Panel Decision for dispute CAC-ADREU-002780

Case number	CAC-ADREU-002780
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Domain names	cybermut.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	EURO-INFORMATION SA

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 issued and which relate to the disputed domain names.

FACTUAL BACKGROUND

The Complainant applied for the registration of the domain name “CYBERMUT.eu” during Sunrise Period I and based its application dated 7 December, 2005, on a prior trademark right. Complainant claimed to be the owner of a registered national trademark in France “CYBERMUT” (No. 95 574 964). As Documentary Evidence he presented - within the forty days period of section 8 (5) subsection 4 Sunrise Rules – a copy of a “Certificat D’Enregistrement” of the INPI, the national French “Institut National de la Propriete Industrielle” with respect to the trademark “CYBERMUT”.

The copy of the Certificat D’Enregistrement with respect to the trademark “CYBERMUT” provides information that the trademark CYBERMUT has been registered for the Complainant with effect as of 6 June, 1995 and was protected for a period of 10 years from the date of application and that it could be renewed afterwards for an indefinite time.

On 5 July, 2006 EURid notified the Complainant that its application was rejected. The decision was based on the fact that the Documentary Evidence filed in support of the application was insufficient to demonstrate the alleged prior right. On 15 August, 2006 the Czech Arbitration Court (CAC) received Complainant’s Complaint.

The Complainant requests the Panel to decide:

Annulment of the disputed decision and attribution of the domain name CYBERMUT.eu to the Complainant.

He attached to its Complaint a “Certificat de Renouvellement” of the French Trademark showing that the date of renewal was 20 March, 2005, thus prior to the application for the .eu-domain.

A. COMPLAINANT

Complainant is of the opinion that EURid’s decision violates the EC Regulations No. 874/2004, No. 733/2002 and section 13 (2) (i) Sunrise Rules. Complainant is of the opinion that by filing the Documentary Evidence it proved to be the owner of prior rights in the sense of Article 10.1 of the EC Regulation No. 874/2004. Acc. to section 13 (2) (i) Sunrise Rules the applicant has to submit as Documentary Evidence a copy of an official document issued by the competent trade mark office indicating that the trademark is registered, for example a certificate of registration, a renewal certificate or an official excerpt from the trademark register. Either document shall be sufficient to prove the prior right claimed.

Further, Complainant argues that in ADR case 340 (Pompadour) the Panel stated that neither the Regulation No. 874/2004 nor the Sunrise Rules mention a document such as an extension notice as a necessary proof for an expired trademark.

Complainant is of the opinion that the Validation Agent was obliged to investigate, for example, in a trademark database to find out that the renewal had been made already. Although the INPI register did not show this already at the time of validation, other databases seem to have done so, then.

Acc. to ADR cases 174 (Domaine) and 1074 (Festool) the Documentary Evidence on the renewal provided in the ADR proceeding should be considered and lead to the decision requested by the Complainant.

B. RESPONDENT

Pursuant to article 14 of the EC Regulation No. 874/2004, "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". This provision further states that "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. 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. (…) The Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure (…)".

Section 11 (3) Sunrise Rules states 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, on which date the Prior Right must be valid, which means that it must be in full force and effect.

The Documentary Evidence timely sent by Complainant did not include any document or information substantiating that the trademark had been renewed after 10 years. The burden of proof was with the Complainant to demonstrate that it is the holder of a prior right. It is therefore of crucial importance that the Respondent is provided with all the Documentary Evidence necessary for it to assess if the applicant is indeed the holder of a prior right. The burden of proof is on the Applicant to substantiate that it is the holder of a prior right.

The Respondent wishes to refer the Panel to several ADR decisions where the Panels decided that a Validation Agent, who was only in receipt of a expired trade mark certificate, was under a duty to reject the application acc. to section 11 (3) Sunrise Rules.

Furthermore, the Respondent and the Validation Agent were under no obligation to investigate into the circumstance of the application. Section 21 (2) Sunrise Rules states that 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. Section 21 (3) Sunrise Rules states that the Validation Agent is not obliged, but it is permitted in its sole discretion, to conduct its own investigations into the circumstances of the Application, the Prior Right claimed and the Documentary Evidence produced.

Pursuant to Article 14 of EC Regulation No. 874/2004, the Respondent may only accept, as Documentary Evidence, documents that are received by the Validation Agent within 40 days from the submission of the domain name application. The Complainant filed its Complaint on 10 August 2006 and submitted new documents attached to this Complaint, in particular a document showing that the French trademark had been renewed. Those documents may not serve as a basis to assess whether the Applicant is the holder of a prior right, since those documents are submitted more than five months after the end of 40 days period set forth by the Regulation. The fact that the Complainant indeed was the holder of a sufficient prior right cannot lead to any other result.

DISCUSSION AND FINDINGS

Article 14 of the EC Regulation No. 874/2004 states that 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 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.

The underlying facts – which are not in dispute - are almost the same as in the ADR case 219 (ISL): The Complainant is the owner of a prior right, a national trademark right in the name “CYBERMUT” in France. At the time of filing of the application, however, the term of protection had expired and the trademark was to be renewed but not already renewed. The Complainant failed to provide any proof that the renewal of the trademark was timely applied for and that the renewal procedure was not finished yet.

The decision of the Panel must focus on the view, the Validation Agent had at the time of the validation. The Panel has to consider the Documentary Evidence provided within the 40 days period of section 8 (5) subsection 4 Sunrise Rules (see also 1071 (Essence)). The

Validation Agent is entitled, at its sole discretion, to further investigate in the circumstances of an application (section 21 (3) Sunrise Rules). The Panel confirms the view of the Respondent that section 21 (3) Sunrise Rules does not impose any obligation of the Validation Agent to further investigate at least in the present case. The Complainant failed to provide further documentation, which could support its view that the trademark was still valid. The renewal application and/or and affidavit explaining the legal situation in France might have persuaded the Validation Agent to grant the domain name to the Complainant or to further investigate.

As it is clear that the applicant for a domain name who claims prior rights must be the owner of such a valid prior right according to section 11 (3) Sunrise Rules, and as the Complainant did not succeed in proving such a right at the time of the application, the Panel does not see an obligation of the Validation Agent to further investigate in the case. It does not have to be decided in this case, if there was an obligation of a Validation Agent in a situation, where the applicant provides Documentary Evidence giving an indication to believe that a renewal had been applied for timely, but due to a delay of the competent register had not been registered already.
The Applicant cannot be heard with its argument that section 13 (2) (i) Sunrise Rules explicitly refers to a renewal certificate as adequate proof of the existence of a prior right. Rather the mention of the renewal certificate shows that in case a trademark is expired, a renewal certificate has to be provided to prove the continuing existence of a prior right.

In providing the renewal certificate with its Complaint, the Complainant was neither able to cure the mistake that had been made within the application procedure. The Panel clearly confirms the view of various decisions that the ADR proceeding may not be used as “second chance” to cure mistakes having been made during the application procedure (see as examples ADR cases 219 (ISL), 1071 (Essence), 1194 (Insuresupermarket)). The Panel is of the opinion that a different view would neglect the fact that the attribution of domain names in the Sunrise Period is based on the “first come - first served” principle. Accepting new documents in the ADR proceeding would penalise applicants which applied for the same domain name with within a Sunrise Period, but at a later time.

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	**Dominik Eickemeier**

DATE OF PANEL DECISION 2006-10-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Complainant is the owner of a national French trademark “CYBERMUT”, registered in June 1995 and applied for the corresponding domain name. At the time of the domain name application the trademark’s initial term of protection had already expired. However, the Complainant had already filed for renewal timely, but could not provide a renewal certificate within the domain name registration procedure. The trademark was renewed and the Complainant provided the Panel with the renewal certificate with its Complaint.

EURid rejected the domain name application, as the certificate of registration provided as Documentary Evidence in the registration procedure did not contain any information on the renewal.

The Panel decided that the rejection was correct and the Complaint had to be denied. At the time of the domain name registration procedure the Complainant did not succeed in proving that he was the owner of a valid registered trademark. The fact that he was able to prove its ownership in the ADR proceeding could not cure this mistake as the Panel is of the opinion that Documentary Evidence sent after expiry of the 40 days period of section 8 (5) subsection 4 Sunrise Rules may not be considered, as the ADR proceeding cannot offer the Complainant a “second chance” to claim its prior rights.