Panel Decision for dispute CAC-ADREU-002983

Case number	**CAC-ADREU-002983**
Time of filing	**2006-09-11 14:49:00**
Domain names	**bormio.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Valtline srl, Giuseppe Pino Brianzoni**

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 Panelist is aware.

FACTUAL BACKGROUND

This Complaint arises out of the decision of the Registry EURid to reject the application for the domain name “BORMIO.EU”.

On 07.12.2005, Mr. Giuseppe Pino Brianzoni (hereinafter the “Applicant”) applied for the rights on the domain name “BORMIO.EU”, submitting, as ground for the application, its rights on the Italian trademark application no. MI2005C008832 “BORMIO” for the Nice class no. 38 (telecommunications), filed on 04.08.2005, and a declaration of license.

On 18.08.2006, with the decision no. 7882, the Registry EURid refused the application for the domain name “BORMIO.EU” deeming that the trademark application submitted by the Applicant could not serve as a prior right for the domain name applied for, since the trademark application no. MI2005C008832 has been filed in the name of Valtline s.r.l., and not in the name of the Applicant.

On 06.09.2006, Valtline s.r.l. and Mr. Giuseppe Pino Brianzoni (hereinafter the “Complainants”), filed a Complaint against the mentioned decision of the Registry EURid (hereinafter the “Respondent”), indicating Italian as the language of the proceedings.

On 15.09.2006, the Case Administrator filed Complaint Check informing the Complainants that the Complaint needed to be amended.

On 18.09.2006, the Complainants filed an Amended Complaint, indicating English as the language of the proceedings.

On 25.09.2006, the Case Administrator filed the Commencement of ADR Proceeding form.

On 10.11.2006, the Respondent filed the “Response to Complaint”.

On 13.11.2006, the Case Administrator filed the “Acknowledgement of Receipt of the Response”.

On 15.11.2006, the “Panelist Selection” was issued. On the same date, this Panelist filed the “Statement of Acceptance and Declaration of Impartiality and Independence”. Therefore, the Case Administrator served the parties with the “Notification of Appointment of the ADR Panel and Projected Decision Date”.

On 20.11.2006, the “Case File” was transmitted to the Panelist.

A. COMPLAINANT

The Complainants filed a Complaint succinctly indicating the factual and legal grounds to obtain the sought remedy of “domain registration”.

The Complainants affirmed that the domain name was required by Valtline s.r.l., the legal owner of the trademark application for “BORMIO”. The Complainants claimed that the indication of the name of Mr. Pino Brianzoni – C.E.O. of Valtline s.r.l. – as the Applicant, instead of Valtline s.r.l., is due to a mistake of the registrar eNom, Inc..

B. RESPONDENT

The Respondent filed a Response indicating the factual and legal grounds on the basis of the decision to reject the domain name application and requested the rejection of the Complaint.

In particular, the Respondent focused its analysis on the application of Articles 10(1) and 14 of the Commission Regulation EC no. 874/2004 (hereinafter the “Regulation no. 874/2004) and Articles 20(1) and 20(3) of the “.eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period” (hereinafter the “Sunrise Rules”), according to which the validation agent concluded that the Applicant did not demonstrate to be the holder of prior right on the name “BORMIO”, based on the documentary evidence submitted.

To the same extent, the Respondent quoted several previous decisions to support its allegations.

The Respondent concluded affirming that the documentary evidence did not explain the difference between the name of the Applicant and the name of the holder of the prior right. Since it is a duty for the Applicant to prove to be the holder of the prior right, the Respondent concluded stating that its decision to reject the Applicant’s application may not be annulled.

DISCUSSION AND FINDINGS

The ADR procedure at issue has been commenced by the Complainants against the decision to reject a domain name application. The application for the domain name “BORMIO.EU” has been filed, according to the “Sunrise Rules”, by the Applicant on the ground of asserted prior rights.

From the Case File, it results that the domain name application is based on the Italian trademark application no. MI2005C008832, the validity of which is out of discussion in the present case, and on a Trademark Licence Declaration pursuant to which the trademark application on issue has been licensed by Valtline s.r.l. to Valtline s.r.l. itself.

(1) The applicable regulations.

Article 10(1) of the Regulation no. 874/2004 provides that “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”. The provision continues stating that “prior rights shall be understood to include, inter alia, (…) registered national and Community trademarks”.

Article 14 of the Regulation no. 874/2004 states that “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. (…) 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. (…)”.

According to the above mentioned provisions, Section 20(3) of the Sunrise Rules affirms 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 (…) 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”.

Finally, Section 21(2) of the Sunrise Rules provides as follows: “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 (…)”. And Section 21(3) of the same regulation clarifies that “the Validation Agent is not obliged, but 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”.

(2) The case at issue.

The domain name application at issue has been filed by Mr. Giuseppe Pino Brianzoni as the Applicant.

The Documentary Evidence submitted by the Applicant consists in the Italian trademark application No. MI2005C008832, for the trademark “BORMIO”, in the name of the company Valtline s.r.l., as well as a Trademark Licence Declaration pursuant to which the trademark application on issue has been licensed by Valtline s.r.l. to Valtline s.r.l. itself. Both the documents indicate as “representative” Mr. Giuseppe Pino Brianzoni.

According to the analysis of the documents and the understanding of this Panelist, it seems that Mr. Brianzoni, who filed the domain name application as the Applicant, is referred as the “representative” of the company Valtline s.r.l. in the trademark application. However, no evidence of the relationship between Mr. Brianzoni and the company Valtline s.r.l. (i.e. a proxy, or a power of attorney, or a certificate of incorporation demonstrating the position of Mr. Brianzoni within the company or the relation between them) has been submitted by the Applicant.

Therefore, the Validation Agent, applying the rules set forth by Section 21(2) of the Sunrise Rules, carried out a “prima facie” review of the Documentary Evidence submitted and did not find any evidence of the ownership of any title on the prior right in the name of the Applicant Mr. Brianzoni.

This Panelist is aware that, probably, performing a research on the relevant Company Registry of the Chambers of Commerce, it is possible to verify if Mr. Brianzoni is an officer or a director of the company Valtline s.r.l.. However, as Section 21(3) clearly states, it is not a duty for the Validation Agent to perform such a research, but only, eventually, a faculty in its own discretion. On the contrary – as stated by Article 14 of the Regulation no. 874/2004 – is the Applicant the one who has the burden of the proof that he is the holder of the prior right.

This Panelist is aware that such clear principle, which should not need further explanation, has been implemented by several previous A.D.R. decisions.

Therefore, according to the above, Mr. Brianzoni had the duty to demonstrate his relationship with Valtline s.r.l. – and, in particular, the reason why he was the applicant of the domain name application – and he failed to submit adequate evidence.

Finally, with regard to the Complainants' claim according to which the indication of Mr. Brianzoni as the Applicant has been due to a mistake made by the Registrar eNom, Inc., it is important to note that Section 5(3) of the Sunrise Rules states that “the Registry, Validation Agents and the Government Validation Points are no party to the agreement between the Applicant and his Registrar or to the agreement between the Applicant and his Document Handling Agent and therefore cannot incur any obligation or liability under these agreements”.

Therefore, according to the mentioned provision, as well as to the previous ADR case law interpreting the provision (for example ADR case No. 393 “4M”, ADR case No. 984 “ISABELLA”, etc.), a mistake made by the Registrar is not a reason for overturning a decision on a domain name application.

According to the above, the Complaint should be denied and the disputed decision should become final.

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	**Francesco Paolino**

DATE OF PANEL DECISION 2006-12-05

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainants filed a Complaint indicating the factual and legal grounds to obtain the sought remedy of “domain registration” and affirming that the domain name was required by Valtline s.r.l., the legal owner of the trademark application for “BORMIO”. The Complainants claimed that the indication of the name of Mr. Pino Brianzoni – C.E.O. of Valtline s.r.l. – as the Applicant, instead of Valtline s.r.l., is due to a mistake of the registrar eNom, Inc..

The Respondent filed a Response indicating the factual and legal grounds on the basis of the decision to reject the domain name application and requested the rejection of the Complaint, affirming that the documentary evidence did not explain the difference between the name of the Applicant and the name of the holder of the prior right. Since it is a duty for the Applicant to prove to be the holder of the prior right, the Respondent concluded stating that its decision to reject the Applicant's application may not be annulled.

The Panelist held that the Validation Agent, applying the rules set forth by Section 21(2) of the Sunrise Rules, carried out a "prima facie" review of the Documentary Evidence submitted and did not find any evidence of the ownership of any title on the prior right in the name of the Applicant Mr. Brianzoni. This Panelist is aware that, probably, performing a research on the relevant Company Registry of the Chambers of Commerce, it is possible to verify if Mr. Brianzoni is an officer or a director of the company Valtline s.r.l.. However, as Section 21(3) clearly states, it is not a duty for the Validation Agent to perform such a research, but only, eventually, a faculty in its own discretion. On the contrary – as stated by Article 14 of the Regulation no. 874/2004 – is the Applicant the one who has the burden of the proof that he is the holder of the prior right.

Finally, the Panelist, according to Section 5(3) of the Sunrise Rules as well as to the previous ADR case law on the issue, held that a mistake made by the Registrar is not a reason for overturning a decision on a domain name application.

For all the foregoing reasons, the Panelist orders that the Complaint is denied.