Panel Decision for dispute CAC-ADREU-002412

Case number	**CAC-ADREU-002412**
Time of filing	**2006-07-21 12:34:29**
Domain names	**scwp.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Saxinger Chalupsky & Partner Rechtsanwälte GmbH, Dr. Peter Baumann**

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 proceeding connected to the disputed domain name SCWP.EU. No such information was obtained from the parties and the Panel is not entitled to make any own investigations.

FACTUAL BACKGROUND

The application for registration of the SCWP.EU domain name was rejected by the Respondent and this decision is subject of the complaint, by which the Complainant seeks the attacked decision be annulled and the domain name SCWP.EU be registered in his name.

Both Complaint and Response have been filed within the set time frame and are therefore admissible.

A. COMPLAINANT

(i) General reasoning

In the opinion of the Complainant, the attacked decision is in contrary to the provisions of Regulation (EC) 874/2004 (here after: the Regulation), as set out in article 10 (1).

The Complainant further informs that the complainant is identical with the trademark owner as mentioned on the certificate of registration of the trademark SCWP, which is attached to the Complaint. He also attaches an extract of the Austrian Commercial Register showing a name change of the Complainant.

(ii) Prior rights

The application is based on a prior Austrian trademark with registration no. 204338 for the word "SCWP", registered in the name of Saxinger Chalupsky Weber & Partner Rechtsanwälte GmbH. The Complainant is the holder of said prior right as can be concluded from the extract of the Austrian Commercial Register, which shows that the company name has changed into Saxinger Chalupsky & Partner Rechtsanwälte GmbH.

The Panel also notes a change of address.

B. RESPONDENT

(i) General reasoning

Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 states that only holders of prior rights which are 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.

Article 14 (4) of the Regulation states that it is up to the applicant to submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. The applicant shall submit the evidence in such a way that it shall be received by the validation agent within forty days from the submission of the application for the domain name. If the documentary evidence has not been received by this deadline, the application for the domain name shall be rejected.

(ii) Respondent´s position

Saxinger Chalupsky Weber & Partner Rechtsanwälte GmbH (hereafter "the Applicant") applied for the domain name SCWP on 15 March 2006. The processing agent received the cover letter on 30 March 2006, which was before the 24 April 2006 deadline.

As no documentary evidence was enclosed to the cover letter, the validation agent concluded that the Applicant had not demonstrated that it was the holder of a prior right. Therefore, the Respondent rejected the Applicant's application.

(iii) Argument's regarding the burden of proof during the registration proceeding

The burden of proof was with the Applicant to demonstrate that it is the holder or the licensee of a prior right.

Pursuant to the Regulation, the relevant question is not whether an applicant is the holder of a prior right, but whether an applicant proves to the validation agent that it is the holder of a prior right (see ADR 1886 GBG).

(iv) Claim of the Respondent

The Respondent demands the complaint be rejected.

DISCUSSION AND FINDINGS

The principle of first-come-first-served is the basic principle of allocating a .eu domain name. This principle has only one exception which is laid down in the phased registration period, the so-called Sunrise Period. The Panel cites Consideration (12) of the Regulation:

In order to safeguard prior rights recognized by Community or national law, a procedure for phased registration should be put in place. Phased registration should take place in two phases, with the aim of ensuring that holders of prior rights have appropriate opportunities to register names on which they hold prior rights. The Registry should ensure that validation of the rights is performed by appointed validation agents. On the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name.

This deviation of the basic principle is the result of experience known from introductions of other Top Level Domain (TLD) registers: many owned names were cybersquatted or victimized by any other types of domain name piracy of owned names. In order to avoid or at least to minimize this phenomenon the European Commission decided to help intellectual property owners in safeguarding their rights, like trademark rights by the introduction of the phased registration procedure for .eu domain names. By this means intellectual property owners have a priority privilege to register their domain names.

A privileged registration phase can only be effectuated when the right itself is demonstrated in a strict time frame. Demonstration should be done by the holder of the invoked right. This is quite logical, for the right holder has the evidence of his rights in his possession. Moreover, a strict time frame when introducing a new TLD is absolutely necessary. First of all because tremendous amounts of domain name applications have to be processed. Secondly, because it is the interest of all applicants that domain names are registered in the shortest timeframe possible. One should not forget that we are dealing here with the Internet infrastructure where the .eu TLD is included as one of the targets to accelerate electronic commerce (see also consideration (1) of Regulation no. 733/2002). It is therefore that showing evidence of a prior right must be made –and has been made- dependent of a set of rules. Those rules for filing a domain name in the Sunrise Period and submitting the evidence and in what time frame are clearly laid down in article 10(1) and (2) and 14 (4) of the Regulation.

In the light of the foregoing, it must be stressed that, especially when taking advantage of the privileged rules for trademark owners which are applicable in the Sunrise Period for filing a domain name application, it is the responsibility of the domain name applicant to provide before applicable deadlines all documentary evidence in a manner that its prior right to the domain name applied for is clearly demonstrated.

In this case Complainant only submitted a cover letter, being the pre-formatted electronic document made available by Respondent, to which documentary evidence within the forty days from the submission of the application for the domain name needed to be attached and sent to the validation agent. No evidence of the rights in the form of a certificate of a national or Community trademark registration was attached to the cover letter.

Complainant did deliver the evidence of his existing trademark rights, but this was done no earlier than in the ADR procedure, which is long after the forty days period which is set in the Regulation.

Complainant did not convey any other documentation or reasons which should have been taken into account by the Panel when examining his case.

The Panel bears in mind that Article 22 (11) (b) of the Regulation states: “In case of a procedure against the Registry, the ADR panel shall decide whether the decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002”.

Furthermore, the Panel follows the expression of the Panel in ADR 551 VIVENDI in which it is stated that the ADR procedure may not in any case serve as a second chance or an additional round providing applicants an option to remedy their imperfect original application that was rejected during the Sunrise Period.

The Panel thus rules the same as in the comparable cases ADR 1432 PETITFORESTIER and ADR 2362 PETIT-FORESTIER.

The Panel founds that the Respondent has decided correctly.

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	**Marieke Westgeest**

DATE OF PANEL DECISION 2006-10-10

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The application for registration of the SCWP.EU domain name was rejected by Respondent because the Applicant did not demonstrate evidence of having trademark rights in the denomination SCWP within the forty days period. The Applicant only sent the cover letter to the validation agent. The Complainant seeks the decision to be annulled and the domain name SCWP.EU be registered in his name. In support of his claim the Complainant attaches a certificate of trademark registration of the word SCWP and an extract of the Austrian Commercial Register which shows that the owner name as mentioned in the trademark certificate is the same as the Complainant. Respondent argues that the decision is in accordance with the Regulation, because the burden of proof was with the Applicant to demonstrate that it is the holder or the licensee of a prior right within the forty days period. Respondent further states that the relevant question is not whether an applicant is the holder of a right, but whether an applicant proves to the validation agent that it is the holder of a prior right.

The Panel ruled that the Respondent was right in rejecting the domain name application. The principle of first-com-first-served is the basic principle of allocating .eu domain names and the Sunrise Period is an exception on that principle. A privileged registration phase, which the Sunrise Period is for trademark owners, can only be effectuated when strict rules are applied. This is necessary because tremendous amounts of domain name applications have to be processed and secondly because it is in the interest of all applicants that domain names are registered in the shortest timeframe possible. One should not forget that we are dealing here with the Internet infrastructure where the .eu TLD is included as one of the targets to accelerate electronic commerce.

In the light of the foregoing it must be stressed that, especially when taking advantage of the privileged rules for trademark owners which are applicable in the Sunrise Period for filing a domain name application, it is the responsibility of the domain name applicant to provide before applicable deadlines all documentary evidence in a manner that its prior right to the domain name applied for is clearly demonstrated.

The Complaint is denied.