, under the Sunrise Rules, the validation agent is only concerned with establishing the prima facie ownership of the prior right at the time of the application and based on the documents filed by the applicant.

According to the Respondent, the above clearly shows that the validation agent does not carry an obligation to examine the documentary evidence. It is not the validation agent's duty to find out whether or not the Applicants were still alive. The validation agent makes his decision on the basis of the submitted documentary evidence and in the case at hand the Applicants appeared to be, prima facie, the prior right holders to the registered trade mark TRIGANO. As the Complainant itself states, the French Trade Mark Register did not suggest the contrary. Hence, the decision of the Registry to accept the application was correct.

The Complainant also submitted a court decision which allegedly proves that Mr. Gilbert Trigano has deceased. According to the Respondent, whereas this decision seems to imply that a certain Mr. Gilbert Trigano has deceased, it does not state that this Mr. Gilbert Trigano was the same person as the Mr. Gilbert Trigano who co-owns the trade mark.

Moreover, the Respondent notes that this decision was not enclosed with the documentary evidence. These documents were provided to the Respondent for the first time in the framework of the present ADR proceedings. The Respondent quotes section 21(2) of the Sunrise Rules whereby it is stated that the validation agent will examine 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. The Respondent refers to case No. 294 (COLT), where the Panel was confronted with a similar situation. In that case, the Panel effectively stated that the Complainant failed to substantiate that the trade mark was properly licensed as it only submitted evidence thereof during the ADR proceedings, whereas it should have filed this evidence with all its documentary evidence.

Therefore, the Respondent requests the Panel in this case to disregard this Court decision as it was submitted for the first time to the Respondent in the framework of the present ADR proceedings. According to the Respondent, neither the Respondent, nor the validation agent has had the opportunity to review this decision when examining the applicants' application. To that regard, article 22 1 (b) of the Regulation states that ADR proceedings may only be initiated when the Respondent's decision conflicts with the Regulation. As the Respondent did not have such a Court decision at its disposal and could have examined it, its decision cannot be in conflict with the Regulation.

Finally, according to the Respondent, the Complainant seems to be applying article 21 of the Regulation, which is entitled “Speculative and abusive registrations”.

However, pursuant 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 this Regulation or with Regulation EC 733/2002.

Article 14.7 of the Regulation provides that under the phased registration the Registry shall register the domain name if it finds that the applicant has demonstrated prior right. Therefore, during the phased registration period, the decision by the Registry whether or not to register the domain name can only be taken on the ground of the findings whether or not the applicant has demonstrated a prior right.

There is no legal ground in the Regulation for the Registry to reject an application for a domain name on the presumption that the application may have been made in bad faith or for speculative reasons. As there is no obligation under the Regulation of the Registry to assess the bad faith of the applicant and as article 22 (1) b states that a decision by the Registry can only be annulled when its decision conflicts with the Regulation, the Complainant must be dismissed. The Respondent quotes two cases:

Case No. 00210 (BINGO): The Panel agreed that the Complainant points to Article 22 (1)(a) of the Public Policy Rules as allowing a party to initiate an ADR procedure where the registration is speculative or abusive within the meaning of Article 21. However, in the Panel’s view, such an ADR procedure would clearly envisage a procedure to which the holder of the domain name should be a respondent, not EURid.

Case No. 00012 (EUROSTAR): The Panel agreed that, with respect to a question whether or not the validation agent or the Registry are also obliged, before the decision on the registration of the domain name, to examine whether or not the application has been made in good faith, the Panel concluded that the Registry is not obliged to make such an assessment.

Based on the above in the case of a speculative and abusive registration, the Respondent contends that ADR proceedings must be initiated against the domain name holder itself, not the Respondent.

DISCUSSION AND FINDINGS

The Complainant’s application is made pursuant to article 22 (1) (b) of EC Regulation 874/2004, which provides that an ADR procedure may be initiated by any party where a decision taken by the Registry conflicts with EC Regulation 733/2002. Pursuant to article 22 (11) of EC Regulation 874/2004, the sole purpose of these proceedings is accordingly to determine whether the decision taken by the Respondent was in accordance with EC Regulation 874/2004 and EC Regulation 733/2002.

The Complainant asserts that one of the applicants is not the current co-owner of the TRIGANO trade mark. To support this contention, the Complainant submits for consideration to the Panel three separate annexes: 1. a decision of the court of Appeal of Paris on 21.11.2003, 2. the Intellectual Property Code, and 3. Platurque Trade Mark TRIGANO No. 1390939.

First of all, the Panel wishes to comment on the attached annexes. Even though the official language of the proceedings is English only two out of three annexes are translated into English. Specifically, the annex entitled Plutarque Trade Mark Trigano No. 1390939 is in French and has not been translated into English. For this reason, the Panel decides not to take the above mentioned annex into account.

Second, the Panel find the annex entitled Intellectual Property Code of no use since the evidence establishing the trade mark rights of the mark TRIGANO is in French.

Finally, when it comes to the decision of the court of appeals the panel does not accept it as documentary evidence. Only part of the decision is translated into English, namely only one page out of five. On this basis the Panel has no option but to reject this attached evidence.

The Panel finds that the allocation of the domain name TRIGANO was properly made by the Respondent with the latter making a decision based on the documents that it had received at the time. As the Respondent correctly stated in its response, under the Sunrise Rules, the validation agent is only concerned with establishing the prima facie ownership of the prior right at the time of the application and based on the documents filed by the applicant.

Moreover, the Panel cannot, at the same time accept the Respondent’s argument, which questions the identity of the deceased Mr. Gilbert Trigano. However, the Panel accepts that any such evidence should have been produced at the time the trade mark owners applied to register the domain name with the Respondent.

As for the Respondent's assertion that the Complainant seems to be applying article 21 of the Regulation, which is entitled "Speculative and abusive registrations", the Panel does not feel that such an assertion has been made by the Complainant.

The Panel believes that, if the Complainant wishes to challenge the co-ownership of the domain name, he should not challenge the registration by the Respondent; instead, he should first challenge the co-ownership of the domain name. However, the Panel feels that such an action falls outside of this dispute and finds that the registration of the domain name by EURid was correct and should not be revoked.

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	**Mr. Konstantinos V. Komaitis**

DATE OF PANEL DECISION 2006-08-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

• The Complainant argues that one of the applicants is not the current co-owner of the TRIGANO trade mark.

• The Respondent claims that his decision to accept the application for the registration of the domain name was correct and that it was based on the evidence that was submitted to the Registrar at the time of registration.

• The Panel finds that EURid did not err in its decision to register the domain name to both owners. The Complainant should have submitted the evidence concerning the death of one of the co-owners of the trade mark when he applied to register the domain name with the Registrar.