Panel Decision for dispute CAC-ADREU-002581

Case number	**CAC-ADREU-002581**
Time of filing	**2006-08-01 10:52:12**
Domain names	**sentier-de-pays.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Federation du Club Vosgien**

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 has not been informed of nor is it aware of any other legal proceedings related to the disputed domain name

FACTUAL BACKGROUND

This decision arises from a complaint filed by the French entity Federation du Club Vosgien ("the Complainant"), against the decision by EURid ("the Respondent"), to reject the application for the domain name sentier-de-pays.eu (“the disputed domain name”) filed by the Complainant.

The Complainant applied for the disputed Domain Name on 07 December 2005 under the first part of the phased registration period.

The Respondent refused the application on the basis that the French trade mark certificate provided by the Complainant could not be rearded as sufficient documentary evidence to support a claim that the Complainant was holder of a registered trademark as required under the first part of the phased registration period.

On 27 July 2006, the Complainant filed a complaint with the Czech Arbitration Court, asking to cancel the decision of the Respondent to refuse the application for the disputed domain names. On 01 August 2006, the Czech Arbitration Court informed the EURid about the complaint and requested it to disclose information and documentary evidence related to the disputed Domain Name. After having received this information and after having made the final Complaint check the Czech Arbitration Court notified the Responsdent of the commencement of the ADR proceedings on 14 August 2006.

A response was filed on 02 October 2006 and the Panel was appointed on 04 October 2006. On 18 October 2006 both parties to the proceedings filed supplementary submissions.

A. COMPLAINANT

The Complainant has filed the original complaint together with a supplementary filing. The Complainants´ submissions can be summarized as follows:

1. On the formalities

1.1 Lack of motivation

The challenged decision of the Respondent was not in any way motivated, which prevented the Applicant (Complainant) to clearly understand the grounds on which it was based. Complainant refers to the decision in a very similar ADR case 00325 ESGE” in which the

lack of motivation led to the revocation of the decision by EURid to reject the application.

Article 22.1 of the Regulation which states that “an ADR Procedure may be initiated by any party where b) a decision taken by the registry conflicts with this Regulation… “.

Respondent asserts that the decision itself must conflict with the Rules, not the alleged lack of motivation of the decision, but Complainant holds the view that it is necessary to have knowledge of the motivation of the Respondent’s decision to determine whether it may conflict with the Regulations.

1.2 Late filing of response

Complainant further claims that the response was filed latelyand that the Panel should therefore consider the Respondent in default.

In a non standard communication dated August 9, 2006, the Court and the Complainant were notified of EURid’s reply to the request for verification concerning the present case. At that time, EURid as the Respondent was informed of the Complaint and confirmed that EURid was the Respondent in the present case.

On August 14th, 2006 the Court notified the parties with the commencement of the ADR Proceeding. In point 4. the formal date of the commencement of the ADR Proceeding was August 14, 2006. On the point 5. named “Deadlines” the Court states that “within 30 working dates from the delivery of this notification, the Respondent must submit to the Court a response according to the requirements that are described in ADR Rules (Paragraph B3)”.

In its response, the Respondent states that the date of receipt of the Complainant was August 14, 2006, which is in accordance with the official notification of commencement. 30 working days deadline from August 14, 2006 is September 22, 2006 or at least September 25, 2006.

However, the response was filed by the Respondent on October 2nd, 2006. Therefore, the Complainant claims that the response was not filed timely and therefore should not be considered by the Panel.

2. On the substance

The Fédération du Club Vosgien (hereafter the Complainant) is a French Association founded on October 1872, state-approved since December 1879, gathering together 110 associations in the east of France, promoting rambling, mountain hiking and generally any nature activity.

On December 7th, 2005 the Complainant filed applications to get several domain names registered, on the basis of its trademarks CLUB VOSGIEN and SENTIER DE PAYS including the disputed domain name SENTIER-DE-PAYS.EU.

The application ranked first and the Complainant filed documentation to prove its prior right to the validation agent within the 40 days allocated time frame, namely on 12 January 2006.

On July 5th, 2006 the Complainant was notified by EURid (hereafter the Respondent) that its application for SENTIER-DE-PAYS.EU was rejected due to a lack of documentation.

The disputed domain name is based on a French registered trade mark SENTIER DE PAYS and stylized holly leaf device n° 05 3 371 497 dated July 21, 2005, i.e. ante December 7th 2005, as requested in article 13 § 1 ii) of the Sunrise Rules.

The trade mark is registered before a European Union Member State Intellectual Property Office, i.e. French INPI, as requested in article 13 §1 i) of the Sunrise Rules.

As stated in article 13 § 2 i) of the Sunrise rules, the documentation filed in support of the application for the disputed domain name enclosed a copy of the official certificate of registration for the trade mark SENTIER DE PAYS, delivered by INPI.

In the forwarded document there is a reference to the date of publication of the trademark registration in the French Official Gazette dated December 23, 2005.

However, the date of publication is a non-formal step of the trademark registration. It does not mean that the owner of the trademark was not notified of the registration before the registration is published in the French Gazette. The owner of the trademark is frequently notified of the registration well before the trademark is published in the French Gazette.

The formal date is the date from which the right is effective i.e. the date of filing, in that case July 21, 2005, as soon as the trademark is registered.

The Complainant further draws the attention to the fact that the same supporting documentation allowed the registration of the domain name SENTIERDEPAYS.EU and the Complainant asserts that this decision was correct and the one that the Complainant is challenging in the present case is contrary to the Regulation and the Rules.

B. RESPONDENT

EURid filed a formal response which has been supplemented by an additional filing by the Czech Arbitration Court. The response(s) can be summarized as follows:

1 On the formalities

1.1 Lack of motivation

The Complainant requests that the Respondent's decision be annulled as it is insufficiently motivated.

Although the Regulation provides for certain rules that must be applied by the validation agent in the application procedure, the Regulation does not contain any provision that would required the Respondent to provide a fully motivated decision. Notwithstanding, the Respondent, by way of good practice, always sends an e-mail to the applicant in which the Respondent explains why an application was rejected. In case an applicant wishes more information, the Respondent's helpdesk assist him with any further queries.

Article 22 (1) b of the Regulation states that ADR proceedings may be initiated "where a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002". The decision itself must conflict with the rules, not the alleged lack of motivation of the decision. The present ADR proceedings must thus deal with the merits of the Respondent's decision as also stated in ADR case 1614 TELENET.

The Complainant cites Case No. 00325 ESGE in support of its position. In that case, the Respondent rejected a domain name application on the basis that the Complainant had not proved that the claimed prior right had been renewed. The ESGE case should however be distinguished from the present case in that the Respondent's belated filing of its explanatory arguments in the ESGE case –as well as Complainant's counterarguments- were declared inadmissible by the Panel. In the present case, however, the Respondent filed timely arguments and provided the specific reasons for the rejection; and the Complainant was allowed, at its own request, an opportunity to refute them".
Furthermore, the Respondent notes that the present cases relates more to the case 1614 (TELENET) than to the case 0325 (ESGE) cited by the Complainant. Indeed, in the case 325 (ESGE), the Respondent did not submit a response to the Complainant's arguments which is the determinative element that lead the Panel to consider the argument of lack of motivation. However in this case, such as in the case 1614 (TELENET), the Respondent clearly explained the grounds for its decision.

1.2 Late filing of response

Under Paragraph B 2(a) of the ADR Rules, the Czech Arbitration Court shall forward the Complaint, if administratively compliant, to the Respondent in the manner prescribed by Paragraph A2(a).

Paragraph A 2(a) states that it is the responsibility of the Czech Arbitration Court to employ reasonably available means so as notify the Respondent (i.e., serve actual notice). Paragraph A 2 (b) provides for which ways the Czech Arbitration Court shall discharge its obligation to achieve actual notice to the Respondent:

A 2 (b) (i) by sending the Complaint, or a notice with information on how to access the Complaint (e.g. for the purposes of an on-line platform operated by the Czech Arbitration Court), to the Respondent employing the means stipulated in (c), below, to the Registry’s seat (hereinafter referred to as EURid);
A 2 (b) (ii) in case the Respondent does not confirm receiving the electronic communication made pursuant to (i) above within five (5) days from sending the communication, then it is to forward the Complaint by registered postal or courier service, postage pre-paid, and

return receipt requested.

Paragraph A 2 (e) then provides: Except as otherwise provided in these ADR Rules, all communication provided for under the ADR Rules shall be deemed to have been received, in accordance with this provision: A 2 (e) (3) if by registered postal or courier service, on the date marked on the receipt, or, if it is not possible to deliver the communication in this way, on the expiry of twelve (12) days from the hand over of the communication to a postal or courier service provider.

The Respondent is obliged, under the Paragraph B 3 (a), to submit the Response within thirty (30) working days of the date of delivery of the Complaint, in accordance with Paragraph A 2 (b).

As flows from the above-stated provisions, if the Respondent failed to confirm the electronic communication made pursuant to A 2 (b) (i) within five (5) days, the Czech Arbitration Court forwards the Complaint by registered postal or courier service. Provided the delivery is not possible to prove according to the date marked on the receipt (and this is quite frequently the case because the receipt is not returned to the Czech Arbitration Court at all), then the effective date of delivery for the Complaint to the Respondent is the twelfth (12th) day from the hand over of the communication (containing the Complaint) to the postal or courier service provider. The Period for submitting the Response then starts on the thirteenth day from the hand over the communication, and the total term for submitting the Response is seventeen (17) (5 + 12) days, at best, plus thirty (30) working days.

As to EURid, EURid communicates with the Czech Arbitration Court during ADR Proceedings electronically, via the on-line platform. In order to clarify the time periods for multiple Responses from EURid, the Czech Arbitration Court and EURid agreed on the following understanding of the time periods as applicable to EURid: if EURid is a Respondent, the period of thirty (30) working days for submitting the Response begins after the term of five (5) days from the date of notification of the commencement of the respective ADR Proceeding in which EURid can access the Complaint on the on-line platform, as any other Respondent. Nevertheless, the additional period of 12 days for the assumption of delivery to EURid does not apply even if EURid does not access the Complaint on the on-line platform. This is because EURid is always aware of every Complaint because it is requested by the Czech Arbitration Court to verify the information contained in every Complaint.

As a general rule, if the termination of a term falls on a holiday, then the term does not end before the end of the next working day following the holiday.

Therefore, with respect to the case No. 2581, the period of thirty (30) working days, within which EURid is obliged to submit its Response, started on 22.8.2006 and ended on 2.10.2006. The electronic version of the Response was delivered on the on-line platform on 2.10.2006; therefore, EURid is not delinquent with respect to the submitting its Response to case No 2581.

2 On the substance

Federation du Club Vosgien (hereafter "the Complainant") applied the for the domain name SENTIER-DE-PAYS on 7 December 2005. In its application, the Applicant claimed to be the holder of prior right in the form of a registered French trademark.

On 13 January 2006, which was before the 16 January 2006 deadline, the processing agent received the documentary evidence consisting of a proof of registration of the semi-figurative French trademark "SENTIER DE PAYS".

The documentary evidence shows that trademark was applied for on 21 July 2005 (in French application is translated by "depot"). The other document is a certificate of registration from the French Industrial Property Office (INPI) stating that the trademark was registered and would be published on 23 December 2005 by the INPI. It is a fact that the certificate of registration does not mention any other date than the date on which the registration of the trademark would be published (23 December 2005).

However, the application for the domain name took place on 7 December 2005.
The validation agent concluded that the documentary evidence did not demonstrate that the French trademark relied upon by the Complainant was registered on the date of the application for the domain name.

In that context it is important to note that the burden of proof lies with the Complainant.
Article 10 (1) of the Regulation states that only the holders of prior rights shall be eligible to apply to register domain names during the period of phased registration. Pursuant to article 14 of the Regulation, the applicant must submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question.

Based on this documentary evidence, the validation agent shall examine whether the applicant has prior rights on the name. Section

21.2. of the Sunrise Rules states that "[t]he Validation Agent examines 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 (including the Documentary Evidence received electronically, where applicable) and in accordance with the provisions of these Sunrise Rules".

It is therefore of crucial importance that the validation agent is provided with all the documentary evidence necessary for it to assess if the applicant is indeed the holder of a prior right.

Article 10 clearly states that "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". Pursuant to the same provision, prior rights shall be understood to include "registered" national and community trademarks. Pursuant article 12 (2) of the Regulation, "[d]uring 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)". Pursuant to article 14 of the Regulation, "[a]ll 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 states 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 13.1.(ii) of the Sunrise Rules states that "A trade mark application is not considered a Prior Right".

It is clear from those provisions that the applicant must demonstrate that it is 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.

Article L712-1 of the French Code on Intellectual Property clearly states that the ownership of the trademark is acquired by the registration.

In the present case, the Complainant filed its application on 7 December 2005.
The documentary evidence shows that trademark was applied for on 21 July 2005 (in French application is translated by "depot"). The certificate of registration from the French Industrial Property Office (INPI) states that the trademark was registered and would be published on 23 December 2005 by the INPI. The certificate of registration does not mention when the trademark has been registered. Therefore, the certificate of registration does not clearly establish that the Complainant was the holder of a valid registered trademark at the time of the application. Since the Complainant failed to meet its burden of proof to establish that it was the holder of a valid prior right on 7 December 2005, the Respondent correctly rejected its application.

As to the Complainant arguments that the Respondent accepted another of the Complainant's registrations, where the Complainant relied upon the same documents, the Respondent wishes to stress that the only object of the ADR proceedings is to determine whether the Respondent's decision to reject the Complainant's application conflicts with the Regulation (Article 22(1) of the Regulation). The legality of the Respondent's decision may not be assessed based on previous applications dealt with by the validation agent and/or the Registry.

This is clearly stated in Section 22(4) of the Sunrise Rules, which reads as follows: “[t]he decision by the Registry to register a Domain Name in the name of an Applicant has no value as a precedent in any judicial or non-judicial settlement of conflicts proceeding […]”. This has been also clearly stated by the Panel in ADR 1711 (AIRCO, EIRCOM).

DISCUSSION AND FINDINGS

On the formalities

1. Lack of motivation

Nothing in the rules governing the phased registration period obliges EURid to state and make public any motivation in immediate connection with the decision to reject an application for a domain name filed during this period. The Panel agrees with the Complainant that it puts the domain name applicant in a rather difficult position, since it is difficult if not impossible to know whether there is a reason to challenge the decision, which again means that a complaint must be based on assumptions rather than facts. However, if the applicant files a complaint in accordance with Art 22 1 (b) of the Regulation EURid will provide the reasoning in their response and Complainant will have the opportunity to file additional observations. As in case 1614 TELENET the Panel finds that both parties have been given a fair opportunity to present their case and that the brevity of the initial notification of the decision to the Complainant has not affected its rights.

2. Late filing of response

In cases like the present one EURid acts both as Registry and Respondent. In their capacity of Registry EURid was informed of the filing of the complaint on 09 august 2006, and in their capacity of Respondent they were informed of the commencement of the ADR proceeding on 14 August 2006.

The various time limits set out in the ADR Rules also apply for EURid as Respondent, but in order to be able to administer the vast number of complaints filed against EURid, in an effective way the Czech Arbitration Court and EURid has agreed on a standard approach that is described above under B. In effect this means that if EURid is a Respondent, the period of thirty (30) working days for submitting the Response always begins after the term of five (5) days from the date of notification of the commencement of the respective ADR Proceeding. Applying this standard of calculating the relevant time limit the Response was actually filed on time.

Consequently, the Panel finds no basis for revoking the decision on this ground. The Panel notes in this context that although a Panel is not required to consider a Response filed late it has the discretion to decide to accept it according to the ADR Rules paragraph 8, and that it would have been inclined to admit the Response even if it had been filed late.

3. On the substance

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.

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 12 (2) third paragraph: During the first part of the phased registration only registered national or Community trademarks…….may be applied for as domain names….

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.

Further Section 11 (3) of the Sunrise Rules states: 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 Complainant requested the disputed domain names during the first part of the phased registration period on the basis of a French trademark. The question in this case is whether the provided certificate was sufficient proof that the applicant (Complainant) had a registered trademark at the time of the filing of the application for the rejected domain name.

The furnished evidence is entitled "CERTIFICAT D´ENREGISTREMENT". The document itself has no date stamp. The document merely refers to the fact that the registration ("cet enregistrement") will be published in the official bulletin on 23 December 2005.

According to the provision of chapter II of Book VII of the French Intellectual Property Code there is a distinction between “application for registration” and “registration”.

In L.712-2 it is thus stated that “applications for registration” shall be published. In 712-3 it is said that during a period of two months from the date of this publication any concerned person may submit observations on the application to INPI, just as oppositions may be filed during this period in accordance with L. 712-4. In L. 712-7 it is stated that “an application for registration shall be rejected” if the specific requirements that are referred to are have not been met, which in (c) includes “if opposition to the application … is upheld”.

Despite the wording of the provided certificate the wording of the French Code indicates that the application for a registration of a trademark is to be regarded as an application at least until the date of publication. The fact that - if a mark is registered - not only has effect from the date of application cf. L.712-1 second paragraph but also gets the application date as registration date does not alter this assessment.

The Panel notes that the Complainant has contested that the date of publication is the relevant date and Complainant has inter alia referred to the fact that the owner of the trademark is actually notified of the publication of the registration before the actual publication. However, the Complainant has not put forward information on what date the certificate was issued by INPI and/or received by the applicant nor provided any information on what legal relevance this notification may have for the purpose of determining whether the applied trademark is registered.

The Panel further notes that it shall take a decision in the present case and based on the facts and arguments presented before it. Respondent appears to have made a contradictory decision based on the same documentary evidence in the Complainants application for sentierdepays.eu, and although it is quite understandable that Complainant refers to this fact Section 22(4) of the Sunrise Rules nevertheless clearly says that such decision do not have legal precedence.

Consequently, the Panel finds that the Complainant has not furnished the documentary evidence that is necessary to support the claim that Complainant - at the date of filing of the contested domain name -was the holder of a trade mark registration. The decision of the Respondent to reject the application was thus in compliance with Article 10(1), Article 14 first and fourth paragraph of EC Regulation No. 874/2004.

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	**Knud Wallberg**

DATE OF PANEL DECISION 2006-11-01

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The initial complaint contested the rejection of the Complainants application based on the arguments that the rejection was not motivated and that the Complainant was entitled to be granted the domain name since it fulflled all the eligibility requirements and had met all requirements for supplying documentary evidence of its rights. In its supplementary filing the Complainant further claimed that the response was filed late and therefore should be disregarded by the Panel.

As to the lack of motivation of the initial rejection of the application by EURid the Panel found Nothing in the rules governing the phased registration period obliges EURid to state and make public any motivation in immediate connection with the decision to reject an application for a domain name filed during this period. If the applicant files a complaint in accordance with Art 22 1 (b) of the Regulation EURid will provide the reasoning in their response and Complainant will have the opportunity to file additional observations. Since both parties are given a fair opportunity to present their case under the ADR procedure the lack of motivation can not in itself lead to a revocation of the decision.

On the question of the timely filing of the Response the Panel cannot follow the Complainants claims. The Panel finds that the explanation given by the Czech Arbitration Court on how the time limits are calculated in cases like the present one is in accordance with

the ADR Rules and that the time limits have been met in the concrete case.

On the substantive part of the complaint the Panel finds that the Complainant did not submit the necessary evidendce to support its claim that Complainant on the date of application of the contested domain name was the proprietor of a registered trade mark. The fact that the Respondent had accepted another sunrise application from the Complainant based on the same documentary evidence did not bind the Panel.