# Panel Decision for dispute CAC-ADREU-001443

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| Case number | **CAC-ADREU-001443** |
| Time of filing | **2006-05-19 12:38:22** |
| Domain names | **urbis.eu** |

## Case administrator

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| Name | **Tereza Bartošková** |

## Complainant

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| Organization / Name | **Kraaijvanger Urbis, Philip Lages** |

## Respondent

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| Organization / Name | **EURid** |

FACTUAL BACKGROUND

Kraaijvanger Urbis (hereinafter "the Complainant") applied for the domain name “urbis.eu” on December 7, 2005.

The validation agent received the documents evidencing the application on January 6, 2006, i.e. within the prescribed period.

On April 11, 2006 the EURID (hereinafter the “Respondent” or the “Registry”) issued the decision based on which the application for the registration of the domain name “urbis.eu” was rejected.

In this context, the Complainant submitted to the Czech Arbitration Court the complaint by email on May 17, 2006 and on June 13, 2006 in hardcopy requesting the annulment of the decision and attribution of the domain name “urbis.eu” to the Complainant. The formal date of commencement of the ADR Proceeding (hereinafter the “ADR Proceeding”) is June 13, 2006.

A. COMPLAINANT

The Complainant argued that the application for the registration of the domain name “urbis.eu” based on the existence of the prior right of the ownership of a trademark "urbis" within the Benelux was duly accompanied with the evidencing documentation.

The Complainant further supported his point by submitting a copy of the Proof of ownership of the trademark "urbis" within the Benelux issued by the Benelux Trademarkbureau (hereinafter the ”Proof of Ownership”) and the original application form for the registration of the domain name “urbis.eu”.

Thus, in the opinion of the Complainant, there was no ground for rejecting the application for the registration of the domain name “urbis.eu” on the ground of alleged lack of evidence.

B. RESPONDENT

The Respondent referred in its statement to Article 10 (1) of Commission Regulation (EC) No. 874/2004 of 28 April 2004

(hereinafter the "Regulation") according to which only the holders of prior rights which are recognized or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.

The Respondent further referred to the wording of Article 14 paragraph 4 of the Regulation which states that ..."every applicant must submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question"…

The Respondent also cited section 20 (3) of the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter the "Sunrise Rules") under which if the documentary evidence provided does not clearly indicate the name of the applicant as being the holder of the prior right claimed (e.g. because the applicant has become subject to a name change, a merger, the prior right has become subject to a de iure 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.

Taking into account the said provisions, the Respondent concluded from its examination of the documentary evidence provided by the Complainant that the Complainant did not appear to be the actual owner of the URBIS trademark as the name of the holder mentioned on the trademark certificate, i.e. Proof of Ownership, differed from the name of the Complainant. The Respondent therefore rejected the Complainant's application.

In this context the Respondent emphasized that the Complainant's name is KRAAIJVANGER URBIS whereas the name of the owner of the URBIS trademark according to the Proof of Ownership which was submitted as documentary evidence is ASTOC INTERNATIONAL B.V.

The Respondent further pointed out that the burden of proof is with the applicant to prove that it is the holder of a prior right. In the opinion of the Respondent, pursuant to the Regulation and the Sunrise Rules it is to the applicant to submit all documents which the validation agent needs to assess whether an applicant is the holder of a prior right corresponding to the domain name. If an applicant fails to submit such documents, its application must be rejected. According to the Respondent, pursuant to the provisions just mentioned, the relevant question is not whether the applicant is the holder of a prior right, but whether the applicant proved to the validation agent that it is the holder of a prior right.

The Respondent further argued by the citation of Article 10 (1) of the Regulation under which only the holder of a prior right is eligible to be granted the corresponding domain name. According to the Respondent it is therefore of great importance that the Registry is provided with all information that allows it to assess whether the applicant is the holder of a prior right. The Respondent in this context concluded that a registered trademark is a prior right within the meaning of the Regulation.

With regard to the interpretation of Article 14 of the Regulation, the Respondent argued by citation of the Panel's reasoning contained in the case n° 00119 (NAGEL) in which the Panel came to the conclusion that Article 14 paragraph 1 of the Regulation requires that all claims for Prior Rights must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists and the Panel's reasoning contained in the case n° 954 (GMP) where the Panel came to the conclusion that Article 14 of the Regulation puts the burden with the applicant to prove that it holds a prior right and if an applicant fails to submit all documents which prove that it is the holder of a prior right, the application must be rejected.

The Respondent pointed out that the applicant's burden of proof results also from section 21 (3) of the Sunrise Rules according to which 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. The Respondent also referred to section 21 (2) of the Sunrise Rules stating that the validation agent shall examine whether an applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence it has received.

The Respondent repeatedly argued that in the case at hand, the name of the owner of the URBIS trademark is clearly

different from the name of the Complainant. According to the Respondent the validation agent was provided with no explanation as to the reason for this difference. Thus, the validation agent cannot be expected to speculate in this regard.

Additionally, in order to support the said conclusion the Respondent cited a part of the Panels´ reasoning contained in the decisions n° 219 (ISL), n° 294 (COLT), n° 1232 (MCE), n° 00192 (ATOLL) n° and n° 00541 (ULTRASUN).

DISCUSSION AND FINDINGS

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

According to Article 14 paragraph 4 of the Regulation every applicant must submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question.

According to section 20 (3) of the Sunrise Rules, in case the documentary evidence provided does not clearly indicate the name of the applicant as being the holder of the prior right claimed (e.g. because the applicant has become subject to a name change, a merger, the prior right has become subject to a de iure 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.

According to section 21 (2) of the Sunrise Rules, the validation agent shall examine whether an applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence it has received.

According to 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.

From the cited stipulations it thus results that (i) the burden of proof lies on the applicant who must submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question, (ii) the applicant must also 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 and (iii) the validation agent/Registry 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 it has received and it is not in any way obliged or forced to conduct its own investigations into the circumstances of the application.

The Complainant applied for the domain name “urbis.eu” on December 7, 2005 and it provided the validation agent with the documents evidencing the application on January 6, 2006, namely with the Proof of Ownership, i.e. a copy of the Proof of ownership of the trademark "URBIS" within the Benelux issued by the Benelux Trademarkbureau.

Nevertheless, as it clearly results from the examination of the Proof of Ownership, the “URBIS” trademark is registered in favor of the holder ASTOC INTERNATIONAL B.V., whereas the application for the registration of the domain name “urbis.eu” was filed under the Complainant's name KRAAIJVANGER URBIS.

In this context it is necessary to point out that the Complainant did not provide validation agent/Registry with any explanation or any evidencing documentation which would clearly indicate the name of the Complainant and applicant as being the holder of the prior right claimed. It is also necessary to point out that the validation agent/Registry cannot be expected and/or forced to speculate whether the Complainant is a holder of the prior right claimed. Moreover, in the ADR Proceeding the Complainant did not provide the Panel with any explanation in this regard to support its position.

Taking into account above facts it is thus apparent that the copy of the Proof of Ownership of the trademark "URBIS" within the Benelux issued by the Benelux Trademarkbureau in favor of the holder ASTOC INTERNATIONAL B.V. did not by itself evidence the existence of the prior right claimed by the Complainant in order to support its application for the registration of

the domain name “urbis.eu” filed under the Complainant's name KRAAIJVANGER URBIS.

The Registry correctly rejected the registration of the domain name “urbis.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

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| Name | **Aleš Chamrád** |

DATE OF PANEL DECISION 2006-08-07

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested the decision of the Registry to reject the application for the registration of the domain name “urbis.eu” on the ground of alleged lack of the documentary evidence provided from the part of the Complainant.

The Complainant who filed its application under its name KRAAIJVANGER URBIS supported its application with the Proof of Ownership (trademark certificate) of the “URBIS” trademark within the Benelux issued by the Benelux Trademarkbureau in favor of the holder ASTOC INTERNATIONAL B.V.

According to Article 14 paragraph 4 of the Regulation every applicant must submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question.

According to section 20 (3) of the Sunrise Rules, if the documentary evidence provided does not clearly indicate the name of the applicant as being the holder of the prior right claimed (e.g. because the applicant has become subject to a name change, a merger, the prior right has become subject to a de iure 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.

Thus, if the filed application is accompanied with the documentary evidence that does not clearly indicate the name of the applicant as being the holder of the prior right claimed and the applicant does not submit official documents substantiating that it is the same person as the person indicated in the documentary evidence as being the holder of the prior right, the respective application has to be rejected.