Panel Decision for dispute CAC-ADREU-002537

Case number	**CAC-ADREU-002537**
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Domain names	**fab.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**FAB, s.r.o., Ing. Dana Petrová**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

On 7 December 2005 the Complainant filed an application for registration of the domain name <fab.eu> on the basis of prior rights in the name “FAB”. On 4 January 2006 the Complainant sent to EURid the following documentary evidence in support of its application:
(i) an extract from online database of trade marks of Czech Republic Industrial Property Office dated 14 December 2005;
(ii) trade mark registration certificate issued by the Industrial Property Office; and
(iii) an extract from the Commercial Register administered by the Regional Court Hadrec Kralove Section C, File No 20609

The application was rejected by the Respondent on 16 June 2006. Two reasons were given as folliows:

(i) insufficient substantiation of connection between the applicant for the domain name and the holder of the prior right; and
(ii) failure to document the prolongation of the validity of the trade mark.

A. COMPLAINANT

The Complainant submits that the evidence supplied in support of its application has sufficiently substantiated the Complainant’s prior right to the “FAB” mark (trade mark number 95148) registered in the Czech Republic in accordance with the Trade Marks Act.

The Complainant submits that its application for the <fab.eu> domain name was first in time and documentary evidence in support of the application was in accordance with Articles 10 and 14 of the Commission Regulation (EC) No.874/2004 “Regulation” and Section 13(2) and Section 20 (3) of the Terms and Conditions for .eu domain name registrations during the Sunrise Period (“Sunrise Rules”).

The Complainant states that FAB, a.s., and not the Complainant, FAB, s.r.o was the holder of the registered trade mark “FAB” but FAB, a.s. was wound up on 1 September 2005 and its business assets transferred to the Complainant. This change has not yet been registered with the Czech Trade Marks Registry. In recognition of this the Complainant attached an extract from the Regional Court which stated that the business assets of FAB, a.s. have passed to the Complainant.

The Complainant is aware that the trade mark certificate does not show the prolongation of the protective period and in accordance with Section 13 (2) (ii) of the Sunrise Rules it attached an extract from the official online database of the Industrial Property Office dated 14 December 2005. The Complainant submits that the extract unambiguously indicates that the trade mark is registered and therefore the validity of the trade mark was prolonged and that the Industrial Property Office renewed the validity the registered trade mark with effect from 8 December 2004.

The Complainant contends that the Respondent made a mistake by rejecting its application for the <fab.eu.> domain name because the documentary evidence unambiguously documents the Complainant's prior right to the "FAB" mark; the Complainants application was fist in line; and the Respondent's decision contradicts the provisions of Article 14 of the Regulation and Section 13(2) and Section 20(3) of the Sunrise Rules.

In its reply to the Respondent's response the Complainant rejects the Respondent's conclusions and contends that the online database of the Czech Republic is due and sufficient evidence showing that the applicant is the owner of the prior right.

B. RESPONDENT

In response to the Complainant's submissions, the Respondent contends that according to Article 10 (1) of the Regulation, holders of prior rights recognised or established by national and/or Community law and public bodies are eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts. Further, under Article 14 of the Regulation, 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.

Section 11.3 of the Sunrise Rules requires that 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.

Section 21.2 of the Sunrise Rules states that the validation agent must examine whether the Applicant has a Prior Right to the name exclusively on the basis of a prima facie review of the first set of Documentary Evidence received and scanned by the Processing Agent.

Although the documentary evidence was received before the deadline, the Respondent submits that it did not include information substantiating that the trade mark had been renewed after 10 years. Therefore, based on the documentary evidence the Respondent rejected the Complainant's application because there was no demonstration that the Complainant held prior rights in the name "FAB" at the time of the application.

The Complainant agrees that it did not provide a certificate of renewal as part of the documentary evidence. It is of crucial importance that the Respondent is provided with all necessary documentary evidence to for it to assess whether the applicant is the holder of a prior right.

The Respondent contends that it is now a widely accepted principle that it is the sole responsibility of the Applicant to ensure that the documentary evidence supplied in support of a domain application is sufficient to substantiate the prior right relied upon. The burden of proof is on the Complainant to show that it is the holder or licence of the prior right. Is support of its submission the Respondent refers to ADR cases 127 (BPW), 219 (ISL), 294 (COLT), 551 (VIVENDI), 984 (ISABELLA), 843 (STARFISH), 1931 (DIEHL, DIEHLCONTROLS), 1242 (APONET), 1625 (TELEDRIVE), 2160 (KEOS) and 1886 (GBG).

Article 23 of the Czech Law on Trademarks (No. 137 of June 21, 1995) provides that
(1) The term of protection shall be 10 years from the date on which the application was filed with the Office. (2) The term of protection of the trademark shall be renewed for further periods of 10 years at the request of the owner of the trademark, which request (hereinafter referred to as "the request for renewal of the registration") shall be filed with the Office in the last year of the current term of protection, or not later than six months after the said term expires.

The documentary evidence did not include any document or information substantiating that the trademark had been renewed after 10 years or contain any document substantiating that the Complainant had applied for such extension after the first period of ten years. Therefore, the Complainant failed to prove that its trademark was still in force when the application to register the domain name was being examined.

The documentary evidence provided did not show that the trade mark was in full force and effect as nothing was provided showing that the trade mark had been renewed after 10 years, or an application to renew the protection had been applied for. The mere printing of the extract is evidence that the information was available at that date, and not that the mark had been renewed. The documents submitted merely showed rights in respect of an expired mark.

It the documentary evidence shows only an expired trade mark certificate then the Respondent must reject the application. In support of its contention the Respondent refers to the ADR decisions 1627 (PLANETINTERNET); 219 (ISL); 1728 (ANNOSE, OFERTA) 2050 (AUTOMOTOGAZETA) and 1262
NATIONALBANK.

The Respondent states that documents submitted for the first time during the present ADR proceedings may not be taken into consideration. Pursuant to the Regulation article 14 of the Regulation, the Respondent may only accept, as documentary evidence, documents that are received by the validation agent within 40 days from the submission of the application. In the present case, the 40 days period ended on 16 January 2006. The complaint commenced on 26 July 2006 and new documents attached to it include a document showing that the Czech trademark had been renewed. Those documents may not serve as a basis to assess whether the Applicant is the holder of a prior right, since those documents are submitted more than five months after the end of 40 days period set forth by the Regulation.

The Respondent states that the Complaint process should not be used by Complainants to perfect imperfect applications. Only the documentary evidence available to the Respondent at the time of the application should be considered in any complaint. Further, a decision taken by the Respondent may only be annulled when it conflicts with the Regulation. Therefore only documentation available to the Respondent at the time of the examination of the application may be used.

DISCUSSION AND FINDINGS

This case concerns the Respondent’s rejection of the Complainant's application for the <fab.eu> domain name during the period of phased registration The two grounds given for rejecting the application were firstly, an insufficient substantiation of connection between the applicant for the domain name and the holder of the prior right; and secondly, a failure to document the prolongation of the validity of the trade mark.

The Respondent has not disputed the Complainant’s submissions in connection with the first ground on which the Complainant’s application was rejected i.e. an insufficient substantiation of connection between the applicant for the domain name and the holder of the prior right. In particular that at the time of the Complainant’s application, the registered holder of the trade mark “FAB” was FAB, a.s., and not the Complainant, FAB, s.r.o. As FAB, a.s. was wound up on 1 September 2005 the transfer of business assets to the Complainant, (which had not yet been registered with the Czech Trade Marks Registry), was evidenced by an extract from a Regional Court which stated that the business assets of FAB, a.s. had passed to the Complainant.

The remaining issue concerns the second ground on which the Respondent rejected the Complainant’s application. This relates to the prolongation of the validity of the trade mark and whether the documentary evidence filed with the Complainant verifies that the Complainant is the holder of prior rights in the “FAB” mark.

The aim of the phased registration period is to ensure that holders of prior rights will have the appropriate opportunity to register the in which they have rights. Under Article 10 of Regulation 874/2004 (the “Regulation”), holders of prior rights recognised or established by national and/or Community law and public bodies are eligible to apply to register domain names during a period of phased registration.

Article 14 of the Regulations requires every applicant to submit documentary evidence that verifies that the applicant is the holder of prior rights claimed on the name in question. The documentary evidence must be filed within forty calendar days following submission of the application to the Registry

The official requirements for documentary evidence and the rules for validation of prior rights are set out in detail in the Sunrise Rules. Under 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"

Section 21.2 of the Sunrise Rules requires the validation agent to examine whether the applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence received. Section 13(2) sets out the documentary evidence required to show a registered trademark. It includes a copy of an official document issued by the competent trade mark office including a certificate of registration or renewal certificate or an extract from an official (on-line) database which must clearly show that the applicant is the registered owner of the registered trade mark.

The Complainant submitted in support of its application both a certificate of registration and an extract from the official (on-line) database to verify it prior rights to the name in question. Both the trade mark certificate and the online database showed the "FAB" trade mark (No.184333) has a filing date and priority date of 08.12.1994. Neither the certificate nor the online database show that the "FAB" trade mark registration has been renewed. The need for renewal every ten years is clearly stated on the trade mark certificate which contains the notation:

"The protective period of the trademark incorporated amounts to ten years and starts to run from the day when the Office receives a TM application. The application for the incorporation renewal can be submitted at the soonest in the last year of the protective period and at the latest six months after its expiry (Section 13 of Act No. 174/1988 Coll)"

On the face of both the certificate of registration and the online database the ten year validity period for the trade mark appears to have expired.

The Complainant argues that the extract from on-line data-base states that: "The database comprises only valid trademarks registered with the Industrial Property Office" and hence the trade mark must have been renewed. However, the extract also contains the caution: "The present extract has only an informative nature and the data for its compilation were generated on the Internet network. If you think that there are mistakes, please turn to the Industrial Property Office."

An extract from the online database is good evidence of the facts contained in it. However, as evidence of the applicant prior rights is flawed in that it did not show an unexpired or renewed mark. One has considerable sympathy for the Complainant, but this is tempered with the knowledge that in fairness to all applicants for a .eu domain name the rules must be applied consistently and that the burden of proof in establishing prior rights rests with the Complainant.

The online database extract generated on 14 December 2005 did not evidence that the trade mark had been renewed after the 10 year period. On the face of it showed a trade mark registration which was valid until 08.12.04.

By contrast the documents attached to the Complaint included not only the extract from the on-line trade mark database kept by the Industrial Property Office; and certificate of the trade mark registration, issued by the Industrial Property Office but also the certificate of renewal of the trade mark certificate. It is this last document which unambiguously indicates that the trade mark registration has been renewed and is valid. If it had been included in the Complainant's first set of documentary evidence which the validation agent examined to determine whether the applicant has a prior right to the name in question the outcome might have been different.

The burden of proof is on the applicant to show the existence of a prior right. The relevant documentary evidence must be submitted in due time to the validation agent. In this case a crucial document, the renewal certificate was not submitted with the first set of documents to the validation agent.

As stated in ADR 1886 (GBG),"the relevant question is thus not whether the Complainant is the holder of a prior right, but whether the Complainant demonstrated to the validation agent that it is the holder of a prior right. If an applicant fails to submit all documents which show that it is the owner of a prior right the application must be rejected".

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	**Veronica Marion Bailey**

DATE OF PANEL DECISION 2006-11-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contests the Respondent's rejection of its application for the domain name <fab.eu> on the grounds of:

(i) insufficient substantiation of connection between the applicant for the domain name and the holder of the prior right; and (ii) failure to document the prolongation of the validity of the trade mark.

The Respondent did not dispute the Complainant's submissions that the connection between the applicant for the domain name and the holder of the prior right was substantiated.

The burden of proof was on the Complaint to show it had the requisite prior rights in the name and that the trade mark had been renewed. The documents filed with the application included certificate of the trade mark registration, an extract from the on-line trade mark database kept by the Industrial Property Office. These documents showed the date of registration but did not show that the trade mark had been renewed. The renewal certificate filed with the Compliant was not within time and so the Respondent has the right to deny Complainant's application