Panel Decision for dispute CAC-ADREU-001728

Case number	**CAC-ADREU-001728**
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Domain names	**anonse.eu, oferta.eu**

Case administrator

Name	**Eva Zahořová**

Complainant

Organization / Name	**Wydawnictwo Jezierski, Tomasz Łukawski**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

WYDAWNICTWO JEZIERSKI (hereafter "the Complainant") applied for the domain names ANONSE and OFERTA on 3 February 2006.

The processing agent did receive the documentary evidence on 2 March 2006, which was before the 15 March 2006 deadline.

The documentary evidence for the domain name ANONSE consisted of a trademark registration on the name "ANONSE", registered on 24 October 1990. The documentary evidence did not contain any document substantiating that the Complainant had renewed the trademark registration after 10 years.

The documentary evidence for the domain name OFERTA consisted of a trademark registration on a figurative with the name OFERTA and the words "Warszawski Tygodnik Bezpłatnych Ogłoszeń", registered on 18 September 1997. The documentary evidence did not contain any document substantiating that the Complainant was the holder of a prior right on the name OFERTA alone.

Based on the documentary evidence, the validation agent found that the Complainant did not demonstrate that it was the holder of prior rights for the domain names ANONSE and OFERTA.

Based on these findings, the Respondent rejected the Complainant's application.

A. COMPLAINANT

Regarding the domain name ANONSE, the Complainant argues that it is the holder of a valid prior right.

Regarding the domain name OFERTA, the Complainant agrees that the figurative trademark submitted with the documentary evidence contains not only the word OFERTA, but also words "Warszawski Tygodnik Bezpłatnych Ogłoszeń". However, the Complainant argues that the name OFERTA is the dominant part of the trademark.

Therefore, the Complainant requires the Panel to annul the Respondent's decisions and to attribute the domain names ANONSE and OFERTA to the Complainant.

The Complainant further argues that if the Panel finds that the Respondent was right in rejecting the Complainant's application for the domain name OFERTA, the Panel should nevertheless grant the domain name OFERTA to the Complainant because the Complainant uses the name OFERTA as a commercial name.

B. RESPONDENT

The Respondent held that the burden of proof was with the Complainant to demonstrate that it is the holder or the licensee of a prior right:

It is therefore of crucial importance that the Respondent is provided with all the documentary evidence necessary for it to assess whether the applicant is indeed the holder or the licensee of a prior right.

As the panel clearly summed up in case ADR 1886 (GBG), "According to the Procedure laid out in the Regulation the relevant question is thus not whether the Complainant is the holder of a prior right, but whether the Complainant demonstrated to the validation agent that it is the holder of a prior right. If an applicant fails to submit all documents which show that it is the owner of a prior right the application must be rejected".

Regarding the domain name ANONSE, the Respondent held that the Complainant did not demonstrate that it was the holder of a prior right valid at the time of the application
The documentary evidence submitted by the Complainant did not show that the Polish ANONSE trademark was in full force and effect.The certificate of registration submitted as documentary evidence shows that the Polish trademark had been registered on 24 October 1990. Pursuant to the Polish Law on Trademarks, a request for extension of the term of protection must be filed after a period of ten years, or the trademark registration expires. The documentary evidence did not contain any document substantiating that the Complainant had applied for such extension after the first period of ten years.

Therefore, the Respondent's decision to reject the Complainant's application was correct, because the documentary evidence submitted by the Complainant before the 15 March 2006 deadline did not demonstrate the existence of a valid registered trademark, but merely demonstrated that the Complainant was the holder of an expired trademark.

The Respondent referred to the ADR decision 1627 (PLANETINTERNET) where the Panel decided that "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)". The same reasoning lead the Panel in the ADR 219 (ISL) to the same conclusion.

Regarding the domain name OFERTA, the Respondent held that the Complainant did not demonstrate that it was the holder of a prior right on the name OFERTA alone
The Polish trademark which the Applicant submitted as documentary evidence consists not only of the word OFERTA, but also of the words "Warszawski Tygodnik Bezpłatnych Ogłoszeń".

This fact is not disputed by the Complainant. However, the Complainant argues that the name OFERTA is the dominant part of the trademark.

The Regulation does not provide that only the distinctive elements of trademark must be included in the domain name. To the contrary, the Regulation and the Sunrise Rules clearly state that a domain name applied for during the Sunrise Period must consist of the complete name of the prior right on which the application is based (article 10 (2) of the Regulation) and that all alphanumeric characters (including hyphens, if any) included in the sign must be contained in the Domain Name applied for (section 19 (2) of the Sunrise Rules).

The difference between distinctive and non-distinctive elements may be of great importance in trademark law, but this difference is not applicable in the determination of the prior rights under the Regulation and the Sunrise Rules. Therefore, the Respondent was not allowed to engage into the appreciation of the distinctive character of the various elements of the trademark. The Respondent was only instructed to verify that all alphanumeric characters included in the trademark are contained in the domain name applied for.

The Respondent referred to the ADR decision Nr 470 (O2), in which the applicant applied for the domain name "O2", on the basis of a French Trademark consisting of a composite sign including words and devices, and more specifically the stylized characters "O2" accompanied, on the right side, by the stylized words (slogan) "l'oxygène de votre quotidien".

The Panel decided that "all alphanumeric characters of the composite sign invoked by Complainant (i.e. the French Trademark), are not contained in the domain name "O2". Indeed, the words (slogan) "l'oxygène de votre quotidien" are part of the composite sign, namely the French Trademark, but do not appear in the domain name Complainant applied for. Accordingly, the decision taken by Registry to reject the "O2" domain name application does not conflict with the Regulation 874/2004 ".

The Respondent was therefore correct to reject the Complainant's application because the Complainant applied for the domain name OFERTA without demonstrating a prior right on the name OFERTA alone.

Furthermore the Respondent denied the request for the attribution of the domain name OFERTA to the Complainant based on a commercial name

The Complainant applied for the domain name OFFERTA on 3 February 2006, which is during the first part of the phased registration.

Therefore, the Complainant's contentions about its prior rights based on a commercial name may not be taken into consideration.

The new information submitted by the Complainant may not be taken into consideration
The Respondent wishes to stress that article 22 (1) b of the Regulation states that a decision taken by the Respondent may only be annulled when it conflicts with the Regulation.

This verification is the only task for the Panel in these proceedings, which may not in any case 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 (see cases Nr. 551 (VIVENDI) and Nr. 810 (AHOLD)). In other words, as decided in case Nr. 1194 (INSURESUPERMARKET), "[t]he ADR procedure is not intended to correct domain name applicants’ mistakes". Thus, only the documentary evidence which the Respondent was able to examine at the time of validation of the application should be considered by the Panel to assess the validity of the Respondent's decision (see notably cases Nr. 294 (COLT), Nr. 954 (GMP), Nr. 01549 (EPAGES) and Nr. 1674 (EBAGS)).

As The Complainant submitted new documents attached to its complaint, the Respondent wishes to stress that some of these documents were not enclosed with the documentary evidence, which means that the Respondent could not use this information in taking its decision. Therefore, the new information may not be taken into consideration to evaluate whether the Respondent's decision conflicts with the Regulation, which is the only purpose of the present ADR proceedings.

DISCUSSION AND FINDINGS

The cases had to be decided within the following legal framework

Article 10 (1) of the Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") 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 10 (2) of the Regulation states that: "The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists".

Pursuant to 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 (…)".

Section 11.3. of the Sunrise Rules states that : "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".

Section 19 (2) of the Sunrise Rules states that a prior right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos, etc.) will only be accepted if the sign exclusively contains a name or if the word element is predominant, and can be clearly separated or distinguished from the device element, provided that "(a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the Domain Name applied for, in the same order as that in which they appear in the sign, and (b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear".

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".

I. The case regarding ANONSE

In the "ANONSE" case, the Complainant only submitted documentary evidence which showed that he has been the owner of a registered trademark "ANONSE" until October 2000. Any hint indicating that the Complainant renewed the trademark registration was missing. The question arises whether it was the task of the processing agent to ask for additional documents regarding the renewal. Such a duty is not foreseen in the Sunrise Rules. During the sunrise period, no deep examination of sources and documents other than the documentary evidence submitted is possible. Only obvious errors between the application and the documentary evidence could be have been considered and communicated by the validation agent, such as a difference between the street address of the applicant given on his application and that shown in the trademark certificate (ADR 253 - Schoeller), or a difference in legal form of the applicant mentioned in the application and in the documentary evidence (ADR 903 - SBK).
However, it is clearly unreasonable to expect that the validation agent should examine more substantial discrepancies like whether or not the trademark which expired has been renewed (see ADR 219 - isl).

The Complainant now tried to prove that he has renewed the trademark registration. However, it s not the task of the ADR panels to examine these additional documents. The applicant should not be allowed to submit additional evidence after the expiration of the 40-day period mentioned in the Sunrise Rules (see ADR 1071 - essence). It is not the role of ADR to verify whether the first applicant in the queue owns the prior right, no matter what documentary evidence was presented. Instead, the ADR has to check whether the validation agent and EURid acted reasonably under the circumstances (ADR 865 - hi).

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.

II. The "OFERTA" case
In addition, the Complainant refers to problems in registering the "OFERTA.eu" domain. He referred to a trademark related to the verbal and graphic terms "WARSZAWSKI TYGODNIK BEZPŁATNYCH OGŁOSZEŃ OFERTA". These terms can be translated into English as "Weekly" (TYGODNIK) "Free" (BEZPŁATNYCH, "Bulletin Board" (OGŁOSZEŃ) Offer (OFERTA) from Warsaw (WARSZAWSKI). All these terms are generic terms in Polish language. In their combination, the terms form the title of a weekly free magazine from Warsaw where sale and service offers can be read. The term "oferta" is in itself descriptive. It is not predominant and does not characterize the whole trademark.

Furthermore, it has to be taken into consideration that it is not the task of the validation agent to check the distinctive character of the various elements of the trademark. With the exception of the alphanumeric elements (see 11 of the Regulation), the domain can only consist of the complete name of the prior right on which the application is based (art. 10 (2) of the Regulation.

Finally, the Complainant cannot argue that he has a commercial name "OFERTA" which can be used a prior right within the Regulation. During the sunrise period, only registered trademarks , geographical indications and the public body names may be applied for as domain names (art. 12(2) of the Regulation).

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaints are denied.

PANELISTS

Name	**Thomas Johann Hoeren**

DATE OF PANEL DECISION 2006-09-14

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested the rejection by the Respondent of its application for two domain names within the first phase of the Sunrise Period.

The rejection by the Respondent was based on the fact that the Complainant did not submit evidence in the renewal of the trademark registration and that he cannot claim to get a domain name which only consists of a small part of the registered trademark.

Although the Complainant now tried to submit new evidence regarding the renewal of his trademark right, 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.
The Panel also held that it is not the task of the validation agent to engage in the appreciation of the distinctive character of the various elements of the trademark. In general the domain name applied has to consist of the complete name of the prior right on which the application is based.