Panel Decision for dispute CAC-ADREU-002863

Case number	**CAC-ADREU-002863**
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Domain names	**vola.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Vola A/S, Jacob Nielsen**

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 other legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is Vola A/S, Denmark.

The Complainant applied for the domain name VOLA on 16 January 2006 during a period (the Sunrise period) of phased registration of domain names of the .eu Top Level Domain before the general registration of .eu domain starts.

The validation agent, PriceWaterhouseCoopers, received the documentary evidence on 24 February 2006, which was before the 25 February 2006 deadline.

The documentary evidence consisted of Community trade mark certificate registered in the name of I.P. Lund Sanitätsarmatur A/S, not the Complainant. The documentary evidence also contained two letters from a Danish trade mark attorney.

Due to the difference in name between the holder of the prior right and the Complainant, the validation agent concluded that both may be different entities and advised the Respondent to reject the Complainant's application.

Therefore, the Respondent, European Registry for Internet Domains (EURID), rejected the Complainant 's application.

Againts this decision the Complainant filed a complaint with the Czech Arbitration Court.

A. COMPLAINANT

The Complainant argues that the difference in the names of the holder of the prior right and the Complainant’s name is only minor. The Complainant argues that the holder of the prior right is Vola Productions AS and the application was based on the registered Danish trade mark VOLA, registered at the Danish Patent and Trade Mark Office since 2 Octobre, 1970, reg. No. 19701002. The apllication was rejected on 23 July, 2006, with the argument that the Complainant had not proven his rights to the domain name. The basis for this argument was that there was a minor discrepancy between the name of the Applicant on the application (Vola A/S), and the name of the owner of the registered trade mark VOLA, i.e. Vola Productions A/S. The above metioned companies are the one and same companies, i. e. the name Vola Productions A/S is a secondary name for Vola A/S. The only diference is the word "Production".

The Complainant argues that it is the same entity as the holder of the prior right. The Complainant argues that a simple search by the Respondent would have revealed this.

In support of this argument, the Complainant submits certificates from the Danish Companies register which allegedly show that the Complainant and the holder of the prior right are one and the same.

The Complainant requests the Panel to annul the Respondent's decision.

B. RESPONDENT

The Respondent expresses as follows:

The Complainant applied for the domain name VOLA on 16 January 2006. The processing agent received the documentary evidence on 24 February 2006, which was before the 25 February 2006 deadline.

The documentary evidence consisted of Community trade mark certificate registered in the name of I.P. Lund Sanitätsarmatur A/S, not the Complainant. The documentary evidence also contained two letters from a Danish trademark attorney. Due to the difference in name between the holder of the prior right and the Complainant, the validation agent concluded that both may be different entities and advised the Respondent to reject the Complainant's application.

Therefore, the Respondent rejected the Complainant 's application.

The Respondent argues that the Regulation and the Sunrise Rules clearly and certainly provide that the burden of proof was with the Complainant to demonstrate that it is the holder of a prior right.

When there is a difference between the name of the applicant and the name of the owner of the prior right, the applicant must submit official documents explaining why and how it is entitled to rely on a prior right which, in the face of the documentary evidence, belongs to someone else.

If an applicant fails to do so, its application must be rejected and Respondent must then give the next applicant in line the opportunity to try to demonstrate its prior rights. During the Sunrise Period, the principle "first-come, first-served" is indeed more properly described as "first-come-and-substantiate, first-served." In other words, during the Sunrise Period, the first applicant in the line does not have an unconditional right to the domain name, but only has an opportunity to try to clearly demonstrate that it is the holder of a prior right.

There can be no doubt that the name of the Complainant and the name of the holder of the prior right are different.

The Complainant's name is VOLA A/S whereas the name of the holder of the prior right, as mentioned on the trade mark certificate which was submitted as documentary evidence, is I.P. LUND SANITÄTSARMATUR A/S

Therefore, the Respondent correctly rejected the Complainant's application, pursuant to the Regulation and the Sunrise Rules, because the Complainant failed to meet its burden of proof.

With regard to the letters sent by the Danish trade mark attorney, the Respondent has noted that one letter was sent to Vola Productions A/S, which the Complainant argues is the current name of the holder of the trade mark.

First of all, the Respondent would like to note that the letter does not state anything about a name change, transfer. As far as was foreseeable to the validation agent, the trade mark was registered in the name of I.P. Lund Sanitätsarmatur A/S, as the trade mark certificate clearly shows. I.P. Lund Sanitätsarmatur A/S and Vola Productions A/S could well have been two different companies from the same group.

Secondly, and although this matter is not relevant as the trade mark certificate did not refer to Vola Productions A/S, the Respondent would like to note that there still is a difference in name between Vola Productions A/S and Vola A/S. Given the number of names referred to in the documentary evidence, it is not unreasonable to think that all these names refer to different companies.

The Respondent argues that the hypothesis that these companies may be part of the same group is not relevant. Indeed, when a trademark certificate only refers to one company as being the holder, affiliated companies have no rights in that trademark. They may however be granted rights by the holder through a licence (but no such licence was submitted as documentary evidence in the case at hand).

In the present case, the 40 days period ended on 16 January 2006.

The Complainant filed its complaint on 7 August 2006 and submitted new information with its complaint.

The Complainant wishes to add those documents to the documentary evidence, thereby trying to correct the Complainant 's application.

These documents may not serve as a basis to asses whether the Complainant 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. Accepting these documents as documentary evidence would clearly violate the Regulation.

Since the Respondent correctly decided to reject the Complainant's application, pursuant to the Regulation, Respondent's decision may not be annulled and the domain name VOLA may not be granted to the Complainant. Indeed, a domain name may only be attributed to the Complainant by this Panel, when the Panel finds that the Respondent's decision conflicts with the Regulation (article 11 of the ADR Rules).

For these reasons, the complaint must be rejected.

DISCUSSION AND FINDINGS

In consideration of the factual background and the Parties contentions, the following legal conclusions must be reached:

Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implemenation and functions of the .eu Top level Domain and the principles governing registration, (hereafter "the Regulation") states that only holders of prior rights which are recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.

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. (…) 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 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. (…) 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. (…) 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 20.3. of the Sunrise Rules states that "If, for any reasons other than as are referred to in Section 20(1) and 20(2) hereof, the Documentary Evidence provided does not clearly indicate the name of the Applicant as being the holder of the Prior Right claimed (e.g. because the Applicant has become subject to a name change, a merger, the Prior Right has become subject to a de iure transfer, etc.), the Applicant must submit official documents substantiating that it is the same person as or the legal successor to the person indicated in the Documentary Evidence as being the holder of the Prior Right".

Section 21 (2) of the Sunrise Rules states that the validation agent shall examine whether an applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence it has received.

The applicant has the burden of providing the evidence needed to support the application. In this case it means the evidence that the applicant and the trademark holder is the same person. The burden of proof is putted on the applicant not on the Respondent.

The burden of proof was thus on the Applicant to substatiate that he is the holder of a prior right.

The Registry's obligation is to examine whether the applicant holds a prior right to the domain name. The right must be verifiable by presented documentary evidence in time.

In the presented case the documentary evidence submitted by the Complainant
did not demonstrate that the Complainant was the holder of a prior right.

There can be no doubt that the name of Complainant and the name of the holder of the prior right are very different. The Complainant trade name is VOLA A/S whereas the name of the holder of the prior right, as mentioned on the trade mark certificate which was submitted as documentary evidence in time, is I.P. LUND SANITÄTSARMATUR A/S. This diference cannot be considered minor. The

Complainant failed to explain this diference in the trade names in time.

If the trade name I.P. LUND SANITÄTSARMATUR A/S and VOLA PRODUCTION A/S are the secondary names of the Applicant according to the Danish law, the principal name of the company shall be added in brackets according to this law.The application under only a secondary name without the addition of the principal company name which is not prima facie verifible from the documentary evidence is a defect application.

As to as the letters sent by the Danish trade mark attorney, one of them was sent to VOLA PRODUCTIONS A/S. This letter, such as, has no relevance in this case because it does not state anything about a trade name change or of a secondary name etc.

Therefore the documentary evidence, which was submitted within the phased registration (Sunrise Period), was incomplete and did not clearly demonstrate that the Complainant and the applicant were the same person.

The documentary evidence does not clearly indicate the name of the applicant as being the holder of the prior right claimed.

Proving that one is the holder of a trade mark means in this case that the name of the trade mark holder must match with the name of the applicant.

The Complainant failed to clearly, prima facie, demonstrate itself as the holder of VOLA trade mark without any doubt.

The validation agent examines whether the applicant has a prior right exclusively on the basis of a prima facie review of the documentary evidence received in time.

The validation agent or the Respondent is not obliged to engage yourself in a possible speculation or to provide its own enquiry especialiy more in the phased registration. The Respondent and the validation agent were under no obligation to investigate into circumstance of the application.

According to the legal position and duties of the validation agent or the Respondent, the clear identity between the applicant and the trade mark holder must be given in time.

In the phased registration (Sunrise Period) there is no reasonable place of a possible speculation about the applicant's identity and the identity of the trade mark holder or about a possible trade mark licence between them or about a possible affiliated company or about a possible principal and secondary names etc.

The new evidence brought in the framework of this proceedings by the Complainant has to be disregarded. The applicant is provided with forty days to demonstrate its prior right (Art. 14 of the Regulation). Once the period is over, the Respondent must asses the prior right on basis of the evidence he received in time.

Only the documentary evidence which the Respondent was able to examine at the time of validation of the application should be considered by the Panel to asses the legal validity of the Respondent's decision. Documents submitted for the first time during the present ADR proceedings may not be taken into consideration by the Panel. These documents may not serve as a basis to asses whether the Complainant is the holder of a prior right. Accepting these documents as documentary evidence would clearly violate the Regulation and the legal nature of the Sunrise Period such as.

Therefore, only the documentary evidence which the Respondent was able to examine at the time of validation of the application should be considered by the Panel to asses the validity of the Respondent‘s decission. The assessment of the validity of the Respondent‘s decision has a very specific legal nature and may not in any case serve as a „second chance“ or an additional round providing applicants an advantage to remedy their imperfect original application that was rejected during the Sunrise Period.

The Complainant has had a sufficient time to submit an accurate application and all relevant documentary evidence without any mismatch in a trade name or trade names, principal and secondary, and a trade mark.

Regarding to the legal nature of the phased registration, it is appropriete to emphasize the legal principle of concentration of the documentary evidence during a restricted time and the legal principle vigilantibus iura, too.

The Regulation and the Sunrise Rules give holders of prior rights the opportunity and the great advantage to demonstrate their prior rights during the phased registration, which is an exception to the basic domain name legal principle of first-come first-served. The prior

right holder has only conditional right to the registration of domain name which depends on his demonstration of his right by a documentary evidence in time.

Any right or any additional advantage given to the Complainant to correct his original defective application at this stage of the procedure would be unfair to the other applicants that may filled for the same domain name immediately after the applicant and would clearly be in breach of the Regulation and the Sunrise Rules.

The decision taken by the Respondent, European Registry of Internet Domain (EURID), does not conflict with the Comission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implemenation and functions of the .eu Top level Domain and the principles governing registration or with the Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain.

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	**Ivo Telec**

DATE OF PANEL DECISION 2006-11-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

1. If the Complainant's trade name is VOLA A/S, whereas the name of the holder of the prior right, as mentioned on the trade mark certificate which was submitted as documentary evidence, is I.P. LUND SANITÄTSARMATUR A/S, the documentary evidence did not demonstrate that the Complainant was the holder of a prior right. This difference cannot be considered minor.

2. If the trade name I.P. LUND SANITÄTSARMATUR A/S and VOLA PRODUCTION A/S are the secondary names according to the Danish law, the principal name of the company shall be added in brackets according to this law.The application under only a secondary name without the addition of the principal company name which is not prima facie verifible from the documentary evidence is a defect application.

3. It must be prima facie verifiable from the documentary evidence presented in time that the applicant for a domain name is the holder of the trade mark to the name.

4. The relevant question within the Sunrise Period is thus not whether the Complainant is the holder of a prior right, but whether the Complainant demonstrated to the validation agent that he is the holder of a prior right.

5. The Comission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implemenation and functions of the .eu Top level Domain and the principles governing registration and the Sunrise Rules give holders of prior rights the opportunity and the great advantage to demonstrate their prior rights during the phased registration, which is an exception to the basic domain name legal principle of first-come first-served. The prior right holder has only conditional right to the registration of domain name which depends on his demonstration of his right by a documentary evidence in time.

6. Regarding to the legal nature of the phased registration (Sunrise Period), it is appropriete to emphasize the legal principle of concentration of the documentary evidence during a restricted time and the legal principle vigilantibus iura, too.

7. No additional documents and new information should be accepted after the 40 day period for the submission of documentary evidence.

8. Any right or any additional advantage given to the Complainant to correct his original defective application at this stage of the procedure would be unfair to the other applicants that may filled for the same domain name immediately after the applicant and would clearly be in breach of the Regulation and the Sunrise Rules.