Panel Decision for dispute CAC-ADREU-002494

Case number	CAC-ADREU-002494
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Domain names	bpsc.eu

Case administrator

Name	Kateřina Fáberová

Complainant

Organization / Name	Biuro Projektowania Systemów Cyfrowych SA, I. Miedziński, F. Szweda, B. Michalik, R. Orawski

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 “Biuro Projektowania Systemów Cyfrowych SA”, a polish company.

The Complainant applied for the Domain Name bpsc.eu on 07/02/2006 11:06:16.139.

Its application is the first one ever made for this domain name and was ranked # 1 in the queue list.

The documentary evidence has been provided in time.

The application, made during the Sunrise Period 2, is based on the following prior right: “Company name / trade name / business identifier”.

It has been rejected by Eurid based on the fact that the documentary evidence doesn’t substantiate enough the prior right.

A. COMPLAINANT

The Complainant contends that it has prior rights to register the domain name during Sunrise, which was proved by documents attached to the application for the domain:

I In the Complainant’s view, its first prior right derives from its name and the acronym thereof:

“Complainant has attached to his application copy of the statute of the company showing that company has the name ‘Biuro Projektowania Systemów Cyfrowych’ and the acronym of the name which is: ‘BPSC’ (created from the first letters of the words from the full name of the Company). Company uses its ‘shorter’ name in correspondence, in its current Web service (www.bpsc.com.pl) and trademarks. This acronym is protected as a personal right according to the article 23 of polish Civil Code”.

II In the Complainant’s view, its second prior right is a trademark application:

“Complainant attached also documents showing that Company has applied for the community trade mark including the name “BPSC”(number of application 003996981)”.

The Complainant sees this as an unregistered trademark that constitutes a prior right under article 10 of EC Regulation 874/2004.

B. RESPONDENT

Respondent contends that although the burden of the proof of the prior right is a duty of the Complainant, the latter failed, in this case, to demonstrate that it is the holder of such a prior right.

As far as the name of the Complainant is concerned, Respondent stress that pursuant to article 10 (2) of the Regulation, the registration on the basis of a prior right (here "Biuro Projektowania Systemów Cyfrowych SA") 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. This means that the company name relied upon by the Complainant could not serve as a prior right for the domain name BPSC, since this is not the complete name of the claimed prior right. Therefore, the Respondent correctly rejected the Complainant's application.

As far as the acronym is concerned, Respondent underlines that pursuant to article 10.3 of the Regulation, only public bodies may rely either on their complete name or the acronym generally used, and that pursuant to article 10.2. of the Regulation, the Complainant could only rely on the complete name of the company.

Also, concerning the acronym, Respondent contends that should this acronym be considered, as such, as a trade name (and not a company name), then sections 16 (2) and (5) of the Sunrise Rules must be applied. In order to establish its prior rights on the name "BPSC" in the form of a trade name, the Complainant needed to provide proof of public use of the trade name or business identifier prior to the date of Application (such as, but not limited to, proof of sales volumes, copies of advertising or promotional materials, invoices on which the trade name or business identifier is mentioned etc., proving public use of the name in the relevant member state). However, the Complainant did not bring any proof that it publicly used the trade name "BPSC", as a part of the documentary evidence submitted before the 19 March 2006 deadline. Such evidence is of great importance as trade names can only exist through their public use.

Eventually, concerning the trademark application, Respondent takes the view that the Complainant's "unregistered trademark" doesn't satisfy to the legal framework applicable (more precisely article 15 of the Sunrise Rules).

DISCUSSION AND FINDINGS

In the Panel view, the Complainant's company name is not a prior right that could substantiate its application for the bpsc.eu domain name.

Indeed, although a company name is, without any doubt, a prior right under article 10 of EC regulation 874/2004, it must be stressed that article 10.2 clearly states that "The registration on the basis of a prior right shall consist of the registration of the COMPLETE [we underline] name for which the prior right exists, as written in the documentation which proves that such a right exists".

As a matter of fact, the complete Complainant's company name appears to be Biuro Projektowania Systemów Cyfrowych. It is not BPSC.

The only case where the acronym could be accepted, as such, as a company name, is where the applicable law protects the full name and its acronym as a company name. Depending on the statutes of a company and the national applicable law, this situation could occur. The Panel has no reliable information that this is the case in the present situation, partly because the documents are in polish (this is sad: the procedure against Eurid is in English and, although it is useless and unreasonable for the Complainant to translate the whole documentation, it would have been wise to provide at least an informal translation of the most important elements).

This being said, due to the wide interpretation of trade names and business identifiers in many European countries, an acronym could potentially be considered as such.

Prior rights are defined by article 10 as such: it "shall be understood to include, inter alia, (…) in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, (…).

Is BPSC a trade name or a business identifier in the present case?

The answer is no, mainly because the public use is a central criteria when trade names and business identifiers are concerned. Article 16.5 of the Sunrise Rules confirms this view: the Complainant must provide "proof of public use of the trade name or business identifier prior to the date of Application (such as, but not limited to, proof of sales volumes, copies of advertising or promotional materials,

invoices on which the trade name or business identifier is mentioned etc., proving public use of the name in the relevant member state)".

In the present case, no proof of public use is produced by the Complainant, neither in the Documentary Evidence, nor in the ADR. (The fact that a website exists in not enough, notably because this is no proof of a public use prior to the date of Application; also, the document of incorporation of the company is not enough because even if it refers to the acronym, it is not as such a proof of any public use.)

The last issue is related to the trademark. The Complainant claims to be the owner of an unregistered trademark that constitutes, under article 10 of the EC Regulation, a prior right.

Article 15 of the Sunrise Rules specifically targeted the situation of unregistered trademarks:

"If an Applicant claims a Prior Right to a name on the basis of (…) (ii) an unregistered trade mark (…) that is protected under the law of one of the member states referred to in Annex 1 as being a member state protecting unregistered trade marks, it is sufficient to prove the existence of such Prior Right in accordance with Sections 12(2) or 12(3) hereof, without there being an obligation to provide the Documentary Evidence referred to in Section 12(1)".

Article 12(2) is clearly not applicable to the present case, and article 12.3 states that:

"If, under the law of the relevant member state, the existence of the Prior Right claimed is subject to certain conditions relating to the name being famous, well known, publicly or generally known, have a certain reputation, goodwill or use, or the like, the Applicant must furthermore submit

(i) an affidavit signed by a competent authority, legal practitioner, or professional representative, accompanied by documentation supporting the affidavit or

(ii) a relevant final judgment by a court or an arbitration decision of an official alternative dispute resolution entity competent in at least one of the member states

stating that the name for which a Prior Right is claimed meets the conditions provided for in the law (including relevant court decisions, scholarly works and such conditions as may be mentioned in Annex 1 (if any)) of the relevant member state in relation to the type of Prior Right concerned".

As a matter of fact, no document of any kind is produced by the Complainant, neither in the Documentary Evidence nor in the ADR. The Panel didn't receive any affidavit or final judgment.

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	**Joost Verbeek**

DATE OF PANEL DECISION 2006-10-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Although a company name is, without any doubt, a prior right under article 10 of EC regulation 874/2004, it must be stressed that article 10.2 clearly states that "The registration on the basis of a prior right shall consist of the registration of the COMPLETE [we underline] name for which the prior right exists, as written in the documentation which proves that such a right exists".

As a matter of fact, the complete Complainant's company name appears to be Biuro Projektowania Systemów Cyfrowych. It is not BPSC.

The only case where the acronym could be accepted, as such, as a company name, is where the applicable law protects the full name and its acronym as a company name. Depending on the statutes of a company and the national applicable law, this situation could occur but the Panel has no reliable information that this is the case in the present situation.

Also, BPSC may not be considered, in the present case, as a trade name or a business identifier in the present case, mainly because the public use is a central criteria when trade names and business identifiers are concerned (see Article 16.5 of the Sunrise Rules). In the present case, no proof of public use is produced.

Eventually, the Panel rejects the Complainant claims that it is the owner of an unregistered trademark that constitutes, under article 10 of the EC Regulation, a prior right. Article 15 of the Sunrise Rules specifically targeted the situation of unregistered trademarks, and request specific document and information. As a matter of fact, no document of any kind is produced by the Complainant, neither in the Documentary Evidence nor in the ADR. The Panel didn't receive any affidavit or final judgment.