Panel Decision for dispute CAC-ADREU-002600

Case number	**CAC-ADREU-002600**
Time of filing	**2006-08-15 13:25:09**
Domain names	**clk.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Česká lékařská komora**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

On January 24, 2006 the Complainant applied for the domain name CLK. The national trademark “CAMERA MEDICA BOHEMICA CESKA LEKARSKA KOMORA” registered in the name of the Complainant was the “prior right” upon which the application for the domain mane clk.eu was based following the Complainant´s application and its documentary evidence received by the processing agent “PriceWaterHouseCoopers”.

The Respondent rejected the application for the domain name clk.eu because the domain name CLK does not corresponds to the complete name “CAMERA MEDICA BOHEMICA CESKA LEKARSKA KOMORA”.

The Applicant filed a complaint against the Respondent on August 15, 2006, and thus he became Complainant. The Respondent filed a response to the Complainant which was received by the Czech Arbitration Court on October 17, 2006. The Czech Arbitration Court appointed the undersigned herewith as a Panelist on October 19, 2006.

A. COMPLAINANT

1. Česká lékařská komora (Czech Medical Chamber) is a “public body”, which acts under the above statutory name or its acronym (ČLK) in all cases both towards third parties or identification inside the organization and according article 10§1 of the Commission Regulation (EC) 874/2004 of 28 April 2004 may register its acronym ČLK as domain name during the phased registration.
2. The registration of the domain name “clk.eu” and not “člk.eu” has been applied for because the domain names do not recognize any punctuation.
3. “ ..the Respondent erred in respect of the actual name of the Complainant, when 1) the Respondent considered the name in the registered trademark as identical with the actual or legal and generally used name for the Complainant and 2) in respect of the grounds of the application since the Complainant applied for the registration of the domain name as a public body (which the Complainant considered as a generally known fact) and not only as a holder of the trademark. This error had then a fundamental impact on the decision as such”

B. RESPONDENT

1. Applicants have three different options when applying for a domain name during the first part of a phased registration. They may rely on a prior right consisting of a) a registered national or Community trademark, b) a geographical indication, and c) a name referred to in article 10§3 of the Regulation(EC) 874/2004 (hereafter “a Public Body name”). The Complainant decided to rely on his prior right consisting of a Czech registered trademark according to his application and the documentary evidence submitted by him. The Complainant did not submit his application as a holder of a Public Body name or even the acronym which is “CLK”. Therefore, the Validation Agent of the “prior right” was PricewaterhouseCoopers.
2. The domain name clk.eu does not consist of the complete name for which the prior right exists. As it is stated in the application of the Complainant, his prior right upon which it relies was the name “CAMERA MEDICA BOHEMICA CESKA LEKARSKA KOMORA” and therefore the prior right in question could only serve as a prior right for the domain name “CAMERAMEDICABOHEMICACESKALEKARSKSKOMORA” and not for the domain name clk.eu. Similar cases are case 470(O2), case 1053 (SANTOS), case 1438 (ELLISON), case 713 (HUETTINGER), and case 1427 (bonollo).
3. As it is clearly stated in case 1194 (insuresupermarket), the ADR procedure does not intend to correct domain name Applicants’ mistakes. Relevant decisions are these on case 551(VIVENDi) and on case 810 (AHOLD).
4. The Registry’s decision to reject the Complainant´s application does not conflict with the Regulation since the right on trademark “CAMERA MEDICA BOHEMICA CESKA LEKARSKA KOMORA” of the Complainant could not serve as a prior right for the domain name applied for.

DISCUSSION AND FINDINGS

1. According to article 10§1, (2 and 3) of Regulation (EC) 874/2004, “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 names. ‘Prior rights’ shall be understood to include, inter alia, registered national and community trademarks...The registration by a public body may consist of the complete name of the public body or the acronym that is generally used. Public bodies that are responsible for governing a particular geographic territory may also register the complete name of the territory for which they are also responsible and the name under which the territory is commonly known. ” The Sunrise Period ran from December 7, 2005 to April 7, 2006.
2. According to article 12§2 of Regulation (EC) 874/2004, applications for .eu domain names submitted during the first stage of the Sunrise Period may only be based to (a) registered trademarks (b) geographical indications and (c) names and acronyms of public bodies. Said applications may be accepted provided that there is sounding evidence on prior rights for the applied domain name.
3. According to article 13 of the Regulation (EC) 874/2004, “….The Registry shall select the validation agents in an objective, transparent and non-discriminatory manner, ensuring the widest possible geographical diversity. The Registry shall require the validation agent to execute the validation in an objective, transparent and non discriminatory manner. Member states shall provide for validation concerning the names mentioned in article 10§3. To that end, the Member States shall send to the Commission within two months following entry into force of this Regulation, a clear indication of the addresses to which documentary evidence is to be sent for verification. The Commission shall notify the Registry of theses addresses. The Registry shall publish information about the validation agents in its website”.
4. Following the announcements of the Respondent as Registry in its website: a) On March 22, 2005, the Respondent / Registry signed an agreement with PricewatershouseCoopers, which undertook the role to validate the documentary evidence to be provided by domain name Applicants during the Sunrise Period. b) Regarding names mentioned in article 10§3 as Government Validation Agent of the Czech Republic is mentioned the “GVP Team, Ministry of Informatics” which follows the validation rules published in the same website.
5. According to article 14§4 of the Regulation (EC) 874/2004, “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.”
6. According to article 10§1 and 14 of the Regulation (EC) 874/2004, the burden of proof of prior right remains on the Applicant/Complainant to substantiate who is the claimed holder of a prior right [cases 294(COLT), 551(VIVENDI), 984(Isabella), 843(starfish), and 1886(GBG)].
7. According to article 22§1(b) of the Regulation (EC) 874/2004, new documents submitted by a Complainant may not be taken into consideration by the Panel stating that a decision taken by the Respondent may only be annulled when it conflicts with the applicable rule and regulations [relevant cases are case 551(VIVENDI), case 810(AHOLD), case 1194 (INSURESUPERMARKET), case 294(COLT), case 954(GMP), case 01549(EPAGES), and case 1422(PORTAS)].

8. Following section 13§2(i) and (ii) of the Sunrise Rules for a registered trademark it is sufficient to submit the following documentary evidence: “(i) a copy of an official document issued by the competent trademark office indicating that the trademark is registered (certificate of registration etc.) or (ii) an extract from an official online database operated and/or managed by the relevant national trademark office, the Benelux Trademarks Office, the OHIM or the WIPO. Extracts from commercial databases are not acceptable even if they reproduce exactly the same information as the official extracts.” Also, “In the foregoing cases the Documentary Evidence must clearly evidence that the Applicant is the reported owner of the registered trademark.”
9. According to Section 19§§1 and 2 of the Sunrise Rules, “Registration of a domain name on the basis of a Prior Right consists in the registration of the complete name for which the Prior Right exists as manifested by the Documentary Evidence. It is not possible for an Applicant to obtain registration of a Domain Name comprising part of the complete name for which the Prior Right exists. Documentary Evidence must clearly depict the name for which a Prior Right is claimed. A Prior Right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos etc) will only be accepted if (i) the sign exclusively contains a name, or (ii) the word element is predominant, and can be clearly separated or distinguished from the device element, provided that (a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the Domain Name applied for, in the same order as that in which they appear in the sign…”
10. According to article 10§§1, 2 and 3 and article 12§2 of Regulation (EC) 874/2004, the Complainant filed an application for the domain name clk.eu on January 24, 2006, i.e. during the first stage of the Sunrise Period which ran from December 7, 2006, to April 7, 2006, and during which applications for .eu domain names may only be based to (a) registered trademarks (b) geographical indications and (c) names and acronyms of public bodies.
11. According to article 10§1 and article 14 of the Regulation (EC) 874/2004, the burden of proof of prior right remains to the Complainant/Applicant to substantiate who is the claimed holder of a prior right. Even if the Complainant alleges that the Respondent erred, among others “in respect of the grounds of the application” since the Complainant applied for the registration of the domain name as a public body (which the Complainant considered as a general known fact) and not only as a holder of the trademark, the Complainant does not provide the Czech Arbitration Court with any pieces of evidence regarding the filing of an application for registration of .eu domain name based on his name or acronym as public body. The allegation of the Complainant according to which the Complainant should consider as a generally known fact the registration of the domain name as a public body is out of importance since according to the whole procedure described in the Regulation (EC) 874/2005 and especially article 10§§1, 2 and 3, article 12§2, and article 13 and in the spirit of the same Regulation, the Respondent examines the application filed during the first stage of the Sunrise Period according to the right on which it is based following article 12§2 of the Regulation. If the Complainant wished to register the domain name clk.eu based on its right on its name or acronym as a Public Body it should have filed an application based on its right on its name or acronym as a Public Body and not an application based in its right on the trademark “CAMERA MEDICA BOHEMICA CESKA LEKARSKA.” In this case and according to article 13 of the Regulation (EC) 874/2004 and the announcements of the Respondent on its website, the validation agent of his “prior right” should be the Government Validation Point indicated by the Czech Republic and not the PricewatershouseCoopers which is the validation point for prior rights based on trademarks.
12. According to article 22§1(b) of the Regulation (EC) 874/2004 and the content of its application for registration of the trademark clk.eu, which, according to the allegation of the Respondent, was relied on prior right consisting of the Czech Registered trademark “CAMERA MEDICA BOHEMICA CESKA LEKARSKA KOMORA”, the subject of this case is restricted to the examination of the decision of the Respondent taking into consideration that the Complainant filed an application for the registration of the domain name clk.eu based on said registered trademark.
13. According to article 13§2(i) and (ii) and article 19§§1 and 2 of the Sunrise Rules, the complete name for which the prior right exists is the name “CAMERA MEDICA BOHEMICA CESKA LEKARSKA KOMORA” and not the word CLK. Therefore only the registration of the domain name “CAMERAMEDICABOHEMICACESKALEKARSKAKOMORA” and not the registration of the domain name clk.eu should have been accepted by the Registry. .

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	**Alexandra Kaponi**

DATE OF PANEL DECISION 2006-11-16

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed a complaint against the Respondent regarding the rejection of his application for the registration of the domain name clk.eu during the Sunrise Period. According to the allegations of the Complainant, the domain name clk.eu should not have been rejected because “1) the Respondent considered the name in the registered trademark as identical with the actual or legal and generally used name of the Complainant and 2) in respect of the grounds of the application since the Complainant applied for the registration of the domain name as a public body (which the Complainant considered as a generally known fact) and not only as a holder of the trademark.” That decision which denies the registration of the domain name clk.eu is taken pursuant to the Regulations (EC) 874/20004 and (EC) 733/2002 and in consideration of the following premises:

1. The burden of proof to substantiate who is the claimed holder of a prior right remains to the Applicant/Complainant.
2. The Complainant did not provide the Czech Arbitration Court with any pieces of evidence regarding the filing of an application during the Sunrise Period as a public body.
3. The Complainant applied for the registration of the domain name clk.eu during the first phase of the Sunrise period and his prior right was based on his trademark “CAMERAMEDICABOHEMICACESKALEKARSKAKOMORA”. According to article 13§2(i) and (ii), and article 19§§1 and 2 of the Sunrise Rules the complete name for which the prior right exists was the name “CAMERA MEDICA BOHEMICA CESKA LEKARSKA KOMORA” and, therefore, the prior right on it could serve as prior right for the domain name “CAMERAMEDICABOHEMICACESKALEKARSKAKOMORA” and not for the domain name clk.eu.

In consideration of the above, the Respondent lawfully rejected the application for the registration of the domain name clk.eu and according to article 10§§1, 2 and 3, article 12§2, article 13, article 14, article 22§1(b) of the Regulation (EC) 874/2004 and article 13§2(i) and (ii) and article 19§§1 and 2 of the Sunrise Rules.