Panel Decision for dispute CAC-ADREU-001849

Case number	**CAC-ADREU-001849**
Time of filing	**2006-06-19 13:16:33**
Domain names	**oko.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**HF CONSEILS**

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 pending or decided legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

Complainant launched by e-mail a Complaint with the Czech Arbitration Court on June 12, 2006 to contest EURid Decision to register the domain name <oko.eu>. The Complaint was accompanied by a print-out of an extract from the EURid WHOIS online database of the <.eu> domain names. The extract showed that the domain name <oko.eu> was registered by MP MEDIA having its official address at Branická 514/140, 14700 Praha 4, Czech Republic. The Complaint was also accompanied with the Certificate of Trade Mark's OKO national registration in France and the Licence Agreement between the Trade Mark Owner (GROUPE ONA) and the Complainant (HF CONSEILS). In response to Complainant's request to the Czech Arbitration Court to require EURid to disclose the Documentary Evidence as defined in the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereafter "Sunrise Rules"), the Respondent disclosed, inter alia, the Documentary Evidence on June 26, 2006. This Documentary Evidence (an extract from the online database of the Czech trade marks) showed that MP MEDIA is a legitimate owner of National Trade Mark OKO in Czech Republic, but the official address of MP MEDIA is Řipská 1432/2, 10000 Praha 10, Czech Republic. On June 26, 2006 the Czech Arbitration Court notified the commencement of the ADR Proceeding, informing the Respondent that Respondent's Response was to be submitted within 30 working days from the delivery of the notification. The Respondent submitted its Response on August 17, 2006, i.e. within the time limit prescribed in .eu Alternative Dispute Resolution Rules (hereafter "ADR Rules"). Following an invitation to serve as a Panel in this dispute communicated on August 21, 2006, the single-member Panel accepted the mandate and submitted Declaration of Impartiality and Independence in due time. The Czech Arbitration Court duly notified the Parties of the identity of the Panelist appointed on August 21, 2006, in accordance with Paragraph B4(e) of the ADR Rules and the date, by which a Decision on the matter was due, which was specified as September 17, 2006. In the absence of a challenge of the Panelist's appointment by either Party according to Paragraph B5(c) of the ADR Rules, the Czech Arbitration Court forwarded the case file to the Panel on August 24, 2006.

A. COMPLAINANT

Complainant contends that a domain name application for <oko.eu> was filed on March 7, 2005 in the name of the firm MP MEDIA (hereafter "the Applicant"), situated Branicka 514/140, 14700 Praha 4, Czech Republic. As Complainant found out, this application has been made on the basis of a Czech Trademark Registration "OKO" and the search made on the online trade mark database did reveal the existence of a national trademark OKO in Czech Republic (No. 130050). Complainant contends that the owner of the Czech trademark OKO is MP MEDIA, however, this company is located at another address, i.e. Ripska 1432/2, 10000 Praha 10.

Complainant in essence contends that: 'Hence, from this discrepancy, it must be concluded that the applicant is not the rightfull owner of the above cited registration. According to the ".eu Sunrise Rules" sections 4-1, 11-1 et 13-2 , a .eu domain name application must be requested in the name of the owner or licensee of a Registered Trademark <...>".

Complainant further provides the said provisions. Complainant concludes that in its view, the domain name application for <oko.eu> in the name of the firm MP MEDIA is not in accordance with registration criteria of the Sunrise Rules and should be rejected.

Complainant requests the transfer of the domain name to the benefit of the firm HF CONSEILS, recorded licensee of the trademark “OKO” (as it is seen from the document attached in Schedule 2, i.e. the recording of the licence before the French Trade Mark Office). Complainant states that it is the following in the queue for the domain name concerned.

B. RESPONDENT

Firstly, the Respondent contends the grounds on which it accepted the application by MP MEDIA for the domain name <oko.eu>, i.e. Article 10 and 14 of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation"). Respondent states that MP MEDIA ("the Applicant") applied for the domain name <oko.eu> on 7 March 2006. The processing agent received the documentary evidence on 13 March 2006, which was before the 16 April 2006 deadline. The documentary evidence consisted of proof of the trademark "OKO", registered with the Czech Patent and Trademark Office, on the MP MEDIA's name and under the number 130050. The validation agent concluded from the documentary evidence that the Applicant was the holder of a prior right on the name OKO. Therefore, the Respondent accepted the Applicant's application.

Secondly, the Respondent summarized the Complainant contentions. As Respondent understood, it should have concluded that the Applicant was not the legitimate owner of the trademark, since the Applicant's address on the trademark register is not the same as the address provided by the Applicant in its application.

Thirdly, the Respondent contends that its decision does not conflict with the Sunrise Rules and the Regulation. Respondent in essence contends that: "None of the provisions of the Sunrise rules cited by the Complainant (namely sections 4-1, 11-1 and 13-2) require the Respondent to conclude that the Applicant was not the holder of the prior right because it moved from the address mentioned on the trademark registration to another location within the same city." The Respondent found that the Applicant had met its burden of proof in accordance with the procedure laid out in the Regulation and the Sunrise Rules and that it had thus sufficiently demonstrated a prior right. Respondent concludes that it had thus no other choice than to accept the application.

Moreover, the Respondent contends that Complainant's request to transfer the domain name to the Complainant is groundless because the Complainant is not the next applicant in the queue, since the third applicant in line is "OKO Osuuspankkien Keskuspankki Oy" while Complainant is the fourth. The Registry must first assess if all registration criteria have been met by the next applicant in the queue, before even considering the Complainant's application.

In conclusion, the Respondent states that the complaint must be rejected.

DISCUSSION AND FINDINGS

This case is related to the interpretation and application of the Regulation and the Sunrise Rules.

Article 3 of the Regulation provides that the request for a domain name shall include inter alia the name and the address of the requesting party and further that any material inaccuracy in the name shall constitute a breach of terms of registration.

Article 10 (1) of the Regulation provides that holders of prior rights 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, and that 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".
Article 12 (3) of the Regulation provides that the request to register a domain name based on a prior right shall include a reference to the legal basis in national or Community law for the right to the name, as well as other relevant information, such as trademark registration number.

Article 14 of the Regulation states that: "<…> Every 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 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 <…>"

Recital 12 of the Regulation is important as it states the purpose of the phased registration period in the following terms: “In order to

safeguard prior rights recognised by Community or national law, a procedure for phased registration should be put in place. Phased registration should take place in two phases, with the aim of ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights. The Registry should ensure that validation of the rights is performed by appointed validation agents. On the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name. Allocation of that name should then take place on a first-come, first-served basis if there are two or more applicants for a domain name, each having a prior right."

The Sunrise Rules are applied to all applications during the phased registration period.

Section 4 (1) of the Sunrise Rules provides that in addition to the representations and warranties contained in Section 4 of the Terms and Conditions, the Applicant represents and warrants that: (i) it is the owner, right-holder or licensee (where applicable) of the Prior Right claimed <...>.

Section 11 (1) of the Sunrise Rules provides that during the first phase of the Phased Registration Period, only Domain Names that correspond to (i) registered Community or national trade marks or (ii) geographical indications or designations of origin may be applied for by the holder and/or licensee (where applicable) of the Prior Right concerned, without prejudice to the names that may be applied for by Public Bodies, as referred to in Article 10(3) of the Public Policy Rules.

Section 11 (3) of the Sunrise Rules states that the Applicant for a domain name must be the owner or licensee of the claimed Prior Right.

Section 13 (2) of the Sunrise Rules provides that: <...> "In the foregoing cases, the Documentary Evidence must clearly evidence that the Applicant is the reported owner of the registered trade mark. <...>"

Section 20.3 of the Sunrise Rules provides that: "If, for any reasons other than as are referred to in Section 20(1) and 20(2) hereof, 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."

Two main questions should be discussed by the Panel according to the order set out below:

1) was the domain name <oko.eu> applied and the application accepted according to the Regulation and the Sunrise Rules, i.e. did the Documentary Evidence clearly evidence that the Applicant was the reported owner of the registered national trade mark OKO;
2) does the Complainant have the legitimate right to request the transfer of the domain name to the Complainant.

If the answer to the first question is positive, the Panel should not discuss the second question as it would not be reasonable.

With regard to the first question, the Panel agrees with the Respondent's contention that none of the provisions of the Sunrise Rules require the Respondent to conclude that the Applicant was not the holder of the prior right because it moved from the address mentioned on the trademark registration to another location within the same city. It is also clear that none of the relevant provisions require the Applicant to provide any further document substantiating that it still remains the same person, in the event that it moved from the address mentioned on the trademark registration.

According to the Sunrise Rules the validation agent must require the Applicant to submit further documents substantiating that it is the same person as the holder of the prior right (see Article 20 of the Sunrise Rules) only when the name of the Applicant and the name the holder of the prior right claimed are not the same. In the present case, the Applicant, which was first in line, submitted documentary evidence consisting of proof of the trademark "OKO", registered on the name of the Applicant. The Respondent found that the Applicant had met its burden of proof in accordance with the procedure laid out in the Regulation and the Sunrise Rules and that it had thus sufficiently demonstrated a prior right. The Respondent had thus no other choice than to accept the application.

While it is true that the street address indicated in the Documentary Evidence and the one in the application are different, no evidence was advanced by the Claimant to indicate that the Validation Agent could have made the mistake. Given the difference of nearly seven years in date between the Documentary Evidence and the application for domain name registration, it is normal that some change of address could be the simple reason for this formal discrepancy. The small check of the issue of identity is enough. A quick Internet search in the database of Czech companies <http://portal.justice.cz/uvod/justice.aspx> consistently shows that MP MEDIA have changed its location in Prague in 2005. This change had neither any impact on the identity of the legal person as such nor on its owner's rights in the registered national trade mark OKO.

It is a fundamental principle of justice that the Validation Agent shall act reasonably. In this case the Validation Agent did acted reasonably as he or she saw that the Documentary Evidence clearly evidence that the Applicant was the reported owner of the registered national trade mark OKO and that the change in the address was clearly not the change in the identity of the Applicant. Just because there was not an immediate and perfect match between the Documentary Evidence and the street address in the domain name application is not sufficient excuse to reject the application for a domain name out of hand.

The facts of the case demonstrate that the Applicant is the owner of the Prior Right on which the application is based. It is also clear that the domain name <oko.eu> was applied and the application accepted according to the Regulation and the Sunrise Rules, i.e. the Documentary Evidence clearly evidenced that the Applicant was the reported owner of the registered national trade mark OKO. In the circumstances the Panel is satisfied that on the particular facts of this case the Respondent complied with both the Regulation and the Sunrise Rules.

As the answer to the first question is positive, the Panel holds that there is no need to analyse the second question.

In the circumstances the decision of Respondent should not be annulled and the Complainant's request should not be granted.

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	**Darius Sauliunas**

DATE OF PANEL DECISION 2006-09-17

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The complainant challenged the EURid’s decision to accept the application of the Applicant nevertheless the street address indicated in the Documentary Evidence and the one in the application was different. The complainant noticed this discrepancy and stated that the applicant is not the rightfull owner of the prior rights. The complainant requested the transfer of the domain name to the benefit of the complainant, as it is the following in the queue for the domain name concerned.

The Panel agreed with the Respondent's contention that none of the provisions of the Sunrise Rules require the Respondent to conclude that the Applicant was not the holder of the prior right because it moved from the address mentioned on the trademark registration to another location within the same city. This change had neither any impact on the identity of the legal person as such nor on its owner's rights in the registered national trade mark OKO. It is also clear that none of the relevant provisions require the Applicant to provide any further document substantiating that it still remains the same person, in the event that it moved from the address mentioned on the trademark registration. In this case the Validation Agent acted reasonably as he or she saw that the Documentary Evidence clearly evidence that the Applicant was the reported owner of the registered national trade mark OKO and that the change in the address was clearly not the change in the identity of the Applicant.

The Panel therefore did not annull the registry’s decision and the complaint was denied.