Panel Decision for dispute CAC-ADREU-003226

Case number	**CAC-ADREU-003226**
Time of filing	**2006-10-03 14:25:05**
Domain names	**caravanclub.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**The Caravan Club, Ms Viv Harrison**

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.

FACTUAL BACKGROUND

On 13 March 2006 the Complainant applied for the domain name "caravanclub.eu". The prior right relied upon was the company name of the Complainant, The Caravan Club Ltd.

The Complainant supplied the validation agent with trademark certificates of three UK trademarks THE CARAVAN CLUB (specified below) within the stipulated time frame but did not include their company's certificate of incorporation. The application was rejected on the basis that the documentary evidence provided did not prove the claimed prior right, that is to say, the company name.

A. COMPLAINANT

The Complainant submitted the following Complaint:

"On March 6 2006, The Caravan Club requested BTNET to register several .eu domains prior to April 7 (and then host them).

On 13 March, we received an email from BTNET to advise that they had applied for the .eu domains. We received an email from EURid and supplied them with trademark documentation. However, we simply forgot to send in a copy of our company certificate of incorporation which was required for the www.caravanclub.eu domain application.

On 14 September, we received an email from no-reply@eurid.eu stating that "our application had been rejected - the documentary evidence received did not sufficiently prove the right claimed" and that we could initiate an ADR Proceeding against the decision within 40 days.

By now supplying a copy of our certificate of incorporation (see Annex) we aim to put right our administrative error and be awarded ownership of the domain.

Updated information regarding proceeding 03226 advised that we had failed to sign as required, failed to send sufficient copies and also wrongly named the Registrar. This amended Complaint contains the correct Registrar details and I will send the signed sets of copies by post".

B. RESPONDENT

The Respondent provided the following response:

“1. GROUNDS ON WHICH THE REGISTRY HAS REJECTED THE APPLICATION FOR THE DOMAIN NAME CARAVANCLUB BY THE CARAVAN CLUB

Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (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.

Article 10 (2) of the Regulation states that the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.

Section 19 (2) of the Sunrise Rules states that a prior right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos, etc.) will only be accepted if the sign exclusively contains a name or if the word element is predominant, and can be clearly separated or distinguished from the device element.

Pursuant to article 14 of the Regulation, it is up to the applicant to submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. Based on this documentary evidence, the validation agent shall examine whether the applicant has prior rights on the name.

The Caravan Club (hereafter "the Complainant") applied for the domain name CARAVANCLUB on 13 March 2006.

In its application, the Complainant claimed a prior right on company name protected in the United Kingdom.

The processing agent received the documentary evidence on 16 March 2006, which was before the 22 April 2006 deadline.

The documentary evidence consisted of trademark certificates issued by the UK Patent and Trademark Office for the composite trademarks n° 1528984, 1528985 and 1528986. The documentary evidence also included certificates of renewal of said trademarks.

The validation agent concluded from its examination of the trademarks that the trademarks could not serve to establish the claimed prior right (a company name). Furthermore, the domain name applied for, CARAVANCLUB, did not consist of the complete name of the trademarks relied upon as prior right.

Based on these findings, the Respondent rejected the Complainant’s application.

2. COMPLAINANT'S CONTENTIONS
The Complainant argues that it forgot to include its certificate of incorporation and includes this certificate to its complaint, thereby trying to add this document to the documentary evidence originally submitted.
Based on these contentions, the Complainant requests the Panel to annul the Respondent’s decision and to attribute the domain name CARAVANCLUB to the Complainant.

3. RESPONSE
3.1 The documentary evidence submitted by the Complainant did not establish the claimed prior right
First the Respondent wishes to stress that the Complainant claimed a prior right in the form of a company name and only submitted documentary evidence establishing trademark rights.
Trademark certificates could not serve to establish a company name. This is not disputed by the Complainant.
The inadequacy of the documentary evidence submitted by the Complainant constitutes a sufficient ground for the Respondent to correctly reject the Complainant’s application.
The Respondent further notes that, even if the Complainant had claimed a prior right based on those trademarks, those trademarks could not establish a prior right on the domain name applied for.
The domain name applied for must indeed consist of the complete name of that prior right, as required by article 10 (2) of the Regulation.
Section 19 (2) of the Sunrise Rules further clarifies article 10 (2) of the Regulation, by stating that: A prior right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos, etc.) will only be accepted if
(i) the sign exclusively contains a name, or
(ii) the word element is predominant, and can be clearly separated or distinguished from the device element,
provided that
(a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the Domain Name applied for, in the

same order as that in which they appear in the sign, and
(b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear.
The figurative trademarks submitted as documentary evidence by the Applicant consists of the following elements:

(1) a figurative element in the shape of a flag; and
(2) the words "THE CARAVAN CLUB" printed in bold, with the letters CC in larger font.
Pursuant to this section 19 (2) of the Sunrise Rules, the Registry must separate the alphanumerical elements from the device elements. The trademark is therefore comprised of the following alphanumerical elements: “THE CARAVAN CLUB". Consequently, pursuant to article 10.2 of the Regulation and section 19 (2) of the Sunrise Rules, this trademark establishes a prior right on the sign THE CARAVAN CLUB, but not on the sign CARAVANCLUB as such.
As the Applicant applied for the CARAVANCLUB domain name (and not for the THECARAVANCLUB domain name), the Registry had no other option than to reject the Applicant's application for the CARAVANCLUB domain name.
In case ADR 1053 (SANTOS), the Panel had to decide on the very same facts and legal arguments. The applicant applied for the domain name SANTOS, based on a trademark comprising the name SANTOS and a stylized S. Even tough, the complainant in this case also argued that the stylized letter S was not to be considered as a letter, the Panel still decided that:
"The Panel is however conscious that the Complainant’s case is not without merit. The Complainant is clearly is known as SANTOS. SANTOS is its company name. It appears to have common law rights in the name SANTOS. It has an Internet presence in its web site established at the <santos.fr> address. Third parties refer to the Complainant’s goods as SANTOS goods. While these do not amount to Prior Rights for the purposes of the first phase of the Sunrise Period, they do indicate that the Complainant has undoubtedly rights in the SANTOS trade mark.
It appears from the documents submitted that the Complainant does not use the word mark S SANTOS.
Since the device element in the Prior Right relied upon by the Complainant is a stylised alpha numeric character, the letter “S” applying the methodology laid down in Rule 19.2(i) of the Sunrise Rules or even the methodology laid down in Rule 19.2(ii) that all alphanumeric characters (including hyphens, if any) included in the sign should be contained in the Domain Name applied for, in the same order as that in which they appear in the sign, it was reasonable that the Respondent should have rejected the application in those circumstances.
In reaching this decision the Panel is conscious that the present case has certain similarities with the proceedings in O2 DEVELOPPEMENT v. EURid (Case 00470, 2006-07-05) where it would appear from the decision that the mark in issue was also composite sign, albeit where the all elements appear to have been clearly alphanumeric.
In the present case both parties seem to have accepted that there were two distinct elements in the mark viz. the device element and the word element SANTOS.
Nonetheless the device element is an alphanumeric character for the purposes of Section 19 of the Sunrise Rules."
In the decision ADR 713 (HUETTINGER), the applicant applied for the domain name HUETTINGER, based on a composite trademark HUETTINGER and two stylized letters H. The Panel decided that: “In the present case, the Panel finds that the composite mark does not comprise exclusively the name HUETTINGER but also the stylised letters HH. The word element HUETTINGER is not predominant and the letters “HH” contained in the composite trademark must be interpreted, for the purposes of article 19.2 (a) of the Sunrise Rules, as alphanumeric characters. Therefore the Panel finds that the letters HH should have been included in the domain name application as also decided in the case N. 00470 O2 Developpement v. EURid (O2), case N. 01053 SANTOS Jacques Fouquet v. EURid (SANTOS) and Case N. 01438 Ellison Educational Europe, Ltd. v. EURid (ELLISON)”.
Finally, the Respondent also refers the Panel to the decisions in ADR (1728 ANONSE, OFERTA), 1427 (BONOLLO), 2061 (MODLINE), 1973 (ICG), 2297 (FENRISULVEN), 2680 (SIEBERT) and 1364 (GUTSCHEINBUCH).
For these reasons, the Respondent correctly rejected the Complainant’s application. The Respondent further notes that this is not disputed by the Complainant.

3.2 Documents submitted for the first time during the present ADR proceedings may not be taken into consideration

The Complainant’s only contention is that it forgot to include its certificate of incorporation and includes this certificate to its complaint, thereby trying to add this document to the documentary evidence originally submitted.

The Respondent first notes that the certificate of incorporation shows that the company name is "The Caravan Club Limited". Therefore, this company name could not serve as a prior right for the domain name CARAVANCLUB pursuant to article 10.2 of the Regulation.

Moreover, the Respondent and this Panel may not consider this document as documentary evidence anyway. Indeed, pursuant to the Regulation article 14 of the Regulation, the Respondent may only accept, as documentary evidence, documents that are received by the validation agent within 40 days from the submission of the application for the domain name.

In the present case, the 40 days period ended on 22 April 2006 and the Complainant filed its complaint with the document attached on 2

October 2006.

Therefore, the attached document may not serve as documentary evidence for the Complainant's application, since it was submitted more than 5 months after the end of 40 days period set forth by the Regulation. Accepting this document as documentary evidence would clearly violate the Regulation.

Furthermore, article 22 (1) b of the Regulation states that a decision taken by the Respondent may only be annulled when it conflicts with the Regulation.

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 assess the validity of the Respondent's decision (see notably cases ADR 294 (COLT), 954 (GMP), 1549 (EPAGES), 1674 (EBAGS), 2124 (EXPOSIUM), etc.).

This verification is the only task for the Panel in these proceedings, which may not in any case serve as a “second chance” or an additional round providing applicants an option to remedy their imperfect original application that was rejected during the Sunrise Period (see cases Nr. 551 (VIVENDI) and Nr. 810 (AHOLD)).

In other words, as decided in case Nr. 1194 (INSURESUPERMARKET), "[t]he ADR procedure is not intended to correct domain name applicants’ mistakes".

The new document attached to the present complaint was not received by the validation agent during the 40 days period, which means that the Respondent could not use this information in taking its decision. Therefore, this new information may not be taken into consideration to evaluate whether the Respondent's decision conflicts with the Regulation, which is the only purpose of the present ADR proceedings.
For these reasons, the complaint should be denied.”

DISCUSSION AND FINDINGS

This case concerns primarily the application of Articles 10 and 14 of the Commission Regulation (EC) No 874/2004. In particular, the panel has to decide two questions. First, can the documentary evidence submitted by the Complainant be taken into account when deciding whether it has a prior right as claimed in the application? If the answer to the first question is affirmative, the panel then has to consider whether the documentation establishes a prior right to the claimed domain name ”caravanclub.eu”.

1. Documentary evidence

According to the Respondent, the Complainant submitted trademark certificates of UK trademark registrations 1528984 THE CARAVAN CLUB (device), 1528985 THE CARAVAN CLUB (device) and 1528986 THE CARAVAN CLUB (device). The validation agent concluded that the trademark registrations could not establish the claimed company name.

Article 10(2) of the Regulation 874/2004 provides that “the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists”.

Further, Article 14 of the same regulation provides that “[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”, and that “[e]very applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question”. Finally, it is expressly stipulated that “[i]f the documentary evidence has not been received by this deadline, the application for the domain name shall be rejected”.

According to the ADR Rules, Section B11(d)(2), the panel has to decide whether the decision of the Registry conflicts with the European Union Regulations. The object of the first question to determine whether the validation agent was correct in rejecting the application on the basis that the Complainant submitted trademark registration extracts rather than evidence relating to the company name.

It follows from the regulations quoted above that the burden of proof is on the applicant to establish that a prior right exists.

In the present case the documentary evidence submitted were extracts from an official government database. According to Annex I of the Sunrise Rules, such extracts are capable of demonstrating a right to a trademark. The question that arises, then, is whether an extract from a trademark register could also establish a right to a company name?

According to Annex I of the Sunrise Rules, company names are protected in the UK under the law of passing off. Therefore, to establish a prior right to a UK company name, Annex I of the Sunrise Rules require that the Applicant must submit documentary evidence in accordance with Section 12(3) of the Sunrise Rules. This requires either an a) affidavit of a competent party as prescribed by the section, or b) judgment of a competent court or arbitration panel indicating that the conditions for passing off have been met. For the present purposes it is not necessary to consider the requisites for passing off action in the UK. To render a decision it is sufficient to note that a mere registration extract is not enough to establish a sufficient prior right to a company name in the UK.

The panel therefore finds that an extract of a trademark register does not sufficiently establish a right to a company name in the UK. The question whether it ever could remains an open one and need not be decided at this stage.

Regarding the certificate of incorporation, the panel is constrained by Regulation 874/2004. Article 14(4), provides that the applicant has forty days to submit the documentary evidence, and if the documentation is not received within the given deadline, the application is rejected. This leaves no discretion to the panel. To decide otherwise would, in effect, mean granting an extension of the term to applicants to submit their documentary evidence. This is outside the powers of the panel, whose decision must be based on the relevant regulations. The certificate of incorporation must therefore not be taken into account.

For these reasons, the panel concludes that the validation agent was correct in finding that an extract from trademark database did not sufficiently establish a right to a company name.

2. Prior Right

The panel also notes that even if the documentary evidence had been taken into account, it would not have established a sufficient prior right. The company name of the Respondent is “The Caravan Club Limited”.

Article 10(2) of Regulation 874/2004 provides that a Sunrise application of a domain name must consist of the complete name for which the prior right exists. In other words, the domain name applied for during the Sunrise Period must be identical to the prior right claimed. For the avoidance of any doubt, the Sunrise Rules stipulate in Section 19(1) that “[i]t is not possible for an Applicant to obtain a registration of a Domain Name comprising part of the complete name for which the Prior Right exists”. According to Section 19(2)(ii)(a) of the Sunrise Rules, composite marks can be sufficient prior rights only if “all alphanumeric characters (including hyphens) included in the sign are contained in the Domain Name applied for, in the same order as that in which they appear in the sign”. The difference between “The Caravan Club” and “Caravan Club” is not great, but is it sufficient to make the names non-identical. Not all alphanumeric characters were included in the applied domain name.

The trademark registrations may have established a right to the domain name “thecaravanclub.eu”. However, it is not necessary for present purposes to assess whether they did. The only relevant question is whether the trademarks established a sufficient prior right for the domain name “caravanclub.eu”. For the reasons given above, the answer to this must be negative.

Even if the documentation submitted by the Complainant after the expiry of the forty-day term, that is to say, the certificate of incorporation, had been taken into account, it would have established a prior right only for the domain name “thecaravanclub.eu”. The identity requirement in Article 10(2) applied regardless of the type of prior right claimed. An exception to the identity requirement is provided in Section 19(4) of the Sunrise Rules, stipulating that the company type, such as “Ltd.”, may be omitted. Therefore, company name The Caravan Club Ltd. would be sufficient prior right for the domain name “thecaravanclub.eu” but not for “caravanclub.eu”.

In this sense the Complainant’s position is not prejudiced by the finding that that the trademark registration extracts did not prove the existence of a company name and that the certificate of incorporation was deemed inadmissible. The Complaint would have failed also on substance.

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	**Erkki Holmila**

DATE OF PANEL DECISION 2006-12-22

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant applied for the domain name ”caravanclub.eu” during the Sunrise period. The claimed prior right was the company name “The Caravan Club Ltd.”. To prove the existence of the prior right the Complainant submitted trademark certificates. The validation agent refused the application on the grounds that the submitted material did not establish the claimed prior right, that is to say, the company name. The panel concluded that in this case the trademark registration extracts were insufficient proof of the existence of the company name. In addition, the certificate of incorporation submitted at later stage was deemed inadmissible. The panel further concluded that the Complaint would have failed in any case, since the material only established rights for the domain name “thecaravanclub.eu”, but not for the applied domain name “caravanclub.eu”.