Panel Decision for dispute CAC-ADREU-002088

Case number	**CAC-ADREU-002088**
Time of filing	**2006-07-10 13:01:53**
Domain names	**prixarcdetriomphe.eu, grandsteeple.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**France Galop, Christian Maigret**

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 legal proceedings, which are pending or decided and which relate to the disputed domain names.

FACTUAL BACKGROUND

The Complainant applied for the registration of the domain names “prixarcdetriomphe.eu” and ”grandsteeple.eu” during Sunrise Period I and based its applications dated 21 February, 2006, on prior trademark rights. Complainant claimed to be the owner of registered national trademarks in France. As documentary evidence he presented - within the forty days period of section 8 (5) subsection 4 Sunrise Rules - copies of certificates of the Bureau Benelux des Marques.

1. The copy of the certificate with respect to the trademark “PRIX ARC DE TRIOMPHE” provides information that the verbal trademark PRIX ARC DE TRIOMPHE has been registered with the BENELUX Trade Mark Office 5 December, 2005 under the registration No. 781620.

2. The copy of the certificate of the verbal trademark “GRAND STEEPLE” provides information that the verbal trademark GRAND STEEPLE has been registered with the BENELUX Trade Mark Office as of 5 December, 2005 under the registration No. 781617.

Both trademarks have been registered in the name of the Complainant. The certificate for the trademark GRAND STEEPLE provides further information as follows:
“Phase de refus, refus provisoire en vertu do l’Article 6bis de la LBM »

By electronic mail dated 24 May, 2006 (PRIX ARC DE TRIOMPHE) and 10 June, 2006 (GRAND STEEPLE) EURid notified the Complainant that its applications had been rejected. The decisions were based on the fact that the documentary evidence filed in support of these applications did not correspond to the prior rights claimed in the domain name applications. On 10 July, 2006 the Czech Arbitration Court (CAC) received Complainant’s Complaint.

With its Complaint Complainant requests the panel to decide:

The cancellation of the two decisions of EURid.

Furthermore complainant requests:

the registration of the domain names prixarcdetriomphe.eu and grandsteeple.eu in its name.

Besides other information he attached to its Complaint translations of the registration documents of the two trademarks in English. The English translation of the trademark registration deed for GRANDSTEEPLE did not contain the information on the provisional refusal. It contains, however, the following wording:

"Accelerated registration phase
According to Article 6e of the LBM this registration could be radiated by the
Benelux Trademark Office"

Furthermore, Complainant provided a letter of the Benelux Trademark Office dated 14 June, 2006, informing the trademark owner (=Complainant) that the decision as of 5 December 2005 not to register the Benelux trademark "GRANDSTEEPLE" shall be revoked.

A. COMPLAINANT

Complainant is of the opinion that EURid's decisions violate Article 10.1 of the EC Regulation No. 874/2004 and section 13 (1) (ii) Sunrise Rules. Complainant is of the opinion that by filing the documentary evidence it proved to be the owner of prior rights in the sense of Article 10.1 of the EC Regulation No. 874/2004. The simple "clerical" mistake, the Complainant argues, may not give reason to EURid's decision to reject its applications, as the documentary evidence confirmed its ownership in the trademarks without the need of any further investigations by the validation agent. Its applications might not be rejected by pure formalistic arguments.

B. RESPONDENT

Respondent argues that section 3 (1) Sunrise Rules states that an application may only be considered complete when the applicant provides the Respondent with the information of the country in which the prior right claimed exists. The Complainant did not comply with this condition as it did not correctly state that it is the owner of Benelux but French trademarks. Respondent is not of the opinion that the admitted mistake is of minor character and refers to ADR cases 119 (Nagel), 404 (Odyssey), 954 (GMP), 1710 (EMI et al).

Furthermore, Respondent argues, Complainant submitted the cover letter, by which it confirmed that "the rules, including the special terms that relate to the phased registration period, apply and have been read and approved without reservation by the applicant. The applicant has understood that any breach of the rules can invalidate the application for the domain name or result in the cancellation of the registration itself.".

In addition, the information referred to in section 3 (1) (viii) and (ix) Sunrise Rules is deemed to constitute the legal basis in national or community law for the claimed prior right to the name. Thus, the country in which the prior right is held is noted erroneously in the application, the application must be rejected for lack of legal basis of the claimed prior right. As section 3 (1) Sunrise Rules also protects the interests of subsequent potential applicants, they could be misguided and be tempted to file another application for the same domain name, once they figure out that the Complainant only pretended to be the owner of a French trademark.

DISCUSSION AND FINDINGS

Article 14 of the EC Regulation No. 874/2004 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 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.

I. Scope of the validation agent's examination
Section 21 (3) of the Sunrise Rules states that the validation agent is not obliged but, however, permitted in his sole discretion, to conduct its own investigations into the circumstances of the application, the prior right claimed and the documentary evidence produced. This provision grants the validation agent a certain administrative discretion, which allows him to correct immaterial or obvious errors. ADR 328 "Last-minute" gives an example of such cure of mistakes made by the applicant. The reason behind this provision is to enable the validation agent to proceed applications within a reasonable time frame.

By examining the documentary evidence the validation agent could have easily corrected the mistake made by the Complainant, who specified the prior right he was claiming, a nation trademark right. Complainant's mistake was that he claimed a prior trademark right in France and provided Benelux trademark documents as documentary evidence. Thus, the question arises, whether the interests of potential subsequent applicants for the same domain names would be violated by curing the mistake of the Complainant. In ADR 328 "Last-minute" the Panel decided that a mistake in completing the field "Prior Right on Name" is not regarded a material mistake which could not be cured by the validation agent, provided that the documentary evidence clearly corrects the missing (or wrong) information.

However, section 3 (1) last sentence Sunrise Rules states that type and country of a prior right claimed by the Applicant are deemed to constitute the legal basis in national or community law for the claimed prior right to the name. This emphasizes, that under the Sunrise Rules, particularly this information is crucial with respect to the validity of an application. The question to be answered is, if this hinders the validation agent (and the panel) to cure the mistake.

The reason to introduce the phased registration (Sunrise Phase) was to avoid domain grabbing and to give rights owners the possibility to claim their rights and apply for the corresponding domain names. In order to protect the rights of subsequent applicants the Sunrise Rules require strict observation of the formalities. The validation procedure must allow the validation agents to quickly review the documentary evidence and confirm or refuse the existence of a prior right of the applicant. However, the Panel is of the opinion that the validation agent may not restrict its examination to the pure formalities in case the documentary evidence enables him to easily cure mistakes and clarify ambiguities. If the validation agent can correct an obvious minor mistake without time-consuming investigations, he is obliged to do so. The interests of subsequent applicants, who could be mislead by the mistake of Complainant, as Respondent argued, have to stand back in this respect.

As the validation agent could have easily cured the mistake, the Complainant admittedly made, by reviewing the documentary evidence, the Panel holds that despite section 3 (1) Sunrise Rules this case is comparable to ADR 328 “last-minute”. Therefore, the mistake made by the Complainant should have been cured by the validation agent. It did not entitle the Respondent to reject the application for the domain names.

II. Examination of the existence of prior rights
After curing the mistake, the Complainant made, the Respondent should have investigated further, whether Complainant was successful in proving its prior rights in the domain names. With respect to PRIXARCDETRIOMPHE the certificate of registration of the Benelux Trademark Office (Bureau Benelux des Marques) provided as documentary evidence proved the ownership of the prior right of Complainant with respect to the required domain name.

With respect to the domain name “GRANDSTEEPLE” the Complainant did not provide a complete translation of the certificate of registration of the Benelux Trademark Office. Although the trademark seem to have been registered as of 5 December, 2005 (after having been applied for 30 November, 2005), the registration was not completed. The office stated that it provisionally refused to register the trademark according to Article 6bis LBM (Benelux Trademark Act).

The certificate of registration does not prove that the Complainant is the owner of a prior right according to Article 10 subsection 1 EC Regulation No. 874/2004 as it states that the registration is refused (provisionally). The letter of the Benelux Trademark Office does not prove that at the time, the Complainant applied for the domain name “GRANDSTEEPLE” (21 February, 2006) he was the owner of the registered trademark in a country of the EC in accordance with Article 10 subsection 1 of the EC Regulation no. 874/2004.

As the burden of proof with respect to the ownership in prior rights according to this provision is with the applicant, and the Complainant neither provided documents within the 40 days period of section 8 (5) Sunrise Rules nor with its complaint, enabling the Panel to confirm its ownership of a registered Benelux trademark in terms of Article 10 (1) EC Regulation No. 874/2004 and at the time of applying for the domain name, the Panel decides that the complaint with respect to the domain name “GRANDSTEEPLE” is denied.

With respect to the domain name “PRIXARCDETRIOMPHE” the Panel decides to annul the decision of EURid and to attribute the disputed domain name to the Complainant. According to the information provided by EURid by non standard communication as of 10 July, 2006, the Complainant complies with the criteria laid down in Paragraph 4 (2) (b) of EC Regulation 733/2002 (General Eligibility Criteria) (Paragraph B11 (c) of the Rules).

DECISION

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

a) with respect to the domain name “PRIXARCDETRIOMPHE” EURid's decision is annulled and the domain name “PRIXARCDETRIOMPHE” is attributed to the Complainant,

b) with respect to the domain name “GRANDSTEEPLE” the complaint is denied.

PANELISTS

Name	Dominik Eickemeier

DATE OF PANEL DECISION 2006-09-15

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested the rejection by the Respondent of its applications for the domain names “PRIXARCDETRIOMPHE.eu” and “GRANDSTEEPLE.eu” within the first phase of the Sunrise Period.

The rejection by the Respondent was based on the fact that in the application the Complainant stated to be the owner of a French registered national trademark but, however, provided registrations of Benelux trademarks with the documentary evidence.
The certificate of registration of Benelux trademark “GRANDSTEEPLE” included information that the trademark was subject to provisional refusal according to Article 6bis LBM (Benelux Trademark Act).

The Panel decided to annul the decision of EURid with respect to the domain name “PRIXARCDETRIOMPHE”, as the validation agent was obliged to examine the documentary evidence and could have cured the obvious mistake, the Complainant made within the application, easily. The Complainant complies with the criteria laid down in Paragraph 4 (2) (b) of EC Regulation 733/2002 (General Eligibility Criteria) (Paragraph B11 (c) of the Rules). The domain name “PRIXARCDETRIOMPHE” is attributed to the Complainant.

With respect to the domain name “GRANDSTEEPLE” the Panel did not accept the decision of EURid either, but, however, is not convinced that the Complainant was the owner of a prior right in terms of Article 10 (1) EC Regulation No. 874/2004 at the time of the domain name application. Therefore, the Panel denied the Complaint in this respect.