Panel Decision for dispute CAC-ADREU-001232

Case number	CAC-ADREU-001232
Time of filing	2006-05-10 11:58:46
Domain names	mce.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Management Centre Europe (American Management Association), Ms Cyndie Di Marco

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 legal proceedings, which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant applied for the registration of the domain mce.eu during sunrise period I and based its application, dated December 7, 2005, on a prior right, namely the registered Benelux trademark “mce”, registered with the Benelux Trademark Office Registry since 31 December 1971, registration no. 0050331. The trademark is registered for the “American Management Association, 1601 Broadway, New York, New York 10019, USA. The protected trademark is a word mark.

According to complainant, Management Center Europe is an non-profit international association with registered offices at B-1050 Brussels, under the above address and registered in the Belgian Legal Entities Registry under no. 0416764953 and, also, the Belgian branch of a non-profit organization incorporated under the laws of the state of New York (USA), called American Management Association, with its registered offices at 1601 Broadway, New York, NY 10019, USA.

On December 8, 2005 the Complainant provided the Respondent with Documentary Evidence including excerpt of the Benelux Trademark Office Registry. The excerpt establishes that American Management Association is the holder of the ‘MCE’ Benelux trademark since 1971.

By electronic mail dated March 27, 2006 EURid notified the Complainant that its application for the domain name mce.eu has been rejected. The decision was based on the ground that the Documentary Evidence that EURid received was not sufficient to prove Complainant’s prior right.

On May 5, 2006 Complainant filed its complaint and requested the panel to decide as follows:
- To cancel the decision taken by EURid on March 27, 2006 to reject the Complainant’s application for the domain name “mce.eu” during the sunrise period;
- to decide that Complainant satisfies all registration criteria set out in the EC Regulations and to attribute the domain name “mce.eu” to Complainant; and
- to decide the subsequent activation by the Registry of the domain name “mce.eu” in the name of the Complainant.

The Complainant attached Annexes to its complaint including
1. A copy of the application filed by the Complainant on December 7, 2005 for the domain name “mce.eu”.
2. The decision of EURid of March 27, 2006 to reject the Complainant’s application for the domain name “mce.eu”.
3. A certificate of renewal of the Benelux Trademark Office of the trademark “mce” in French (original) and English translation.

4. An excerpt of the trademark registration from the Benelux Trademark Office Registry; both in French (original) and in English translation.
5. An excerpt of publication in the official GAZETTE establishing that Management Center Europe is the Belgium branch of the American Management Association (Original document in French and an English translation in relevant parts).
6. Article 26octies Belgium NPO Act in French and an English translation of the relevant parts of the Article).
7. Proof of payment of the ADR fees by bank transfer to the account of the Czech Arbitration Court

A. COMPLAINANT

The Complainant submits that he could rightfully claim a prior right based on the Benelux trademark registered for American Management Association registered with the Benelux Trademark Office since 31 December 1971 under registration no. 0050331.

Complainant argues that it was not necessary to provide EURid with a license agreement on the respective trademark “mce”, as the Complainant is identical with the trademark owner “American Management Association”. In support of this argument, Complainant refers to Article 26octies of the Belgian Law of June 27, 1921, amended by the Law of May 2, 2002.

B. RESPONDENT

Respondent refers to Article 10 (1) of the EC Regulation 874/2004, stating that only holders of prior rights, which are recognized or established by national or Community law are eligible to apply to register domain names during the so-called sunrise periods. Article 14 (4) of the EC Regulation 874/2004 states that every applicant has to submit Documentary Evidence that shows that it is the holder of the prior right claimed.

Further, Respondent refers to Section 20 (3) of the Sunrise Rules and argues that if the Documentary Evidence provided does not clearly indicate the name of the applicant as being the holder of the prior right claimed (for example: because the applicant has become subject to a name change, a merger, the prior right has become subject to a de jure 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. The Respondent states that it concluded from the examination of the Documentary Evidence that the Complainant was not the actual owner of the Benelux trademark “mce” and rejected the Complainant’s application. It argues that the Documentary Evidence did not prove that the Complainant was licensed to use the Benelux trademark “mce” nor that the Complainant was identical to the registered trademark owner “American Management Association”.

The Respondent refers to the fact that the burden of proof is with the applicant and that according to Section 21 (3) Sunrise Rules the validation agent is not obliged, although permitted in its sole discretion, to conduct own investigations with respect to the circumstances of a .eu application. Section 21 (2) Sunrise Rules states that the validation agent shall 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.

According to the Respondent, the Complainant failed to provide the Respondent with any official document establishing the relation between both entities.

For Respondent, it is clear that the names of the Complainant and the trademark holder are substantially different and that the Complainant failed to provide the Respondent with any official document substantiating that both were the same entity. Consequently, the Respondent was in no position to assess if the Complainant was actually the holder of a prior right in the MCE trademark. Therefore, it rejected the Complainant's application.

The providing of new documents with the complaint does not lead to a different decision of EURid and may not lead to a success of the complaint, as the 40 days deadline to provide complete Documentary Evidence (Section 8 (5) Subsection 4 Sunrise Rules) already expired.

DISCUSSION AND FINDINGS

According to Section 8 (3) (iv) Sunrise Rules the applicant is required to enclose the relevant Documentary Evidence referred to in Chapter 5 Sunrise Rules (validation of prior rights). Section 10 (1) Sunrise Rules provides that the validation agent validates whether the Documentary Evidence substantiates the prior right claimed by the applicant. Section 11 (3) Sunrise Rules provides that the applicant must be the holder of the prior right.

Section 13 (2), Subsection 2 Sunrise Rules provides that:
“In the forgoing cases, the Documentary Evidence must clearly evidence that the applicant is the reported owner of the registered trademark.”

“In the forgoing cases” refers to registered trademarks and the provision of copies of official documents or online database excerpts, as mentioned in Section 13 (2) (i) and (ii) Sunrise Rules.

Section 21 Sunrise Rules describes the examination of the application including the Documentary Evidence by the validation agent. Section 21 (2) Sunrise Rules provides that the validation agent examines the prior right of the applicant exclusively on the basis of a “prima facie review” of the first set of Documentary Evidence received by the Registry and in accordance with the provisions of these Sunrise Rules.

Section 21 (3) Sunrise Rules confirms that the validation agent is not obliged but only permitted (in its sole discretion), to conduct own investigations into the circumstances of the application, the prior right claimed and the Documentary Evidence produced.

From the Sunrise Rules, one can conclude that the validation agent was not obliged to investigate into the question, whether the reported trademark owner “American Management Association” is the same entity as the Complainant or if both are licensor and licensee, or the like. The application process, particularly the Sunrise Phases, does not provide such obligation of the Registry. The reason behind that is the need to proceed enormous numbers of .eu domain name applications within a reasonable time frame. The Sunrise Rules as well as the Domain Name Registration Policy were publicly accessible during the Sunrise Period by the applicants. Each applicant subscribed to these rules. It is obvious that the validation agent respectively the Registry could not conclude without any supporting evidence that Complainant and the American Management Association were the same entity. Therefore, it can be concluded that relevant Documentary Evidence, such as the confirmation of the right of the Complainant with respect to the trademark of the American Management Association, was not received within the 40 days period laid down in section 8 (5), Subsection 4 Sunrise Rules. By only reviewing the Documentary Evidence provided by the Complainant, the validation agent could not confirm that the Complainant was the owner the prior right in the trademark “mce”, as he claimed. Therefore, the Registry was entitled to the denial of the application.

According to the above said the Panel is of the opinion that the application for the domain name mce.eu, filed within the first phase of the Sunrise Period did not comply with the Sunrise Rules, particularly section 13 (2), Subsection 2 in connection with section 21 (2) Sunrise Rules. The Documentary Evidence provided did not evidence that the applicant was the reported owner of the registered trademark “mce”. Therefore, the Registry was entitled to the denial of the application.

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	**Flip Jan Claude Petillion**

DATE OF PANEL DECISION 2006-07-28

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested the rejection by the Respondent of its application for the domain name mce.eu within the first phase of the Sunrise Period.

The rejection by the Respondent was bases on the fact that the Complainant failed to forward all relevant Documentary Evidence that it is the registered owner of the Benelux trademark “mce”. This Benelux trademark “mce” was registered not under the name of the Complainant but under the name “American Management Association”.
Although the Complainant claimed that the reported and registered owner of the trademark “mce” and the Complainant itself were the same entity, the Panel found that the Registry was entitled to its decision to reject the application.

As the Complainant did not provide the Registry with Documentary Evidence within the 40 days deadline of Section 8 (5), Subsection 4 Sunrise Rules, such Documentary Evidence was regarded incomplete and not sufficient to prove the claimed prior right of the Complainant. As sufficient documentation was not submitted to the Registry within the 40 days period of Section 8 (5), Subsection 4 Sunrise Rules, and as the timely submitted evidence did not substantiate the prior right of the Complainant, the Panel held that the Registry was entitled to reject the application.