# Panel Decision for dispute CAC-ADREU-001722

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| Case number | **CAC-ADREU-001722** |
| Time of filing | **2006-06-29 08:38:44** |
| Domain names | **belvedere.eu** |

## Case administrator

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| Name | **Tereza Bartošková** |

## Complainant

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| Organization / Name | **Association pour la Promotion et la Protection des Droits de Propriété Intellectuelle, Emilie Dessens** |

## Respondent

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| 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 that the Panel is aware of.

FACTUAL BACKGROUND

The Complaint was filed with the Czech Arbitration Court (hereinafter "CAC") on June 6, 2006 against EURid's Decision of April 28, 2006 to register the domain name <belvedere.eu> for Sobieski Spółka z o.o., Ul. Bellttiego 1, 01-022 Wrszawa. On June 29, 2006, the CAC transmitted by email to EURid a request for verification in connection with the domain name at issue. On July 6, 2006 EURid transmitted by email to the CAC its verification response confirming that Sobieski Spółka z o.o. is listed as the registrant, providing the contact details for the administrative, billing, and technical contact and disclosing the Documentary Evidence related to the disputed domain name.

The Documentary Evidence shows that:

- Sobieski Spółka's Sunrise Application template indicates "national trademark" for Poland in the field "Prior Right on Name";
- Belvedere SA has concluded a licence agreement with Sobieski Spółka on January 3, 2006 authorizing Sobieski Spółka to apply for the domain name <belvedere.eu> during the Phased Registration Period;
- Belvedere SA is the holder of a valid international trademark registration No. 681 762 (designating Poland) consisting of the sign BELVEDERE.

The CAC verified that the Complaint satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (hereinafter "ADR-Rules") and the Supplemental ADR Rules of the Arbitration Court attached to the Economic Chamber of the Czech Republic and Agricultural Chamber of the Czech Republic (hereinafter "Supplemental ADR-Rules").

In accordance with the ADR-Rules, paragraph B2, the Czech Arbitration Court formally notified the Respondent of the Complaint and the proceedings commenced on July 10, 2006. The Respondent submitted a Response on August 30, 2006, in essence incorporating the grounds on which the Registry registered the domain name for Sobieski Spółka z o.o.

On September 1, 2006 further submissions were filed by the Complainant by way of a non-standard communication.

On September 4, 2006 having received the Statement of Acceptance and Declaration of Impartiality, the CAC appointed Dr. Torsten Bettinger as the Sole Panelist, in accordance with ADR-Rules, Paragraph B4(e).

A. COMPLAINANT

The Complainant asserts that the Respondent's decision to register the disputed domain for Sobieski Spółka conflicts with Article 12 (3) of the Regulation (EC) No. 874/2004.

Sobieski Spółka filed an application to register the disputed domain name on December 7, 2006. The Complainant contends that Sobieski Spółka does not have a valid trademark registration in Poland and that Sobieski Spółka's request to register the disputed domain name did not made reference to the legal basis in national or Community law for the trademark right on which Sobieski Spółka's request to register the disputed domain name during the Phased Registration Period was based.

Furthermore, the Complainant contends that Sobieski Spółka was not authorised to apply for the registration of the disputed domain name during Phased Registration Period I because

(1) the licence agreement between Sobieski Spółka and Belvedere SA was concluded after Sobieski Spółka's request to register the disputed domain name,
(2) the licence agreement was signed by Sobieski Spółka's agent and not by the trademark holder and
(3) the licence agreement did not show an official stamp and is not on the licensee's letterhead.

B. RESPONDENT

The Respondent contends that its decision to register the domain name for Sobieski Spółka was fully in line with Regulation (EC) No. 874/2004.

In support of this assertion the Respondent provided evidence that

- Belvedere SA is the holder of a valid international trademark (designating Poland) consisting of the sign BELVEDERE; and
- Belvedere SA has licensed Sobieski Spółka to use this trademark to apply for the domain name <belvedere.eu>.

DISCUSSION AND FINDINGS

The principal obligations of the Registry regarding its decisions to register or to reject .eu domain names based on registered trademarks during the phased registration period are set out in Article 13 of the .eu Sunrise Rules which states:

1. General
(i) Where the Prior Right claimed by an Applicant is a registered trade mark, the trade mark must be registered by a trade mark office in one of the member states, the Benelux Trade Marks 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.
(ii) A trade mark application is not considered a Prior Right.

2. Documentary Evidence for registered trade marks
Unless otherwise provided for in Annex 1 hereto, it is sufficient to submit the following Documentary Evidence for a registered trade mark:
(i) a copy of an official document issued by the competent trade mark office indicating that the trade mark is registered (certificate of registration, renewal certificate, official extract from the register, declaration by the trade mark office, publication of the fact of registration in an official journal, etc.); or
(ii) an extract from an official (on-line) database operated and/or managed by the relevant national trade mark office, the Benelux Trade Marks Office, the OHIM or the WIPO. Extracts from commercial databases are not acceptable even if they reproduce exactly the same information as the official extracts.

In the foregoing cases, the Documentary Evidence must clearly evidence that the Applicant is the reported owner of the registered trade mark.

In case the Applicant is a licensee or transferee of a registered trade mark referred to in Section 13(1) above, Section 20 hereof shall apply.

Section 20 of the .eu Sunrise Rules states:

If an Applicant has obtained a licence for a registered trade mark referred to in Section 13(1)(i) above in respect of which it claims a Prior Right, it must enclose with the Documentary Evidence an acknowledgement and declaration form, a template of which is contained in Annex 2 hereto, duly completed and signed by both the licensor of the relevant registered trade mark and the Applicant (as licensee).

Sobieski Spółka submitted Documentary Evidence to the Validation Agent within the 40 day deadline showing that it has obtained a duly completed and signed licence by Belvedere SA to use the international trademark registration No. 681 762 BELVEDERE to apply for the disputed domain name during the Phased Registration Period.

Sobieski Spółka also provided evidence that Belvedere SA, the licensor, is the holder of a valid international trademark with priority date of October 23, 1997 (designating Poland) consisting of the sign BELVEDERE.

The fact that Sobieski Spółka in its request to register the disputed domain name claimed a national registered trademark in Poland, but provided evidence that the trademark is protected in Poland following an international trademark designating Poland, is not opposed to the assumption that Sobieski Spółka has demonstrated that the licensor has a valid trademark registration for Poland.

Furthermore, the Panel holds that Respondent's decision to register the disputed domain name for Sobieski Spółka does not violate the Regulation (EC) No. 874/2004 or the .eu Sunrise Rules although the licence agreement between Sobieski Spółka and the trademark holder was concluded after the filing of the Sunrise Application. Whilst it is clear from the above that a prior right must be in full force and effect on or before the date of the application, and that the burden is on an applicant to prove the validity of its prior right, there is nothing in the Regulation (EC) Nr. 874/2004 or the .eu Sunrise Rules which states that the licence agreement between the applicant and the trademark holder has to be concluded before the filing of the Sunrise Application. The Panel therefore assumes that it is sufficient if the applicant provides a licence agreement which retroactively authorizes the applicant to use a trademark to apply during the Phased Registration Period for the disputed domain name.

Finally, the Panel notes that the licence agreement fully corresponds with the acknowledgment and declaration form, template of which was contained in Annex 2 of the .eu Sunrise Rules, and is contrary to Complainant's allegations duly completed and signed by both the licensor and licensee. The fact that the licence agreement does not show a stamp or any other official symbol of Sobieski Spółka does not question the validity of the agreement.

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

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| Name | **Dr. Torsten Bettinger, LL.M.** |

DATE OF PANEL DECISION 2006-09-28

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Sobieski Spółka filed an application to register the disputed domain name <belvedere.eu> during phase I of the .eu Phased Registration Period. It submitted Documentary Evidence to the Validation Agent within the 40 day deadline, showing it has obtained a licence by Belvedere SA to use the international trademark registration No. 681 762 BELVEDERE to apply during the Phased Registration Period for the disputed domain name. Sobieski Spółka also provided evidence that Belvedere SA is the holder of a valid international trademark (designating Poland) consisting of the sign BELVEDERE.

The Complainant contends that Respondent's decision to register the disputed domain for Sobieski Spółka conflicts with Article 12 (3) of the Regulation (EC) No. 874/2004 because Sobieski Spółka does not have a valid national trademark registration in Poland and that the licence agreement between Belvedere SA, the holder of the international trademark registration No. 681 762 BELVEDERE and Sobieski Spółka was concluded after Sobieski Spółka's request to register the disputed domain.

The Panel denied the Complaint holding that the documentary evidence showed that Belvedere SA is the holder of a valid international trademark (designating Poland) and that it is sufficient if the applicant provides a licence agreement which retroactively authorizes the applicant to use a trademark to apply during the Phased Registration Period for the disputed domain name.