Panel Decision for dispute CAC-ADREU-001535

Case number	**CAC-ADREU-001535**
Time of filing	**2006-05-29 10:43:30**
Domain names	**archive.eu, library.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Stichting Internet Archive, brewster kahle**

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

N/A

FACTUAL BACKGROUND

The Complainant, Stichting Internet Archive, is the owner of the trademarks “archive” and “library”. These trademarks were registered in the name of the Complainant on 22 November 2005 by the Benelux Trademark office. (Hereinafter these trademarks shall be referred to as the “archive trademark” and “library trademark”).

On 7 December 2005, the Complainant filed an application for the registration of the domain name “archive.eu”. The documentary evidence regarding the application was submitted to EURid by Complainant in due time. As documentary evidence proving the prior right the Complainant presented trademark application for archive trademark.

The same day, Complainant filed another application for the registration of the domain name “library.eu”. The documentary evidence regarding the application was submitted to EURid by Complainant in due time. As documentary evidence proving the prior right the Complainant presented trademark application for library trademark.

The Respondent rejected the application for the registration of domain names “archive.eu” and “library.eu” because in case of “archive.eu” as well as in the case of “library.eu” the documentary evidence only included an application for trademark registration, not a certificate proving the existence of a registered trademark.

A. COMPLAINANT

The Complainant is the owner of archive trademark and library trademark and therefore pursuant to article 14 of the Commission Regulation (EC) No.874/2004 the Registry should have registered domain names "archive.eu" and "library.eu" in Complainant's name. The Registry rejected Complainant's applications and therefore the Registry's decisions conflict with the European Union Regulations.

B. RESPONDENT

The documentary evidence submitted by the Complainant regarding the applications for "library.eu" and "archive.eu" domain name consisted of trademark applications and therefore the Respondent was in the position to reject the applications as the Commission Regulation (EC) No.874/2004 states that only the holder of a prior right is eligible to be granted the corresponding domain name and Sunrise Rules provide expressly that a trademark application is not considered a prior right.
The Respondent also states that the Respondent was under no obligation to conduct its own investigation to find out whether the library trademark and archive trademark had been registered in the name of the Complainant or not.

DISCUSSION AND FINDINGS

In consideration of the Factual Background and the Parties' Contentions stated above, the Panelist comes to the following conclusion:

Article 10 of the Commission Regulation (EC) No 874/2004 of 28 April 2004 (Regulation) states that only holders of "Prior Rights recognised or established by national and/or Community law and public bodies are eligible to apply to register domain names during the period of phased registration before general registration of .eu domain starts (i.e. during the so called "Sunrise Period").

Article 13.1 of the Sunrise Rules states that "where the Prior Right claimed by Applicant is a registered trademark, the trademark must be registered by a trademarks office in one of the member states, the Benelux Trademarks 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. Article 13.1. of the Sunrise Rules expressly states that a trademark application is not considered a prior right".

The above allows this Panel to conclude, as it has also been found in case no 376 (FUTBOL, CHEAPTICKETS) that "under the Commission Regulation (EC) no 874/2004 of 28 April 2004 and the Sunrise Rules (without prejudice to any other possible Prior Rights) only trademarks already registered constitute Prior Rights for the application for the registration of .eu domain names during the "Sunrise Period"".

According to the Registration Certificates provided by Complainant, it occurs that archive trademark and library trademark were registered on 22 November 2005. On 7 December 2005, the date in which the Complainant applied for the registration of the domain names in issue, the trademarks named above were already registered.

Article 14 of the Regulation states that 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. This article clearly expresses that the burden of proof rests with the applicant and that the applicant must present documentary evidence proving the existence of a prior right.

In current case the library trademark and archive trademark were registered before the Complainant applied for the domain names "library.eu" and "archive.eu" but the Complainant did not provide proof of the subsequent registration of the trademarks. The Complainant only presented documents proving that the Complainant had applied for library trademark and archive trademark as documentary evidence. The Complainant presented documents proving the registration of library trademark and archive trademark only during this ADR proceeding.

Having failed to submit relevant documentary evidence proving the existence of a prior right in due time the Panel – based on the presentation of the case under this ADR proceeding – finds that the rejection made by the Respondent of the Complainants application regarding the domain names "archive.eu" and "library.eu" was correct.

With regard to the Respondent's obligation to conduct its own investigation Article 21.3 of the Sunrise Rules has to be taken in consideration. Pursuant to this Article 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.

In this situation the validation agent has to make reasonable decisions. In some cases it might be necessary to further investigate whether or not the applicant is the holder of the prior right claimed. In current case the presented documentary evidence quite clearly indicated that the applicant had only applied for the library trademark and archive trademark. In such case it would be unreasonable to expect the validation agent to further investigate if the trademarks are already registered in the name of the applicant or not.

The Complainant has not indicated that it was impossible for the Complainant to present the Registration Certificates regarding the library trademark and archive trademark as documentary evidence. Therefore the fact that the Complainant presented trademark applications instead of the trademark registration certificates as documentary evidence should be considered as a mistake of the Complainant. An applicant can not file an application where it has not given the adequate information and hope that the validation agent during further investigation will discover it and give the applicant an opportunity to correct his errors. In several ADR proceedings (INSURESUPERMARKET 01194, ISL 00219, ULTRASUN 00541, NAGEL 00119, COLT 00294) the Panel has found that the burden of proof is with the applicant and found that the purpose of the ADR proceedings is not to correct the mistakes done by the applicants.

In the current matter it was obvious from the presented documentary evidence that the Complainant had only applied for the library trademark and archive trademark. Therefore the Panelist decides that it would not have been reasonable to expect that the Respondent should have carried out further investigation and the Respondent was entitled to reject the applications regarding domain named „llibrary.eu" and „archive.eu" after carrying out the prima facie review of the first set of documentary evidence provided by the applicant

according to section 21.2 of the Runrise Rules

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	**Viive Naslund**

DATE OF PANEL DECISION 2006-09-06

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contests the Respondent's decision of rejecting the domain name application for "archive.eu" and "library.eu" during the Sunrise Period.

According to the Respondent the application was rejected because from the documentary evidence which the Respondent was provided with it appeared that the "archive" and "library" trademarks were not registered and the Applicant did not appear to be the holder of the alleged prior right.

As it was obvious from the documentary evidence presented by the Applicant that the Applicant had only applied for the trademarks and the Applicant did not present trademark registration certificates proving that the Applicant is the holder of trademarks, the Panel decides that it would not have been reasonable to expect that the Respondent should have carried out further investigations and the Respondent was entitled to reject the application after carrying out the prima facie review of the first set of documentary evidence provided by the Applicant according to section 21.2 of the Sunrise Rules.