Panel Decision for dispute CAC-ADREU-001407

Case number	**CAC-ADREU-001407**
Time of filing	**2006-05-23 15:06:01**
Domain names	**lexolution.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**STP Informationstechnologie AG, Peter Nümann**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

STP Informationstechnologie AG (hereinafter the “Complainant”) applied for registration of the domain “lexolution.eu” on December 7, 2005 at 12:40:05

On December 12, 2005, the trademark on the basis of which the Complainant claims its “prior right” was registered.

The documents evidencing the application were filed to the EURID (hereinafter the “Respondent” or the “Registry”) on January 13, 2006, i.e. within the prescribed period.

On April 10, 2006, the Respondent notified the Complainant that the registration was rejected.

The complaint was filed on May 19, 2006, whereas the respective deadline was May 20, 2006.

A. COMPLAINANT

The Complainant argued that the fact that the trademark, on which the request for registration was based, was registered on December 12, 2005 – after the domain name request was filed, does not justify the Respondent’s negative decision. In this respect the Complainant claimed that the relevant date to consider is the date of priority of the trademark which is the date of the application, which was before the request for registration of the domain was filed.

The Complainant further supported his point by citing the provision of German trademark law (Markengesetz), which states that: “the relevant date for the priority in time of the registered trademark is the date of application.” He also claimed that such view was also expressed in certain provisions of EC trademark law.

On the basis of the abovementioned the Complainant concludes that, regarding a trademark, the date of the application is the relevant date which has to be considered with respect to the question of priority of one trademark before the other, and that, since the question of allowing or rejecting a request for a domain in the Sunrise phase of domain registration is also a matter of priority, the date of priority of the trademark has to be taken into account.

The Complainant continued his argument by stating that the requirement that the applicant for the domain has to have a registered trademark was enacted for the purpose of ensuring that the evidence given in the course of the registration establishes that the trademark has approved legal protection. In this respect the Complainant pointed out that in the present case he had submitted such evidence within the time limit for the filing of evidence.

The Complainant further tried to demonstrate the absurdity of the conclusion that the date of actual registration of a trademark is the relevant date for the purposes of the .eu domain registration proceedings. In such case, the Complainant argued that the rights of the applicants concerned would depend on the incidental fact of the speed of work of the relevant trademark offices.

From the abovementioned, the Complainant concludes that the decision on .eu domain registration should be based on the date of priority of the trademark, provided that the registration of the trademark with the earlier priority could be proved within the deadline for the filing of evidence to the register.

The Complainant thus argued that the registry should have registered the domain name for the Complainant as he has requested the domain name first (at the beginning of the “Sunrise 1” phase) and has given evidence within the relevant deadline that he enjoyed the right out of a registered trademark with priority earlier than the date of the filing of the request for the domain.

Therefore, in the Complainant’s opinion, the decision of the registry conflicts to the regulation in Article 2 para. 2 of the Commission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration (hereinafter the “Regulation”).

Based on the arguments above, the Complainant insisted that regarding the “first come first served”-basis and the legal provisions regarding the priority in time of the relevant trademark the domain had to be registered for the Complainant as he had requested the domain name first and had given appropriate evidence for the registration of the claimed right, which had legal priority before the request for the domain.

B. RESPONDENT

The Respondent argued by interpretation of article 10 (1) of the Regulation. According to Respondent's opinion the Regulation clearly provides that only registered national or Community trademarks may be considered as a prior right. This is allegedly reflected in Section 13 of the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter the “Sunrise Rules”).

The Respondent argued that it was widely accepted, inter alia by the Panels in case n° 119 (NAGEL) and case n° 404 (ODYSSEY) that an applicant should comply with the Sunrise Rules.

The Respondent further supported his opinion by citing the Panel's decision in case n° 404 (ODYSSEY) that (i) a trademark application did not constitute a prior right, and that (ii) it was irrelevant whether the trademark application has become a registered trademark after submitting the domain name application.

In the Respondent's opinion, the documentary evidence submitted by the Complainant clearly shows that the Complainant did not own the relevant registered trademark on the date of the domain name application.

The Respondent argued that the Regulation and the Sunrise Rules clearly and expressly provided that only registered trademarks could be taken into account by the Respondent when assessing a domain name application.

For reasons mentioned above, the Respondent claimed that he was correct in rejecting the Complainant's application, and that the Complaint must therefore be dismissed.

DISCUSSION AND FINDINGS

According to Article 10 (1) of the Regulation, “holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.“

Pursuant to Article 12 (2) of the Regulation, “during the first part of phased registration, only registered national and Community trademarks, geographical indications, and the names and acronyms referred to in Article 10 (3) of the Regulation, may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in Article 10 (1) of the Regulation.”

Pursuant to Article 14 of the Regulation, “all claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists.”

Furthermore according to Article 14 of the Regulation, ”every applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question”

Furthermore, pursuant to Article 14 of the Regulation, “the relevant validation agent shall examine whether the applicant has prior rights on the name.”

The Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has duly demonstrated a prior right.

Under Section 11 of the Sunrise Rules, the applicant must be the holder (or licensee, where applicable) of the Prior Right claimed no later than at the date on which the application is received by the Registry, on which date the Prior Right must be valid, which means that it must be in full force and effect.

Under Section 13 (1) of the Sunrise Rules, (i) Where the Prior Right claimed by an Applicant is a registered trade mark, the trade mark must be registered by a trade mark office in one of the member states, the Benelux Trade Marks Office or the Office for Harmonisation in the Internal Market (OHIM), or it must be internationally registered and protection must have been obtained in at least one of the member states of the European Union. (ii) A trade mark application is not considered as a Prior Right.

Thus, as it results from the said stipulations, (i) trademark application shall not be considered as a "Prior Right" for the purposes of the .eu Domain Name registration, and (ii) "Prior Right" shall be valid no later than on the date on which the application is received by the Registry.

From the “WHOIS Database” it results that the application of the respective .eu domain has been filed by the Complainant on December 7, 2005 12:40:05.026.

The Complainant subsequently provided the relevant validation agent with an evidence of existence of the German trademark “Lexolution” registered in name of the Complainant.

However, the said trademark was registered on December 12, 2005.

Taking into account the above facts, it is apparent that the trademark “Lexolution” registered with the German Patent and Trade Mark Office only on December 12, 2005 did not constitute the "Prior Right" on the date on which the Application was received by the Registry.

The Registry correctly denied the registration of the eu-domain-name “lexolution.eu”.

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	**Pavel Safar**

DATE OF PANEL DECISION 2006-07-28

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

According to Article 10 (1) of the Regulation, “holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.“

Thus, if the application is filed at the moment when the “prior right” had not been constituted yet and such fact is apparent from the submitted documents, the respective application has to be denied.