Panel Decision for dispute CAC-ADREU-002211

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Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Image Information & Communication Technology V.O.F., E. Gerats-Adriaens

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

This Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

1. On December 7th, 2005 (at 11 hrs 08 min.), complainant, Image Information & Communication Technology V.O.F. ("Complainant"), filed an application for the registration of the domain name "IMAGE.EU" on the grounds of the Benelux trademark number 0774050 registered by Complainant, manly consisting in figurative trademark containing the term "IMAGE".

2. The Benelux trademark, on which Complainant's application for the domain name "IMAGE.EU" was based, was registered with the Benelux trademark office by "Image Information & Communication Technology V.O.F.", with address at Sint Franciscusweg 69, 6416 EV Heerlen (The Netherlands), whereas the application for the domain name "IMAGE.EU" was signed by "Image ICT", with address at Sint Franciscusweg 69, 6416 EV Heerlen (Belgium).

3. On the same date (at 11hrs 14 min.), Traffic Web Holding BV ("Traffic Web"), a Dutch Internet service provider filed an application for the registration of the domain name "IMAGE.EU", being next in the queue, after Complainant.

4. On May 22, 2006, EURid (the "Respondent") refused the application of the Complainant for the registration of the domain name "IMAGE.EU", since the name and address of the applicant and those of the holder of the alleged prior right were not coincident and, therefore, the validation of the prior right could not succeed.

5. As a consequence of the denial of the application filed by Image ICT, the domain name "IMAGE.EU" was assigned to Traffic Web as next applicant in the queue.

6. On July 3, 2006, Complainant submitted, by electronic means, a complaint to the Czech Arbitration Court ("CAC") challenging the decision of EURid refusing its application for the registration of the domain name "IMAGE.EU" and requesting: (a) the annulment of the decision of the Respondent denying the application of the Complainant for the registration of the domain name; (b) the revocation of the decision of EURid accepting the registration of "IMAGE.EU" in favour of Traffic Web; and (c) the acceptance of the Complainant's application for the registration of the domain name "IMAGE.EU".

A. COMPLAINANT

In support of its position, Complainant contents as follows:

1. Complainant filed an application for the registration of the domain name "IMAGE.EU", which was accompanied by sufficient evidence

of its prior right, represented by its ownership over the Benelux trademark number 0774050, consisting in a figurative trademark containing the term "IMAGE".

2. However, the Respondent denied the application of the Complainant for the domain name "IMAGE.EU" on the basis that no evidence of a prior right was brought, since the name of the applicant for the domain name "IMAGE.EU", as appearing in the application form (i.e., "Image ICT"), differed from that of the legitimate titleholder of the Benelux trademark (i.e., "Image Information & Communication Technology, V.O.F."), and that the address of such companies was also different.

3. In the Complainant's point of view, the divergence between names and addresses is a pure formalistic issue which cannot lead to the denial of the Complainant's application. On the contrary, the validation agent should have concluded that "Image ICT" (as appearing in the domain name application) is merely a commonly used abbreviation of "Image Information & Communication Technology" (as appearing in the trademark ownership certificate).

In particular, the Complainant contends that the validation agent was supposed to carry out its own investigations into the circumstances of the application, the prior right claimed and the documentary evidence, as stated in Article 21(3) of the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (the "Sunrise Rules"). To such extent, the validation agent should have acted more reasonably and carefully by carrying out certain simple investigations, which would have cleared up any doubts as to the identity of the Complainant.

4. Finally, the Complainant contends that the Respondent has not acted diligently since it allocated the domain name "IMAGE.EU" to the next applicant in the queue (i.e., Traffic Web) before the expiry of the term for filing a complaint in the framework of the Alternative Dispute Resolution proceedings. In this regard, the Respondent would have accepted the application of Traffic Web while the decision to deny the application filed by the Complainant was not already firm and, therefore, could be appealed.

B. RESPONDENT

With regard to Complainant's arguments, Respondent contents as follows:

1. Pursuant to article 14 of the Commission Regulation (EC) No. 874/2004, of 28 April 2004, laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain (the, "Regulation"), the Applicant must submit the relevant documentary evidence showing that he or she is the holder of the prior right claimed.

In the Respondent's point of view, the question to be cleared is not whether the applicant is the legitimate titleholder of the prior right, but rather whether the applicant has sufficiently demonstrated the existence of a prior right. To such extent, Respondent argues that the Complainant has failed to demonstrate his ownership over the prior right, since the application was defective as the applicant's name differed from that of the titleholder of the prior right.

2. Respondent also contends that, pursuant to article 20 of the Sunrise Rules, the applicant shall file the sufficient documentary evidence on the ownership over the alleged prior right, as well as any modification or alteration that may have been produced on such prior right. Accordingly, article 20(3) of the Sunrise Rules sets forth that the applicant shall submit the 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. However, in the Respondent's view, the Complainant has failed to demonstrate that the applicant was the same legal person than the one appearing as holder of the prior right. Thus, the application had to be denied.

In support to the Respondent's contention, the response to the complaint includes an extensive list of reference to several precedents of the .EU ADR Decisions stating that the registry cannot accept defective applications for domain names and, confirming that the appeal of the decision of the registry shall not be considered as a "second chance" or an additional round providing an option to remedy their imperfect original application that was duly rejected.

DISCUSSION AND FINDINGS

1. REGARDING THE FACT THAT THE COMPLAINT WAS FILED AFTER THE SUNRISE APPEAL PERIOD

Although the parties have not alleged nor discussed on the expiry of the term to file the complaint, this Panel understands, as previously stated by the Panel in its Decision in case number 01167 "DADDY", that "one of the Panel's first duties is to assess whether or not the Complaint has been filed timely".
In relation to this, as a preliminary and procedural remark, this Panel finds especially relevant the fact that the complaint against the decision of the Respondent was filed after the expiry of the Sunrise Appeal Period (i.e., after 40 days from the decision of the

Respondent to deny the application of the Complainant).

In this regard, it must be noted that the Respondent's decision to deny the application of the Complainant was issued on May 22, 2006, whereas the electronic copy of the complaint was received by the CAC on July 3, 2006, being the hard copy of it delivered on July 7, 2006 and the Time of Filing of the complaint July 10, 2006. Pursuant to Article 26(1) of the Sunrise Rules, the Complainant may only file a complaint- against the decision of the Respondent to register or not to register a domain name- within the term of 40 calendar days from the date of the adoption of the Respondent's decision. To such extent, the term for filing the complaint against the decision of the Respondent dated May 22, 2006, expired on July 1, 2006.

In consequence, the complaint was filed after the expiry of the term established by the Sunrise Rules in order to challenge the decision of the Respondent denying the registration of the domain name "IMAGE.EU". In line with Panel Decision in case number 00904 "NOELL", "Sunrise Rules clearly state that the applicant may initiate an ADR proceeding only within forty (40) days following the contended decision with the consequences that the Complainant loses his remedy in case the Complaint is not timely filed with the "Sunrise Appeal Period" and that the disputed decision then becomes final".

To such extend, this Panel finds that the late filing of the complaint is, per se, sufficient as to deny the complaint and confirm the Respondent's disputed decision.

2. REGARDING THE VALIDATION OF THE APPLICATION BY THE VALIDATION AGENT AND THE CLEARING UP OF DEFICIENCIES IN THE DOCUMENTATION PROVIDED BY THE APPLICANT

Without prejudice to the above - and, in particular, taking into consideration that the referred issue on the late filing of the complaint by the Complainant has not been alleged by the Respondent - this Panel desires to also discuss on the more substantive issues raised in the complaint, including the non-formalistic approach requirable upon the validation agent when examining the application for the registration of a domain name and the related Documentary Evidence and to what extent the validation agent has the obligation to check and clear up the discrepancies between the application and the Documentary Evidence.

Complainant contends that when examining its application for the domain name at hand, the Respondent used a pure formalistic approach and that a less formalistic, but generally more fair approach had to be considered.

This Panel agrees that a pure formalistic approach may not be acceptable for the validation agent when analysing the documentation provided by the applicant for a domain name .eu (hereinafter, the "Submitted Documentation"). However, the issue is to establish the limits of this "non pure formalistic approach". To such extent, it is essential to distinguish those behaviours and actions which may fall within the scope of this approach and, therefore, are requirable upon the validation agent, from those other behaviours falling outside the threshold of the mentioned "non pure formalistic approach" (and, thus, that are not requirable upon the validation agent). This issue is particularly relevant when, as it is the case in this proceeding, it is necessary to determine whether the validation agent should have cleared up defects in the Submitted Documentation.

In relation to the above, this Panel finds that the answer to this issue shall take into consideration the following three elements:

A) The applicant (and not the Respondent nor the validation agent) has the burden of the proof regarding the title and existence of the alleged prior rights:

Under Article 14 of the Regulation, all claims regarding prior rights made within the application for a domain name shall be verifiable in light of the Documentary Evidence. Such Documentary Evidence has to be submitted by the applicant for the .eu domain name. Therefore, as a general rule, all claims on the existence of a prior right require that the applicant sufficiently demonstrates the existence of such prior right. This does not imply an analysis of the prior right itself but rather to check that the applicant has demonstrated the existence of such right.

B) The validation of the applications for .eu domain names by the validation agent has to be done in accordance with the Submitted Documentation:

Article 21(2) of the Sunrise Rules provides that the validation agent has to examine "(..) 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". In this sense, in order to assess whether or not an application for a domain name during the Sunrise Period fulfils the

requirements provided in the Regulation and, therefore, has to succeed, the validation agent has only the obligation to analyse the Submitted Documentation. In particular - as further described below - the validation agent has no obligation to carry out further searches or investigations.

C) The validation agent is permitted (but it is not obliged) to carry out investigations in connection with the application for a domain name:

Article 21(3) of the Sunrise Rules enables the validation agent to carry out its own investigations in order to determine whether the Documentary Evidence brought by the Complainant is sufficient as to determine the existence of a prior right. This Panel is of the opinion that Article 21(3) of the Sunrise Rules shall be construed as granting a right, but not as imposing an obligation, to the validation agent in order to proceed with certain investigations aimed at assessing whether or not the application for the registration for a domain name has to succeed. The wording of Article 21(3) offers no doubt in this respect: "The Validation Agent is not obliged, but it is permitted in its sole discretion (…)".

In light of the above-mentioned three elements this Panel finds that the scope of the "non pure formalistic approach" requirable upon the validation agent has to be construed on a restrictive basis, specially when this approach is used in connection with the clearing up of defects in the application filed for the registration of a domain name.

According to element A) above, the applicant has the burden of proving that it is the holder of a valid prior right. Therefore, the applicant has to be sufficiently diligent as to ensure that the Submitted Documentation does not contain defects and inconsistencies and, in particular, he or she cannot rely on the "non pure formalistic approach" of the validation agent in order to solve any possible deficiencies. Moreover, in accordance with elements B) and C) above, the validation agent shall assess the application for the registration of domain names and the related Documentary Evidence in accordance with the Submitted Documentation. On the other hand, the validation agent has also the right (but no obligation) to carry out certain investigations in connection with the application. Therefore, to the extent that such investigations (i.e. investigations for the clearance of deficiencies of the application) are merely discretional for the validation agent, it is not possible to include such investigation within the scope of the mentioned "non-formalistic approach" which (according to the above) is requirable (i.e. it is not discretional) upon the validation agent.. Otherwise, it would result that the validation agent would be obliged to carry out investigations which are discretional under Article 21(3) of the Sunrise Rules, which is unacceptable. In this line, the Panel in decision number 00551 "VIVENDI" stated that "nothing in the Sunrise Rules construes the obligation of the validation agent or the Respondent to investigate the circumstances of applications, where the prior right was not sufficiently demonstrated, or notify applicants of deficiencies in their applications".

Therefore, when an application for a domain name is defective, the validation agent is not obliged to carry out any investigation aimed at remedying such deficiencies and, therefore, it shall deny the application of such applicant if, for instance, such deficiencies prevent the applicant to evidence the existence of a prior right. This same conclusion has been supported by several .EU ADR decisions (some of them mentioned in the response to the complaint), including the decision in case number 00810 "AHOLD" where the Panel concluded that "when faced before a difference between the applicant name and the prior right holder name, correctly detected by the Validation Agent, the Registry may not accept the corresponding domain name application being the application incomplete under section 3(1) of the Sunrise Rules". However, there may be situations where the deficiencies can be solved without carrying out such investigations (e.g. when the applicant does not identify the prior right but the Documentary Evidence provides such identification, etc.) and, in such cases, the non-formalistic approach requirable upon the validation agent will result in validation agent clearing up such deficiencies.

In the case at hand, the inconsistencies and deficiencies detected in the application for the registration of the domain name "IMAGE.EU" and the Submitted Documentation, refer to the name and address of the applicant and the name and address of the holder of the prior rights. In particular, the name and address of the applicant, as appearing in the application form, did not match with the name and address of the holder of the Benelux trademark number 0774050.

In this Panel point of view, such formal deficiencies are more than trivial (as contended by the Complainant) and, moreover, this Panel considers that the analysis of the information contained in the Submitted Documentation does not allow per se the clearance of such deficiencies. In particular, such information does not allow the validation agent to conclude that the term "Image ICT" is only the abbreviation of "Image Information & Communication Technology V.O.F.", specially taking into account that the addresses (in particular, the country) contained in the application and the certificate of ownership over the prior right were different and, in consequence, "Image ICT" and "Image Information & Communication Technology V.O.F." could well be different entities. The fact that clearance of such deficiencies would require to have access to other information sources (different from the Submitted Documentation) is indeed assumed and accepted in the complaint, since the Complainant stated that "In the circumstances of this case, the Validation Agent could have easily cleared up any doubts by seeking and obtaining further proof of identity (…)".Thus, it is clear that the Complainant admits that the solution of the deficiencies in its application for the registration of the domain name requires "seeking and obtaining

further proof of identity", i.e. to carry out investigations in order to obtain information not provided in the application and Submitted Documentation.

According to this, this Panel finds that in the Submitted Documentation, there are not enough links between the applicant and the holder of the prior rights so that the validation agent could have concluded (even with a non-formalistic approach) that both entities were the same entity, as it was necessary to carry out additional investigations (which are entirely discretional) in order to reach such conclusion. Therefore, in line with the arguments of the Respondent, this Panel is of the opinion that the Complainant did not sufficiently evidence the existence of the prior right on the basis of which the domain name was applied. This lack of evidence - which comes from the divergence between the name and address of the applicant of the domain name and the holder of the relevant prior right - cannot be fixed with just a non-formalistic approach from the validation agent. On the contrary, it requires to carry out investigations and to seek additional information not provided by the Complainant. The carrying out of such investigations constitutes an action falling outside the scope of such non-formalistic approach and, therefore, shall not be requirable upon the validation agent.

Due to the fact the Complainant did not evidenced its title by means of a valid prior right for the registration of the domain name at hand, his application was correctly dismissed by the Respondent. The same conclusion has been reached in several .EU ADR decisions, among others, in the case number 01242 "APONET", where the Panel expressly stated that "the Respondent, without having at its disposal any pertinent document providing that VGDA GmbH and Verwaltungsgesellschaft Deutscher Apotheker GmbH were the same entity, did not err in its decision to reject the Complainant's application."

3. REGARDING THE "FIRST COME FIRST SERVED" PRINCIPLE AND THE AMENDMENT OF DEFICIENCIES IN THE ADR PROCEEDING

Finally, it must be noted that in accordance with Article 14 of the Regulation and Article 2 of the Sunrise Rules, during the Sunrise Period, the applications for the registration of a particular domain name are examined in the order in which the applications are received (i.e., in a pure chronological order). The examination of each application (in chronological order) is made until an application is validated by the validation agent on the basis of the applicant having demonstrated the existence of a prior right in the name at hand. To such extent, each applicant for a same domain name has to diligently provide the documentary evidence of his or her valid prior rights, as otherwise the next applicant in the queue must have also the right to prove the title and existence of his/her valid prior right. Therefore, the "first come first served" principle which, in general terms, applied for the registration of domain names during the Sunrise Period has to be completed in the sense that the first who comes is first to be served, provided that it sufficiently evidences that it is the holder of valid prior rights.

Thus, this Panel finds that the acceptance of the Complainant arguments would imply the possibility of amending the deficiencies of the initial application, in detriment of the legal position of the next applicant in the queue. As established in the CAC's decision in case 1194 "INSURESUPERMARKET", "the ADR procedure is not intended to correct domain name applicant's mistakes".

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	**Gonzalo Gállego**

DATE OF PANEL DECISION 2006-10-06

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

1. On December 7th, 2005 (at 11 hrs 08 min.), complainant, Image Information & Communication Technology V.O.F. (or "Complainant"), filed an application for the registration of the domain name "IMAGE.EU" on the grounds of the Benelux trademark number 0774050 registered by Complainant, manly consisting in figurative trademark containing the term "IMAGE". However, the Benelux trademark, on which Complainant's application relied on, was registered by "Image Information & Communication Technology V.O.F." whereas the application for the domain name was filed in the name of "Image ICT". The address of the registrant of the trademark and the one of the applicant for the domain name was also different.

On May 22, 2006, EURid (the "Respondent") refused the application of the Complainant for the registration of the domain name "IMAGE.EU", since the name and address of the applicant and that of the holder of the alleged prior right were not coincident and, therefore, the validation of the prior right could not succeed.

Only on July 3, 2006, Complainant submitted, by electronic means, a complaint to the Czech Arbitration Court ("CAC") challenging the decision of the Respondent denying the registration of the domain name "IMAGE.EU" and requesting: (a) the annulment of the decision of the Respondent denying the application of the Complainant for the registration of the domain name; (b) the revocation of the decision of EURid accepting the registration of "IMAGE.EU" in favour of Traffic Web; and (c) acceptance of the Complainant's application for the registration of the domain name "IMAGE.EU".

2. In summary, Complainant contends that the denial of the application for the registration of the domain name "IMAGE.EU" was exclusively based on the divergence between the name and addresses of the applicant as established in the application and the certificate of ownership over the prior right. Such divergence could have easily cleared up by the validation agent who has been expressly entitled, by law, to carry out additional investigations. Therefore, in the Complainant's view, there is no argument to support the denial of the application for the domain name "IMAGE.EU".

In support to that contention, Complainant argues that "Image ICT", as contained in the application form, was used as an abbreviation of "Image Information & Communication Technology V.O.F.", as appearing in the certificate of ownership of the prior right. Therefore, the validation agent should have acted diligently and should have assessed that the applicant and the owner of the prior right were one and the same entity.

3. On the other hand, Respondent contends that, due to the differences in the name of the applicant for the registration of the domain name and the one of the owner of the trademark, the documentary evidence submitted to the Registry by the Complainant was not sufficient to assess that the applicant was also the owner of the Benelux trademark "Image" serving as prior right for the purposes of the registration of the domain name "IMAGE.EU".

Additionally, Respondent also contends that it has no obligation to carry out additional searches and investigations and that, the appeal of its decision (not to register the domain name) shall not serve as a second chance or as an additional round for remedy the defective application.

4. In relation to the above, the Panel finds as follows:

4.1. Although this has not been alleged by the parties, as a preliminary and procedural remark, it is worth mentioning that the complaint has been filed after the expiry of the 40-day term, as established in Article 26(1) of the Sunrise Rules, for the initiation of an alternative dispute resolution proceeding before the CAC. To such extent, as already stated in a relevant number of Decisions in other ADR Proceedings, the late filing of the complaint implies that the Complainant looses his or her right to initiate any ADR proceeding. Therefore, the complaint should be denied on the grounds of the late filing of the complaint.

4.2. Pursuant to articles 10 and 14 of the Commission Regulation (EC) No. 874/2004, of 28 April 2004, laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain (the "Regulation"), the applicant for a domain name has the burden of proving that it has sufficient prior rights for the registration of the domain name. Since the applicant filed a defective application (where the applicant's name and address differed from that of the holder of the prior right) it did not evidenced the existence of a prior right.

As explained in several Decisions on .EU ADR Proceedings, the registry shall deny the application for a domain name when the applicant failed to demonstrate its ownership over the prior right.

4.3. In addition, the deficiencies detected in the application may not be solved by means of the appeal of the decision of the registry. In this regard, the Complainant is sole responsible of the accuracy of the information and documentation submitted to the registry and, therefore, Respondent is not obliged to carry out additional investigations nor to access other information sources (other than the documentation provided along with the application) in order to counter-check the accuracy of the information contained in the application. In particular, no obligation exists for the validation agent to carry out additional investigations on the accuracy of the documentation submitted by the applicant.

In line with other many Decisions on .EU ADR cases, if the information on the applicant does not match with that of the holder of the prior right, the registry can deny the application without having to carry out any supplemental investigation.

For all the foregoing reasons, the Panel orders that the Complaint is denied.