Panel Decision for dispute CAC-ADREU-002579

Case number	CAC-ADREU-002579
Time of filing	2006-08-07 11:49:45
Domain names	24hours.eu, 4adults.eu, adres.eu, adresse.eu, adwokaci.eu, aerosvit.eu, agencje.eu, akkumulatoren.eu, akkus.eu, akty.eu, akumulatory.eu, alarmy.eu, alkohole.eu, alpy.eu, angebot.eu, angebote.eu, angielski.eu, anglia.eu, aparaty.eu, apartamenty.eu, apteki.eu, arbeiten.eu, arbeitsamt.eu, architekci.eu, archiwum.eu, armchairs.eu, armenien.eu, ateny.eu, audyt.eu, aukcja.eu, auktionen.eu, auschwitz.eu, auta.eu, autobusy.eu, autokomis.eu, autokomisy.eu, autoshop.eu, autosuche.eu, bahnen.eu, baterie.eu, bawaria.eu, beleuchtung.eu, beograd.eu, bestsex.eu, biblia.eu, biblioteka.eu, bibliothek.eu, bielizna.eu, bigbreasts.eu, biletylotnicze.eu, billigreisen.eu, biuro.eu, bizuteria.eu, blogen.eu, blondinen.eu, bramy.eu, boazeria.eu, budowa.eu, buty.eu, chemist.eu, kable.eu, kalkulatory.eu, kancelaria.eu, kasyfiskalne.eu, katalog.eu, kawa.eu, klimatyzacja.eu, klimatyzatory.eu, klub.eu, klubs.eu, kluby.eu, kobiety.eu, komorki.eu, komputery.eu, kosmetyki.eu, kupuj.eu, kwiaty.eu, lakiery.eu, lampen.eu, lampy.eu, laptopy.eu, leczenie.eu, lekarstwa.eu, lekarze.eu, leuchten.eu, licht.eu, ludzie.eu, massagen.eu, massages.eu, mazowsze.eu, medycyna.eu, mieszkania.eu, miksery.eu, modelki.eu, monitory.eu, motocykle.eu, motory.eu, motoryzacja.eu, muzyka.eu, napoje.eu, nastolatki.eu, newfashion.eu, niszczarki.eu, notebooki.eu, nudes.eu, obrazki.eu, ochrona.eu, odkurzacze.eu, oferty.eu, ogrody.eu, ogrodzenia.eu, ogrzewanie.eu, okulary.eu, optyk.eu, oswietlenie.eu, parkiet.eu, perfumeria.eu, perfumy.eu, piwo.eu, podatki.eu, pojazdy.eu, porady.eu, pornografia.eu, pornostars.eu, pralki.eu, prawo.eu, prezenty.eu, projektory.eu, promocja.eu, promocje.eu, prywatne.eu, przychodnia.eu, randki.eu, raty.eu, reklama.eu, reklamy.eu, rekreacja.eu, remonty.eu, rezerwacje.eu, rezydencja.eu, rezydencje.eu, rozrywka.eu, russland.eu, rzeczpospolita.eu, samoloty.eu, santaclaus.eu, sciaga.eu, serwer.eu, serwis.eu, sexclub.eu, silniki.eu, sklepy.eu, skutery.eu, smsy.eu, strona.eu, sukces.eu, suszarki.eu, swiatlo.eu, sympatia.eu, szpital.eu, tanielatanie.eu, tapety.eu, tatry.eu, telefony.eu, telewizory.eu, terakota.eu, tkaniny.eu, tonery.eu, torby.eu, trendy.eu, turystyka.eu, ubezpieczenia.eu, ubrania.eu, uczelnie.eu, ukraina.eu, ulubione.eu, upominki.eu, urlop.eu, uroda.eu, wagi.eu, wczasy.eu, wentylatory.eu, willa.eu, wyjazdy.eu, zabawki.eu, zdrowie.eu, zegarki.eu, zwierzaki.eu, czat.eu, chemists.eu, ciuchy.eu, couples.eu, cyfrowki.eu, czajniki.eu, czekolada.eu, delikatesy.eu, dowcipy.eu, drukarki.eu, drzwi.eu, dziennik.eu, dziewczynki.eu, dziewczyny.eu, dzwonki.eu, e-bank.eu, e-banking.eu, e-bay.eu, e-bilety.eu, e-credit.eu, e-credits.eu, e-fotos.eu, e-game.eu, e-games.eu, e-gry.eu, e-hotel.eu, e-hotels.eu, e-lawyer.eu, e-photo.eu, e-praca.eu, e-seks.eu, e-sklep.eu, e-zakupy.eu, ekspresy.eu, erotyczne.eu, farby.eu, fetysz.eu, filmy.eu, firmy.eu, gebot.eu, gebraucht.eu, ginekolog.eu, glazura.eu, golarki.eu, gotowce.eu, grunty.eu, grzejniki.eu, higiena.eu, hodinky.eu, horoskopy.eu, izrael.eu, jews.eu

Case administrator

Name	Kateřina Fáberová

Complainant

Organization / Name	Anyro & Co. sp. z o.o., Pan Paweł Długosz

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 other legal proceedings which are pending or decided and which relate to the disputed domain names.

FACTUAL BACKGROUND

This decision arises from a complaint filed by the Polish company Anyro & Co. sp. zo. o. ("the Complainant"), against the decision by EURid ("the Respondent"), to reject the application for the following domain names (“the disputed domain name”) filed by the Complainant:

24HOURS, 4ADULTS, ADRES, ADRESSE, ADWOKACI, AEROSVIT, AGENCJE, AKKUMULATOREN, AKKUS, AKTY, AKUMULATORY, ALARMY, ALKOHOLE, ALPY, ANGEBOT, ANGEBOTE, ANGIELSKI, ANGLIA, APARATY, APARTAMENTY, APTEKI, ARBEITEN, ARBEITSAMT, ARCHITEKCI, ARCHIWUM, ARMCHAIRS, ARMENIEN, ATENY, AUDYT, AUKCJA, AUKTIONEN, AUSCHWITZ, AUTA, AUTOBUSY, AUTOKOMIS, AUTOKOMISY, AUTOSHOP, AUTOSUCHE, BAHNEN, BATERIE, BAWARIA, BELEUCHTUNG, BEOGRAD, BESTSEX, BIBLIA, BIBLIOTEKA, BIBLIOTHEK, BIELIZNA, BIGBREASTS, BILETYLOTNICZE, BILLIGREISEN, BIURO, BIZUTERIA, BLOGEN, BLONDINEN, BRAMY, BOAZERIA, BUDOWA, BUTY, CHEMIST, KABLE, KALKULATORY, KANCELARIA, KASYFISKALNE, KATALOG, KAWA, KLIMATYZACJA, KLIMATYZATORY, KLUB, KLUBS, KLUBY, KOBIETY, KOMORKI, KOMPUTERY, KOSMETYKI, KUPUJ, KWIATY, LAKIERY, LAMPEN, LAMPY, LAPTOPY, LECZENIE, LEKARSTWA, LEKARZE, LEUCHTEN, LICHT, LUDZIE, MASSAGEN, MASSAGES, MAZOWSZE, MEDYCYNA, MIESZKANIA, MIKSERY, MODELKI, MONITORY, MOTOCYKLE, MOTORY, MOTORYZACJA, MUZYKA, NAPOJE, NASTOLATKI, NEWFASHION, NISZCZARKI, NOTEBOOKI, NUDES, OBRAZKI, OCHRONA, ODKURZACZE, OFERTY, OGRODY, OGRODZENIA, OGRZEWANIE, OKULARY, OPTYK, OSWIETLENIE, PARKIET, PERFUMERIA, PERFUMY, PIWO, PODATKI, POJAZDY, PORADY, PORNOGRAFIA, PORNOSTARS, PRALKI, PRAWO, PREZENTY, PROJEKTORY, PROMOCJA, PROMOCJE, PRYWATNE, PRZYCHODNIA, RANDKI, RATY, REKLAMA, REKLAMY, REKREACJA, REMONTY, REZERWACJE, REZYDENCJA, REZYDENCJE, ROZRYWKA, RUSSLAND, RZECZPOSPOLITA, SAMOLOTY, SANTACLAUS, SCIAGA, SERWER, SERWIS, SEXCLUB, SILNIKI, SKLEPY, SKUTERY, SMSY, STRONA, SUKCES, SUSZARKI, SWIATLO, SYMPATIA, SZPITAL, TANIELATANIE, TAPETY, TATRY, TELEFONY, TELEWIZORY, TERAKOTA, TKANINY, TONERY, TORBY, TRENDY, TURYSTYKA, UBEZPIECZENIA, UBRANIA, UCZELNIE, UKRAINA, ULUBIONE, UPOMINKI, URLOP, URODA, WAGI, WCZASY, WENTYLATORY, WILLA, WYJAZDY, ZABAWKI, ZDROWIE, ZEGARKI, ZWIERZAKI, CZAT, CHEMISTS, CIUCHY, COUPLES, CYFROWKI, CZAJNIKI, CZEKOLADA, DELIKATESY, DOWCIPY, DRUKARKI, DRZWI, DZIENNIK, DZIEWCZYNKI, DZIEWCZYNY, DZWONKI, E-BANK, E-BANKING, E-BAY, E-BILETY, E-CREDIT, E-CREDITS, E-FOTOS, E-GAME, E-GAMES, E-GRY, E-HOTEL, E-HOTELS, E-LAWYER, E-PHOTO, E-PRACA, E-SEKS, E-SKLEP, E-ZAKUPY, EKSPRESY, EROTYCZNE, FARBY, FETYSZ, FILMY, FIRMY, GEBOT, GEBRAUCHT, GINEKOLOG, GLAZURA, GOLARKI, GOTOWCE, GRUNTY, GRZEJNIKI, HIGIENA, HODINKY, HOROSKOPY, IZRAEL, JEWS

The Complainant applied for the disputed Domain Names in three batches (on 02 March, 10 March and 05 April 2006) under the second part of the phased registration period.

The Respondent refused the applications on the basis that the Polish trade mark applications invoked by the Complainant could not be considered prior rights under the second part of the phased registration period.

On 04 August 2006, the Complainant filed a complaint with the Czech Arbitration Court, asking to cancel the decision of the Respondent to refuse the applications for the disputed domain names.

On 07 August 2006, the Czech Arbitration Court informed the Respondent about the complaint and requested it to disclose information and documentary evidence related to the disputed Domain Name. On 11 August 2006, the Respondent provided the requested information and evidence. On 09 August 2006, the Complainant submitted further evidence in support of its claim. According to the documents attached to the Complainant's communications of 09 August 2006, the Complainant requested the disputed domain names on the basis of prior Polish trade mark applications for identical signs.

On 15 August 2006, the ADR proceedings commenced.

On 11 October 2006, following a request for an extension of time, the Respondent filed a response to the statements and allegations made by the Complainant.

On 11 October 2006, the Czech Arbitration Court appointed Mr. André Pohlmann as sole Panelist in this matter. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence in compliance with Paragraph B5 of the ADR Rules and Paragraph B(5) of the Supplemental ADR Rules.

A. COMPLAINANT

In support of its position, the Complainant contends as follows:

1. According to Section 11(2) of the Sunrise Rules, during the second phase of the phased registration period, domain names that correspond to: (i) the types of Prior Rights listed in Section 11(1), above or (ii) other types of prior rights may be applied for by the holder of the prior right concerned. The documents attached to the applications confirm that the Complainant is the holder of trade mark rights, applied for registration at the Polish Patent Office. The documents also show that the signs are used by the applicant in trading. Both the fact of usage as well as application for registration have been certified in accordance to the requirements of Section 12(1)(i) of the Sunrise Rules by a lawyer. The referring documents proving this were attached to the applications.

2. Under Polish law, entities who have submitted a proper application for a trademark, acquire an expectative right to the trademark applied for and this right is protected under the Civil Code. It needs to be pointed out that according to the Polish Industrial Property Act (IPA), an entity that has applied for a trademark, even before its registration and receipt of a protective right, may demand the cessation of infringement of the trademark covered by the application and demand, after its registration, protection, including damages, for the period before registration, i.e. the date that a demand was made. The act of applying for registration of the trade mark creates a right on the side of applicant which allows it to act against persons infringing its applied mark. This right corresponds with Art. 153(2) IPA which states that the protective period for the sign as a trademark is considered to start at the date of application and not registration. At the same time, according to Art. 162 IPA, an application for the trademark that has not been awarded a protective right, is transferable and can be a subject of transfer, which additionally confirms that the trade mark application in the Polish Patent Office creates a right on the side of the applicant. Only in the first phase of the phased registration period rights that stemmed from trade mark applications could not be claimed. Therefore, and in light of Polish law in force, a specific trade mark application creates certain rights on the part of the Applicant, so there is a basis to request registration of a domain that includes the mark that is a subject of the correct legal trademark application. Apart from that, the Complainant has additionally provided evidence of use of the applied trade marks in trading in accordance with Section 12 of the Sunrise Rules.

3. Consequently, the decision taken by the Registry should be annulled and the disputed domain names should be registered in the name of the Complainant.

B. RESPONDENT

In its response, the Respondent makes the following observations:

1. Since the Complainant applied for the disputed domain names during the phased registration, its applications could only be accepted if the Complainant demonstrated that it was the holder of a prior right that is valid (i.e. in full force and effect) no later than on the date on which the application is received by the Registry. Trade mark applications do not constitute valid prior rights that are in full force and effect. Article 10(1) of EC Regulation No. 874/2004 clearly lists the rights that may be understood as prior rights for the purpose of the phased registration. This list is not an exhaustive list (see the words "inter alia"). As far as trade marks are concerned, however, Article 10 of the Regulation clearly provides that only registered national or community trade marks and unregistered trade marks (as far as they are protected under national law in the Member-State where they are held) may be considered as prior rights. Mere trademark applications that have not yet been registered, on the other hand, may not be considered as valid prior rights. Accordingly, Section 13(1)(ii) of the Sunrise Rules clearly states that "A trade mark application is not considered a Prior Right". This has been confirmed in a number of Panel decisions (1886 [GBG]; 2180 [LOTTERIE, IRC, NBA, SLOTMACHINES, T-SHIRT], 1275 [THUN], 1710 [EMI], 876 [FUTBOL, CHEAPTICKETS], 1612 [ACER], 1518 [VANHOUTEN], 1566 [AIRLINTICKETS, CREDITREPORT]).

2. As regards Articles 153 (2) and 162 IPA relied upon by the Complainant, those provisions cannot be interpreted as meaning that a mere trade mark application constitutes a prior right in the sense of article 10 (1) of the Regulation. Indeed, it appears clearly from Article 162 (6) IPA that no right of protection is granted to a mere trade mark application, which is defined as "an application filed with the Patent Office, for which no right of protection has yet been granted". Moreover, the other provisions of the Polish Industrial Property Act clearly provide that a trade mark application does not constitute a prior right. The Respondent refers, in particular, to Articles 121, 147, 149 and 150 IPA. In that context, it should be noted that, in view of some of the words for which the Complainant filed trade mark applications, it remains to be seen whether the registration process before the Polish Patent Office will result in the granting of registered trade mark rights to the Complainant. This uncertainty surrounding any trade mark application is exactly one reason why the European and national legislators have made clear distinctions between a registered trade mark right (which does constitute a prior right) and a mere trade mark application (which does not constitute a prior right).

3. For the above mentioned reasons, the Complainant's request to annul the Respondent's decisions and to attribute the domain names to the Complainant must be denied.

DISCUSSION AND FINDINGS

1. The Complainant’s complaint is made pursuant to Article 22(1)(b) of EC Regulation No. 874/2004, which provides that an ADR procedure may be initiated by any party where a decision taken by the Registry conflicts with this Regulation or with EC Regulation No. 733/2002. Pursuant to Article 22(11) second subparagraph of EC Regulation No. 874/2004, the sole purpose of these proceedings is accordingly to determine whether the decision taken by the Respondent was in accordance with the EC Regulation No. 874/2004 or EC Regulation No. 733/2002.

2. The relevant provisions of EC Regulation No. 874/2004 which require particular consideration are as follows:

Article 10(1): Holders of prior rights recognised 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 first paragraph: 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.

Article 14 fourth paragraph: 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 documentary evidence shall be submitted to a validation agent indicated by the Registry. 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 by this deadline, the application for the domain name shall be rejected.

3. The Complainant requested the disputed domain names during the second part of the phased registration period on the basis of identical Polish trade mark applications. It is undisputed between the parties that trade mark applications are not considered valid rights under the first part of the phased registration period. This follows from Article 12(2) third subparagraph of EC Regulation No. 874/2004 which explicitly refers to "registered national and Community trademarks". The Regulation does not give a clear answer as to whether trade mark applications can be invoked during the second part of the phased registration. The list of "prior rights" mentioned in Article 10(1) second subparagraph of the Regulation is not exhaustive, which is confirmed by the words "inter alia". However, it follows from the nature of trade mark applications that they cannot be considered as "prior rights" in the sense of Article 10(1) of the Regulation. A trade mark application does not convey the same rights to its owner as a registered trade mark. It is merely a "right in expectancy" rather than a "full right". It is true that trade mark applications may be assigned, licensed, or be the basis for an opposition against subsequent applications. However, applications do only become "full rights" if they are registered which requires at least a minimum assessment of their aptness for registration under absolute grounds for refusal by the relevant Trade Mark Office.

4. The Polish "Industrial Property Law", to which both parties have referred, draws also clear distinctions between "trade mark applications" and "trade mark registrations". According to Article 296(1) of the Polish Industrial Property Law, an infringement claim may be lodged by any person whose "right of protection" for a trade mark has been infringed. A trade mark application is characterised by the fact that "no right of protection has yet been granted" (Article 162(6) of the Industrial Property Law). According to Articles 144 to 149 of the Industrial Property Law, the grant of a "right of protection" for a trade mark depends on the decision of the Polish Patent Office. Article 149 states that granted "rights of protection" for trade marks shall be recorded in the Trade Mark Register. Only from that moment onwards, the Polish trade mark enjoys "exclusivity" in the meaning of Article 153(1) of the Industrial Property Law. As the Respondent correctly observed, there is an uncertainty surrounding trade mark applications resulting from the fact that they may eventually be refused on the basis of absolute grounds (or, where applicable, relative grounds) of refusal. Accordingly, trade mark applications are rights in expectancy which convey "certain rights" but which cannot be placed on the same footing with registered trade mark rights. In that respect, the Polish Trade Mark Law is not different from the Trade Mark Law of other EU member states.

5. Consequently, trade mark applications cannot be invoked as "prior rights" in the meaning of Article 10(1) of the Regulation during the second part of the phased registration. It is irrelevant whether the Polish trade mark applications claimed by the Complainant eventually mature to registration. Fact is that the Complainant's trade mark applications were not yet registered when requesting the disputed domain names. The decision of the Respondent to reject the applications was in line with Article 10(1), Article 14 first and fourth paragraph of EC Regulation No. 874/2004. The Complaint has to be denied.

DECISION

For the reasons given above, and in accordance with Article 22(11) second subparagraph of EC Regulation No. 874/2004, the Panel decides that

- the complaint be rejected.

PANELISTS

Name	**André Pohlmann**

DATE OF PANEL DECISION 2006-10-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

This case concerns a complaint lodged against the decision by EURid to reject 240 applications for domain names. The applications were lodged during the second part of the phased registration period and based on prior Polish trade mark applications. Trade mark applications are not "prior rights" in the meaning of Article 10(1) EC Regulation No. 874/2004 and can therefore not be claimed as basis for a domain name request during the second part of the phased registration period. Although a trade mark application conveys certain rights to its owner, it remains a "right in expectancy" and cannot be placed on an equal footing with a registered trade mark right. The decision of EURid was in line with Article 10(1), Article 14 first and fourth paragraph of EC Regulation No. 874/2004. Consequently, the Panel decided to reject the complaint.