Wyrok arbitrażowy for dispute CAC-ADREU-001518

Case number	CAC-ADREU-001518
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Domain names	vanhouten.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Barry Callebaut Services N.V., Timothy Holman

Respondent

Organization / Name	EURid

INNE POSTĘPOWANIA PRAWNE

The Panel is not aware of any other legal proceedings relating to the disputed domain name.

STAN FAKTYCZNY

On December 7th, 2005 Barry Callebaut Services N.V (hereinafter “the Complainant”) filed a request for registration of the domain name “vanhouten.eu”.

The application was allegedly based on a right to a Community Trademark. The Complainant was granted this right by virtue of a license agreement between Complainant and Van Houten GmbH & Co. KG (hereinafter “the Licensor”).

According to EURid (hereinafter “the Respondent”) they received the documentary evidence on 2 January 2006 consisting of an extract from the CTM-ONLINE database showing that the Licensor had applied for registration of a Community Trademark with the name of “Van Houten” (application no. 4 299 046 filed on 21 February, 2005).

Furthermore, a License Declaration for the Community trademark application for “Van Houten” dated 12 January 2006 was submitted to the Respondent.

The Respondent rejected the request for registration of the domain name on the grounds that the documentary evidence submitted by the Complainant did not prove that the Complainant owned rights to a registered trademark.

On June 6th, 2006 Complainant filed a complaint to the Czech Arbitration Court. With the complaint the Complainant has submitted new documentary showing evidence that it held rights to several national trademark registrations of “Van Houten” when filing for registration of the disputed domain name.

Respondent submitted the Response on August 8th, 2006, which was within the deadline of thirty working days after the delivery of the Complaint to the Respondent.

A. POWÓD

The following are the Complainant's main contentions.

Complainant asserts that the Respondent's decision to refuse registration is in violation of EC Regulation no. 874/2004 (hereinafter "the Regulation"), in particular Article 10 (1) and EC Regulation 733/2002.

The Complainant as the licensee of Van Houten GmbH & Co. KG (Licensor) bases its claim on the following prior rights established by national or community law:

- CTM trademark application 4 299 046 "Van Houten",
- DE trademark registration 2 028 113 "Van Houten" and English translation,
- DE trademark registration 306 863 "Van Houten" and English translation,
- BX trademark registration 9785 "VAN HOUTEN" and English translation and
- BX trademark registration 47585 "VAN HOUTEN" and English translation.

Moreover, the Complainant states that it met the conditions for a community trademark on the time of application for the domain name, since it has proven among other things the existence of prior national rights in 24 countries. A Community trademark is a consolidation of prior national trademarks and therefore the Complainant is of the view that the submitted documentation of proof is sufficient to establish the existence of prior rights within the meaning of Article 10 of the Regulation.

According to the Complainant the Panel shall take the new evidence into consideration when determining whether the Complainant has demonstrated the existence of prior rights.

The submission to the Panel of the annexes 2, 3, 4, 5, 7, 8, 9 and 10 to this complaint along with the complaint itself, has provided the necessary documentary evidence required by Article 14 of the Regulation.

Since Article B1 (b) (16) of the ADR-Rules (hereinafter "the Rules") provides that the Complainant "annex(es) any documentary evidence, including any evidence concerning the rights on which the complaint relies, together with a schedule indexing such evidence", the Complainant's further submitted evidence is not to be excluded by the Panel.

The Complainant stresses that the purpose of the phased registration of .EU-domains is to ensure that holders of prior rights are protected.

On these grounds the Panel is requested to take into account the previously submitted evidence and the further documentary evidence submitted with the complaint.

B. POZWANY

The following are the Respondent's main contentions.

Respondent refers to Article 10 of the Regulation which states that "holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to register domain names during a period of phased registration before general registration of EU-domains starts. Prior rights shall be understood to include, inter alia, registered national and Community trademarks…".

The documentary evidence submitted by the Complainant consisted of an extract from the CTM-ONLINE database showing that the Licensor had applied for the Community trademark on 21 February 2005 and a License Declaration for a registered trademark. However, the license declaration was in fact not for a registered Community trademark, but instead for an application for such a trademark.

The submitted evidence consisted of no proof of a subsequent registration of the trademark.

In the Respondent's view the documentary evidence consisted of no proof of existence of prior rights owned or licensed by the Complainant.

Section 13 (ii) of the Sunrise Rules expressly states that: "A trade mark application is not considered a prior right".

The Respondent has referred the Panel to the cases no. 404 (ODYSSEY) and no. 219 (ISL) in which the Panels ruled that an application for a trademark registration must be rejected as documentary evidence of the existence of a prior right.

In the Respondent's opinion the submitted evidence in this case did not demonstrate that prior rights existed at the time of the application.

Section 21 (2) of the Sunrise Rules states that the validation agent will 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.

Therefore, in the Respondent's opinion new documents and contentions submitted by the Complainant may not be taken into consideration.

In support of this view Respondent refers to cases no. 219 (ISL), no. 294 (COLT), no. 706 (AUTOWELT), no. 954 (GMP), no. 1275 (THUN) and no. 1549 (EPAGES).

ROZPOZNANIE I STWIERDZENIA

The present case raises the issue of whether or not an application for a CTM registration is sufficient evidence of the existence of a prior right and whether or not the Complainant can be allowed to submit new documentary evidence during the ADR-procedure.

Initially, the Panel must stress that it has not received a copy from the Respondent of the documentary evidence originally submitted by the Complainant.

However, the Panel understands that the documentary evidence submitted by the Complainant within the 40 days deadline consisted of an application for registration of the Community trademark "VAN HOUTEN" (no. 4 299 046, filed on 21 February, 2005 by Van Houten GmbH & Co. KG). Moreover, the Complainant did also submit additional evidence showing that the Complainant was the Licensee of the said trademark application. This License Declaration was signed on 12 January 2006 and received by Respondent on 13 January 2006.

The Complainant argues that the application for the trademark registration and the License Declaration together with the documents submitted during the course of this proceeding are evidence that Complainant holds a prior right to the name "Van Houten".

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 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".

Pursuant to section 11 of the Sunrise Rules, the applicant must be the holder or Licensee of the prior right claimed no later than on the date on which the Application is received by the Registry.

Section 13 (1) (ii) of the Sunrise Rules expressly emphasize that a trademark application is not considered a prior right.

This is supported by a number of cases including e.g. case no. 404 (ODYSSEY) in which the Panel agrees with the Respondent to reject the Complainant's application for the domain name because the Complainant could only show evidence consisting of a Community trade mark application that had not reached registration before the filing date of the domain name application. In regard to this matter the Panel also refers to case no. 1407 (LEXOLUTION).

The documentary evidence, which the Complainant sent to the Respondent, did only consist of a trademark application, and a license agreement regarding the rights to this application. This evidence does not meet the requirements in the Regulation, and is therefore not sufficient evidence to prove a prior right to the domain name.

The fact that the trademark is now registered does not change the Panel's view hereof.

The Complainant has subsequently during the ADR-procedure provided evidence proving that the Claimant actually is the holder of several national trademark registrations to the name "Van Houten" at the time of the application for the domain name. Complainant argues that the Complainant had a prior right - on the date of the application of the disputed domain name - by virtue of these national trademark registrations.

The submission of the new evidence raises the issue as to whether the Complainant should be allowed to present this new material to the Panel and whether the Panel can take the material into consideration when making its decision. Basically, the problem is whether it is the Panel's role to determine if the Complainant did in fact have a right to vanhouten.eu based on the new material presented to the Panel, or whether it is to determine if the Respondent and the validation agent has complied with the Regulation based on the material which was presented to the Respondent and its agent.

It is the Panel's view that the role of the Panel is to determine whether the Respondent has complied with the Regulation. Consequently, if the Panel admitted the new material as documentary evidence it would conflict with the first-come-first served principle and conflict with the legitimate expectations of the potential next applicant in line for the domain name. The Panel is aware that no applicant is in queue for the said domain name. However, this does not change the Panel's view of the matter. Finally, it is the Complainant who has the burden of evidence for proving a prior right to the domain name, and the Complainant could have submitted the said new evidence of national trademark registrations within the 40 day period. The risk of not doing so must lie with the Complainant.

The Panel also refers to cases no. 219 (ISL), no. 294 (COLT), no. 706 (AUTOWELT), no. 865 (HI), no. 954 (GMP), no. 1275 (THUN) and no. 1549 (EPAGES).

For these reasons the Panel cannot admit the new evidence from the Complainant when making its decision.

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	**Jakob Plesner Mathiasen**

DATA WYROKU ARBITRAŻOWEGO 2006-09-05

Summary

STRESZCZENIE WYROKU ARBITRAŻOWEGO W JĘZYKU ANGIELSKIM STANOWI ZAŁĄCZNIK NR 1

On December 7th, 2005 the Complainant filed a request for registration of the domain name "vanhouten.eu".

The Complainant was the first applicant in queue for the domain name.

The Prior right claimed was based on a license agreement to an application for a Community trademark.

The Respondent rejected the request for registration of the domain name on the grounds that the documentary evidence submitted by the Complainant did not prove that the Complainant owned rights to a registered trademark.

On June 6th, 2006 Complainant filed a complaint to the Czech Arbitration Court. With the complaint the Complainant has submitted new documentary showing evidence that it held rights to several national trademark registrations of “Van Houten” when filing for registration of the disputed domain name.

The Panel ordered the complaint to be denied, since a trademark application did not constitute a prior right according to the Regulation.

Finally, the Panel did not admit the new evidence from the Complainant presented during the ADR procedure. Thus, it is the Panel’s view that the role of the Panel is to determine whether the Respondent has complied with the Regulation. Consequently, if the Panel admitted the new material as documentary evidence it would conflict with the first-come-first served principle and conflict with the legitimate expectations of the potential next applicant in line for the domain name. Finally, it is the Complainant who has the burden of evidence for proving a prior right to the domain name, and the Complainant could have submitted the said new evidence of national trademark registrations within the 40 day period. The risk of not doing so must lie with the Complainant.