Panel Decision for dispute CAC-ADREU-001919

Case number	**CAC-ADREU-001919**
Time of filing	**2006-07-31 13:20:04**
Domain names	**fijinaturalmineralwater.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Roll International Corporation, Mr. Andrew Eric Asch, Esq.**

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 other legal proceedings that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant by the name Roll International Corporation produces, markets and sells Fiji Water, a bottled water product. Complainant, and its subsidiary companies, began bottling, selling and marketing natural artesian mineral water under the brand name Fiji Water with its current product design in 1996. Complainant has produced over 250 million bottles of Fiji Water over the past decade. The success of Fiji Water is due, in large part, to the purity and taste of its natural mineral water. Complainant bottles Fiji Water in the Republic of Fiji and conducts stringent quality testing to maintain the highest purity of its natural mineral water. Complainant has received widespread press coverage for its Fiji Natural Mineral Water.

The Complainant states that it is the owner of a number of UK, US and other trademark registrations for Fiji Water and Fiji Water-based marks, including the exact mark at issue here “FIJI NATURAL MINERAL WATER”, i.e., Community trademark No. 3081809 (registered on December 20, 2004), as well as the following additional marks: “FIJI PURE NATURAL WATER”, “FIJI”, “THE TASTE OF PARADISE”, “A TASTE OF PARADISE”. Complainant is also the owner of, among others, the domain names fijiwater.com, fijiwater.net, fijiwater.co.uk, and thetasteofparadise.eu.

The application for “FIJINATURALMINERALWATER.EU” was filed by Fiji Water (UK) Limited on January 26, 2006, thus during the first part of the phased registration. To demonstrate a prior right to the name in question, on February 3, 2006 (within the deadline being March 7, 2006), the Applicant submitted as documentary evidence a certificate of “Fiji Natural Mineral Water” Community trademark registration No. 3081809 issued by the Office for Harmonization in the Internal Market (OHIM) according to which the owner of the aforementioned trademark is Natural Waters of Viti Limited.

Due to the difference between the Applicant for the domain name in question and the holder of the prior right, EURid being the Respondent rejected that application. In its timely filed complaint, the Complainant contests that Respondent’s decision.

A. COMPLAINANT

The Complainant maintains that it is a holder of prior rights recognized or established by national and/or Community law as defined by Article 10 (1) of Commission Regulation (EC) No 874/2004 (hereinafter Regulation 874/2004) and thus met the application eligibility criteria defined by Section 11 of Sunrise Rules. Further, in compliance with Article 10 (2) and 14 of Regulation 874/2004 and Section 13 of Sunrise Rules, it provided a certified copy of the registered trademark “FIJI NATURAL MINERAL WATER” to the registrar for the domain name “fijinaturalmineralwater.eu”.

The Complainant requests annulment of EURid's decision of May 5, 2006 denying Complainant's prior right claim to "fijinaturalmineralwater.eu", and transfer that domain name to the Complainant.

To its complaint, the Complainant attached a document consisting of five exhibits with which will be dealt below.

B. RESPONDENT

In its well-founded and qualified response, the Respondent points out that names of the following three companies appear in the present proceedings:
- Fiji Water (UK) Limited - a UK company which applied for the domain name
- Natural Waters of Viti Limited - a company from Fiji which on the trademark certificate, which was submitted as documentary evidence, is referred to as being the holder of the FIJI NATURAL MINERAL WATER Community trademark
- Roll International Corporation, a US company which submitted the Complaint

It cannot be disputed that these three are different persons. The difference between the Applicant and the holder of the prior right was the reason why the Applicant's application was rejected. As the application for the domain name was filed by the UK company, that UK company was to prove that it was the holder of a prior right. The UK company failed to do so.

The Respondent argues that the documentary evidence did not demonstrate that the Applicant was the holder or licensee of a prior right. The burden of proof is with an Applicant in that respect which results from pertinent provisions of Regulation 874/2004, Sunrise Rules and previous ADR decisions. The Applicant failed to carry its burden of proof. The only thing which was clear from the documentary evidence was that the Applicant was not the actual owner of the FIJI NATURAL MINERAL WATER Community trademark

Furthermore, the Respondent states that the Complainant submits information for the first time in the framework of the present ADR proceedings (although not very clear, the Complainant appears to be arguing that it is the holding company of the other companies involved in the present ADR proceedings). This information was not submitted as documentary evidence to the validation agent.

With regard to documents submitted by the Complainant with its complaint, the Respondent contents that pursuant to Article 14 of Regulation 874/2004, only information that is received by the validation agent within 40 days from the submission of the application for the domain name may be accepted as documentary evidence. In the present case, the 40 day period ended on March 29, 2006, whereas the Complaint (with the new documents attached) was submitted on August 3, 2006. These documents may not serve as a basis to assess whether the Applicant is the holder of a prior right, since those documents are submitted several months after the end of 40 day period set forth by the Regulation 874/2004. Accepting these documents as documentary evidence would clearly violate that Regulation.

The Respondent also alleges that the disputed domain name cannot be transferred to the Complainant because it fulfills none of the two requirements set out in Paragraph B11 (c) of the ADR Rules, i.e.:
- the Complainant must be the next applicant in the queue for the domain name concerned – the Complainant never filed the application;
- according to Respondent's decision, the Complainant satisfies all registration criteria set forth in Regulation (EC) No. 733/2002 (hereinafter Regulation 733/2002) and the Regulation 874/2004 - Complainant is the US company and therefore, does not meet the criterion under Article 4 (2) (b) of Regulation 733/2002.

Consequently, the complaint must be rejected.

DISCUSSION AND FINDINGS

1. Eligibility of the Complainant to be Party to these Proceedings
The Respondent is right in pointing out that there are three various legal entities involved in the present ADR proceeding: the Applicant being Fiji Water (UK) Limited (United Kingdom), the trademark proprietor named in the certificate as Natural Waters of Viti Limited (Fiji) and the Complainant entitled Roll International Corporation (United States of America).

The preliminary question the Panel must asses first is whether the Complainant is allowed to act in this proceeding.

Pursuant to Article 22 (1) of Regulation 874/2004, an ADR proceeding may be initiated by any party where a decision taken by the Registry conflicts with this Regulation or Regulation 733/2002. Similarly, Paragraph B1 (a) of the ADR Rules states that any person or entity may initiate an ADR proceeding against the Registry. Literal interpretation of that provision would lead to a conclusion that any person regardless of being adversely affected by the Respondent's decision or without any connection with the prior right holder may initiate an ADR proceeding, and request transfer of the domain name. The Panel shares the view expressed in ADR 596 (RESTAURANTS) that the Regulation 874/2004 may not be interpreted so broadly that it would not require certainty that, at the minimum, a complaint

must have been filed with the consent of the holder of the right concerned.

Even though the Complainant does not give a clear explanation of the relationship between it and the other two subjects, whose names appear in the application and certificate of trademark registration, it results from its complaint that it has control over the other two companies. In the Panel's opinion, the Complainant proved the appropriate link between it and other two entities and is therefore entitled to be a party to this dispute.

The related issue of the request to transfer the domain name to the Complainant will be discussed hereafter.

2. Prior Right Claim and Documentary Evidence
Article 10 (1) of Regulation 874/2004 provides that holders of prior rights recognized 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.

Pursuant to Article 14 (4) of Regulation 874/2004, every Applicant shall submit documentary evidence that shows that he or she is the holder of prior right claimed on the name in question and this documentation shall be submitted to the Validation Agent within forty days from the submission of an application for the domain name. Section 13 (2) of Sunrise Rules further clarifies that the documentary evidence must clearly evidence that the Applicant is the reported owner of the registered trademark.

From the wording of the previously mentioned provision of Article 14 of Regulation 874/2004, it is apparent that it is up to the Applicant to provide appropriate documentary evidence substantiating that it is a holder of the prior right claimed on the name in question. If the trademark proprietor recorded in the submitted documentary evidence is not identical to the Applicant, the Applicant has to furnish documentary evidence in compliance with Section 20 of the Sunrise Rules proving that the owner of the mark granted a license to the Applicant, assigned the trademark to the Applicant, or was subject to a name change, merger, de iure transfer etc. The burden of proof in that respect lies with the Applicant which must prove existence of the prior right.

The Applicant demonstrated none of the requirements mentioned above and therefore, did not carry the burden of proof. The name of the Applicant (Fiji Water (UK) Limited) is materially different from the name Natural Waters of Viti Limited being recorded as proprietor of the "FIJI NATURAL MINERAL WATER" Community trademark in the certificate issued by OHIM. Without submission of pertinent documentary evidence within the 40-day period clarifying the difference between the Applicant and the trademark owner, the Respondent did not err in rejecting of the Applicant's application.

The Complainant annexed to its complaint a document containing five exhibits that are as follows:
a) an affidavit of Complainant's former President/CEO, Douglas Carlson, describing the extent of the promotion and advertising used by Complainant to market its Fiji Water brand,
b) descriptions of the bottling process from fijiwater.com,
c) copy of selected Fiji Water and Fiji Water-based marks, and WHOIS information for thetasteofparadise.eu from EURid's WHOIS database on June 21, 2006,
d) copy of the results of Google search for "Fiji Water", which yielded approximately 17.000.000 results, conducted on July 10, 2006, and a copy of some of the referenced articles,
e) copy of the certificate of the "FIJI NATURAL MINERAL WATER" Community trademark registration.

However, these documents are not relevant in determining whether or not the Respondent's decision of May 6, 2006 conflicts either with Regulation 733/2002 or Regulation 874/2004. Even though the Complainant, in its complaint, would produce other documentary evidence, which should have been submitted during the registration process, the Panel would not take them into account due to expiry of 40-day period stipulated in Article 14 (4) of Regulation 874/2004. This is the settled practice invoked by majority of the Panelists of the Czech Arbitration Court, see, for instance, ADR 219 (ISL), 294 (COLT), 706 (AUTOWELT), 865 (HI), 1071 (ESSENCE), 1518 (VANHOUTEN) and others.

3. Request for transferring the Domain Name to the Complainant
The Panel is aware of one decision (ADR 1325 (KOHLPHARMA)) where despite of the conclusion that the Respondent was correct to reject the application for the "KOHLPHARMA" domain name because the Applicant differed from the trademark proprietor, the Panelist ordered to transfer that domain name to the Complainant. Account has been taken of the fact that there was only one Sunrise Applicant (the Complainant) and "...that the sunrise procedure was instituted to assist trademark owners against abusive and speculative registrations, and the consequences of not transferring the Domain Name would mean that the domain name would be transferred to the general pool of available names and thus subject to abusive and speculative registrations, this Panel finds that justice is best served by ordering that the Domain Name be transferred to the Complainant, ..."

To a certain extent, the present case is similar to the one referred above. The Applicant is also only one in the queue for the domain name in question which the Panel found out by performed search in the WWHOIS database. But under Article 22 (11) of Regulation 874/2004, the Panel may order transferring the disputed domain name to the Complainant that fulfills general eligibility criteria set forth in Article 4 (2) (b) of Regulation 733/2002. In the case before us, the Complainant is the US company and does not meet the criterion under Article 4 (2) (b) (i) of the aforementioned Regulation. Without commenting on the referred case ADR 1325 (KOHLPHARMA), under these circumstances, the disputed domain name cannot be transferred to the Complainant.

4. Conclusions
The Panel has carefully assessed all facts and circumstances of this case. It reached a conclusion that the Respondent acted reasonably while rejecting the application for the "FIJINATURALMINERALWATER.EU" domain name application and therefore, its decision is not in conflict with Regulation 733/2002 or Regulation 874/2004.

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	**Radim Charvat**

DATE OF PANEL DECISION 2006-11-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The application for "FIJINATURALMINERALWATER.EU" was filed by Fiji Water (UK) Limited on January 26, 2006, thus during the first part of the phased registration. To demonstrate a prior right to the name in question, on February 3, 2006 (within the deadline being March 7, 2006), the Applicant submitted as documentary evidence a certificate of "Fiji Natural Mineral Water" Community trademark registration according to which the owner of the aforementioned trademark is Natural Waters of Viti Limited. Due to difference between the Applicant for the domain name in question and the holder of the prior right, EURid being the Respondent rejected that application. In its timely filed complaint, the Complainant by the name Roll International Corporation contests that Respondent's decision.

1. Eligibility of the Complainant to be Party to these Proceedings
There are three various legal entities involved in the present ADR proceeding: the Applicant being Fiji Water (UK) Limited (United Kingdom), the trademark proprietor named in the certificate as Natural Waters of Viti Limited (Fiji) and the Complainant entitled Roll International Corporation (United States of America).

The Panel first assessed a preliminary question whether the Complainant is allowed to act in this proceeding. The Panel stated that literal interpretation of Article 22 (1) of Regulation 874/2004 (Paragraph B1 (a) of the ADR Rules respectively) would lead to a conclusion that any person regardless of being adversely affected by the Respondent's decision or without any connection with the prior right holder may initiate an ADR proceeding, and request transfer of the domain name.

Even though the Complainant does not give a clear explanation of the relationship between it and the other two subjects, whose names appear in the application and certificate of trademark registration, its complaint shows that it has control over the other two companies. The Complainant proved the appropriate link between it and other two entities and is therefore entitled to be a party to this dispute.

2. Prior Right Claim and Documentary Evidence
Within the meaning of Article 14 of Regulation 874/2004, the burden of proof lies with the Applicant which has to provide appropriate documentary evidence proving that it is a holder of the prior right claimed on the name in question. If the trademark proprietor recorded in the submitted documentary evidence is not identical to the Applicant, the Applicant has to furnish documentary evidence in compliance with Section 20 of Sunrise Rules proving that the owner of the mark granted a license to the Applicant, assigned the trademark to the Applicant, or was subject to a name change, merger, de iure transfer etc. The Applicant demonstrated none of these requirements and therefore, did not carry the burden of proof. The name of the Applicant (Fiji Water (UK) Limited) is materially different from the name Natural Waters of Viti Limited being recorded as proprietor of the "FIJI NATURAL MINERAL WATER" Community trademark in the certificate issued by OHIM. Without submission of pertinent documentary evidence clarifying the difference between the Applicant and the trademark owner, the Respondent did not err in deciding to reject of the Applicant's application.

The Complainant annexed to its complaint a document containing five exhibits that, however, are not relevant for determining whether or not the Respondent's decision of May 6, 2006 conflicts either with Regulation 733/2002 or Regulation 874/2004.

3. Request for transferring the Domain Name to the Complainant
The Complainant is the US company and does not fulfill the general eligibility criterion according to Article 4 (2) (b) (i) of Regulation 733/2002. Thus, the domain name could not be transferred to it.

4. Conclusions
The Panel reached a conclusion that the Respondent's decision is not in conflict with Regulation 733/2002 or Regulation 874/2004.

Consequently, the Panel denied the complaint.