Panel Decision for dispute CAC-ADREU-003281

Case number	**CAC-ADREU-003281**
Time of filing	**2006-10-10 12:32:26**
Domain names	**qosmio.eu, regza.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**Toshiba of Europe Ltd., Mr. Clive Sturgess, Web Services Manager - EMEAR**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

Toshiba of Europe Ltd ("the Complainant") applied for two domain names: <qosmio.eu> on February 14, 2006 and <regza.eu> on March 16, 2006. The first of these claimed, as a prior right, a trade name or business identifier in the United Kingdom, while the second claimed a trade name or business identifier in Germany. The Complainant's documentation was presented to the Validation Agent on March 22, 2006 in the case of <qosmio.eu> and on April 11, 2006 in the case of <regza.eu>. In both instances this was before the deadline for doing so. However the Validation Agent rejected both applications on the grounds that in neither case did the documents establish that the Applicant was the holder of a trade name or business identifier in, respectively, the UK or Germany.

The Complainant argued that it had applied for several other domain names all of which had been accepted and he could not understand why these two had been refused. He pointed out that both REGZA and QOSMIO are well-known Toshiba brands for, respectively, a flat screen television and a computer notebook. Both names had also been registered as domain names in numerous other jurisdictions.

EURid ("the Respondent") argued that the onus is on an applicant to demonstrate that he is the owner of a prior right claimed in an application during the Sunrise Period and, because the Complainant had not so demonstrated, the applications were correctly refused. The Respondent quoted from a number of ADR Decisions which, it claimed, backed up and confirmed that this decision was correct.

A. COMPLAINANT

Toshiba of Europe Limited ("the Complainant") contended that the words 'qosmio' and 'regza' are its product brand names, specifically created by it, and used in Europe and globally. It stated, in the Complaint, that "Evidence can be seen in the various press, TV advertisements, online regional and national websites etc." It complained that although the applications to register the domain names <qosmio.eu> and <regza.eu> had been submitted at the same time as applications for other Toshiba product names, these two applications were rejected, but the applications for other product names were accepted.

The Complainant then set out in the Complaint the texts of the two rejecting e-mails from EURid and of two others in which

the domain name <portege.eu> and <tecra.eu> were accepted.

The Complainant contended that all of these four names are Toshiba inventions. Regza is a widely known Toshiba brand name, while Portege, Tecra, Qosmio are all also widely known as Toshiba computer brand names. No other parties could have a claim to the two disputed domain names. The Complainant then referred to the websites where information relating to the products ‘Qosmio’ and ‘Regza’ can be found. The Complainant also listed a great many other domain names in numerous countries all containing the names ‘Qosmio’ and ‘Regza’

In an Amended Complaint, the Complainant made the following additional point: “'qosmio' and 'regza' are Toshiba product brand names with Trademarks in the EU region.”

B. RESPONDENT

The Respondent stated that Toshiba of Europe Ltd. ("the Complainant") had applied for the domain names REGZA and QOSMIO, and that both had been refused.

(a) REGZA
The Complainant applied for this domain name on March 16, 2006, claiming as a prior right a trade name or business identifier protected in the United Kingdom for the name REGZA.

The documentary evidence was received on April 11, 2006, which was before the deadline of April 25, 2006. This consisted of -
- a document entitled "POWER OF ATTORNEY"; and
- documents (advertisements and a press release) showing that the Complainant’s new flat panel television is called REGZA.

According to section 12 (3) of the Sunrise Rules the Complainant should have filed a final judgment or affidavit that would clearly establish that he was the holder of a trade name protected in the United Kingdom but none was submitted.

Based on its review of the documentary evidence received, the Validation Agent found that the Applicant had not clearly established that it was the holder of the claimed prior right and so the Respondent rejected the application.

(b) QOSMIO
The Complainant applied for the domain name QOSMIO on February 14, 2006, claiming as prior right a trade name or business identifier protected in Germany for the name QOSMIO.

The documentary evidence was received on March 22, 2006, which was before the deadline of March 26, 2006. This consisted of -
- a License Declaration for a Registered Trade Mark;
- a print-out from the OHIM database showing that the trademark QOSMIO is registered in the name of Kabushiki Kaisha Toshiba; and
- documents (web advertisements) showing that Toshiba is selling notebooks under the name QOSMIO.

The Applicant did not submit any extract from the official register (pursuant to section 16 (5) of the Sunrise Rules) or any relevant final judgment or affidavit (pursuant to section 12 (3) of the Sunrise Rules) that would establish that the Complainant is trading under the name QOSMIO.

Based on its review of the documentary evidence received, the Validation Agent found that the Applicant had not clearly established that it was the holder of the claimed prior right and so the Respondent rejected the application.

Article 10 (1) of the Regulation states that only the holders of prior rights shall be eligible to apply to register domain names during the period of phased registration.

Article 14 of the Regulation 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.

Section 21.2. of the Sunrise Rules clearly explains 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 and scanned by the processing agent. If a Complainant fails to provide adequate documentary evidence, its application must be rejected.

In other words, the applicant bears the burden of proof to clearly demonstrate that he or she is the holder of the prior right claimed on the name in question, and the Responmdent referred to the following ADR cases: 127 (BPW), 219 (ISL), 294 (COLT), 551 (VIVENDI), 984 (ISABELLA), 843 (STARFISH), 1931 (DIEHL, DIEHLCONTROLS)).

In addition, as the Panel clearly summed up in ADR case 1886 (GBG), "According to the Procedure laid out in the Regulation the relevant question is thus not whether the Complainant is the holder of a prior right, but whether the Complainant demonstrated to the Validation Agent that it is the holder of a prior right. If an applicant fails to submit all documents which show that it is the owner of a prior right the application must be rejected".

The adequate documentary evidence to demonstrate a prior right is defined in the Sunrise Rules, including Annex 1 to the Sunrise Rules, but the Complainant was not able to clearly demonstrate that it is the holder of the claimed prior rights

(a) REGZA
In order to meet its burden of demonstrating its prior right in the Company name / Trade name / Business Identifier REGZA protected in the United Kingdom, the Complainant needed to submit as documentary evidence showing that rights in passing off exist in the United Kingdom for this name. Pursuant to article 14 of the Regulation, section 12.3 of the Sunrise Rules and Annex 1 to the Sunrise Rules, this evidence should at least consist of:
- an affidavit signed by a competent authority, legal practitioner, or professional representative, accompanied by documentation supporting the affidavit, or
- a relevant final judgment by a court or an arbitration decision of an official alternative dispute resolution entity competent in at least one of the member states stating that the name for which a Prior Right is claimed meets the conditions provided for in the law (including relevant court decisions, scholarly works and such conditions as may be mentioned in Annex 1 (if any)) of the relevant member state in relation to the type of Prior Right concerned.

As noted above, only 2 items of documentary evidence were received by the Validation Agent within the deadline and neither of these was an affidavit or a relevant final judgement. They do not provide the necessary proof that the name meets the conditions provided for in the law of passing off in the United Kingdom, so the Validation Agent correctly found that the Complainant did not meet its burden of proof pursuant to article 14 of the Regulation.

Consequently, the Respondent rejected the Complainant's application for the domain name REGZA.

(b) QOSMIO
In order to meet its burden of demonstrating its prior right in the Company name / Trade name / Business Identifier QOSMIO protected in Germany, the Complainant needed to submit the documentary evidence as referred to in Section 16(5) of the Sunrise Rules.

Pursuant to article 14 of the Regulation, section 16.5 of the Sunrise Rules and Annex 1 to the Sunrise Rules, the documentary evidence should at least consist of
- (i) where it is obligatory and/or possible to register the relevant trade name or business identifier in an official register (where such a register exists in the member state where the business is located) inter alia:
an extract from that official register, mentioning the date on which the trade name was registered; and
proof of public use of the trade name or business identifier prior to the date of Application (such as, but not limited to, proof of sales volumes, copies of advertising or promotional materials, invoices on which the trade name or business identifier is mentioned etc., proving public use of the name in the relevant member state);

- (ii) where registration is not obligatory, the Documentary Evidence referred to in Section 12(3).

As noted above, only 3 items of documentary evidence were received by the Validation Agent within the deadline. None of these was an an extract from a German official register (section 16.5 (i)) or any affidavit or relevant final judgement ((section 16.5 (ii)).

Therefore, the Validation Agent correctly found that the Complainant did not meet its burden of proof pursuant to article 14 of the Regulation.

Consequently, the Respondent rejected the Complainant's application.

Conclusion
As the Panel in ADR 219 (ISL) stated: "One could argue that sympathy is overruled by the applicable Regulations serving among other purposes the (cost-effective) functionality of the phased registration and the principles hereof".

In ADR1627 ("PLANETINTERNET"), the Panel agreed with the Panel in ISL and further explained that "the Regulations and the Sunrise Rules were clearly drafted to ensure a fair distribution of .eu domain names during the phased period and if an applicant fails to fulfill its primary obligations, then, even where such failure is due to an oversight or genuine mistake, the application must be rejected by the validation agent".

The Respondent contended that it had correctly decided to reject the Complainant's applications, pursuant to the Regulation. Therefore its decisions in this respect should not be annulled; the domain names REGZA and QOSMIO should not be granted to the Complainant; and the Complaint should be denied.

DISCUSSION AND FINDINGS

The Facts
The Complainant applied for the domain name <qosmio.eu> on February 14, 2006 claiming, as a prior right, a trade name or business identifier in the United Kingdom. The supporting documentation was presented to the Validation Agent on March 22, 2006 which was before the deadline for doing so. The Respondent contended that this consisted of:
- a License Declaration for a Registered Trade Mark;
- a print-out from the OHIM database showing that the trademark QOSMIO is registered in the name of Kabushiki Kaisha Toshiba; and
- documents (web advertisements) showing that Toshiba is selling notebooks under the name QOSMIO.

The Complainant applied for the domain name <regza.eu> on March 16, 2006 claiming, as a prior right, a trade name or business identifier in Germany and presented the relevant documentation to the Validation Agent on April 11, 2006 which was before the deadline for doing so. This consisted of a Power of Attorney and copies of some advertisements and a press release relating to the Complainant’s flat panel television called REGZA.

The Validation Agent rejected both applications on the grounds that in neither case did the documents establish that the Complainant was the holder of a trade name or business identifier in, respectively, the UK or Germany.

The Complainant’s Contentions
The Complainant argued that it had applied for several other domain names all of which had been accepted and he could not understand why these two had been refused. He pointed out that both REGZA and QOSMIO are well-known Toshiba brands for, respectively, a flat screen television and a computer notebook. Both names had also been registered as domain names in numerous other jurisdictions.

The Respondent’s Response
Quoting extensively from Commission Regulation (EC) No 874/2004 of 28 April 2004 ("the Regulation") and the Sunrise Rules, the Respondent argued that the onus is on an applicant to demonstrate that he is the owner of a prior right claimed in

an application during the Sunrise Period and, because the Complainant had not so demonstrated, the applications were correctly refused. The Respondent also referred to a number of ADR Decisions which, it claimed, backed up and confirmed that this decision was correct.

The Legal Position
Article 10 (1) of 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 14 of the Regulation 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 set out in the second, third and fourth paragraphs".

Section 16 (5) of the Sunrise Rules states that: "Unless otherwise provided in Annex 1 hereto, it is sufficient to submit the following Documentary Evidence for trade names and business identifiers referred to in Section 16(2) respectively 16(3):
(i)where it is obligatory and/or possible to register the relevant trade name or business identifier in an official register (where such a register exists in the member state where the business is located):
a. an extract from that official register, mentioning the date on which the trade name was registered; and
b. proof of public use of the trade name or business identifier prior to the date of Application (such as, but not limited to, proof of sales volumes, copies of advertising or promotional materials, invoices on which the trade name or business identifier is mentioned etc., proving public use of the name in the relevant member state);
(ii) where registration is not obligatory, the Documentary Evidence referred to in Section 12(3) hereof. (…)".

Section 12 (3) of the Sunrise Rules states that: "If, under the law of the relevant member state, the existence of the Prior Right claimed is subject to certain conditions relating to the name being famous, well known, publicly or generally known, have a certain reputation, goodwill or use, or the like, the Applicant must furthermore submit
(i) an affidavit signed by a competent authority, legal practitioner, or professional representative, accompanied by documentation supporting the affidavit or
(ii)a relevant final judgment by a court or an arbitration decision of an official alternative dispute resolution entity competent in at least one of the member states
stating that the name for which a Prior Right is claimed meets the conditions provided for in the law (including relevant court decisions, scholarly works and such conditions as may be mentioned in Annex 1 (if any)) of the relevant member state in relation to the type of Prior Right concerned. ".

As far as trade name protection in the United Kingdom is concerned, Annex 1 to the Sunrise Rules states that trade names may serve as prior rights "only to the extent that rights in passing off exist" and requires documentary evidence as referred to in Section 12(3) of the Sunrise Rules (and not the documentary evidence referred to in Section 16 of the Sunrise Rules). Annex 1 finally states that "Where documentary evidence is submitted as referred to in Section 12(3)(i) of the Sunrise Rules, the documentary evidence must enable the Validation Agent to validate the existence of a protected prior right (under the law of Passing Off) on the basis of a prima facie review of the documentation as set out in Section 21(2) of the Sunrise Rules".

As far as trade name protection in the Germany is concerned, Annex 1 to the Sunrise Rules requires "documentary evidence as referred to in Section 16(5) of the Sunrise Rules".

Decision
The Panel sees no reason to disturb the Respondent’s decision to refuse these two domain name applications.

The law is quite clear. If an applicant applies for a domain name during the Sunrise Period he must, within a certain period of time, produce the appropriate documentation to prove his claim to have prior rights in that name. In this case, the

Complainant based his application for <qosmio.eu> on a claim to have rights in the trade name or business identifier 'Qosmio' in the United Kingdom. The application for <regza.eu> was similarly based, but on a claim to have rights in the trade name or business identifier 'Regza' in Germany. According to the Respondent, none of the documentation supplied – in due time – bore any relation to these claims and the Complainant completely failed to prove his claim to have prior rights in the trading names QOSMIO in the United Kingdom or REGZA in Germany.

In the Amended Complaint appear the words: "Evidence has been attached together with the signed documentation and sent by courier 23/10/06." To the Panel these words appeared to imply that this 'evidence' could consist of documents that were different from those received by the Validation Agent and which did prove the Complainant's prior rights. Therefore, in a Nonstandard Communication, he called for copies of this 'evidence'. On January 2, 2007, copies of the following were received from the Complainant –

A Licence Declaration between K. K. Toshiba and Toshiba of Europe Ltd authorizing the latter to use the CTM 3876009 QOSMIO.

A copy of the entry in the Register of the CTM QOSMIO No. 3876009.

A Powre (sic) of Attorney signed by Mr. Taisuke Kato, the General Manager of the Intellectual Property Division of Toshiba Corporation authorizing Mr. Takahiro Ishii to act on behalf of Toshiba Corporation in the registration of the domain names QOSMIO, TECRA, PORTÉGÉ, SATELLITE and LIBRETTO.

A Press Release dated February 21, 2006 relating to the unveiling of REGZA as the new brand name for Toshiba's Flat Panel television.

As can be seen, these are not exactly the same as the documentation which the Respondent claims was received by the Validation Agent, but nevertheless they still do nothing to reinforce the Complainant's original claim to have prior rights in QOSMIO and REGZA as trade or business names.

There is no doubt that these two names do belong to the Complainant. They are applied to products produced and sold by the Complainant but that in itself is not sufficient for him to automatically be granted rights to the corresponding domain names in the .eu domain during the Sunrise Period. It would do, now that this period is over, but the whole raison d'etre of the Sunrise Period was to give the owners of earlier rights an advantage over any cybersquatter who might wish to register someone else's legitimate name. In return he only had to prove that he was the owner of one of several types of prior right set out in Article 10 of the Regulation.

We can only speculate as to whether, perhaps, the Complainant in this case made mistakes when completing the necessary application forms and so claimed the wrong prior right. But the fact remains that he claimed prior rights in QOSMIO and REGZA as trade or business names and failed to prove it. Therefore the Complaint fails.

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	**David Tatham**

DATE OF PANEL DECISION 2007-01-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant (Toshiba of Europe Ltd) filed a Complaint against the decision by the Respondent (EURid) to reject its applications for the two domain names: <qosmio.eu>, and <regza.eu>. The rejection was based upon the fact that the documentation supplied by the Complainant did not prove the prior rights which it had claimed for both marks, namely trade names or business identifiers in the United Kingdom (Qosmio) and Germany (Regza).

The Complainant did not attempt to argue that the two names were in fact business names, it merely stated that they were both his brand names – for a flat screen television set (REGZA) and for a notebook computer (QOSMIO).

The Respondent argued that the onus is on an applicant to demonstrate that he is the owner of a prior right claimed in an application during the Sunrise Period and, because the Complainant had not so demonstrated, the applications were correctly refused.

The Panel called for copies of the evidence supplied by the Complainant and, having examined this, concluded that the Complainant had not proved his case, that the domain name applications had correctly been refused, and so the Complaint should be rejected.