Panel Decision for dispute CAC-ADREU-001549

Case number	CAC-ADREU-001549
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Domain names	epages.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	ePages Software GmbH, Charles Julien

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 Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

A. Factual Background related to the Application for the domain name <epages.eu>

1. The Complainant is ePages Software GmbH, based in Germany.

2. The Complainant is the owner of the following German trademarks:
- 303 32 240 "epages", filed on June 27, 2003 and registered on March 23, 2006.
- 303 32 267 "e.pages", filed on June 27, 2003 and registered on March 10, 2004.

3. On February 2, 2006 the Complainant applied to register the domain name <epages.eu>, based on the German trademark 303 32 240 "epages", considered as Prior Right during the Sunrise Period.

4. On February 8, 2006 the registrar of the Complainant submitted an extract from the German Trademark and Patent Office concerning the 303 32 240 "epages" German trademark and evidencing that the Complainant had applied for this trademark on June 27, 2003.

5. On April 19, 2006 EURid refused to register the domain name <epages.eu> in the name of the Complainant on the grounds that the Documentary Evidences do not document said Prior Right.

B. Factual Background related to the ADR Proceeding

6. On May 29, 2006, the Complainant filed his complaint with the ADR Center for .eu attached to the Czech Arbitration Court (herein after the "Court").

7. On June 2, 2006, the Respondent provided the Court with a copy of the Documentary Evidence filed by the Complainant in support of his Application, as asked by the Case Administrator.

8. On July 17, 2006, the Respondent sent his Response to Complaint.

9. On July 19, 2006, the Panel was duly appointed by the Court.

10. On July 24, 2006, the case file was transmitted to the Panel.

A. COMPLAINANT

11. The Complainant contends as follows:

11.1. The German trademark 303 32 240 "epages" has been registered on March 23, 2006 "which was after the expiration of the deadline for documents, but before the application has been reviewed and refused by the Registry".

11.2. Therefore, the EURid's decision "violates Article 12 (2), (3) and Article 14 EC Regulation No. 874/2004. According to said Regulation, during the first part of phased registration inter alia national trademarks may be applied for as domain names".

11.3. "In accordance with Article 12 (3) EC Regulation No. 874/2004 the request to register the domain name shall include a reference to the legal basis in national or Community law for the right to the name, as well as other relevant information such as trademark registration number".

11.4. "According to Article 14 EC Regulation No. 874/2004 the validation agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name".

11.5. "The complainant was registered owner of the German trademark 303 32 267 "e.pages" when he applied for the domain name "epages.eu". The complainant based her application on a national trademark and – by submitting the extract of the official database concerning its German trademark – informed the validation agent about his trademark rights and the registration number of his trademark".

11.6. Therefore, according to the Compainant, "the validation agent was in a position to examine the trademark rights of the complainant and the Registry had to accept the application for the domain name <epages.eu>".

B. RESPONDENT

12. The Respondent contends as follows:

12.1. To explain the grounds on which the Respondent has rejected the Application for the domain name <epages.eu>, the Respondent quotes Article 10 (1) of the Regulation and Article 13.1(ii) of the Sunrise Rules which states that "trademark applications shall not be considered to be a prior right".

12.2. As the validation agent concluded that the Complainant's documentary evidence only demonstrated that he held a trademark application on the "epages" sign, and not a registered trademark as required by article 10 (1) of the Regulation, the Respondent rejected the Complainant's application".

12.3. In order to reject Complainant's arguments based on German trademark n° 303 32 267, which was "apparently already been registered on 10 March 2004", the Respondent note "that the Complainant did not enclose the trademark registration, or even refer to it in any way, with its documentary evidence. These documents were provided to the Respondent for the first time in the framework of the present ADR proceedings". Consequently, "the Respondent could therefore not take into account this trademark when deciding on the Complainant's domain name application so that it was correct in rejecting the Complainant's domain name application".

DISCUSSION AND FINDINGS

13. In consideration of the Factual Background and the Parties' Contentions stated above, the Panel comes to the following conclusions:

A. About the German Trademark 303 32 240 "epages" registered on March 23, 2006

14. Article 10 (1) of the Regulation states that only the holder of a Prior Right is eligible to be granted the corresponding domain name during Sunrise Period, being said that "Prior Rights" shall be understood to include "registered national and community trademarks".

15. Section 13 (1) (ii) of the Sunrise Rules adds: "A trade mark application is not considered a Prior Right" and it is 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.

16. The Documentary Evidence described above at 4. consists of an extract from the German Trademark and Patent Office concerning the 303 32 240 German Trademark "epages" evidencing only that the Complainant had applied for this trademark on June 27, 2003.

17. Consequently, on the basis of the above-mentioned provisions of the Regulation and the Sunrise Rules, it is this Panel's finding that the Documentary Evidence filed by the Complainant in support of his Application for the disputed domain name (described above at 4.) does not constitute a Prior Right.

18. Although the Complainant admits that he only submitted the German trademark application n° 303 32 240 on the sign "epages", it results from his complaint that it is not relevant whether a trademark has been registered at the time of application for the disputed domain name, but only whether it has been registered at the time of the decision of EURid. Furthermore, the Complainant asserts that EURid should have independently verified whether the trademark application had in the meantime been registered.

19. However, pursuant 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 abd the Documentary Evidence produced". Consequently, there was no obligation for the Respondent to conduct its own investigations concerning the Prior Right claimed (e.g. verify whether the trademark application has been registered since its application), as decided by the Panel in case n° 127 (BPW).

20. Moreover, Article 14 (4) of the Regulation states that it is up to the applicant to substantiate that he holds a Prior Right. The applicant must do this by submitting Documentary Evidence which would allow the Respondent to assess if the applicant holds a Prior Right. In the present case, the Complainant failed to submit documentary evidence showing that he was the holder of a Prior Right as he only submitted proof that he applied for a trademark.

21. On the basis of the above-mentioned provisions of the Regulation and the Sunrise Rules, it is this Panel's finding that the Respondent had no obligations to conduct its own investigations and that the Respondent had sufficient grounds to reject the Complainant's application.

B. About the German Trademark 303 32 267 "e.pages" registered on March 10, 2004

22. To demonstrate that he had a trademark registration at the time of its application, the Complainant also refers to trademark n° 303 32 267, which has been registered on 10 March 2004.

23. However, the Documentary Evidence provided by the Respondent, at the request of the Case Administrator, shows that the Complainant did not enclose the trademark n° 303 32 267 registration, or even refer to it in any way, with its Documentary Evidence when he applied for the disputed domain name. This fact is not contested by the Complainant. Consequently, it is stated that these documents were provided to the Respondent for the first time in the framework of the present ADR proceeding.

24. Section 21 (2) of the Sunrise Rules states that "the Validation Agent examines whether the Applicant has a Prior Right" to the domain name "exclusively on the basis of a prima facie review of the first set of Documentary Evidence received". On this matter, in case n° 294 (COLT), the Panel agreed that a Panel cannot take into account documents submitted in the framework of an ADR proceeding when assessing the validity of a decision of the Respondent.

25. Thus, only the documents which the Respondent was able to examine at the time of validation of Complainant's application should be considered by the Panel. In the present case, trademark n° 303 32 267 was not submitted with or referred to in the Documentary Evidence that the Complainant submitted to the Respondent. The Respondent could therefore not take into account this trademark when deciding on the Complainant's domain name application.

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	Frédéric Sardain

DATE OF PANEL DECISION 2006-07-24

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed an application for the domain name <epages.eu>, during Sunrise Period, which was rejected by EURid on the

grounds that the Complainant failed to submit Documentary Evidence showing that he was the holder of a Prior Right as he only submitted proof that he applied for a trademark.

To demonstrate that he had a trademark registration at the time of its application, the Complainant also refers to another trademark which had been registered on 10 March 2004. However, after examination of the Documentary Evidence, it seems clear that this registered trademark was not enclosed with said Documentary Evidence when the Complainant applied for the disputed domain name.

Having reviewed the Documentary Evidence and having considered all other documents in the case file in this complaint, the Panel decides that:

(i) the Documentary Evidence filed by the Complainant in support of his Application for the disputed domain name does not constitute a Prior Right;

(ii) there is no obligation for the Respondent to conduct its own investigations concerning the Prior Right claimed (e.g. verify whether the trademark application has been registered since its application);

(iii) the Panel cannot take into account documents submitted in the framework of an ADR proceeding when assessing the validity of a decision of the Respondent.

The complaint is dismissed.