Panel Decision for dispute CAC-ADREU-002316

Case number	**CAC-ADREU-002316**
Time of filing	**2006-07-12 16:32:12**
Domain names	**medtronic.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Medtronic EOC**

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

There are no other legal proceedings.

FACTUAL BACKGROUND

The Complainant is a company registered in the Netherlands and belongs to the Medtronic group, a major multinational group dealing in medical technology. The Complainant filed an application for the registration of the disputed domain name “medtronic.eu” during the Sunrise Period (on 7 December 2005). The application was based on another application for registration of the trademark “Medtronic”. The registration of the trademark had not been completed at the time of the application for the domain name.

The Registry refused to register the disputed domain name during the Sunrise Period.

A. COMPLAINANT

The Complainant claims that according to Article 10 of the Commission Regulation (EC) No 874/2004 the Complainant is entitled to registration of the disputed domain name in the Sunrise Period as a holder of a Community trademark.

The Complainant further claims, that apart from the trademark Medtronic, which was registered after the application for a domain name was filed and before the Registry issued a decision, there were other bases for registration of the disputed domain name, existing at the time of filing the application, namely the Complainant’s company name and other trademarks already registered well before the beginning of the Sunrise Period. Those trademarks were registered by the US Medtronic Inc. company. One of the Community trademarks was licensed to the Complainant on 13 January 2006. All this happened before the Registry rejected the Complainant’s application.

The Complainant also explains that no other company or person or public entity has requested registration of the disputed domain name and that it would be against the regulations not to attribute the domain name to the Complainant.

B. RESPONDENT

The Respondent claims that according to paragraphs 3 and 4 of Article 12(2) of the Commission Regulation No 874/2004 only registered trademarks may be the basis for applications for domain names in the Sunrise Period. All claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists. Pursuant to Section 13.1 (ii) of the Sunrise Rules trademark applications are not considered a prior right.

The Complainant’s documentary evidence submitted with the application for the domain name included only a trademark application without any documents proving that the trademark had been registered.

As far as its company name is concerned, pursuant to Article 12 of the Commission Regulation No 874/2004 such names cannot serve as the basis for registration in the Sunrise Period.

The Respondent further contends that the ADR procedure is not intended to cure the deficiencies of the initial application or offer a "second chance" for the Applicants to remedy their initial applications that were rejected during the Sunrise Period.

The Respondent quotes a number of previous ADR cases supporting its contentions: Case No. 127 (BPW), No. 219 (ISL), No. 294 (Colt), No. 551 (Vivendi), No. 984 (Isabela), No. 843 (Starfish), No. 1931 (Diehl, Diehlcontroles), No. 1186 (GBG), No. 404 (Odyssey), No. 1612 (ACER), No. 1680 (Commercials, Unlimited), No. 1275 (Thun), No. 1566 (Airlinetickets, Creditreport), No. 1518 (Vanholten), No. 810 (Ahold), and others.

DISCUSSION AND FINDINGS

The factual circumstances in this case are undisputed. The Complainant applied for the "medtronic.eu" domain name during the Sunrise Period on the basis of a trademark application. At the time of the domain name application (on 7 December 2005), the trademark was not yet registered.

The Complainant contends that even an application for the trademark registration is sufficient for the submission of a domain name registration application.

The Complainant is not right, because Section 13.1 (ii) of the Sunrise Rules expressly states that a mere trademark registration application is not considered trademark registration. Such provision is a logical concretisation of the "first-come-first-served" principle. This principle was confirmed in the Vanhouten Case (No. 1518).

The second legal question is whether the ADR proceedings can serve as a remedy for mistakes that an Applicant made in earlier proceedings. The applicable rules in such cases are also very clear.

According to Article 14 of the Commission Regulation No 874/2004 all claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists. 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 question for the Panel is therefore not whether the applicant is the holder of a prior right, but whether the applicant submitted sufficient evidence to the validation agent proving that it is the holder of a prior right. Such was also the view of the Panel in a previous ADR case No. 1886 (GBG).

The Panel also agrees with the previous ADR decisions that ADR proceedings were not designed to remedy the deficiencies of applications in the domain name registration phase (Case No. 551 - Vivendi, Case no. 810 - Ahold).

For the said reasons the Panel holds that the Respondent was right in refusing the Complainant's domain name application.

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	**Blaz Mrva**

DATE OF PANEL DECISION 2006-10-23

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is a company based in the Netherlands and who applied for a domain name in the Sunrise Period on the basis of an application for a Community trademark. The trademark was registered three months after application for the domain name was filed. The Respondent refused to register the domain name.

The Complainant contends that apart from the Community trademark the Complainant's parent company Medtronic Inc. from the United States had other registered trademarks at the time of the domain name registration application, and that the domain name could also be registered on the basis of the name of the Applicant itself.

The Panel held that according to paragraphs 3 and 4 of Article 12(2) of the Commission Regulation No 874/2004 only registered trademarks can be the basis for a domain name registration application in the Sunrise Period. The Section 13.1 (ii) of the Sunrise Rules states that trademark application is not considered a prior right. The rule was confirmed in the ADR case Vanhouten (No. 1518).

The Panel further held that according to Article 10(1) and (2) of the Commission Regulation No 874/2004 all prior rights must be verifiable by documentary evidence and that the evidence must be submitted by the Applicant. The Panel agrees with the previous ADR decisions that ADR proceedings were not designed to remedy the deficiencies of the applications in the domain name registration phase (Case No. 551 - Vivendi, Case no. 810 - Ahold).

For the said reasons the Panel holds that the Respondent was right in refusing the Complainant's domain name application.

The Complaint is denied.