Panel Decision for dispute CAC-ADREU-002756

Case number	**CAC-ADREU-002756**
Time of filing	**2006-08-11 12:40:23**
Domain names	**tecno-center.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Dr Massimo Introvigne**

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

FACTUAL BACKGROUND

On January 24, 2006 i.e. during the sunrise period the Italian company Tecno Center s.r.l. filed through the Italian Registrar Dominiando Srl the domain name TECHNO CENTER claiming a prior right on an Italian trademark in the name of Techno Center in 2003.

On January 24, 2006 Tecno Center S.r.l. sent to the designed validation agent Price Waterhouse Coopers – Belgium as requested a document aiming to evidence the prior trademark right claimed in its request. The said document written in Italian mentioned the existence of an Italian trademark as the basis of the domain name application. To this document was attached a copy of an extract of the German trademark registration for Tecno Center No. 303 57 629 dated April 19, 2004.

Considering that the said document did not substantiate the prior trademark right claimed in the domain name request, EURID rejected the application.

In view of this refusal, Dr Massimo Introvigne acting on behalf of Tecno Center S.r.l. (the defendant) filed by the Czech Arbitration Court a complaint against EURID.

The considered time of filing is 2006.08.11.

EURID (the respondent) submitted its response to the Czech Arbitration Court on 2006.10.09.

A. COMPLAINANT

The Complainant has expressed the following:

- Tecno Center S.r.l. is using the trademark and the trade name TECHNO CENTER since 1990;

- Trademark TECNO CENTER is registered in Germany and applied for in Italy in 2003., the registration being not yet granted due to the of slow process of registration in Italy. Thus, according to the complainant, the right conferred by this application is substantially the same than the right deriving from a registration;

- The copies of the certificates sent by TECNO CENTER to the Italian registrar Dominiando Srl by Tecno Center as well as the right on its trade name should have been considered as sufficient by the validation agent to substantiate the claimed prior right;

- In case of technical mistake made by the Italian Registrar, it should be possible for the Complainant to cure at the stage of the ADR proceeding, taking into consideration besides that there are no other applicants for Tecno-Center.eu which may be damaged by a decision in favours of the complainant.

The remedies sought are the annulment of the disputed decision and its attribution to Tecno Center S.r.l.

B. RESPONDENT

In its response, the Respondent believes that it was correct in rejecting the complainant's domain name application. Indeed, Article 3 of the Sunrise Rules provides in particular that "an application is duly considered complete when the applicant provides the Registry, with a least the country in which the prior right claimed is protected, and the language in which the documentary evidence will be provided to the Validation Agent".

The Respondent insists in lengthy developments on the validity and the importance of the Sunrise Rules. Indeed, according to the Respondent, these rules were adopted in consideration of and on the basis of (EC) regulation No. 733/2002 which required from the Registry the adoption of public policy rules, were duly published on the Respondent's web site as requested by (EC) Regulation No. 874/2004, and are binding on the applicants who sign them when filing a domain name application.

Respondent further states that compliance with such rules is necessary to secure the process of registration, and making it fair with respect to the third parties the filing policy of which could be influenced by the information given by the previous domain name applicants regarding its trademarks rights.

DISCUSSION AND FINDINGS

In accordance with Article 22 of (EC) Regulation No. 874/2004, paragraph 11: "in the case of a procedure against the Registry, the ADR panel shall decide whether a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002. The ADR panel shall decide that the decision shall be annulled and may decide in appropriate cases that the domain name in question shall be transferred, revoked or attributed, provided that, where necessary, the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002 are fulfilled".

Considering the documents attached to the complaint and the arguments of the parties, the Panel considers that it has sufficient data to examine whether the Registry's decision complies with (EC) Regulation No. 874/2004.

1) The applicable law

- (EC) Regulation No. 874/2004

The following are the relevant provisions of (EC) Regulation No. 874/2004 to decide on the case at issue:

12th recital: "In order to safeguard prior rights recognised by Community or national law, a procedure for phased registration should be put in place. Phased registration should take place in two phases, with the aim of ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights. The Registry should ensure that validation of the rights is performed by appointed validation agents. 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."

Article 2 – Eligibility and general principles for registration (extract): "Without prejudice to Chapter IV, a specific domain name shall be allocated for use to the eligible party whose request has been received first by the Registry in the technically correct manner and in accordance with this Regulation".

Article 3 – Requests for domain name registration (extract): "The request for domain name registration shall include all of the following: (d) an undertaking by electronic means from the requesting party that it shall abide by all the terms and conditions for registration, including the policy on the extra-judicial settlement of conflicts set out in Chapter VI. Any material inaccuracy in the elements set out in points (a) to (d) shall constitute a breach of the terms of registration".

Article 10 – Eligible parties and the names they can register (extract): “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 – Principles for phased registration (extract): “3. The request to register a domain name based on a prior right under Article 10(1) and (2) shall include a reference to the legal basis in national or Community law for the right to the name, as well as other relevant information, such as trademark registration number, information concerning publication in an official journal or government gazette, registration information at professional or business associations and chambers of commerce.”

Article 14 – Validation and registration of applications received during phased registration (extract): “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.

The Registry, upon receipt of the application, shall block the domain name in question until validation has taken place or until the deadline passes for receipt of documentation. If the Registry receives more than one claim for the same domain during the phased registration period, applications shall be dealt with in strict chronological order.

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 relevant validation agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name. If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this”.

- .eu Registration Policy and terms and Conditions for Domain Name Applications made during the Phased Registration Period “Sunrise Rules”

The Panel will also take into consideration the Sunrise Rules adopted on the basis of Article 5.5.3 of (EC) Regulation 733/2002 and Article 12 of (EC) Regulation No. 874/2004 which provide in particular that “the Sunrise Rules apply to all Applications made during the Phased Registration Period”.

Article 3 - Obligations of the Applicant (extract): “An application is only considered complete when the Applicant provides the Registry, via a Registrar, with at least the following information:
(viii) the type of Prior Right claimed by the Applicant, as referred to in Article 10 (1), second paragraph, of the Public Policy Rules,
(ix) the country in which the Prior Right claimed is protected,
(x) the language in which the Documentary Evidence to be provided to the Validation Agent will be couched.”

Article 8 – Official Requirements for Documentary Evidence (extract): “3. The Applicant or its Document Handling Agent shall be required to: (ii) indicate on the Cover Letter the official language in which the Documentary Evidence is being submitted where such Documentary Evidence is submitted in another official language of the European Union than the language chosen in the Application. In the case that another official language is selected in the Cover Letter, any and all documentary Evidence submitted must be in the language selected in the Cover Letter.

Documentary Evidence in another language than the language chosen in accordance with these Sunrise Rules will not be considered. If any of the Documentary Evidence is not in the official language selected by the Applicant, it must be accompanied by a translation made by a certified translator in the language selected in the Application or, as the case may be, in the Cover Letter.

It is the sole responsibility of the Applicant to ensure that these requirements are complied with. Documentary Evidence sent to the Processing Agent by a third party in the name and on behalf of the Applicant is deemed to have been sent by the Applicant”.

Article 21 - Examination by the Validation Agent (extract): “2. The 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.

3. The 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 by the validation Agent".

2) The case at issue

Preliminary observation concerning the identity of the Complainant

Although the Complaint has been filed in the name of Dr Massimo Introvigne, and although this latter appears as the Complainant in all the documents relating to this ADR proceeding, it is clear that the real Complainant in the case at issue is the Italian company Tecno Center s.r.l., which is the party adversely affected by the contested decision of the Respondent (in this sense, see case No. 449 CANDY). In fact, Dr Massimo Introvigne has already initiated several ADR disputes, in his own name, but really on behalf of Tecno Center s.r.l. (see cases No. 2061 MODLINE and No. 1318 SYS).

The identification of the earlier right in the domain name application

The domain name application filed on January 24, 2006 claimed the existence of a prior right identified as follows: registered national trademark; prior right country: Italy.

On the same day, and within the relevant time period, the applicant sent to the validation agent the cover letter generated by the Respondent, indicating that the documentary evidence would be sent in Italian. However, enclosed with the cover letter was a copy of a German trademark registration, in German.

It is not so much the issue of language of documentary evidence which is critical in this matter, but rather the identification of the earlier right.

The domain name Tecno-Center was applied for by Complainant, and as a consequence was immediately blocked for registration by third parties, on the basis of an earlier Italian trademark which, however, was not registered, and which therefore could not serve as a valid basis for an application. Only a registered trademark can support a request for a eu domain name, except the unregistered rights strictly listed in the article 15 of the Sunrise Rules. In spite of the arguments put forward by the Complainant regarding the legal effects of a trademark application in accordance with Italian law, the Panel considers that in any case the Italian trademark mentioned in the request by the applicant cannot substantiate the prior right requested by the Registry, as it has not matured to registration.

Complainant probably noticed the error, and therefore sent to the validation agent a German trademark registration over Tecno-Center.

Should the Respondent have accepted to take into consideration this earlier right, which however was not claimed as a basis for the application, neither in the basic electronic form, nor in the cover letter sent by the applicant?

The mistake in the present case is not minor and affects substantially the basis of the request. Indeed, Article 12(3) of (EC) Regulation No. 874/2004 puts an obligation on the applicant to identify the earlier right on which the domain name is blocked and reserved. Article 3 of the Sunrise rules, cited above, are even clearer in this respect.

The Rules have been set forth in order to ensure a fair distribution of eu domain name during the phased period as it has been underlined in Case No. 1627 PLANET INTERNET. Such rules although it could have been considered as too formalistic ensure an equal treatment of the candidates.

The incorrect information sent by the applicant's Registrar could not be checked by any third party interested in the same domain name.

The error committed by the domain name applicant is substantial and cannot be cured at a later stage, nor during the validation process, nor in the course of an ADR proceeding, the purpose of which is only to check whether the Registry complies with the EC Regulation (in this respect, see cases No. 219 ISL and No. 1071 ESSENCE, in which the Panel expressed opinions with which this Panel fully concurs).

The possibility for the Complainant to rely on its trade name

Complainant asserts that its rights over Tecno Center were also supported by its trade name, Tecno-Center s.r.l. In any case, this earlier right could not be invoked as a basis for the registration during the first part of the Phased Registration, and cannot be invoked at a later stage. In addition, Complainant did not submit formal evidence of its rights over Tecno Center as a trade name.

Observation concerning a possible error committed by the registrar

Complainant suggests in its Complaint that a technical mistake may have been committed by the Italian registrar, Dominiando, to which copies of Complainant's earlier rights in Germany and Italy were allegedly sent. In this respect, the Panel solely wishes to stress that the respondent cannot be requested to modify its practice in "sympathy" for the domain name applicant, further to an error committed by the registrar. The Registrar acts on behalf of the candidate and the candidate is responsible of any mistakes contained in its request (Article 8.6 of the Sunrise Rules). It is up to the Complainant to bring an action against the registrar, if deemed justified.

Observation concerning the allegation made by the Complainant that there are no other applicants for the domain name TECNO-CENTER.EU

Complainant claims that "there are no other applicants for tecno-center.eu in the registration queue that would be damaged by a decision in favour of Complainant". In this respect, the Panel fully concurs with the opinion expressed by the Panel in case No. 2021 MODLINE, in the sense that "it is important to note that such evaluation is irrelevant to determine if the Respondent's decision to reject the domain name application is in compliance with the relevant regulations". If, indeed, the domain name at issue has not been requested by a third party, then why did Complainant chose to initiate an ADR dispute, instead of filing a fresh application for the identical domain name?

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	**Martine Dehaut**

DATE OF PANEL DECISION 2006-10-30

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The domain name TECNO-CENTER.EU was applied for by the Italian company Tecno Center s.r.l. during the first part of the phased registration period, on the basis of an Italian registered trademark. However, the applicant sent to the validation agent a German trademark registration, as its Italian trademark had not matured to registration yet. In addition, and although this is a secondary issue, the documentary evidence, which should have been provided in Italian, was sent in German.

The Panel considers that the error committed by the applicant is substantial and cannot be cured at a later stage, during the validation period or in the course of an ADR proceeding, as it directly affects the basis of the request. Indeed, Article 12(3) of (EC) Regulation No. 874/2004 puts an obligation on the applicant to identify the earlier right on which the domain name is blocked and reserved. Only a registered trademark can support a request for a eu domain name, except the unregistered rights strictly listed in the article 15 of the Sunrise Rules.

The fact that there are no other applicants for the domain name at issue is irrelevant.

For this reason, the Complaint is denied.