Panel Decision for dispute CAC-ADREU-001886

Case number	**CAC-ADREU-001886**
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Domain names	**gbg.eu**

Case administrator

Name	**Eva Zahořová**

Complainant

Organization / Name	**Ali S.p.A., Gino Cocchi**

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

N/A

FACTUAL BACKGROUND

The Complainant applied for the Disputed Domain Name on the basis of its CTM registration 3177763 "CTM Registration". When requested to file the Documentary Evidence of its prior trade mark rights for GBG the Complainant mistakenly filed details of an Application no 4735122 instead of a copy of its CTM Registration. The Application for the Disputed Domain Name was refused.

A. COMPLAINANT

The Complainant contends in summary:

1.In the presence of valid prior rights the rejection of a .eu name for formal reasons is an extreme measure not in accordance with EU law.

2.Regulations 733/2002 and 874/2004 provide that holders of prior rights such as registered trade marks should benefit from a sunrise period during which the holders of such prior rights can register domain names related to their rights before registration is open to the general public. The Regulations confer preferential treatment on such owners of prior rights.

3. The sunrise rules provision 13 (1) (ii) "A trade mark application is not considered a Prior Right" should not be interpreted as "(The filing of Documentary Evidenceshowing) a trade mark application is not considered a Prior Right" bit as "(The simple ownership of) a trade mark application shall not be considered a Prior Right)".

4. CTM Registration NO. 3177763 was registered well before November 11 2004 the date of the application for the Disputed Domin Name on December 7 2005. The Complainant must be considered the owner of a Prior Right fully entitling it to obtain the registration of the Disputed Domain Name in the sunrise period. The burden to prove the ownership of the prior right must be considered as complied with through this Complaint since the applicant for a .eu domain name cannot amend the Documentary Evidence proivided to the validation agent.

5.The Complainant requests the annulment of the Decision to reject its application for the Disputed Domain Name and the registration of the Disputed Domain Name in its name.

B. RESPONDENT

The Respondent contends in summary:

1. Pursuant to Article 14 of the Regulation it is up to the applicant to submit documentary eidence showing that he or she is the holder of the prior right claimed on the name in question. Based on this documentary evidence the validation agent shall examine whether the applicant has prior rights on the name.

2. Section 13(1)(ii) of the Sunrise Rules states the "A trade mark application is not considered a Prior Right".

3. The Complainant did not satisfy its burden of proof to demonstrate that it is the holder of a prior right on the name.

4.According to the Procedure laid out in the Regulation the relevant question is this 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 ower of a prior right the application must be rejected. Section 21.2 of the Sunrise Rules makes it clear that the validation agent is to carry out a prima facie review of the documentary evidence received from the applicant to establish whether a prior right exists and Section 21.3 of the Sunrise Rules clearly states that the validation agent is under no obligation to conduct its own investigation into the circumstances of the application.

5. New documents submited in this ADR proceeding and not enclosed with the Documentary Evidence to the validation agent cannot be taken into account. Only the documents which the Respondent was able to examine at the time of validation of an application should be taken into account to assess the validity of the Respondent's decision.

6. In order to be given the opportunity to demonstrate its prior rights and to benefit from the preferential treatment given by the Regulation the applicant must comply with the strict procedure laid down by the Regulation for dealing with the thousands of applications received during the phased registration. The Complainant in the present case did not correctly fulfil the substantial requirements.

DISCUSSION AND FINDINGS

Article 12 (1) of Regulation 874/2004 ("the Regulation") provides that Eurid should publish the rules for the Sunrise Period on its website ("the Sunrise Rules").

Article 14 of the Regulalation provides:

"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 documentary evidence shall be submitted to a validation agent indicated by the Registry. The applicant shall submit the evidence in such a way that it shall be received by the validation agent within 40 days from the submission of the application for the domain name. if the documentary evidence has not been received by this deadline the application for the domain name shall be rejected."

Chapter 1 Section 2 (1) (i) of the Sunrise Rules provides that:

"The first come first served principle ... during the Phased regitration Period means that the Registry effects registration of a particular Domain Name in response to the first Application received by the Registry in respect of that Domain Name ...subject to:
(i) the receipt of Documentary Evidence by the Processing Agent within 40 calendar days following the date of receipt of the Application y the Registry; and
(ii) validation of the existence of the Prior Right .."

Chapter VI, Section 21 (2) of the Sunrise Rules provides that:

"The 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 whre applicable)

Chapter VI, Section 21 (3) of the Sunrise Rules provides that:

"The Validation Agent is not obliged but it is permitted in tis sole discretion to conduct its own investigations into the circumstances of the Application, the Prior Right claimed and the Documentary Evidence produced."

Chapter VI, Section 22 (2) of the Sunrise Rules provides that:

"The Registry registers Domain Names on a first come, first servedbasis where it finds that the Applicant has demonstrated a Prior Right in acordance with Section 2 hereof."

It is common ground that a trade mark application cannot be a Prior Right under the Regulation and the Sunrise Rules.

From a review of the above provisions of the Regulation and Sunrise Rules it is clear that the Documentary Evidence submitted by the Applicant must show that the Applicant is the holder of a Prior Right. Due to a mistake of the Applicant in submitting a copy of a trade mark application and not its CTM registration it did not satisfy the requirements of the Sunrise Rules. The Respondent refused the Application as the Applicant had failed to demonstrate a Prior Right under the Regulation and the Sunrise Rules. In the opinion of the Panel the Respondent was right to do so and the Complaint must be dismissed.

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	**Dawn Osborne**

DATE OF PANEL DECISION 2006-08-24

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant applied for the Disputed Domain Name on the basis of its CTM registration 3177763 "CTM Registration". When requested to file the Documentary Evidence of its prior trade mark rights for GBG the Complainant mistakenly filed details of an Application no 4735122 instead of a copy of its CTM Registration. The Application for the Disputed Domain Name was refused.

The Documentary Evidence submitted by the Applicant must show that the Applicant is the holder of a Prior Right. For these purpises a trade mark application is not sufficient under the Regulation or the Rules. Due to a mistake of the Applicant in submitting a copy of a trade mark application and not its CTM registration it did not satisfy the requirements of the Sunrise Rules. The Respondent refused the Application as the Applicant had failed to demonstrate a Prior Right under the Regulation and the Sunrise Rules. In the opinion of the Panel the Respondent was right to do so and the Complaint must be dismissed.