Panel Decision for dispute CAC-ADREU-001710

Case number	**CAC-ADREU-001710**
Time of filing	**2006-06-09 13:49:02**
Domain names	**parlophone.eu, emi.eu, emimusic.eu, emirecords.eu, angel.eu, theraft.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**EMI (IP) Limited, Ruth Bond**

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 any other legal proceedings, which are pending or decided and which relate to the disputed domain name
English summary of the decision: English summary of this Decision is hereby attached as Annex 1

FACTUAL BACKGROUND

The Complainant applied for the following domain names within the Sunrise period:
emi.eu, emimusic.eu, emirecords.eu, angel.eu, parlophone.eu, theraft.eu

The Complaint is made in respect of the Respondent's rejections of the Disputed Domains, the Respondent's rejection of which was communicated to the Complainant by emails dated 25 April, 10 May, 16 May, 18 May, 24 May and 25 May 2006. In November 2005, the Complainant instructed the firm MarkMonitor of London House, 100 New Kings Road, London, SW6 4LX, to apply for a number of domain names including the Disputed Domains within the Sunrise Period.The Complainant's instructions specified the trade mark registrations that were to be used as a basis for the domain names emi.eu, parlophone.eu and angel.eu, under the column, "Trade Mark Number." The Complainant secured registration of its Benelux trade marks for THE RAFT, EMI MUSIC and EMI RECORDS on 1 December 2005 and informed MarkMonitor, by email on 5 December, of the registration numbers prior to the beginning of the Sunrise Period on 7 December. On receipt of the Respondent's notification of the rejection of the Disputed Domains, the Complainant obtained copies of the documentation submitted by MarkMonitor and/or its validation agent in support of the Complainant's applications to register the Disputed Domains. The Complainant noted from these documents that contrary to the instructions provided to MarkMonitor the domain names applications for emi.eu, parlophone.eu and angel.eu, were based on pending applications rather than on registered trade marks cited in the Complainant's instructions to MarkMonitor. With regard to the domain names theraft.eu, emimusic.eu, emirecords.eu, the documents used to validate the domain names did not show that the marks were in fact registered.

A. COMPLAINANT

With regard to the THERAFT, EMIMUSIC and EMIRECORDS domain names, the Complainant states that, contrary to his instructions, his registrar sent documentary evidence which only proves that Benelux trademarks had been applied for on December 1, 2005 whereas these trademarks had been registered December 2.

With regard to the EMI, PARLOPHONE and ANGEL domain names, the Complainant states that, contrary to his instructions, his registrar sent documentary evidence containing Community trademark applications, whereas the Complainant is the owner of Community trademarks which have already been registered for other classes.
The Complainant submits that his instructions to MarkMonitor were provided in good faith and on the basis of valid registered trade marks in the Complainant's proprietorship. It would therefore be inequitable as a result of the Respondent's rejections for the domain names to be registered by a third party who does not have a legitimate claim to the domainnames.

The Complainant requests that the rejections are annulled and the domain names are transferred to EMI (IP) Limited and activated.

B. RESPONDENT

The Respondent held that Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") states that only holders of prior rights which are recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.
In his view, the Regulation clearly provides that registered national or Community trademarks may be considered as a prior right.

The Respondent furthermore makes a reference to Section 13.1(ii) of the Sunrise Rules which provides that trademark applications shall not be considered to be a prior right. The Respondent argues that the documentary evidence provided by the Complainant during the sunrise period only consisted of trademark applications.
The validation agent therefore correctly concluded that the Complainant was not the holder of registered trademarks and therefore not the holder of prior rights pursuant to article 10 (1) of the Regulation.

Referring to several ADR decisions the Respondent claims that an applicant should comply with the Sunrise Rules. Furthermore, the burden of proof is with the Complainant to show that it is the holder of a prior right. He has to submit all documents which the validation agent needs to assess whether an applicant is the holder of a prior right corresponding to the domain name. In case an applicant fails to submit such documents, its application must be rejected. With reference to several ADR decisions, the Respondent helds that an application must be rejected if an applicant has failed to submit the required documentary evidence.

The new documents submitted by the Complainant might show that it is the holder of prior rights. However these documents were not enclosed with the documentary evidence. These documents were provided to the Respondent for the first time in the framework of the present ADR proceedings. Referring to several ADR decisions, the Respondent states that 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.

Finally, the Respondent states that the mistake in this case was made by the Complainant's registrar, not by the Registry. The Registry's decision was correct and may not be annulled as a result of an error made by the Complainant's registrar.

DISCUSSION AND FINDINGS

1. According to Section 8 (3) (iv) Sunrise Rules the applicant is required to enclose the relevant Documentary Evidence referred to in Chapter 5 Sunrise Rules (validation of prior rights). Section 10 (1) Sunrise Rules provides that the validation agent validates whether the Documentary Evidence substantiates the prior right claimed by the applicant. Section 11 (3) Sunrise Rules provides that the applicant must be the holder of the prior right.
Section 13 (2), Subsection 2 Sunrise Rules provides that:
"In the forgoing cases, the Documentary Evidence must clearly evidence that the applicant is the reported owner of the registered trademark."
Sect 13 (1) Sunrise Rules provides that a trademark application is not considered a prior right.
Section 21 Sunrise Rules describes the examination of the application including the Documentary Evidence by the validation agent.
Section 21 (2) Sunrise Rules provides that the validation agent examines the prior right of the applicant exclusively on the basis of a "prima facie review" of the first set of Documentary Evidence received by the Registry and in accordance with the provisions of these Sunrise Rules.
As the documentary evidence submitted by the Complainant´s registrar only included only trademark applications, the validation agent correctly concluded that the Complainant was not the holder the holder of registered trademarks and therefore not the holder of prior rights.
2. Section 21 (3) Sunrise Rules confirms that the validation agent is not obliged but only permitted (in its sole discretion), to conduct own investigations into the circumstances of the application, the prior right claimed and the Documentary Evidence produced.
From the Sunrise Rules, one can conclude that the validation agent was not obliged to investigate into the question, whether the documentation provided by the registrar was correct. The application process, particularly the Sunrise Phases, does not provide such obligation of the Registry. The reason behind that is the need to proceed enormous numbers of .eu domain name applications within a reasonable time frame (see Decision No. 01232 – MCE) The Sunrise Rules as well as the Domain Name Registration Policy were publicly accessible during the Sunrise Period by the applicants. Each applicant subscribed to these rules. It is obvious that the validation agent respectively the Registry could not conclude without any supporting evidence that the documentary evidence. Therefore, it can be concluded that relevant Documentary Evidence, such as the confirmation of the right of the Complainant with respect to the registered trademarks, was not received within the 40 days period laid down in section 8 (5), Subsection 4 Sunrise Rules. By only reviewing the Documentary Evidence provided by the Complainant, the validation agent could not confirm that the Complainant was the owner of the prior right in the trademarks, as he claimed. Therefore, the Registry was entitled to the denial of the application.

3. Sect 8 (5) Sunrise Rules mentions two ways to provide the processing agent with the documentary evidence. On the one hand, the applicant can send the evidence via regular mail. On the other hand, he can ask his registrar to send the evidence electronically. The complainant may choose between the two ways; therefore, the decision he made is done on his own risk, including all the problems and irregularities which might be linked with the chosen procedure. The mistakes made by the registrar are internal problems which have nothing to do with the registry. The Complainant is free to claim damages from his registrar subject to national laws. But he cannot held the registry responsible for the mistakes made by his registrar.

4. The Complainant submitted new documents which show that he is the holder of prior rights. However, only the documents which the Respondent was able to examine at the time of validation of the Complainant´s application should be considered by the panel (see Decision No. 219 – ISL). Should the panel consider new evidence now, it would treat unfairly any other applicant that may have filed for the Domain name immediately after the applicant (see Decision No. 706 – Autowelt).
According to the above said the Panel is of the opinion that the application for the domain names, filed within the first phase of the Sunrise Period did not comply with the Sunrise Rules, particularly section 13 (2), Subsection 2 in connection with section 21 (2) Sunrise Rules. The Documentary Evidence provided did not evidence that the applicant was the reported owner of the registered trademarks. Therefore, the Registry was entitled to the denial of the 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	**Thomas Johann Hoeren**

DATE OF PANEL DECISION 2006-08-15

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested the rejection by the Respondent of its application for the domain names within the first phase of the Sunrise Period.
The rejection by the Respondent was based on the fact that the Registrar chosen by the Complainant failed to forward all relevant Documentary Evidence that the Complainant is the registered owner of the trademarks in question.
Although the Complainant now submitted new evidence regarding his trademark rights, the Panel found that the Registry was entitled to its decision to reject the application.
As the Complainant did not provide the Registry with Documentary Evidence within the 40 days deadline of Section 8 (5), Subsection 4 Sunrise Rules, the Documentary Evidence presented by the Complainant´s registrar during the Sunrise period was regarded incomplete and not sufficient to prove the claimed prior right of the Complainant. As sufficient documentation was not submitted to the Registry within the 40 days period of Section 8 (5), Subsection 4 Sunrise Rules, and as the timely submitted evidence did not substantiate the prior right of the Complainant, the Panel held that the Registry was entitled to reject the application.