Panel Decision for dispute CAC-ADREU-001627

Case number	**CAC-ADREU-001627**
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Domain names	**planetinternet.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Richard Canten (Koninklijke KPN N.V.)**

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

None

FACTUAL BACKGROUND

This Complaint arises out of the interpretation and application of Commission Regulation (EC) No 874/2004 of 28 April 2004 (“Regulation”) and the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the phased registration period (“the Sunrise Rules”).

The Complaint is made by Koninklijke KPN N.V. (“the Complainant”) against the decision of the EURid (“the Respondent”) which rejected the Complainant’s application for the registration of the domain name «planetinternet.eu».

The Complainant applied for the domain name «planetinternet.eu » on 18 January 2006, relying on its rights in the Benelux trademark 0551229. The Complainant’s documentary evidence was received on 30 January 2006. The application was thereafter reviewed by the validation agent and subsequently dismissed by the Respondent for failing to establish a prior right.

By way of remedy, the Complainant requests that the domain name «planetinternet.eu» be transferred to itself.

The Complainant has lodged its Complaint pursuant to Section 26 of Sunrise Rules, which provides that following a decision by the Registry to register a .eu domain name, an interested party may initiate an ADR Proceeding (as defined therein) against the Registry with regard to that decision.

A. COMPLAINANT

The following is a summary of the main submissions of the Complainant.

The Complainant asserts:

1. The Complainant is a renowned telecom provider, with its statutory seat in The Hague, the Netherlands. Until 27 June 1998, the Complainant was known as PTT Nederland N.V. On 27 June 1998 the name of the company was changed from Koninklijke PTT Nederland N.V. into Koninklijke KPN N.V. The name change was effected by a change of the articles of association. The articles were changed by a deed of which a copy is attached to this complaint (provided in Annex 2).

2. The Complainant has held the right to the Benelux trademark PLANET INTERNET (hereinafter referred to as “the trademark”) since 1 February 1995. The Complainant sets out the requirements for establishing the right to a trademark in the Benelux and the history of the Complainant’s trademark for PLANET INTERNET.

(a) The condition for recognition and establishment of a trade mark right in the Netherlands, is that the trade mark must be registered as a trade mark with the Benelux Trademark Office and in accordance with the Benelux Trademark Act. (A trade mark right can also be established by registration as a Community Trademark with OHIM, but this is not relevant for this complaint.) Section 3 of the Benelux Trademark Act stipulates that the sole right to a trade mark within the Benelux is established by registration of the trade mark with the Benelux Trademark Office.

(b) The Complainant has been the rights holder with regard to PLANET INTERNET as a trademark within the Benelux since 1 February 1995. The trademark was of course originally registered in name of Koninklijke PTT N.V. (hereinafter “PTT”). The Benelux Trademark Office issued a formal proof of registration document, which was sent to the registrant PTT. A copy of this official document is attached (provided in Annex 3) to the Complaint. As shown, the trademark was registered for numerous goods and services under registration number 551229.

(c) As the trademark was legally due to expire on 18 August 2004, the Complainant submitted a request for renewal to the Benelux Trademark Office. The Benelux Trademark office confirmed receipt of the request. This document, the acknowledgment of receipt, is attached as Annex 4 to this complaint. The acknowledgment of receipt explicitly states on the top of the page, that the information on the acknowledgment sheet is identical to the information filed and documented about the trademark and its holder in the Benelux Trademark Register. Therefore, on the date the Benelux Trademark office received the request for renewal of the trademark PLANET INTERNET the trademark had registration number 551229, and the trade mark holder was Koninklijke KPN N.V (the Complainant). The date the request for renewal was received is 26 May 2004. The request for renewal was granted. The new expiry date for the trade mark PLANET INTERNET is now 18 August 2014. Annex 5 contains a copy of the trademark registration from the online trade mark register of the Benelux Trademark Office. Annex 5 also shows the new expiry date of 18 August 2014, as well as the date the renewal was officially published: 1 November 2004.

Therefore, it should be concluded that the Complainant has a prior right to the domain name «planetinternet.eu».

3. On 18 January 2006, the Complainant applied for the domain name «planetinternet.eu». The Complainant states that by mistake, the evidentiary material that it submitted consisted solely of an extract of the certificate of registration with regard to the trademark PLANET INTERNET, of which a copy has been attached as Annex 3 to the Complaint. The Complainant further admits that it mistakenly failed to submit an extract of the certificate of renewal as referred to below, of which a copy is attached as Annex 6 to the Complaint.

4. The Complainant considers that the Respondent’s decision to reject the Complainant’s application for domain name «planetinternet.eu» could be based on two arguments, both of which it refutes below:

(a) First, the certificate of registration indicates that the name of the applicant (i.e. the holder of the trademark PLANET INTERNET) is Koninklijke PTT Nederland N.V. If the Respondent decided to reject the application because the holder of the trade mark mentioned on the certificate of registration (PTT) was supposedly not the same as the applicant (KPN), this decision is based on a false assumption. As stated above, Koninklijke PTT Nederland N.V. changed its name on 27 June 1998 into Koninklijke KPN N.V. The name change was effected by a change of the articles of association. The articles were changed by a deed of which a copy is attached to the Complaint as Annex 2.

(b) Second, the certificate of registration indicates that the trademark PLANET INTERNET was legally due to expire on 18 August 2004. Pursuant to the certificate of registration the Complainant did not have a prior right to the domain name «planetinternet.eu» when it applied for the domain name on 18 January 2006. However, as elaborated above, the Complainant submitted a request for renewal for the trademark PLANET INTERNET, which was granted by the Benelux Trademark Office. The certificate of renewal was published on 1 November 2004 and indicates the new expiry date of 18 August 2014. The certificate of renewal is provided in Annex 6 to the Complaint.

Either way, the Complainant considers that KPN (formerly under the name of PTT, but since 1998 under its current name KPN) is the exclusive and legitimate owner of the trademark since 1 February 1995, and therefore the Complainant, KPN, has a prior right to the domain name «planetinternet.eu».

B. RESPONDENT

The following is a summary of the main submissions of the Respondent:

The Respondent contends:

PROCESS AND PROCEDURE

1. The Respondent rejected the Complainant’s application for the the domain name «planetinternet.eu» on the basis of:

(a) Regulation

Article 10 (1) of the Regulation which states that: "[h]olders 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. Prior rights shall be understood to include, inter alia, registered national and community trademarks (…)".

Article 14 of the Regulation, "[a]ll 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 provision further states that "[e]very applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question. (…)The relevant 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. If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this. (…) The Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure (…)".

(b) Sunrise Rules

Section 11.3. of the Sunrise Rules states that "[t]he Applicant must be the holder (or licensee, where applicable) of the Prior Right claimed no later than 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".

Section 21.2. of the Sunrise Rules states that "[t]he Validation Agent examines 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 and scanned by the Processing Agent (including the Documentary Evidence received electronically, where applicable) and in accordance with the provisions of these Sunrise Rules".

Section 21.3. of the Sunrise Rules further states that "[t]he Validation Agent is not obliged, but it 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".

2. The Complainant applied for the domain name «planetinternet.eu» for the first time on 7 December 2005. The processing agent did not receive the documentary evidence before the 16 January 2006 deadline, which lead to the expiration of the application. The Complainant applied a second time for the domain name «planetinternet.eu» on 18 January 2006. The processing agent received the documentary evidence on 30 January 2006, which was before the 27 February 2006 deadline. The validation agent concluded from its examination of the documentary evidence that the Complainant was not the actual owner of the PLANETINTERNET trademark. Indeed, the Complainant submitted an extract from the Benelux Trademark Register in support of its application. This extract mentioned a different company as the owner of the PLANETINTERNET trademark.

3. Furthermore, the validation agent concluded from its examination of the documentary evidence that the prior right relied upon in the documentary evidence had expired. Indeed, the Complainant submitted a certificate of registration that indicates that the PLANETINTERNET trademark was legally due to expire on 18 August 2004. In its complaint, the Complainant acknowledges that it "mistakenly failed to submit an extract of the certificate of renewal".

4. The Registry therefore rejected the Complainant's application.

RESPONSE TO COMPLAINANT'S CONTENTIONS

5. The Complainant agrees that the extract it submitted mentions a name as the owner of the PLANETINTERNET trademark ("Koninklijke PTT Nederland NV") which is different from the name of the Complainant ("Koninklijke KPN NV"). However, the Complainant argues that it is the owner of the trademark. The Complainant states that in 1998 its name was changed from Koninklijke PTT Nederland NV (which is mentioned as the owner of the trademark on the extract) to its present name Koninklijke KPN NV. In support of this argument, the Complainant submits a deed which allegedly proves that the name was changed. With this ADR procedure, the Complainant seems to be aiming to repair the mistake that it made when submitting the documentary evidence.

6. The Complainant also agrees that on the face of the documentary evidence, the trademark was legally due to expire on 18 August 2004. The Complainant acknowledges that it "mistakenly failed to submit an extract of the certificate of renewal"; but now explains that such certificate of renewal was published on 1 November 2004 and indicates the new expiry date of 18 August 2014. Here again, the Complainant seems to be using this ADR procedure to repair the mistake that it made when submitting the documentary evidence.

7. Pursuant to Article 22(1) b of the Regulation, the object of the present ADR proceedings is to determine whether the Respondent's decision to reject the Complainant's application is in conflict with the applicable rules: the Regulation and the Sunrise Rules. As decided in ADR 1194 «insuresupermarket.eu», "[t]he ADR procedure is not intended to correct domain name applicants' mistakes".

8. The documentary evidence did not prove that the Complainant was the owner or licensee of the PLANETINTERNET trademark. Article 10 (1) of the Regulation states that only the holder of a prior right is eligible to be granted the corresponding domain name. It is therefore of great importance that the Registry is provided with all information that allows it to assess if the Applicant is the holder of a prior right. Pursuant to Article 14 (4) of the Regulation, the documentary evidence must clearly show that the applicant is the holder of the prior right claimed on the name in question.

9. Section 20 (3) of the Sunrise Rules states that 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.

10. The Complainant failed to submit an official document showing the name change with its application. Therefore, the Registry could not have known that the Complainant was indeed the same entity as the entity mentioned in the extract of the Benelux Trademark Register.

11. The Panels in ADR 00119 «nagel.eu» and ADR 00232 «dmc.eu» both stated that Article 14 of the Regulation puts the burden with the applicant to prove that it holds a prior right. If an applicant fails to prove that it is the holder of a prior right, the application must be rejected.

12. Therefore, the Respondent contends that the applicable rules were respected in so far as the Respondent based its rejection decision on the fact that, before the 27 February 2006 deadline, the documentary evidence did NOT demonstrate that:

(a) Complainant was the owner or licensee of the PLANETINTERNET trademark.

(b) the PLANETINTERNET trademark registration was still valid. Pursuant to Section 11.3. of the Sunrise Rules, the applicant must show a valid prior right, "which means that it must be in full force and effect".

(c) PLANETINTERNET trademark was in full force and effect, since, as the Complainant acknowledges, the PLANETINTERNET trademark was legally due to expire on 18 August 2004 and the Complainant mistakenly failed to submit an extract of the certificate of renewal.

Therefore, the Respondent contends that the applicable rules were respected in so far as the Respondent based its rejection decision on the fact that, before the 27 February 2006 deadline, the documentary evidence did not demonstrate the existence of a valid registered trademark, but merely demonstrated that the Complainant was the holder of an expired trademark.

13. In ADR 219 «isl.eu», the Panel stated that:

"The Complainant contested the rejection made by the Respondent (EURid) to the Complainants application for the domain name «isl.eu» under the sunrise periods. Rejection was based on the fact that the Complainant in the, in due time, filed documentary evidence did not proof that the trademark - on which the application was based – was in fact existing, hereunder renewed in due time. The Panel concluded that the prior right was in fact existing but found that such documentary evidence proving such was not in due time presented

before the validation agent hence the Respondent had the right to deny the Complainants application as the burden of proof is the Complainant"

NEW EVIDENCE SUBMITTED BY COMPLAINANT

14. The Complainant now submits new evidence to demonstrate that the Koninklijke PTT Nederland N.V. changed its name on 27 June 1998 into Koninklijke KPN N.V. and that the PLANETINTERNET trademark registration was renewed until 18 August 2014.

15. The Respondent wishes to stress that the Complainant did not enclose the trademark registration, or even refer to it in any way, within its documentary evidence. These documents were provided to the Respondent for the first time in the framework of the present ADR proceeding.

16. 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.

17. In ADR 706 «autowelt.eu» and ADR 219 «isl.eu», the Panel agreed that a Panel may not take into account documents submitted in the framework of an ADR proceeding when assessing the validity of a decision of the Respondent

18. The Panels in cases ADR 294 «colt.eu», ADR 954 «gmp.eu» and ADR 1549 «epages.eu» also assert that documents which were not part of the first set of documents submitted to the validation agent at the application stage should be disregarded in ADR proceedings against the Respondent.

19. Even if the new documents submitted by the Complainant were to adequately demonstrate that it is the holder of the trademark at stake and that this trademark has been successfully renewed, these new documents may not be taken into consideration to evaluate the Respondent's decision. Thus, only the documentary evidence that was submitted to the Respondent at the time of validation of the applications should be considered by the Panel.

FURTHER REMARKS AND CONCLUSION

20. The Respondent also brings to the attention of the Panel that the Complainant was involved in at least two other cases involving part of the same factual elements and legal arguments, both of which were decided in favour of the Respondent (see ADR 894 «beep.eu» and ADR 865 «hi.eu»).

21. For the abovementioned reasons, the Complainant's request to annul the Respondent's decisions to transfer the domain name PLANETINTERNET to the Complainant must be rejected.

22. As the Panel in ADR 219 «isl.eu» stated, "One could argue that sympathy is overruled by the applicable Regulations serving among other purposes the (cost-effective) functionality of the phased registration and the principles hereof". Strict rules are indeed essential to manage the validation of hundreds of thousands of domain name applications.

DISCUSSION AND FINDINGS

SUBMISSION DEADLINES

1. Before the Panel assesses the merits of this case, it must first deal with the preliminary issue of the Respondent’s failure to file its response to the Complaint within the given deadline. Section A2(i) of the ADR Rules provides that the Provider may only extend a deadline (other than by agreement of all Parties) provided that the requesting party has filed its request before the expiration of the original deadline. In this instance, the Respondent was notified that an ADR Proceeding had been commenced against them on 12 June. 2006. In accordance with Section B3(a), the notification stated that the Respondent had to submit a Response to the Complaint within 30 working days from the delivery of the notification i.e. by 24 July 2006. The Respondent did not respond until 1 August 2006, and at that point, sought an extension to the original deadline. This extension, which was approved by the Provider, now appears to have been granted erroneously.

In light of this, the Panel relying on Section B3(f) of the ADR Rules, and further Section B8, shall solely admit the Respondent’s Response purely for information.

PANEL FINDINGS

2. The Regulation and further the Sunrise Rules govern all .eu domain name applications made during the phased registration period. The principal obligations of the Registry regarding its decision to register .eu domain names during the phased registration are set out in Article 14 of the Regulation, and in particular, the final paragraph of that Article 14 obliges the Registry to register .eu domain names on a the first come first served basis, PROVIDED THAT it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in that Article. Thus, the Panel must establish whether the Complainant demonstrated such a prior right when it applied for the domain name «planetinternet.eu».

3. It should be noted that the Complainant has attached many new documents to its Complaint which did not form part of its application: the Panel agrees with previous Panels' comments on this point – that documents which did not form part of the first set of documents submitted to the validation agent should be disregarded when assessing the validity of a decision of the Respondent (ADR 706 «autowelt.eu», ADR 294 «colt.eu», ADR 219 «isl.eu»). Moreover, "[i]f the Panel admitted the documents filed by the Complainant, it would put it self into a role of quasi-validation or registration entity which would go beyond its powers" (ADR 865 «hi.eu»).

4. The application for the domain name «planetinternet.eu» by the Complainant was made on 18 January 2006, with the documentary evidence being received by the Respondent's validation agent on 30 January 2006. The Complainant only submitted an extract of the certificate of registration for the Benelux trade mark PLANET INTERNET with which there were 2 issues:

(i) The name on trade mark certificate did not match the applicant's name; and

(ii) The submitted trade mark certificate had expired in August 2004

5. In light of these abnormalities in respect of the documentary evidence submitted by the Complainant in its application for the domain name «planetinternet.eu», the Panel must consider whether the validation agent fulfilled its obligations when assessing the Complainant's application. Under the Sunrise Rules:

"The Validation Agent examines 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" (Section 21.2); and further,

"The Validation Agent is not obliged, but it 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." (Section 21.3).

6. The Panel must consider each issue with the Complainant's application (as set out in paragraph 4, above).

(i) The name on trade mark certificate did not match the applicant's name

The Complainant explains in detail that in 1998, it changed its company name from «Koninklijke PTT Nederland NV» to «Koninklijke KPN NV», and given that the trade mark was granted in 1995, the certificate still contained the original name of «Koninklijke PTT Nederland NV»: for that reason, the name on the trade mark certificate which it submitted to the validation agent was different to the name set out on its application for the domain name «planetinternet.eu». It should be recalled that Section 20.3 of the Sunrise Rules expressly provides that where there has been a name change, the relevant documentation must be submitted to substantiate that it is the same person.

The validation agent conducted a prima facie review of the submitted document, and in conjunction with point (ii) below, reached the conclusion that as the names did not match, and there was no other documentary evidence to explain such a discrepancy, that the applicant (i.e. the Complainant) had not established its prior right. While it is pure speculation on the part of the Panel, had the Complainant submitted a copy of the deed which shows the name change (as has been provided in this Complaint), the validation agent may well have reached a different conclusion on this point. As noted in paragraph 5, the validation agent is not obliged to conduct its own investigations and therefore an applicant must take care in making its application during the phased registration period to ensure all necessary documentation is submitted to support its application and clearly establish its prior right to a domain name. In this application, the Complainant failed to meet this requirement.

(ii) The submitted trade mark certificate had expired in August 2004

It is undisputed that the Complainant submitted as its documentary evidence, a trade mark certificate which had expired in August 2004, i.e. prior to the date of the application. At the time of its application, the Complainant was in fact in possession of a valid certificate of renewal for the trade mark (and in the correct name), but while it has provided a copy of this in its Complaint, it did not submit this to the validation agent: as the Complainant acknowledges, this was a mistake and it does appear to be an unfortunate oversight.

The validation agent, who was only in receipt of the expired trade mark certificate, was under a duty to reject the application on the basis of Section 11.3, given that as far as the validation agent was aware, on the date of the Application (18 January 2006) the Prior Right had already expired (18 August 2004). Section 11.3 provides,

“The Applicant must be the holder (or licensee, where applicable) of the Prior Right claimed no later than 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.”

5. While it could be argued that the validation agent could have conducted its own investigations, it is certainly not obliged to and indeed should not be expected to. Rather the onus falls on the applicant to provide all documentation to support its application. Further, in this particular instance, given that there were the two anomalies – incorrect name and an expired trade mark certificate, the validation agent and therefore the Respondent was reasonable in reaching its decision to reject the application.

6. As the Panel noted in ADR 219 «isl.eu», “One could argue that sympathy is overruled by the applicable Regulations serving among other purposes the (cost-effective) functionality of the phased registration and the principles hereof”, however, the Regulations and the Sunrise Rules were clearly drafted to ensure a fair distribution of .eu domain names during the phased period and if an applicant fails to fulfil its primary obligations, then, even where such failure is due to an oversight or genuine mistake, the application must be rejected by the validation agent.

CONCLUSION

7. The Panel has carefully considered all facts of this case and, while sympathetic to the Complainant’s position, the Panel does not find any breach of the aforesaid Regulations or Sunrise Rules by the Respondent. The Panel therefore must dismiss the Complaint. While the Panel cannot overly speculate, had the Complainant submitted the correct documentation, demonstrating a name change and the renewal certificate, there would probably be a different outcome.

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	**Simon Moran**

DATE OF PANEL DECISION 2006-08-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested the Respondent’s (EURid) rejection of the Complainant’s application for the domain name «planetinternet.eu» during the phased sunrise period.

The Respondent rejected the application on the basis that (i) the name on the trade mark certificate (the sole documentary evidence) was different to that of the applicant’s (the Complainant) name; and (ii) the trade mark certificate submitted to the Respondent had in fact expired in 2004. The Complainant explained that it mistakenly submitted the incorrect documentation, and provided to the Panel evidence that it had in fact changed its company name and the trade mark had been renewed in due time.

The Panel concluded that the prior right was in fact existing but found that such documentary evidence proving such was not in due time submitted to the validation agent and therefore the Respondent had the right to deny the Complainant's application as the burden of proof remains squarely with the Complainant to submit the correct documentation.