Panel Decision for dispute CAC-ADREU-002573

Case number	**CAC-ADREU-002573**
Time of filing	**2006-07-31 13:16:42**
Domain names	**brooksrunning.eu, brooks.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Brooks Sports GmbH, Rechtsanwalt Peter Heyers**

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 pending legal proceedings.

FACTUAL BACKGROUND

The Brooks Sports GmbH (hereafter "the Complainant" or “Applicant”) applied for the domain names “brooks.eu” and “brooksrunning.eu” on January 23, 2006. The validation agent received the documentary evidence on March 3, 2006 within the prescribed deadline.

The Complainant submitted the German trademark “Brooks” as documentary evidence for both applications, thereby claiming a prior right to the domain names “brooks.eu” as well as “brooksrunning.eu”. This trademark was registered in the name of Brooks Sports Inc. (Seattle, Wash., US) and not the Complainant’s name. The documentary evidence did not contain any licence declaration form stating that the Applicant was a licensee to the trademark. The validation agent concluded that the Applicant was not the holder of a prior right and rejected the applications for both domain names by decision on May 18, 2006.

The Applicant submitted a complaint by e-mail and in hardcopy on July 27, 2006 to the Czech Arbitration Court. The complaint was filed on July 31, 2006. With this complaint the Complainant requests the Panel to annul the Registry’s decision and to attribute the domain names “brooks.eu” and “brooksrunning.eu” to it. With its launched complaint, the Complainant submitted a licence declaration signed on February 1, 2006 between the holder of the trademark and the Complainant as licensee as new document.

In the meantime one of the domain names, namely “brooks.eu”, has been transferred to another Applicant.

A. COMPLAINANT

The Complainant contends to be entitled to use the trademark “Brooks” because of German Trademark Law.

The trademark “Brooks” is registered in the German Trademark Register (“Deutsches Markenregister”) under the number 1186858, “BROOKS”. The Complainant contends to be a subsidiary company of Brooks Sport Inc. (Seattle, Washington, USA) as the owner of the trademark.

Because of a licence contract with the trademark owner, the Complainant claims to have the right to use the trademark “Brooks”.

The Complainant further contends to be a well-known sports goods company in Germany using the trademark “Brooks” on its products for many years and being associated by the customers with the trademark “Brooks”

Moreover, the Complainant contends that the first who applied for the domains is allowed to keep them.

Since there is no such person, the domain names have to be attributed to the Complainant.

B. RESPONDENT

The Respondent contends that the Complainant did not submit documentary evidence showing that it is the holder or licensee of a valid prior right. The Complainant only submitted a German trademark registered in another company's name. A licence declaration was never received by the validation agent. Without a licence, the validation agent was in no position to determine whether the Complainant was entitled to rely on the trademark “Brooks”. The Respondent, therefore, rejected the Complainant's application.

The Respondent further contends that ADR proceedings may not be used to correct the Complainant's application. A license declaration was not submitted within the 40 days deadline, but with the complaint later on. Therefore, this document can not be considered as documentary evidence, pursuant to article 14 of the Regulation. This new information may not be taken into consideration to evaluate whether the Respondent's decision conflicts with the Regulation.

The domain name applied for BROOKSRUNNING consists of more characters than the trademark. The domain name applied for does not exactly correspond to the prior right claimed.

During the Sunrise Period, the first-come-first-served principle only comes to play after the validation agent has accepted an application. This effectively means that the first to have applied for a domain name and who succeeds in proving that it is the holder of a prior right will be granted the domain name.

The Complainant failed to prove that it is the holder of a prior right.

DISCUSSION AND FINDINGS

1. domain name “brooks.eu”:

According to Article 14 of the Regulation, it exclusively falls on the Applicant to prove to be the holder or the licensee of a prior right. If an Applicant fails to submit all documents which demonstrate the proof of a prior right, the application must be rejected (see ADR cases no. 551- Vivendi, 984 - Isabella, 843 - Starfish).

Section 20 (3) of the Sunrise Rules provides that if an Applicant has obtained a license for a registered trade mark in respect of which it claims a prior right, it must enclose with the documentary evidence an acknowledgement and declaration form, completed and signed by both the licensor of the relevant registered trademark and the Applicant. Here, the Complainant was not the holder of the trademark “Brooks”, but rather a licensee to it.

The submitted documentary evidence of the application, however, did not demonstrate that the Complainant was such a licensee. In order to meet its burden of proof, the Complainant should have submitted the licence declaration of February 1, 2006 already with its application documents. Then it would have been possible for the validation agent to examine the application in the light of the Applicant holding a valid license from the trademark owner. Since the Complainant failed to attach a license declaration as documentary evidence to its application the validation agent could not conclude a prior right for the benefit of the Complainant. He was under no obligation to investigate about the eventuality that the Complainant was a licensee to the trademark. Section 21.2 of the Sunrise Rules makes it clear that the validation agent is only to carry out a prima facie review of the first set of documentary evidence received from the Applicant to establish whether of not a prior right exists (ADR case no. 02190 - worlee).

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 (see ADR case no. 1886 - GBG). If an applicant fails to submit all documents which show that it is the owner of a prior right the application must be rejected. Anything else would endanger a domain name registration deprived of legitimation on the applicant’s side (see ADR case no. 810 - AHOLD). Therefore, the Respondent correctly rejected the attribution of the domain name “brooks.eu” to the Complainant.

The license declaration which was presented with the complaint does not influence the decision of the Panel. The Panel agrees with the Respondent that documents which did not form part of the first set of documents submitted to the validation agent should be disregarded when assessing the validity of a decision of the Respondent (see ADR cases no.219 -Isl, no.294 - Colt). Since the ADR procedure is generally not intended to correct a domain name applicants’ mistakes, this would go far beyond the Panel’s task and power (see ADR cases no. 865 - Hi, no 1843 - Metzler). The Panel must strictly stick to the rule that documentary evidence (if wanted by the Applicant to be considered for its application) needs to be received within the 40-days period (see ADR cases no. 01943 – Metzler). The

licence declaration attached to the present complaint was not received during this 40 days period. Accordingly, the Respondent could not use this information in taking its decision.

2. domain name “brooksrunning.eu”:

Besides the fact, that (as stated above) the Complainant did not prove to be the holder or licensee to a prior right to the trademark “Brooks”, the application for the domain name “brooksrunning.eu” was correctly rejected for a further reason.

Article 10 (2) of the Regulation states that a domain name applied for during the Sunrise Period must consist of the complete name of the prior right on which the application is based. Furthermore, Section 19 (2) of the Sunrise Rules further clarifies article 10 (2) of the Regulation and states that documentary evidence must clearly depict the name for which a prior right is claimed.

The trademark which the Complainant submitted as documentary evidence for its “brooksrunning.eu” application only consists of the sign “brooks”. The domain name applied for, thus, does not exactly correspond to the claimed prior right. The application was therefore correctly rejected by the Respondent (see ADR cases no. 470 - O2, no. 713 - Huettinger, no. 1438 - Ellison).

3. first-come-first-served principle:

The order of priority set out in article 4(2) as in article 10(1) of the Commission Regulations (EC) no 874/2004 has fully been taken into account by the Registrar.

Also, Article 14 of the Commission Regulations (EC) No 874/2004 clearly states that the first application in line must be considered first by the validation agent if certain requirements are met. In effect, the validation agent concluded from documentary evidence that the Complainant was not the holder of a prior right and that is why Eurid (hereinafter, “the Respondent”) did not accept the Complainant’s application.

The first-come-first-served principle solely applies when the validation agent has accepted an application. An Application will only be accepted, if the Applicant has successfully proven to be the holder of a prior right. The conclusion derives from the 12th recital of the Regulation: "…On the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name. Allocation of that name should then take place on a first-come, first-served basis if there are two or more applicants for a domain name, each having a prior right. …". In the presented case the Complainant failed to prove a prior right. The Application was rejected and, consequently, the first-come-first- served principle cannot be invoked by the Complainant.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel does not find any breach of the Regulations or Sunrise Rules by the Respondent.

The complaint must therefore be denied.

PANELISTS

Name	**Lambert Grosskopf**

DATE OF PANEL DECISION 2006-10-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

1. The burden of proof is on the Applicant to show that he is the holder of a valid prior right or a licensee thereof.

2. Documentary evidence submitted after the 40-days deadline will not be considered by the Panel in a proceeding against the Registry as Respondent.

3. It must be prima facie verifiable from the presented documentary evidence that the applicant for a domain name is also the holder of the trade mark right to the name.

4. A domain name applied for during the Sunrise Period must exactly correspond to the complete name of the prior right on which the application is based.

5. The first-come-first-served principle solely applies where the validation agent has accepted an application because the Applicant has successfully proven to be the holder of a prior right.

6. For all the foregoing reasons, the Panel orders that the Complaint is Denied