Panel Decision for dispute CAC-ADREU-002479

Case number	**CAC-ADREU-002479**
Time of filing	**2006-08-08 10:58:20**
Domain names	**smartech.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Mariusz Szepietowski**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

SMARTech, respectively Mariusz Szepietowski (hereinafter "the Complainant") applied for the domain name “smartech.eu” on January 25, 2006.

The validation agent received the documents evidencing the application on March 2, 2006, i.e. within the prescribed period.

On June 25, 2006 the EURid (hereinafter the “Respondent” or the “Registry”) issued the decision based on which the application for the registration of the domain name “smartech.eu” was rejected.

In this context, the Complainant submitted to the Czech Arbitration Court the complaint by email on August 3, 2006 and on August 23, 2006 in hardcopy requesting the annulment of the decision and attribution of the domain name “smartech.eu” to the Complainant. The formal date of commencement of the ADR Proceeding (hereinafter the “ADR Proceeding”) is August 23, 2006.

A. COMPLAINANT

The Complainant argued that the application for the registration of the domain name “smartech.eu” based on the existence of the prior right corresponding to the trademark "SMARTECH" was duly accompanied with the evidencing documentation.

According to the Complainant, the Respondent lost the confirmation of the payment for trademark registration of word trademark "SMARTECH" that was sent by the validation agent to the Respondent.

In the opinion of the Complainant, based on the said payment he has the rights to the said trademark. Complainant in this context further stated that after the realization of the payment he received the official confirmation of rights to the respective trademark since 2002, which he attached to the complaint.

Thus, in the opinion of the Complainant, there was no ground for rejecting the application for the registration of the domain name “smartech.eu”.

B. RESPONDENT

The Respondent summarized the grounds under which the Complainant's application for the registration of the domain name "smartech.eu" was rejected. In this context it referred, in particular, to Articles 10, 12 (2), 14 of Commission Regulation (EC) No. 874/2004 of 28 April 2004 (hereinafter the "Regulation") and sections 11.3, 13.1 (ii), 21.2 of eu. Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter the "Sunrise Rules").

The Respondent emphasized that Complainant applied for the domain name "smartech.eu" on 25 January 2006 and on 2 March 2006, which was before the 6 March 2006. i.e. before the deadline, the processing agent received the documentary evidence consisting of a letter from the Polish Trademark Office which stated that for the respective trademark to be effectively registered a registration fee should be paid. Therefore, the validation agent concluded that the Complainant was not the holder of a prior right and the Respondent rejected the Complainant's application.

In regard to the Complainant's contentions the Respondent stated that the documentary evidence did not demonstrate that the Complainant was the holder of a prior right corresponding to the respective trademark and argued that the burden of proof is with an applicant to demonstrate that it is the holder or the licensee of a prior right.

Additionally, the Respondent cited Article 10 (1) of the Regulation which states that only the holders of prior rights shall be eligible to register domain names during the period of phased registration.

The Respondent also referred to Article 14 of the Regulation under which "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".

According to the Respondent, based on this documentary evidence, the validation agent shall examine whether the applicant has prior rights on the name, as it is clearly indicated by the 12th recital of the Regulation which states that "on the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name."

In order to support the said conclusion the Respondent referred to the ADR cases n° 127 (BPW), n° 219 (ISL), n° 294 (COLT), n° 551 (VIVENDI), n° 984 (ISABELLA), n° 843 (STARFISH), n° 1886 (GBG), n° 1931 (DIEHL, DIEHLCONTROLS) and it also referred to section 21 (2) of the Sunrise Rules according to which the validation agent shall examine whether an applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence it has received and section 21 (3) of Sunrise Rules according to which the validation agent cannot be expected to undertake further investigations.

In this context the Respondent summarized that it is thus clear that the documentary evidence submitted by the Complainant should stand on its own and prove that the Complainant is the holder of a prior right.

The Respondent further stressed that only the holders of prior rights are eligible to apply for a domain name during the phased registration.

In this context the Respondent referred to Article 10 of the Regulation which clearly states that the "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". According to the Respondent, pursuant to the said provision, prior rights shall be understood to include registered national and community trademarks. Pursuant to Article 12 (2) of the Regulation, during the first part of phased registration, only registered national and Community trademarks, geographical indications, and the names and acronyms referred to in Article 10(3), may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in Article 10(1) of the Regulation.

Furthermore, the Respondent argued that according to section 11.3. of the Sunrise Rules, the applicant must be the holder (or licensee, where applicable) of the prior right claimed no later than the date on which the application is received by the

Registry, on which date the prior right must be valid, which means that it must be in full force and effect. The Respondent also stated that with reference to section 13.1 (ii) of the Sunrise Rules, a trademark application is not considered a prior right.

In order to support the said conclusion the Respondent referred to the ADR cases n° 01125 (ETS), (VANHOUTEN), n° 1566 (AIRLINTICKETS, CREDITREPORT), n°1680 (COMMERCIALS, UNLIMITED) and n° 404 (ODYSSEY), n° 1566 (AIRLINETICKETS, CREDITREPORT).

According to the Respondent, in case at hand, the Complainant submitted a letter from the Polish Trademark Office stating that the amount of 1850 zl should be paid for the trademark to be registered. The Respondent further noted that all the documentary evidence it ever received in regard to the Complainant's application did not consist of a proof of the payment. The Respondent also pointed out that all documentary evidence is immediately scanned by the processing agent upon receipt and then stored electronically.

The Respondent further argued by Article 44 (1) of the Polish Trademark Act, which states that after ascertaining that no obstacles to the registration of the trademark exist and that the fees laid down in section 5 have been paid, the Patent Office shall take the decision to register the trademark and shall enter it in the respective Register.

In the light of the said Article 44 (1) the Respondent is of the opinion that the said letter of the Polish Trademark Office merely proved that the grounds for registration had been met, without there being any proof that the trademark had already been registered. Indeed, the letter clearly states that the fees had not yet been paid.

On top of the said reasoning, the Respondent emphasized with reference to Article 14 of the Regulation that information submitted as documentary evidence for the first time in the framework of the present ADR Proceeding, i.e. a certificate of the Polish Trademark Office dated 17 May 2006, should not be taken into consideration. To support its standpoint it referred to various ADR cases, namely cases n° 294 (COLT), n° 954 (GMP), n° 1549 (EPAGES), n° 1674 (EBAGS), n° 2124 (EXPOSIUM), n° 551 (VIVENDI), n° 810 (AHOLD) and n° 1194 (INSURESUPERMARKET).

Upon the above stated, according to the Respondent the Complainant's complaint shall be denied.

DISCUSSION AND FINDINGS

According to Article 10 (1) of the Regulation, the 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.

According to Article 10 (2) of the Regulation, the domain registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.

According to Article 14 paragraph 4 of the Regulation, every applicant must 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 within forty days from the submission of the application for the domain name, otherwise the application for the domain name shall be rejected.

According to section 21 (2) of the Sunrise Rules, the validation agent shall examine whether an applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence it has received.

According to section 21 (3) of the Sunrise Rules, the validation agent is not obliged, but is permitted in its sole discretion, to conduct its own investigations into the circumstances of the application, the prior right claimed and the documentary evidence produced.

The Complainant applied for the domain name "smartech.eu" on 25 January 2006 based on the existence of the prior right

corresponding to the word trademark “SMARTECH” and it provided the validation agent with the documentary evidence on 2 March 2006.

In this context it is necessary to state that it is undisputable that the validation agent received within the prescribed period the documentary evidence consisting of the letter of the Polish Patent Office (Trademark Department) from which it clearly results that the respective trademark will become effective after the payment of the respective registration fee.

Moreover, according to the Complainant, the validation agent was also provided within the prescribed period with the confirmation of the payment for trademark registration of the word trademark "SMARTECH", which was in the meantime lost by the Respondent and thus could not be taken into account by the Respondent at the moment of the assessing application for the registration of domain name “smartech.eu”. However, the Complainant did not provide any evidence confirming the submission of the said document in the prescribed period to the validation agent/Respondent. The Respondent in this regard strictly refused the fact of being provided by the Complainant with the said document within the prescribed period.

Furthermore, the Complainant provided the Panel in the ADR Proceeding with the trademark certificate of the Polish Patent Office confirming the existence of the registered trademark “SMARTECH”.

With regard to the above cited provisions and facts, there is no doubt that the only documentary evidence to be taken into account by the Panel should be the documentary evidence provided from the part of the Complainant within the prescribed period. Thus, the Panel did not consider as relevant the documentary evidence that was provided by the Complainant for the first time in the ADR Proceeding. The Panel also did not consider the alleged confirmation of the payment for trademark registration of the word trademark "SMARTECH" as relevant due to the fact that the Complainant did not provide any evidence confirming that such document was submitted to the validation agent within the prescribed period. On the other hand, the Panel carefully examined and considered as relevant the letter of the Polish Patent Office (Trademark Department) dated December 13, 2005 submitted by the Complainant within the prescribed period. Nevertheless, as it clearly results from the examination of the said document it only confirms the fact that the respective trademark will become effective after the payment of the respective registration fee. Thus, the Panel is of the opinion that such documentary evidence cannot in any way serve as prima facie documentary evidence confirming the existence of registered word trademark “SMARTECH” at the moment the application for the registration of the domain name “smartech.eu” was filed.

The Registry correctly rejected the registration of the domain name “smartech.eu”.

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	**Aleš Chamrád**

DATE OF PANEL DECISION 2006-11-05

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested the decision of the Registry to reject the application for registration of the domain name “smartech.eu” on the ground of alleged lack of documentary evidence provided from the part of the Complainant in order to confirm the existence of prior right corresponding to the word trademark “SMARTECH”.

The Complainant supported its application with the letter of the Polish Patent Office (Trademark Department) from which it clearly results that the respective trademark will become effective after the payment of the respective registration fee. In the ADR Proceeding the Complainant provided the Panel with the trademark certificate of the Polish Patent Office confirming

the existence of the registered trademark “SMARTECH”.

According to Article 10 (1) of the Regulation, the 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.

According to Article 10 (2) of the Regulation, the domain registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.

According to Article 14 paragraph 4 of the Regulation every applicant must 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 within forty days from the submission of the application for the domain name otherwise the application for the domain name shall be rejected.

According to section 21 (2) of the Sunrise Rules, the validation agent shall examine whether an applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence it has received.

Since the Complainant did not provide the documentary evidence confirming the existence of the prior right claimed, i.e. word trademark ”SMARTECH” within the prescribed period, the application was rightfully rejected by the Registry.