Panel Decision for dispute CAC-ADREU-001323

Case number	**CAC-ADREU-001323**
Time of filing	**2006-05-17 13:55:26**
Domain names	**7x4med.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Kohlpharma GmbH, Thilo Bauroth**

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 Panels is not aware of any such proceedings.

FACTUAL BACKGROUND

The Complainant submitted the application for registration (hereinafter the “Application”) of the .eu domain name “7x4med.eu” (hereinafter the “Domain Name”) on 20 December 2005. The Application ranked no. 1 and no other applications for registration of the Domain Name were filed in Sunrise 1 or Sunrise 2.

The Application was based on the following prior rights within the meaning of Article 10 (1) of the Commission Regulation No. 874/2004 (hereinafter “Public Policy Rules”):

(a) German national trademark “7x4med”no. 30437289;
(b) International trademark “7x4med” no. 839334; and
(c) Community trademark “7x4 med” no. 003916574

The deadline for filing the documentary evidence pursuant to Article 14 of Public Policy Rules was 29 January 2006 and the Complainant submitted documentary evidence on 20 January 2006 and thus within the said deadline. The documentary evidence consisted of:

(i) Certificate of Registration issued by German Patent and Trademark Office for the German national trademark “7x4med” reg. no. 30437289;
(ii) Certificate of Registration of Community trademark “7x4 med” reg. no. 003916574 issued by Office for Harmonization in the Internal Market (OHIM); and
(iii) Certificate of Registration of the international trademark “7x4med”, reg. no. 839334 issued by World Intellectual Property Organization (WIPO).

According to the certificates (i) and (iii) above the company assist Pharma GmbH with its seat at Im Holzau 8, D-66663 Merzig, Germany, is the owner of the German national trademark “7x4med” and international trademark “7x4med”. The name of the trademark owner is not shown on the scanned version of the certificate (ii) above provided to the Panel (or it is illegible), however, from the online database of Community trademarks maintained by OHIM it appears that assist Pharma GmBH is the owner of the Community trademark “7x4 med” as well.

By its decision dated 5 April 2006 (hereinafter the “Decision”) the Respondent rejected the Application because the documentary evidence as provided by the Complainant was considered insufficient to demonstrate the Prior Right of the Complainant to the Domain

Name within the meaning of Article 10 (1) of the Public Policy Rules.

On 12 May 2006 and thus within Sunrise Appeal Period as defined by Sunrise Rules the Complainant filed the complaint against the Decision, subsequently amended on 29 May 2006 (hereinafter the “Complaint”) seeking “setting aside” of the Decision and “approval of the registration of the Domain Name in the name of the Complainant”.

The Respondent submitted its response to the Complaint on 18 July 2006 (hereinafter the “Response”) and thus within the deadline as stipulated by Paragraph B3 (a) of the ADR Rules.

A. COMPLAINANT

The Complainant contends the following:

(a) The aforesaid trademarks constitute prior right within the meaning of Article 10 (1) of the Public Policy Rules.

(b) This prior right is absolutely identical with the Domain Name within the meaning of Article 10 (2) of the Public Policy Rules.

(c) Pursuant to Article 14 of the Public Policy Rules, all claims for prior right must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists and every applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the domain name in question. This requirement was met by filing of the aforesaid documentary evidence by the Complainant.

(d) Pursuant to Section 13 (2) in conjunction with Section 20 (1) of the Sunrise Rules if the applicant is a licensee or assignee of a trademark on the basis of which the prior right is asserted, such applicant must submit a license agreement signed by the applicant as well as the trademark holder. This provision is explicitly applicable to cases in which the applicant is not the holder of the asserted prior right and where the right to a registration of the domain name is based on the license agreement. In this case however, the Complainant is authorized to use and dispose of the aforesaid trademarks on the basis of “group internal authority” (as documented by Exhibits 1 and 2 of the Complaint) and not on the basis of the license. The “group internal authority” is broader than a regular license and the Complainant is vested with factual trademark rights a consequently the proprietorship in the aforesaid trademarks. Furthermore, from Exhibit 3 it ensues that the aforesaid trademarks were in fact assigned to the Complainant. For these reasons, the requirement to submit the license agreement as a part of the documentary evidence did not apply to the Complainant.

(e) It is stipulated by Section 21 (3) of the Sunrise Rules that the validation agent can investigate the circumstances of a domain name application, the asserted prior right and the submitted documentary evidence at its own discretion. The Regulation (EC) No. 733/2002 sets forth the principle that speculative and abusive registrations of domain names should be avoided and the rights of the trademark owners should be protected. The validation agent is bound by these principles and therefore, while empowered to investigate the circumstances of the domain name application, the prior right and the documentary evidence at its own discretion, it must also exercise such discretion in line with the said principles. As a result, in the case at hand, the validation agent should have investigated the circumstances of the Application and the prior right, instead of rejecting the Application on strictly formal grounds.

(f) The Complainant tried to register the Domain Name in Landrush period, however, the Domain Name was blocked and therefore the registration was not possible. All domain names applied for in Sunrise Period and rejected by the Registry will be published by the Registry on a summary list. The registration phase for all these domain names will begin on 7 June 2006. Such list of rejected domain names is actually an invitation to abusive and speculative domain name registrations, since the major part of the rejections is obviously based on strictly formalistic examinations leaving out of consideration the actual legal situation.

For all the aforesaid reasons the Decision should be set aside and the Application should be examined in the light of the circumstances described above.

B. RESPONDENT

The Respondent contends the following:

(a) The burden of proof as to establishment of the prior right is with the Complainant.

(b) In the case at hand the Respondent was requested to grant the domain name to the Complainant on the basis of trademarks which the Complainant apparently did not own. In the event an applicant does not own the trademark on the basis of which the prior right is asserted, the actual owner must give its consent to such use and such consent must be provided to the registry as part of documentary

evidence (Section 20 (1) of the Sunrise Rules). The Complainant did not meet this requirement and therefore the Application was rejected by the Respondent.

(c) The Complainant submitted to the Panel new documents showing that he has the right to trademarks on the basis of which the prior right should be established. Such documents, however, were not part of the documentary evidence. Pursuant to Section 21 (2) of the Sunrise Rules the validation agent will examine whether the applicant has a prior right to the domain name in question exclusively on the basis of prima facie review of the first set of documentary evidence received. Therefore, the documents provided later by the Complainant are not relevant for these proceedings.

In the light of the foregoing it must be concluded that the Complainant failed to demonstrate the prior right to the Domain Name and therefore the Complaint should be dismissed.

The Respondent also cites a number of previous decisions in ADR proceedings in support of the aforesaid arguments.

DISCUSSION AND FINDINGS

The Panel concurs with the Respondent.

According to Article 10 of the Public Policy Rules only an applicant who is able to demonstrate a prior right to a domain name is eligible for registration of such domain name in Sunrise Period.

According to Article 14 of the Public Policy Rules every applicant shall submit the documentary evidence that shows he or she is the holder of the prior right claimed on the domain name in question. This requirement is further specified with respect to each type of prior rights by Sunrise Rules. If the prior right is based on a trademark, the applicant must provide the documentary evidence according to the requirements set forth in Section 13 (2) (i) or (ii) of the Sunrise Rules.

Section 20 of the Sunrise Rules sets forth additional requirements the applicant must meet in the event that the documentary evidence (such as trademark registration certificates) shows that the registered owner of the prior right is different from the applicant. If the applicant is a licensee of the trademark on the basis of which the prior right is claimed, it must submit an acknowledgement and declaration form according to the template forming Annex 2 of the Sunrise Rules, duly completed and signed by licensor and the applicant (Section 20 (1) of the Sunrise Rules). Similar requirements apply in cases where the applicant is different from the holder of the prior right in question as shown on the documentary evidence due to the transfer of the prior right, merger, or other reasons (Section 20 (2) and (3) of the Sunrise Rules).

According to Section 21 (1) (ii) of the Sunrise Rules, the validation agent shall verify whether the requirement for the existence of the prior right to the domain name claimed by the applicant is fulfilled. According to Section 21 (2) the validation agent examines whether the applicant has a prior right to the domain name in question on the basis of prima facie review of the first set of documentary evidence received. According to Section 21 (1) in fine of the Sunrise Rules, the validation agent and the Respondent are not obliged to notify the applicant if the requirement to sufficiently demonstrate the prior right to a domain name is not complied with.

The documentary evidence provided by the Complainant shows that the registered owner of the trademarks on the basis of which the prior right to the Domain Name was asserted is the company assist Pharma GmbH and not the Complainant. The Complainant did not provide any document within the documentary evidence which would demonstrate Complainant's right to the trademarks in question. Therefore a conclusion has to be drawn that the Complainant failed to demonstrate its prior right to the Domain Name. The additional documents provided by the Complainant in the course of these ADR proceedings cannot be taken into consideration, as they did not form part of the documentary evidence.

The Complainant, on one hand, argues that it was not obligated to provide the documentary evidence as to its right to aforesaid trademarks because such right is not based on a license agreement, but rather on "group internal authority". On the other hand the Complainant argues that the validation agent was obligated to investigate as to why the registered owner of the said trademarks as shown on the documentary evidence provided by the Complainant is different entity than the Complainant. Such argumentation of the Complainant is apparently purpose-built and cannot stand.

Generally, throughout the world, domain names have always been registered on "first come first serve" principle without having specific regard to the rights of the owners of intellectual property. The European Community, having regard to legitimate interests of the intellectual property right owners, provided such owners with the opportunity of privileged registration of the domain name corresponding to their intellectual property rights in the Sunrise Period. In order to administer such a tremendous task it was absolutely necessary to establish strict and straightforward rules for demonstrating of the intellectual property rights on which the privileged

registration of domain names should be based. These strict rules are without any doubt justified and necessary in situation when hundreds of thousands of applications for registration of the domain names in the Sunrise Period had to be examined. Nothing in these rules stipulates the obligation of the validation agent or the Respondent to investigate into the circumstances of the applications where the prior right was not sufficiently demonstrated, or the obligation of the validation agent or the Respondent to notify applicants of deficiencies in their applications. Quite to the contrary, Section 21 (1) and (2) of the Sunrise Rules expressly stipulate that the validation agent and the Respondent shall not have any such obligations. The Complainant tries to construe such obligations of the validation agent and the Respondent by invoking the general principles of phased registration such as “safeguarding of the trademarks’ owners rights” and “avoiding speculative and abusive domain registrations”. In fact, these principles can only be fulfilled by setting forth strict rules for demonstrating of prior rights otherwise the phased registration would not be manageable. Therefore, it cannot be reasonably anticipated that the validation agent (although it has the permission to do so pursuant to Section 21 (3) of the Sunrise Rules) would investigate into the circumstances of each and every domain name application where the documentary evidence submitted by the applicant does not comply with the requirements set forth by Sunrise Rules.

In the light of the foregoing it has to be concluded that it is the responsibility of the domain name applicant to provide documentary evidence in a manner that its prior right to the domain name applied for is clearly demonstrated. Should the documentary evidence show that the registered owner of the prior right is different from the applicant, the documentary evidence must include appropriate documents demonstrating applicant’s authorization to register the domain name on the basis of the asserted prior right, regardless of whether such authorization is named “license” or anyhow else. If such documents are not provided by the applicant, the validation agent, exercising prima facie review of the documentary evidence pursuant to Section 21 (2) of the Sunrise Rules may (and most likely will) conclude that the prior right of the applicant to the domain name is not demonstrated and thus reject the domain name application.

The Complainant’s speculations as to the possibility of abusive or speculative registration of the Domain Name are not relevant for these ADR proceedings. In accordance with Section 22 (6) of the Public Policy Rules the Domain Name remains suspended until these ADR proceedings or subsequent legal proceedings are complete, after that it will be released for Landrush registration. If the Complainant intended to register the Domain Name immediately at the beginning of Landrush period it should not have initiated these ADR proceedings.

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	**Michal Matejka**

DATE OF PANEL DECISION 2006-07-24

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant applied for a domain name 7x4med.eu on the basis of registered trademarks, which are, according to the documentary evidence provided by the Complainant, owned by different entity than the Complainant. In the documentary evidence the Complainant did not provide any of the Documents required by Section 20 of the Sunrise Rules that would demonstrate its authorization to register the domain name on the basis of the said trademarks, arguing, that it was not obligated to do so as its authorization to use these trademarks was not based on license agreement but rather on “group internal authority”. With its complaint the Complainant provided several documents in demonstration of this authority, however, these documents were not part of the documentary evidence. The Complainant also argued that the validation agent in fact was obligated to investigate into the said deficiency of Complainant’s domain name application.

The Panel held that the Complainant apparently failed to demonstrate the prior right to the claimed domain name in compliance with the requirements of Public Policy Rules and Sunrise Rules as no documents showing Complainant’s authority to register the domain name on the basis of the trademarks which the Complainant does not own were submitted as a part of documentary evidence. Submission of such documents in the course of subsequent ADR proceedings is not relevant. The validation agent and the Respondent, on the other hand, did not have any obligation to investigate into the deficiency of Complainant’s domain name application on its own. The validation agent or the Respondent had no obligation to notify the Complainant of such deficiency either.