Panel Decision for dispute CAC-ADREU-002637

Case number	CAC-ADREU-002637
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Domain names	swiss.eu

Case administrator

Name	Josef Herian

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

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant in these proceedings is 'Anyro & Co. sp. z.o.o.' ('Anyro) and the Respondent is EURid.

On 29 April 2003, Anyro applied for trademark registration for the word 'SWISS' before the Polish Patent Office. Subsequently, the Complainant submitted an application for registration of swiss.eu (the 'Application') on 7 December 2005.

The Polish Patent Office reached a decision on 9 January 2006 granting a protective right to the SWISS trademark ('the Trademark'), although the decision was not delivered to the Complainant until 10 January 2006.

The processing agency received the documentary evidence relating to the Application on 10 January 2006, before the deadline of 16 January 2006, consisting of an application for the Polish trademark SWISS. No documents were submitted to show that Anyro was the holder of a registration for the Trademark.

Based on the documentary evidence received, the validation agent found that Anyro did not demonstrate that it had a prior right within the meaning of Article 10 (1) of Commission Regulation No. 874/2004 ('Regulation 874').

The Complaint was filed by email on 4 August 2006 (hardcopy on 15 August 2006) and notified to the Respondent on 18 August 2006, enclosing: (i) a certificate from the Polish Patent Office of 20 July 2006 (attachment no. 1); (ii) two pictures of a 'SWISS' store, owned by the Complainant (attachments no. 2 and 3); (iii) a printout of the website http://www.swiss.com.pl (attachment no. 4); and (iv) a printout from the website of the Polish Patent Office (attachment no. 5). The Complainant seeks the annulment of the Registrar's decision and the transfer of rights to the SWISS domain name to Anyro.

The Respondent submitted its Response to the statements and allegations made in the Complaint on 3 October 2006. On 6 October 2006, Dr. David J. A. Cairns was appointed as single panellist, and the file was transmitted to the Panel on 9 October 2006.

A. COMPLAINANT

The Complainant states that it has protective rights to the Trademark with priority from 29 April 2003, as a result of the decision of the Polish Patent Office of 9 January 2006 granting registration of the Trademark. The Complainant argues that although the Trademark had not been registered at the time of the Application, the subsequent registration on 9 January 2006 has retroactive effects to the date the

Application was filed.

The Complainant argues that Regulation 874 "…does not require for a domain name applicant to file a trademark certificate from the relevant national patent office at the time of the application but only requires 'a reference to the legal basis in national or Community law for the right to the name'…." The Complainant contends that no further requirement may be imposed under the '.eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period' ('the Sunrise Rules'). The Panel is therefore required to decide on the basis of Regulation 874 and Regulation (EC) No. 733/2002.

The Complainant further contends that the documents submitted with the Application and the decision of the Polish Patent Office of 9 January 2006 –submitted with the Complaint– prove "…that the applicant's prior right to the 'Swiss' mark exists…" and that Anyro had a prior right, protected under Regulation 874 as from the date of the filing of the application for the registration of the Trademark, and therefore also at the time of the Application.

The Complainant states that "in refusing a registration for the swiss.eu application, the Registry is abusing the applicant's rights under Community and national law" by modifying Regulation 874's provisions regarding documentary evidence by refusing to recognise a trademark application as evidence of a prior right where a certificate of registration (through no fault of the Complainant) is not available. "In ADR proceedings, it must be accepted as fact that a prior right existed as of the date of the domain application, otherwise Regulation 874 (recognizing prior rights) and national law (granting prior rights on the mark application date) will be contravened."

Accordingly, the Complainant seeks the "…annulment of the Registrar's decision on not registering the SWISS domain in the name of Anyro & Co. Ltd. and for transferring the rights to the SWISS domain to Anyro & Co. Ltd."

B. RESPONDENT

The Respondent argues that the Application was rejected because the documentary evidence submitted by the Complainant did not demonstrate that the Complainant was the holder of a prior right. The Respondent's Response is grounded on the Regulations and the provisions of the Sunrise Rules.

Article 10 (1) of Regulation 874 states that "…holders of prior rights recognized 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 name starts…." In addition, the Sunrise Rules apply to the present case and are not in conflict with Regulation 874 when they state that "…the Applicant must be the holder …of the Prior Right claimed no later than the date on which the Application is received by the Registry …which means that it must be in full force and effect…" (Section 11.3 of the Sunrise Rules) and "…a trademark application is not considered a Prior Right…" (Section 13.1 (ii) of the Sunrise Rules). The Respondent argues that Articles 10 (1) and 14 of Regulation 874, require the applicant "…to demonstrate that is the holder of a prior right that is valid (i.e. in full force and effect) no later than the date on which the application is received by the Registry."

Therefore, contrary to the Complainant's assertions, both Regulation 874 and the Sunrise Rules provide that only registered trademarks may be taken into account by the Respondent when assessing a domain name application.

The Respondent states that "…the Complainant was not the holder of a registered trademark in the sign SWISS…" at the time of the Application. The Complainant acknowledges that "…the trademark was registered on 10 January 2006, whereas the Complainant applied for the domain name on 7 December 2005." At the time of the Application the Complainant was not a holder of a prior right, but only a trademark applicant. As validation is 'snap-shot' view of the moment of application, "…the Complainant was not eligible to apply for a domain name based on its trademark application on 7 December 2005."

For all these reasons, the Respondent requests that the Complaint be rejected.

DISCUSSION AND FINDINGS

Regulation 874 establishes a phased registration procedure for .eu Top Level Domain Names. Registration is based on validation of rights, performed by appointed validation agents. Under Article 10 (1) of Regulation 874, only holders of prior rights recognised or established by national and/or Community law –or authorized parties– and public bodies are eligible for phased registration.

Pursuant to Article 22.11 of Regulation 874, the Panel shall decide whether a decision taken by the Registry conflicts with the Regulation 874 or Regulation (EC) No. 733/2002. It follows that the Panel shall make its decision exclusively on the basis of whether it has been demonstrated the the decision of the Registry conflicts with one or other of these regulations (see cases 1047 – Festool and 1674 – Ebags).

The second paragraph of Article 10 (1) of Regulation 874 provides that 'prior rights' include "…registered national and community trademarks … 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." Therefore, unregistered trademarks may constitute prior rights within the meaning of this provision if "…protected under national law in the Member-State…." The burden of proof is on the applicant (the Complainant) to submit with the application all the "…evidence that shows that he or she is the holder of the prior right claimed on the name in question…." (Article 14 of Regulation 874).

The Complainant states that the Application of 7 December 2005 was made on a basis of the application for the registration of the Trademark of 29 April 2003. According to the Complaint, the Polish Patent Office communicated the registration of the mark to the Complainant on 10 January 2006, after the Complainant had already submitted all the Application's documentary evidence to the processing agency. Therefore, the Application included as evidence only an application for a trademark registration, but no certificate of registration, nor any evidence that the unregistered 'SWISS' sign was entitled to protection under Polish law on the basis of either the application for the trademark registration, or on some other basis.

The Panel considers that the decision of the Respondent does not conflict with Regulation 874 or Regulation (EC) No. 733/2002. The Application demonstrated neither a prior right based on a registered trademark, nor protection of the unregistered trademark under Polish law. The Respondent therefore concluded that the Complainant did not demonstrate that it had a prior right within the meaning of Article 10(1) of Regulation 874.

The Complainant however relies on the retroactive effect in Polish law of its trademark registration. The Complainant alleges and the Panel is prepared to accept that under Polish law the effect of the registration is retroactive to 29 April 2003, and on this basis the Complainant alleges a prior right as at the date of the Application. The Complainant states that as the prior right existed at the date of the Application, the Respondent's decision to reject the application conflicts with Regulation 874.

Article 10(1) of Regulation 874 states that the holder of a prior right "shall be eligible to apply to register" a domain name. Article 14, first paragraph states that the claim to a prior right "must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists." The point is not whether the Complainant had a prior right in Polish law at the date of the Application, but whether it demonstrated the right at the prescribed time in accordance with Article 14.

In the present case, the Respondent did not submit the registration certificate to the validation agent, because at the time of its submission of the documentary evidence it did not have the registration certificate. Nor did it demonstrate to the validation agent that a trademark application might constitute prior rights in Polish law. On this basis the validation agent and the Respondent properly rejected the application.

There remains the question of whether this Panel can take into consideration the new documents included with the Complaint, which include the certificate of trademark registration. The certificate demonstrates that the Trademark was registered before the deadline of 16 January 2006 to submit all the Application's supporting documentation.

The Panel considers that these new documents may not be taken into consideration to evaluate the Respondent's decision. In case no. 02087 – Plextor, the Panel stressed that even if new documents submitted by the Complainant were to adequately demonstrate that it is the holder of the trademark, these new documents may not be considered in order to decide whether the Respondent's decision conforms to the applicable Regulations (See also case no. 1627 – Planetinternet). An applicant cannot use ADR proceedings in order to amend or perfect a Sunrise application that was properly rejected (See Case no. 551 – Vivendi).

From the Complainant's perspective, it was unfortunate that the registration of the Trademark did not occur sooner, so that the certificate confirming the registration could have been included with its documentary evidence. It may or may not also be true that Regulation 874 and the Sunrise Rules do not adequately address the situation of pending trademark applications. in any event, the result is the rejection of an application that has subsequently -but only subsequently- proved to be based on firm grounds.

Having reviewed the documentary evidence supplied by the Complainant, and having considered all other documents in the case file in this Complaint, this Panel finds that the Respondent's decision to reject the Complainant's application for the disputed domain name "swiss.eu" was correct, and that it was not in conflict with the applicable Regulations.

DECISION

For all the foregoing reasons, in accordance with paragraph B12 (b) and (c) of the Rules, the Panel orders that the Complaint is denied.

PANELISTS

Name	David Cairns

DATE OF PANEL DECISION 2006-11-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

An Application during the Sunrise period was rejected by the Registry on the basis that the documentary evidence submitted with the application –a trademark application– did not substantiate a prior right. The trademark application was, however, subsequently granted.

The Complainant in this proceeding relied on the retroactive effect in Polish law of its trademark registration. The Complainant alleged and the Panel accepted that under Polish law the effect of the registration is retroactive to 29 April 2003, and therefore a prior right existed as at the date of the Application. The Complainant asserted that as the prior right existed at the date of the Application, the Respondent's decision to reject the application conflicts with Regulation 874.

Article 10(1) of Regulation 874 states that the holder of a prior right "shall be eligible to apply to register" a domain name. Article 14, first paragraph states that the claim to a prior right "must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists." The point is not whether the Complainant had a prior right in Polish law at the date of the Application, but whether it demonstrated the right at the prescribed time in accordance with Article 14.

In the present case, the Respondent did not submit the registration certificate to the validation agent, because at the time of its submission of the supporting documentation it did not have the registration certificate. Nor did it demonstrate to the validation agent that a trademark application might constitute prior rights in Polish law. On this basis the validation agent and the Respondent properly rejected the application.