Panel Decision for dispute CAC-ADREU-001275

Case number	CAC-ADREU-001275
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Domain names	thun.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Thun AG, Dr. Martin Plieger

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 involving the disputed domain name.

FACTUAL BACKGROUND

1 On 7 December 2005, the first day upon which it was possible to apply to register .eu domain names, the Complainant made an application in respect of the domain name <thun.eu> (the “Domain Name”). Later the same day, two other entities also sought to register the Domain Name.

2 The Complainant supplied to the appointed validation agent documentary evidence in support of that application on 4 January 2006. That evidence took the form of a copy extract from the community trade marks database showing that the Complainant was the owner of a community trade mark application No. 003499506 (the “CTM Application”). The CTM Application sought a device mark comprising a block of colour enclosing the underlined word “THUN”. It is apparent from the materials provided that the CTM Application was subject to an opposition that had been commenced on 15 February 2005.

3 EURid refused the application on the basis that the Complainant had failed to provide evidence of a registered trade mark right in the name THUN.

4 The Complainant filed a Complaint on 8 May 2006 and these proceedings were commenced on 19 May 2006. A Response was filed by the Respondent on 7 July 2006.

5 On 13 July 2006 Matthew Harris, Pierfrancesco Fasano and Robert Elliott were appointed as panellists in this matter (the “Panel”) having each filed the necessary Statement of Acceptance and Declaration of Impartiality and Independence.

A. COMPLAINANT

The Complainant contends as follows:

(i) It is the holder of international trade mark registration no. 637696 under the Madrid Agreement and Protocol (the “International Trade Mark”) which covers a number of EU states. The Complainant, therefore, asserts that it is “the owner of the prior right of the trade mark ‘THUN’ as requested by EC Regulation 733/2002 Article 5, 1(b).”

(ii) It is the owner of the domain names <thun.com> and <thun.it>.

(iii) In the circumstances, even though it provided “an inappropriate document” in connection with its initial application, there is “no

doubt" that it fulfils all the requirements necessary to obtain the requested registration.

B. RESPONDENT

The Respondent (which is the Registry, EURid) contends as follows:

(i) The Complainant does not rely in its Complaint upon the CTM Application initially submitted.

(ii) "Article 45 of Regulation no. 40/49" (presumably a reference to Council Regulation 40/94/EEC; i.e. the "Community Trade Mark Regulation") provides that a community trade mark can only be treated as registered when any opposition has been rejected. Therefore, insofar as the CTM Application was still in "opposition" status at the time of the Complainant's application for the Domain Name, the Complainant was not the holder of a prior right for the purposes of its application.

(iii) So far as the new documentation contained in the Complaint evidencing the Complainant's International Trade Mark is concerned, this was not before the validation agent at the relevant time. Under section 21(2) of the Sunrise Rules, 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. Accordingly, on that evidence, the application was properly rejected. In this respect, EURid maintains that this case is similar to that in Mitsubishi Motors Europe BV v EURid Case no. 00294 <colt.eu>. It therefore states that the Panel should disregard the International Trade Mark for the purposes of these proceedings.

(iv) The domain names in other TLDs referred to by the Complainant do not provide prior rights for the purposes of the Complainant's application.

DISCUSSION AND FINDINGS

1 The Complainant has brought proceedings against EURid under Article 22(1)(b) Commission Regulation (EC) no. 874/2004 of 28 April 2004 (the "Public Policy Rules"). Under Article 22(11) of the Public Policy Rules the Panel is required to decide whether EURid's decision to refuse the Complainant's application for the Domain Name conflicts with the Public Policy Rules or with Regulation 733/2002 of the European Parliament and of the Council (which is the legislation under which the Public Policy Rules are made).

2 Article 10(1) of the "Public Policy Rules" states that only holders of "prior rights" which are recognised or established by national or community law shall be eligible to apply for a .eu domain name "during a period of phased registration before general registration of .eu domain starts" (i.e. the "Sunrise Period").

3 The manner in which applications in the Sunrise Period are to be dealt with is set out in Articles 12 to 14 of the Public Policy Rules. Article 12(2) provides that in the first phase of the Sunrise Period "only registered national and Community trade marks [sic], geographical indications, and the names and acronyms referred to in Article 10(3) may be applied for as domain names".

4 Article 12(3) of the Public Policy Rules requires that any request to register a domain name based on a prior right "shall include a reference to the legal basis in national or Community law for the right to the name, as well as other relevant information".

5 Article 14 of the Public Policy Rules provides that where a "prior right" such as a registered trade mark is claimed, the applicant "shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question". It further goes on to assert that "the 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 [earlier in Article 14]".

6 Against this background the Panel in this case has to address the following questions:

(i) to what extent a community trade mark application that is subject to an on-going opposition provides an applicant with a prior right under the first phase of the Sunrise Period;

(ii) to what extent the Complainant's ownership of the International Trade Mark, evidence of which was not provided to the validation agent, would justify annulment of EURid's decision to reject the Complainant's initial application.

7 The Panel accepts that the EURid's contention that a community trade mark application which is subject to an ongoing opposition does not constitute a registered community trade mark for the purposes of Article 12 of the Public Policy Rules. As EURid maintains, Article 45 of the Community Trade Mark Regulation states that a community trade mark can only be registered once any opposition has been rejected. Article 9(3) of the Community Trade Mark Regulation does grant rights after registration in respect of acts between

publication of an application and publication of the registration. However, this does not mean that the Complainant can be treated as possessing a registered community trade mark for the purposes of the proceedings currently before the Panel. The Panel notes that its findings in this respect are consistent with the comments of the panel on the status of an opposed community trade mark in Murak NV v EURid Case no 00207 <murak.eu>.

8 The Panel also notes that the Complainant seems to accept that the material initially provided in support of its domain name application was “inappropriate” and does not seek to pursue any argument that it is entitled to the Domain Name on the basis of the Community Trade Mark Application.

9 Further, the Panel accepts EURid’s contention that the International Trade Mark should be disregarded for the purposes of the present proceedings. These proceedings have been commenced under Article 22(1)(b) of the Public Policy Rules. The test is not whether the Complainant had registered trade mark rights under Article 12 of the Public Policy Rules as at the time the Domain Name application was made. Instead it is whether the Registry has acted properly in rejecting the Application where the International Trade Mark had not at that time been brought to its or the validation agent’s attention.

10 Article 14 of the Public Policy Rules is quite clear. It is for the domain name applicant to demonstrate that it possesses the relevant prior right by the submission of documentary evidence of that right to the validation agent. This the Complainant did not do. The reference to Article 5 (1)(b) of Regulation (EC) No. 733/2002 of the European Parliament and of the Council does not help the Complainant. It simply states that the Commission in formulating the Public Policy Rules should allow for “the possibility of registrations of domain names in a phased manner to ensure appropriate temporary opportunities for the holders of prior rights”. The terms of the Public Policy Rules provided that opportunity to the Complainant. The form of the Complainant’s application was such that it did not take it.

11 The Panel also believes its decision in this respect to be consistent with the previous decisions of panels in BPW Bergische Achsen KG v EURid Case no. 00127 <bpw.eu>, EMC Design for Media and Communication GmbH v EURid Case no. 00232 <dmc.eu>, Ultrason BV v EURid Case no. 00541 <ultrason.eu>, Mitsubishi Motors Europe BV v EURid Case no. 00294 <colt.eu> and Nager Verwaltung & Logistik GmbH v EURid Case no. 00119 <nager.eu>.

12 For the avoidance of doubt, the Panel also agrees with EURid’s contention that the Complainant’s ownership of domain names in other TLDs including the name THUN is not relevant to any issue in the current proceedings, and should be disregarded.

13 Accordingly, the Panel upholds EURid’s decision to reject the Complainant’s application for the Domain Name.

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	**Pierfrancesco Fasano**

DATE OF PANEL DECISION 2006-07-20

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant’s application for the Domain Name was rejected by the Registry where the verification material provided in respect of the Complainant’s claimed prior rights comprised evidence of a Community Trade Mark application subject to opposition.

The Complainant contended in its Complaint that it was also the owner of an international trade mark registration under the Madrid Agreement and Protocol and that, therefore, it was entitled to the Domain Name.

The Panel held as follows:

(i) A Community Trade mark application subject to opposition did not provide “prior rights” for the purposes of the Public Policy Rules.

(ii) The Complainant’s contentions so far as its International Trade Mark were concerned were rejected. The Complainant bore the burden of proof under Article 14 of the Public Policy Rules to supply the validation agent with evidence of any prior right relied upon. That evidence had not been supplied at the appropriate time in this case.

The Panel therefore ordered that the Complaint be denied.