Panel Decision for dispute CAC-ADREU-001665

Case number	**CAC-ADREU-001665**
Time of filing	**2006-06-12 12:02:45**
Domain names	**it-staffing.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Domino Automatisering b.v., Rob Kok**

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

The Complainant submitted an application for registration of the .eu domain name “it-staffing.eu” (hereinafter the “Domain Name”) on 6 February 2006 (hereinafter the “Application”).

This Application was based on the national trademarks “IT-STAFFING” registered with the Benelux Trade Association under No. 0736818 and No. 0747367 (hereinafter “Trademarks”) since July 2003 that were supposed to establish prior rights within the meaning of Article 10 (1) of EC Regulation No. 874/2004 (hereinafter “Public Policy Rules”). According to the excerpt from the Benelux trademarks register, the said trademarks were registered for a company “De IT Staffing Groep B.V.” (hereinafter “Owner of the Trademark”) not for the Complainant (which is the company “Domino Automatisering b.v.”). The Complainant did not provide any additional documents to the Registry explaining the relationship between the trademark owner and the Complainant.

The deadline for filing documentary evidence pursuant to Article 14 of Public Policy Rules was on 18 March 2006 and the Complainant submitted the abovementioned documentary evidence meeting this deadline.

The Respondent by its decision dated 11 May 2006 (hereinafter the “Decision”) rejected the Application because the documentary evidence as provided by the Complainant was considered insufficient to prove the Prior Right of the Complainant to the Domain Name within the meaning of Article 10 (1) of the Public Policy Rules.

On 9 June 2006 and, thus, within the Sunrise Appeal Period as defined by the Sunrise Rules, the Complainant filed a complaint against the Decision (hereinafter the “Complaint”), seeking annulment of the Decision and requesting that the Domain Name be granted to the Complainant. This Complaint was filed incorrectly in Dutch (since, as follows from the registration agreements, the language of the ADR Proceedings against the Registry shall be in English only), and based upon an invitation by the ADR Court the Complainant submitted within the additional deadline the Complaint in the English language, as requested.

The Respondent submitted its unofficial response to the Complaint by way of a non-standard communication on 30 August 2006 (hereinafter the “Response”), failing to comply with the deadline for submission of the Response.

The Complainant followed up on the Response with a non-standard communication of 20 September 2006 advising about certificates of registration with the Utrecht Chamber of Commerce proving that the Owner of the Trademark, De IT Staffing Groep B.V., holds shares in the Complainant company. Copies of these additional documents were attached.

A. COMPLAINANT

The Complainant contends the following:

(a) The abovementioned Trademarks, in particular the trademark registered under No. 0736818, constitutes prior right within the meaning of Article 10 (1) of the Public Policy Rules.

(b) The name IT Staffing has been used by the De IT Staffing Groep B.V. since its set up in November 1999.

(c) The Complainant states that it is an owner of the following domain names: IT-STAFFING.NL, IT-STAFFING.NU, IT-STAFFING.INFO, IT-STAFFING.BE, ITSTAFFING.NL, ITSTAFFING.NU, ITSTAFFING.INFO and ITSTAFFING.BE.

The Complainant contends that the decision of the Respondent to refuse its Application would damage the De IT Staffing Groep B.V. company and its business results, as it is the largest supplier of ICT freelancers in The Netherlands with a well established name within the market.

In a non-standard communication during the ADR proceeding, the Complainant provided certificates of registration with the Utrecht Chamber of Commerce to prove that the Complainant is a 100% subsidiary of the Owner of the Trademark, De IT Staffing Groep B.V., and alleges that this fact establishes a sufficient ground for the Complainant to apply for a domain name on behalf of the trademark holder. The Complainant believes that this fact should have been taken into consideration as well.

In addition, the Complainant also argues that it based its Application on other prior rights than trademark rights, namely on rights to business name, which should be also reflected. This was documented by the prior domain name application filed with the registrar (BIT) (herein after the “Registrar”).

For all the aforesaid reasons, the Decision should be annulled and the Application should be examined in light of the circumstances described above and the Domain Name should be granted to the Complainant.

B. RESPONDENT

The Panel emphasizes that the Response was not filed within the period set forth by Paragraph B3 (a) of the .eu Alternative Dispute Resolution Rules (hereinafter the “ADR Rules”). Nevertheless, the Respondent (by way of a non-standard communication) contends the following:

(a) The Application was rejected due to the fact that the Owner of the Trademark (on the basis of which the prior right was asserted) was different from the Complainant and such difference was not explained in documentary evidence as required by Article 14 of the Public Policy Rules in conjunction with Section 20 (1) of the Sunrise Rules.

(b) The burden of proof as to establishment of the prior right is with the Complainant.

(c) The validation agent examines whether the applicant has a prior right to the domain name in question exclusively on the basis of a prima facie review of the first set of documentary evidence received. The documents later provided (during the ADR Proceedings) by the Complainant are not relevant.

The Respondent was not able to take into consideration the relationship between the Complainant and the trademark holder as this was not explained and supported by relevant evidence documentation provided within the set deadline. Also, the validation agent is not obligated to investigate into the question whether the reported trademark owner is the same entity as the Complainant or further investigate the relationship between them; there may be various reasons why the names of an applicant and trademark owner differ.

In light of the foregoing, it must be concluded that the Complainant failed to establish the prior right to the Domain Name and, therefore, the Complaint should be denied.

DISCUSSION AND FINDINGS

It should be noted that the ADR Proceedings initiated against the Registry (EURid) shall not in any way serve as a “second chance” or an additional round providing applicants an option to remedy their imperfect original application that was rejected during the Sunrise Period (i.e. by way of submitting additional documentary evidence that was not duly presented within the deadline as stipulated in the Article 8 (5) of the Sunrise Rules).

On the contrary, the ADR Proceedings against EURid is strictly limited to a review whether EURid's decision conflicts with the Regulation and with Sunrise Rules.

In light of the above, the Panel observes as follows:

According to Article 10 of the Public Policy Rules, only an applicant who is able to establish a prior right to a domain name is eligible for registration of such domain name during the Sunrise Period.

According to Article 14 of the Public Policy Rules, every applicant shall submit documentary evidence that shows he or she is the holder of the prior right claimed on the domain name in question. This requirement is further specified with respect to each type of prior right by the Sunrise Rules. If the prior right is based on a trademark, the applicant must provide documentary evidence according to the requirements set forth in Section 13 (2) (i) or (ii) of the Sunrise Rules.

Section 20 of the Sunrise Rules sets forth additional requirements the applicant must meet in the event that it is not completely clear from the documentary evidence that the applicant is holder of the prior right on which the application is based. Such requirements, inter alia, apply in cases where the applicant is different from the holder of the prior right in question due to transfer of the prior right, merger or other reasons (Section 20 (2) and (3) of the Sunrise Rules).

According to Section 8 (5) of the Sunrise Rules, all such documentary evidence must be submitted (received by the validation agent) within forty calendar days following receipt of the application in question. This, without a shadow of doubt, also applies to submission of all additional documents (if any) under Section 20 (3) of the Sunrise Rules. As for the Application, such deadline expired on 18 March 2006.

According to Section 21 (1) (ii) of the Sunrise Rules, the validation agent shall verify whether the requirement for existence of the prior right to the domain name claimed by the applicant is fulfilled. According to Section 21 (2), the validation agent examines whether the applicant has a prior right to the domain name in question on the basis of a prima facie review of the first set of documentary evidence received. According to Section 21 (1) in fine of the Sunrise Rules, the validation agent and the Respondent are not obligated to notify the applicant if the requirement to sufficiently establish the prior right to a domain name is not complied with.

The documentary evidence provided by the Complainant shows that the owner of the trademark, on the basis of which the prior right to the Domain Name was asserted, is the company De IT Staffing Groep B.V., and not the Complainant (Domino Automatisering b.v.). The Complainant did not provide any proof within the documentary evidence which would explain that Domino Automatisering b.v. has any right to the Trademark.

During the ADR proceeding the Complainant provided additional certificates (in Dutch without English translation) showing that De IT Staffing Groep B.V. is a shareholder in Domino Automatisering b.v. First, this additional evidence only indicates that there is a certain relationship between these two entities, but still does not precisely explain what rights toward the Trademark (e.g. license rights) or rights to act on behalf of the Owner of the Trademark in this matter were granted to Domino Automatisering b.v. by its shareholder De IT Staffing Groep B.V., who owns the Trademark. Second, the Registry bases its decision exclusively on review of the documentary evidence submitted by the applicant at the time of filing of the Application and within the forty day period as defined in the Public Policy Rules; any documentation provided later or provided only to the Registrar (which was BIT in this case), however not to the Validation Agent, is irrelevant and may not have any influence on the decision.

At this point, the Panel would like to stress that the essence is not whether an applicant is the holder of a prior right, but whether an applicant proves to the validation agent that it is the holder of a prior right. Thus, an applicant should, in its own interest, act with diligence and care and provide all information clearly proving that it is the holder of the prior right or (as the case be) an entity otherwise authorized from such prior right (e.g. as a licensee). The validation agent is not allowed to guess or speculate in this respect.

In light of the foregoing, it must be concluded that it is the responsibility of the domain name applicant to provide before applicable deadlines all documentary evidence in a manner that its prior right to the domain name applied for is clearly demonstrated. Should the documentary evidence show that the holder of the prior right is different from the applicant, the documentary evidence must include an appropriate explanation and documents demonstrating authorization of the applicant to register the domain name on the basis of the asserted prior right.

As for Complainant's assertion that the Application was also based on prior rights other than trademark rights (namely rights to the business name), this was not properly documented in the Application. The Complainant merely provided an original form for registration of the domain name submitted to the Registrar (BIT), which, however, was not corresponding to the official documents provided together

with the Application to Registry.

Moreover, the Application to the Registry was filed on 6 February 2006, which was within the first phased registration (Sunrise Period I). During the first phased registration (Sunrise Period I), it was only possible that registered national or Community trademarks, geographical indications and personal names and acronyms could be served as a prior right for a .eu domain name registration. As a result, the Complainant was not allowed to apply on 6 February 2006 for the Domain Name based upon company or business names and, hence, such Complainant's argument would be irrelevant.

In light of the above, the conclusion must be drawn that the Complainant failed to provide satisfactory evidence on its prior rights within the statutory deadline. The Registry (EURid) correctly rejected the Complainant's Application and its decision conflicts neither with the Sunrise Rules, nor with the Regulation.

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	**Jiri Cermak**

DATE OF PANEL DECISION 2006-10-06

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant applied during the Sunrise Period for the domain name "it-staffing.eu". This domain name application was rejected due to the fact that the owner of the trademark on the basis of which the prior right was asserted was different from the Complainant and such difference was not explained in the documentary evidence.

The Complainant later submitted to the Panel documents that were not part of the documentary evidence showing that the Trademark owner is a shareholder of the Complainant's company.

The Panel holds that the Complainant failed to provide satisfactory evidence on its prior rights within the statutory deadline. The Registry (EURid) should not be held responsible for such Complainant's failure and the purpose of the ADR Proceeding is not to remedy such Complainant's omission.

The Panel denied the Complaint.