Panel Decision for dispute CAC-ADREU-002473

Case number	**CAC-ADREU-002473**
Time of filing	**2006-08-07 11:01:22**
Domain names	**oknoplast.eu, oknoplastkrakow.eu, oknoplast-krakow.eu, oknazkrakowa.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Przedsiębiorstwo Produkcyjne "OKNOPLAST-Kraków" Sp. z o.o., Marcin Bryniarski**

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

No information with regard to other legal proceedings is known to the Panelist

FACTUAL BACKGROUND

On 7 February 2006, Przedsiębiorstwo Produkcyjne “OKNOPLAST – Kraków” Spółka z ograniczoną odpowiedzialnością [hereinafter referred to as “the Complainant”] filed with EURID the applications for registration of the following domain names:
1. www.oknoplast.eu
2. www.oknoplastkrakow.eu
3. www.oknoplast-krakow.eu
4. www.oknazkrakowa.eu

By virtue of EURID’s disputed decision, all the aforementioned domain name applications were rejected; The complainant decided to challenge EURID’s decision and filed a complaint. The Complaint submitted by Przedsiębiorstwo Produkcyjne "OKNOPLAST-Kraków" Sp. z o.o., Marcin Bryniarski was received by e-mail on 2006-08-04 14:44:56 and in hardcopy on 2006-08-03 by the Czech Arbitration Court. In accordance with Paragraph B2 (a) of the .eu Dispute Resolution Rules (ADR Rules), the Czech Arbitration Court has verified that the Complaint satisfies the formal requirements of the ADR Rules and ADR Supplemental Rules of the Czech Arbitration Court. The payment in the required amount to the Czech Arbitration Court has been made by the Complainant. The formal date of the commencement of the ADR Proceeding is 2006-08-17, according to the Courts statement. The CAC acknowledged receipt of the Response on 2006-10-03 and appointed the undersigned to serve as a single Panelist on the 5th of October 2006.

A. COMPLAINANT

According to the Complainant’s opinion, the decision to reject the above-mentioned applications were erroneous and non-compliant with the provisions of law in force, including the Community legislation, in particular the provisions of Regulation (EC) 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain and Commission Regulation (EC) 874/2004 of 28 April 2004, laying down public policy rules concerning the implementation and function of the .eu Top Level Domain and the principles governing registration. Consequently, the Complainant applied for the annulment of the decision taken by the Respondent to reject the applications for registration of the domain names mentioned above and asks for all the above-mentioned domain names to be attributed to the Complainant. The grounds for annulment stated were the following:
Regarding the domain name oknoplast:

On 22 December 2005, by virtue of the Agreement of sale of a protective right to a trademark [hereinafter referred to as “the Agreement”] executed in the form of a Notarial Deed in the Notary’s Office in Niepołomice, ul. Bocheńska No 4, before Notary Public Agnieszka Mikułowska-Krupska, MA (Register A No 5276/2005), the Complainant purchased the protective right to “OKNOPLAST” word trademark registered in the Trademark Register under number 98250. As a result of the Agreement, by virtue of the Decision of 19 April 2006 (ref.

DR/R-98250), the Patent Office of the Republic of Poland, in the Trademark Register, under number R-98250, in box A, deleted the previous entry and made an entry in the following wording: Przedsiębiorstwo Produkcyjne „OKNOPLAST – KRAKÓW" Sp. z o.o., Ochmanów, Polska, 6780038167. The above-mentioned Decision is already final and valid. As a result of the Decision issued, the Complainant applied, on 23 January 2006, via the Patent Office of the Republic of Poland, for international registration of "OKNOPLAST" word trademark R-98250 in the EU Member States and certain other states. Consequently, the Complainant is the sole holder of the exclusive right to use "OKNOPLAST" word trademark in trading. By purchasing the right to "OKNOPLAST" word trademark, the Complainant took over the rights of the entity selling the trademark and therefore the protection resulting from the right to register "OKNOPLAST" word trademark has been in force since 25 March 1994.
Therefore, the Complainant claims that it is at present and was on the date of filing the application for registration of www.oknoplast.eu domain, fully eligible to use this trademark; moreover, it is currently and was on the date of filing the above-mentioned application, the sole holder of the exclusive right to use "OKNOPLAST" word trademark.
Regarding the domain names www.oknoplastkrakow.eu and www.oknoplast-krakow.eu
On 12 August 2004, the Patent Office of the Republic of Poland issued a decision to grant the Complainant the protective right to "OKNOPLAST KRAKÓW" word and graphic trademark. The protection resulting from the registration of "OKNOPLAST KRAKÓW" trademark has been in force since the date of filing relevant application, i.e., since 29 December 2003.
Based on the above decision, the Complainant applied for the respective registration of "OKNOPLAST KRAKÓW" word and graphic trademark to the Office for Harmonization in the Internal Market and to the World Intellectual Property Organization. As a result of the applications filed, the Complainant received respective certificates to register the above-mentioned "OKNOPLAST KRAKÓW" trademark in its name.
Considering the above, the Complainant claims that it is at present and was on the date of filing the application for registration of www.oknoplastkrakow.eu and www.oknoplast-krakow.eu domains, fully eligible to use "OKNOPLAST KRAKÓW" trademark; moreover, it is currently and was on the date of filing the above-mentioned application, the sole holder of the exclusive right to use "OKNOPLAST KRAKÓW" trademark.
Regarding the domain name www.oknazkrakowa.eu
On 31 October 2003, the Complainant applied to the Patent Office of the Republic of Poland for granting a protective right to "Okna z Krakowa" word and graphic trademark. Consequently, although the Complainant has not received a decision to grant a protective right to "Okna z Krakowa" word and graphic trademark yet, it is currently, in accordance with the provisions of law in force, eligible to use this trademark in trading. What is extremely significant in this case is that when the Company is granted the protective right to „Okna z Krakowa" trademark and becomes the holder of the exclusive right to use it, the actual protection will be deemed to have commenced as of the date of filing the application, i.e., as of 31 October 2003.
Therefore, it must be considered that while filing the application for registration of the www.oknazkrakowa.eu domain, the Complainant was eligible to file the application and the domain should be attributed to the Complainant in consideration of the commonly recognized principle of the prior rights safeguarding, also expressed in Regulation 874/2004.
In the opinion of the Complainant, the Respondent's decision to reject the application for registration of the domain names aforementioned was non-compliant with the provisions of law in force, including the provisions of Regulation 733/2002 and Regulation 874/2004, in particular:
- the intention to safeguard the prior rights recognised by the Community or national law (item (12) of the preamble to Regulation 874/2004 and item (16) of the preamble to Regulation 733/2002)
- Article 10 (1) and (2) of Regulation 874/2004
- Article 12 of Regulation 874/2004.

B. RESPONDENT

The Respondent calls attention to the fact that the Complainant applied for the domain names OKNOPLAST, OKNOPLASTKRAKOW, OKNOPLAST-KRAKOW AND OKNOPLASTKRAKOWA on 7 February 2006.
The documentary evidence was received on 17 March 2006, which was before the 19 March 2006 deadline. This documentary evidence consisted for all four domain names applied for of:
- An extract of the Polish company register "REGON" setting out that the Complainant is registered under REGON number 350661450
- An extract demonstrating that the Complainant is registered in the tax office and received a tax identification number
- An extract of the Polish company register "KRS" demonstrating that the Complainant is registered under KRS number 0000141430
- A trademark application for the name OKNA Z KRAKOWA at the Polish trademark office
- Promotional leaflets of the Complainant
The validation agent found that documentary evidence submitted by the Complainant did not sufficiently demonstrate that the Complainant was the holder of a prior right. Based on these findings, the Respondent rejected the Complainant's applications.
The Respondent based the grounds for rejecting the application of the Complainant on the following provisions: Articles 10 (1) and (2), 12 (2) and 14 of Regulation 874/2004
The Respondent states that the burden of proof was with the Complainant to demonstrate that it is the holder or the licensee of a prior right. In particular, Article 10 (1) of the Regulation states that only the holders of prior rights shall be eligible to apply register domain

names during the period of phased registration. Pursuant to article 14 of the Regulation, the applicant must submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. Based on this documentary evidence, the validation agent shall examine whether the applicant has prior rights on the name. It is therefore of crucial importance that the Respondent is provided with all the documentary evidence necessary for it to assess if the applicant is indeed the holder of a prior right. The burden of proof was therefore on the Complainant to substantiate that it is the holder or the licensee of a prior right. The Respondent refers to a number of respective case law [cases 127 (BPW), 219 (ISL), 294 (COLT), 551 (VIVENDI), 984 (ISABELLA), 843 (STARFISH), 1931 (DIEHL, DIEHLCONTROLS)]. A passage from case 1886 (GBG) is also included in the Response.
Further on the Respondent underlines that only documentary evidence submitted at the time of the domain name application may be taken into account. In the context of the present proceedings, the Complainant submits new documentary evidence. Although this documentary evidence may or may not demonstrate the Complainant's prior rights on the domain names applied for, this may not be examined by the Panel. This view is based on article 22 (1) b of the Regulation. Additionally, pursuant to article 14 of the Regulation, the Respondent may only accept, as documentary evidence, documents that are received by the validation agent within forty days from the submission of the application for the domain name. In the present case, the 40 days period for submitted documentary evidence ended on 19 March 2006. The Complainant filed its complaint on 4 August 2006 and submitted new documents attached to its complaint. According to article 14 of the Regulation, these new documents may thus not be considered as documentary evidence. Consequently, they may not serve as a basis to asses whether the Complainant was the holder of a prior right at the time of the application. Therefore, only the documentary evidence which the Respondent was able to examine at the time of validation of the application should be considered by the Panel to assess the validity of the Respondent's decision. This position is based on several decisions in earlier cases of a similar nature [cases 294 (COLT), 954 (GMP), 1549 (EPAGES) and 1674 (EBAGS)]. A passage from case 1931 (DIEHL, DIEHLCONTROLS) is also included in the Response.
Finally, the documentary evidence did not demonstrate that the applicant was the holder of the claimed prior rights at the time of the application
(a) Regarding OKNOPLAST
The documents mentioned by the Complainant were submitted for the first time during this dispute. They were not included in the documentary evidence submitted at the time of the application, so that they cannot be taken into account when assessing whether the Respondent's decision conflicted with the Regulation. Furthermore, as admitted by the Complainant itself, the Polish OKNOPLAST trademark was only registered at the Polish trademark register on 19 April 2006, i.e. more than one month after the deadline for the documentary evidence. Therefore, the Respondent did not know of – and a fortiori could not take into account – this trademark registration in its decision to refuse the domain name application.
The Respondent also notes that the international trademark application for the OKNOPLAST name cannot be taken into account as section 13.1.(ii) of the Sunrise Rules unequivocally states that "[a] trade mark application is not considered a Prior Right". This section reflects article 12 (2) of the Regulation, pursuant to which "[d]uring the first part of phased registration, only registered national and Community trademarks" can be relied on as prior rights for domain name applications. In the present case, the Complainant was not the holder of a registered trademark at the time of its application for the OKNOPLAST domain name, but only of a trademark application. Therefore, the Complainant was ineligible to apply for a domain name based on its trademark application. The Respondent refers to a number of decisions in cases 876 (FUTBOL, CHEAPTICKETS), 1566 (AIRLINTICKETS, CREDITREPORT), 1886 (GBG) and 1680 (COMMERCIALS, UNLIMITED), where the Panel decided that a trademark application is not sufficient to establish a prior right. A passage from case 1886 (GBG) is also included in the Response.
(b) Regarding OKNOPLASTKRAKOW and OKNOPLAST-KRAKOW
The documents mentioned by the Complainant were submitted for the first time during this dispute. They were not included in the documentary evidence submitted at the time of the application, so that they cannot be taken into account when assessing whether the Respondent's decision conflicted with the Regulation.

(c) Regarding OKNAZKRAKOWA
The Respondent cannot take into account trademark applications as section 13.1.(ii) of the Sunrise Rules unequivocally states that "[a] trade mark application is not considered a Prior Right". This section reflects article 12 (2) of the Regulation, pursuant to which "[d]uring the first part of phased registration, only registered national and Community trademarks" can be relied on as prior rights for domain name applications. The Respondent refers to decisions taken in cases 876 (FUTBOL, CHEAPTICKETS), 1566 (AIRLINTICKETS, CREDITREPORT), 1886 (GBG) and 1680 (COMMERCIALS, UNLIMITED), where the Panel decided that a trademark application is not sufficient to establish a prior right. In the present case, the Complainant admits not to have been the holder of a registered trademark at the time of its application for the OKNAZKRAKOWA domain name, but only of a trademark application. Therefore, the Complainant was ineligible to apply for a domain name based on its trademark application.
For all the above reasons, the Respondent asks for the rejection of the complaint.

DISCUSSION AND FINDINGS

This is a dispute whose facts are obviously similar to a number of earlier cases brought before the CAC. The main issues are the following: First, the issue regarding the burden of proof of prior rights to a domain name. Second, the issue of the admissibility of new

evidence, i.e. documentation filed during the ADR proceedings. Third, the issue concerning the importance of a trademark application as documentary evidence for a domain name registration bearing the same indication.

1. Burden of proof

The relevant provisions on this point are Articles 10 and 14 of Regulation (EC) No 874/2004 (hereafter "the Regulation").

Article 10 (1) of the Regulation states that: "Holders of prior rights recognized or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of. eu domain starts. 'Prior rights' shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works". Article 14 of the Regulation states that "[a]ll 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 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 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.(…) The Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in the second, third and fourth paragraphs".

In a series of decisions it is already established that the burden of proving a prior right lies with the applicant [see apart from the cases mentioned by the Respondent the following: Cases 1518, 1542, 1664, 1943, 2013, 2050, 2094, 2119, 2124, 2138, 2268, 2316, 2335, 2564].

In the present case the Complainant failed to produce to the Validation Agent the necessary documentary evidence within the 40 day term.

2. Admissibility of new evidence

With regard to the domain names OKNOPLAST, OKNOPLASTKRAKOW and OKNOPLAST-KRAKOW, it is undisputed that the appropriate documentary evidence was presented by the Complainant for the first time during these proceedings. A large number of decisions have already established a case law rule under .eu ADR proceedings, namely that new evidence presented for the first time before the Panel, i.e. not within the 40 days period, as required by Art. 14 Reg. 874/2004, are to be held inadmissible [see apart from the case law mentioned by the Respondent, cases 1518, 1665, 1943, 2013, 2022, 2055, 2087, 2094, 2119, 2124, 2190, 2268, 2316].

Hand in hand with the above goes a second rule, namely that the only task for the Panel in these proceedings is to check the compliance of the decision taken by the Respondent with the Public Policy Rules. Hence, these proceedings may not serve as a "second chance", in terms of providing applicants an option to remedy their imperfect original application that was rejected during the Sunrise Period (see cases 551, 810 1194, and 1537).

Consequently, the belated reaction coming from the Complainant cannot be taken into account by the Panel. In this context I would like to repeat a meanwhile often mentioned passage from case 219, where panelist Mikkel Gudsøe stated the following: "One could argue that sympathy is overruled by the applicable Regulations serving among other purposes the (cost-effective) functionality of the phased registration and the principles hereof".

3. The validity of trademark application under the registration process

This issue concerns solely the fourth domain name of the complainant's application, namely the indication OKNAZKRAKOWA. It is clear from the wording of Art. 10 (2) and 12 (2) Reg. 874/2004 that a trademark application is inappropriate to serve as a sufficient piece of documentary evidence. This view is further based on Section 13.1 (ii) of the Sunrise Rules, where it is clearly stated that a trademark application is not considered a prior right. This position has been already followed by a number of earlier decisions. Some of them are mentioned by the Respondent in its Response (see above). I would like to add some recent case law in the same direction, namely cases 1518, 1612, 2055, 2084, 2180, 2316 and 2422. The opposite view has been followed solely in case 2145. However, the factual background of the latter dispute is evidently divergent from those of the present case; Thus, it could not serve as a precedent.

A final word on this matter concerns the retroactivity of trademark applications, an argument which was indirectly presented by the Complainant. In the case before hand, it is very important to underline that even today the Complainant did not produce any evidence of an actual trademark registration. Hence, the domain name application continues to rely on the trademark application dated from 31.10.2003. Nevertheless, even if the Complainant was able to present a trademark registration, the situation would not have been a different one. As Panelist Tuukka Ilkka Airaksinen stated in case 2422, "[i]t is indeed an established principle of trademark laws in various jurisdictions that a registration confers exclusive rights to the mark as of the filing date. However, this "backdating" is done only at the date of registration, not before. Therefore, at the time of filing of the domain name application the Complainant did not hold exclusive rights to the trademark…".

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	**Apostolos Anthimos**

DATE OF PANEL DECISION 2006-11-01

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant seeks for the annulment of the Respondent's decision to reject its application to register the disputed domain names, and the attribution of them to the Complainant. The application was rejected due to insufficient documentary evidence, namely lack of trademark registration certificates. The Complainant produced during the present proceedings trademark certificates for three out of four domain names.
It is held that it is already established that the burden of proving a prior right within the specific 40 days deadline, stipulated by Art. 14 Reg. 874/2004 lies with the applicant.
New evidence presented for the first time before the Panel, i.e. not within the 40 days period, as required by Art. 14 Reg. 874/2004, are to be held inadmissible under .eu ADR proceedings.
A trademark application is inappropriate to serve as a sufficient piece of documentary evidence. The retroactive effect of a trademark application is not of importance within the .eu registration process, since the prior right has to be proved within the 40 days deadline, in accordance with Art. 14 Reg. 874/2004.