Panel Decision for dispute CAC-ADREU-002216

Case number	**CAC-ADREU-002216**
Time of filing	**2006-08-09 15:15:11**
Domain names	**miva.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Miva UK ltd, Rick Tyler**

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

None

FACTUAL BACKGROUND

The Complainant is a limited company which, it would seem, is incorporated in the United Kingdom. It is evident from the Complaint and from the other documents referred to below that it is a subsidiary of an American company, Miva Corporation . Nothing is known about the activities of either company. However, Miva Corporation is the owner of a Community Trade Mark, number 001456748 in Class 9 for amongst other matters computer hardware and software ("the trademark"). The address of Miva Corporation, as shown on the trademark certificate, is San Diego, United States.

On 23rd January 2006, Miva Corporation applied for registration of the Domain Name under the phased registration ("Sunrise") period pursuant to article 10(1) of Commission Regulation EC number 874/2004 ("the 2004 Regulation"). In support of its application it provided a copy of the trademark.

Article 4 (2) (b) of Regulation No 733/2002 provides that "the Registry shall…(b) register domain names in the .eu TLD ….requested by any:
(i) undertaking having its registered office, central administration or principal place of business within the Community, or
(ii) organisation established within the Community…..
(iii) natural person resident within the Community"

As the Applicant was a United States company, the Respondent rejected the Applicant's application.

On 3 July 2006 the Complainant filed a Complaint with the Czech Arbitration Court against the rejection of the Applicant's application. The formal date of commencement of the ADR proceedings was 9th August 2006.

A. COMPLAINANT

The Complainant says as follows;

The Respondent is at fault for failing to explain to it that it should have attached a copy of a trade mark licence from Miva Corporation to the Complainant, in order to show that the Complainant was (to use the Complainant's words) "indeed also holder of the trademark of the word miva". It says that the Respondent should have included more information on its site as to what was required and that the Applicant should not have had to search for information as to exactly what needed to be submitted.

The Complainant says that the trademark protects Miva Corporation and all its subsidiaries throughout Europe. It asserts “The application was made by Miva UK Ltd, a subsidiary to the parent company and not an independent company, therefore legally, all Miva trademarks applies de facto to all miva subsidiaries” (sic). In other words, it considers that Miva Corporation’s trademark should have been treated as, in effect, the trademark of the Complainant for the purpose of the Sunrise application.

By a non-standard communication dated 9th August the Complainant’s authorised representative adds that, in the view of its legal team “the “licence declaration” requested by Eurid is not a proof an actual agreement between 2 companies and that any company for that matter can sign a document of that kind with no actual contractual engagement”. The language of the remainder of the communication is still more confusing but the gist of the Complainant’s assertion appears to be that a licence is unnecessary between a parent company and its subsidiary.

B. RESPONDENT

The Respondent says as follows;

The Applicant for the domain name was Miva Corporation, a US company, albeit a UK address was listed in the application form. The documentary evidence consisted of a Community Trademark registered in the name of Miva Corporation. The Complainant is a separate company to Miva Corporation, with a registered office in the United Kingdom.

Regulation 7333/2002 (summarised above) defines eligibility requirements for registration of a .eu domain name. The effect of these regulations is that domain names under the .eu TLD cannot be registered by US companies. Although the Applicant provided a UK address, it is a US company, as evidenced by the address which appears on the trademark certificate of San Diego, California. The Respondent cites two earlier decisions (ADR 1674 (EBAGS) and ADR 370 (KANE)) in support of its contention.

The Complainant is incorrect in asserting that it applied for the domain name. The application was made by Miva Corporation, a different corporate entity.

Even if, which the Respondent does not accept, the Complainant should be treated as the party which applied for the domain name, it has failed to provide evidence that, as a company which is separate to Miva Corporation, it was the holder of a prior right as required by Articles 10 (1) and 14 of the Regulation. In particular, Article 14 of the Regulation provides that claims for prior rights under Article 10 must be supported by documentary evidence that the applicant is the holder of the prior right claimed on the name in question. Section 20.1 of the Sunrise Rules provides that “If an Applicant has obtained a licence for a registered trade mark ….in respect of which it contains a Prior Right, it must enclose with the Documentary Evidence an acknowledgement and declaration form…duly completed and signed by both [the licensor] and the Applicant (as licensee)”.

If the Complainant had sought to suggest that it was the holder of a trademark license from Miva Corporation it should have submitted a copy of the license. It failed to do this.

Lastly, the Respondent says that, even if the Panel were to find in favour of the Complainant, transfer of the Domain Name is inappropriate because the Complainant is a different entity to the Applicant and only the Applicant filed an application, not the Complainant.

DISCUSSION AND FINDINGS

The effect of Regulation 733/2002 (the material parts of which are set out in the Factual Background section above) is to restrict applications for .eu domain names to the classes of persons set out in the regulation. These provisions would exclude a United States company.

The application for the domain name was made by Miva Corporation. The evidence available to the Respondent at the time the application was made was the following;

(1) the application form dated 15th February 2006. This states that the name of the applicant is Miva Corporation. In response to the section headed “Type of prior right claimed” the response is given “Registered National Trademark - United Kingdom”;

(2) the trademark certificate. This shows that the owner of the trademark “MIVA” is Miva Corporation and that the address for Miva Corporation is in San Diego, California.

There was nothing else of materiality. The only candidate for the application for the domain name was the party whose name appeared

on the application form and trademark registration certificate ie Miva Corporation. Moreover, there was no evidence provided to show the exact nature of the relationship between Miva Corporation and the Complainant, Miva UK Limited. Nor was there any evidence to show on what basis Miva UK Limited (which is not even referred to on the application form) was entitled to the benefit of the trademark.

In these circumstances, the Respondent could conclude only that the Applicant was Miva Corporation. It is unreasonable to expect it to have speculated as to whether the correct applicant should have been some other company, not least when there was no evidence to suggest the nature of the legal relationship between that company and the Applicant. It cannot be the responsibility of the Respondent to have a roving obligation to remedy mistakes in application forms.

It was also reasonable for the Respondent conclude, correctly, that the Mira Corporation was a US company. The address for Miva Corporation on the trademark certificate was San Diego, California. Moreover, “Corporation” is, as the Respondent points out, a term often used to denote American companies. As a matter of theory, the Applicant could have had its registered office in the United States but have had its central office or principal place of business within the United Kingdom and have thereby been eligible to apply for a Domain Name. However, there was no evidence available to the Respondent to suggest that this was the position nor any basis to make such an assumption.

In these circumstances there is no basis to disturb the decision made by the Respondent to reject the Applicant’s application.

Two further points require brief comment. First, the Panel accepts the Respondent’s argument that, even if had been expected to divine that the Applicant had really intended its application to have been on behalf of the Complainant, Miva Limited, there was no evidence submitted to show that the Complainant had the benefit of the trade mark and so its application would have been properly rejected for that reason. Second, there is no evidence to support the Complainant’s assertion that there was a failure on the part of the Respondent to explain the requirement of the Sunrise rules properly on its website or (even if there had been) that this would somehow entitle the Complainant to succeed in its Complaint.

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

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	**Antony Gold**

DATE OF PANEL DECISION 2006-10-30

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Respondent was justified in rejecting an application for a Domain Name made under the phased registration (Sunrise) period when the application form showed the applicant to be a United States company, when the trademark relied on was a certificate which was in the name of that company and when there was no other evidence to suggest that the Complainant, a United Kingdom company, should have been treated as the Applicant.