Panel Decision for dispute CAC-ADREU-003400

Case number	**CAC-ADREU-003400**
Time of filing	**2006-11-09 14:12:00**
Domain names	**sexandsubmission.eu, fuckingmachines.eu, devicebondage.eu, free-hardcore.eu, kinkcinema.eu, kinkgirls.eu, latexbondage.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**CNE Data International, BV, Peter Acworth**

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

NONE

FACTUAL BACKGROUND

The Complainant filed applications for registrations (the “Applications”) of the .eu domain names: sexandsubmission.eu (20/9/2006), fuckingmachines.eu (27/9/2006), devicebondage.eu (29/9/2006), free-hardcore.eu (27/9/2006), kinkcinema.eu (20/9/2006), kinkgirls.eu (20/9/2006), latexbondage.eu (29/9/2006), wiredpenis.eu (12/9/2006), (the “Domain Names”).

The Applications included extracts from the trade name database of the Dutch Chamber of Commerce.

The Respondent rejected the Applications (the “Decision”) because the documentary evidence provided by the Complainant was considered insufficient to establish the prior right of the applicant to the Domain Names within the meaning of Article 10(1) of the .eu Sunrise Rules (the “Sunrise Rules”).

On 21 November 2006, the Complainant filed this Complaint against the Decision seeking an annulment of the Decision and requesting that the Domain Names must be granted to the Complainant. These proceedings were formally commenced on 9 January 2007.

A. COMPLAINANT

The Complainant contends the following:

(a) It has a prior right according to Article 10(1) of the Commission Regulation 874/2004 (the “Regulation”) because the Complainant had registered names that correspond to the Domain Names at the Dutch Chamber of Commerce and that under Article 6:162 of the Dutch Civil Code, such names would be protected under the law of tort or unfair competition. In addition, the names “sexandsubmission”, “free-hardcore”, “kinkgirls” and “fuckingmachines” had been used by the Complainant on the world wide web for many years under the top level domain “.com”. As such the Complainant was eligible to apply for the Domain Names and should have thus benefited from the Sunrise Registration period.

(b) Article 10(1) provides that prior rights can include unregistered trade marks, trade names, business identifiers, company names and distinctive titles to protected literary and artistic works.

(c) It provided extracts from various .com websites in respect of the claim that such names had been used by it under the .com domain, the Complainant also provided extracts taken from the Dutch Handelsregister demonstrating registration of the names at the Dutch of

Chamber of Commerce.

(d) It further claims that it is in the process of using the Madrid Protocol to seek trade mark registrations in multiple European Union nations. However, no evidence of this is provided.

(e) It applied for the Domain Names under the name of its principal shareholder and its president Mr Peter Acworth.

(f) It states that there is no justification for a denial of the Applications due to hyper-technical reasons.

(g) Although it placed the name of one of its directors, Peter Thomas Acworth in the application for the domain, it was clear, along with the documents provided, that CNE Data International B.V. was the actual applicant and that the trade names were reserved to that corporation. It would have been a very simple matter for the validation agent to test this issue. The validation agent could either have relied upon the submitted materials or conducted a simple internet search that would show that the actual owner of the trade names at the Dutch Chamber of Commerce was in fact the Complainant.

(h) The Sunrise Rules grant the validation agent discretion to undertake its own investigation. The validation agent could have resolved any doubts itself by conducting minor research and/or contacting the Complainant.

(i) The lack of an immediate and perfect match between the documentary evidence and the details of a domain name application should not have been a sufficient excuse to reject the Applications. Holders of prior rights should not be denied such applications, particularly since such denial would leave the owners of prior rights subject to the whims of cybersquatters, of which the Complainant has already been a victim.

(j) The Registry cannot dispute that the Complainant is the owner of the trade names applied as .eu domains. Accordingly, the Complainant not only has a right to these Domain Names, but has a right that is superior to any or all comers who may seek registration at a later date.

(k) Even if the Registry acted properly in denying the Complainant the Domain Names the Panel is empowered to enforce the Sunrise Rules, and to enforce Regulation EC No. 733/2002 which demands that owners of a prior right should have the ability to register domain names consistent with those prior rights.

(l) The Applications should be examined in the light of the circumstances described above, the Decision should be annulled and the Domain Names should be granted to the Complainant.

B. RESPONDENT

The Respondent contends as follows:
(a) The applicant for the Domain Names is Peter Acworth. The owner of the prior rights that were submitted as documentary evidence is CNE Data International BV.

(b) The burden of proof is with an applicant to show that it is a holder of a prior right. 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 Sunrise Registration Period.

(c) Pursuant to Article 14 of the Regulation every applicant shall submit documentary evidence that shows he or she is the holder of the prior right claimed of the name in question. Based upon this evidence, the validation agent shall examine whether the applicant has prior rights on the name, and as clearly indicated in the 12th Recital of the Regulation which states that “on the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name”.

(d) The burden of proof is therefore on the applicant to substantiate that it is the holder of a prior right. The relevant question is thus not whether the Complainant is a holder of the prior right, but whether the Complainant demonstrates 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.

(e) 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.

(f) 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 which was rejected during the Sunrise Registration Period.

(g) The new documents attached to the Complaint relating to the .com domain names were not received by the validation agent as part of the documentary evidence for the Applications, 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.

(h) A request for the application of a domain name made during the Sunrise Registration Period must contain the information listed in Section 3(1) of the Sunrise Rules. The request form contains various fields. Two of these fields are important in the case at hand, the field "name" and the field "organisation". Filling in these fields is of great importance with regard to the qualification of "applicant". In order to facilitate communication with a company which is the registrant of a domain name, a contact person may be provided. The natural person/department who is mentioned in the "name" field will be considered as the contact person within the company. The actual applicant however, will not be the natural person (department) who submitted the request form, but the company. Section 3(1)(i) of the Sunrise Rules state that: "where no name of a company or organisation is specified, the individual requesting registration of the Domain Name is considered the Applicant; if a name of the company or the organisation is specified then the company or organisation is considered the applicant". The Respondent attaches an example of the application of this rule that shows that in respect of the eurid.eu domain name the contact person is Mr Mark Van Wesemael, whereas the Registrant is EURid vzw.

(i) The effect of this is that Peter Acworth was considered the applicant for the disputed Domain Names not CNE Data International, B.V.

(j) For the reasons stated above the Complaint must be rejected.

DISCUSSION AND FINDINGS

The principal issues in this Complaint are as follows:

(a) The Complainant made an error in the application process for the Domain Names in that it failed to correctly insert the name of the holder of the prior rights in the correct field in the application form. Instead, it inserted the contact name at the organisation as the applicant. Such individual, Mr Peter Acworth, did not on the face of the documents provided have any apparent prior rights to the Domain Names.

(b) The information provided at the time the application for registration was submitted did not include all the documents that were submitted to the Panel in this Complaint. The documents that were submitted namely the Dutch Chamber of Commerce database entries demonstrated that the company CNE Data International B.V. had registered the names that corresponded to the Domain Names at the Dutch Chamber of Commerce. The Complainant contends that this is sufficient to establish a prior right whereas the Respondent contends that under Dutch law registration at the Dutch Chamber of Commerce alone is not sufficient to establish such prior right.

The Panel has considered both these issues in turn:

(a) Article 14 of the Regulation is clear in that the applicant for a domain name during the Sunrise Registration Period is required to submit "documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question". The question therefore to be decided is to what extent the validation agent was under a duty to investigate why such an apparent discrepancy existed and to what extent it was obliged to check whether the documents submitted were correct. The Complainant indicates that a simple internet check would have revealed that the holder of the prior right was the Complainant. However, the Respondent contends that the burden of proof is upon the applicant to demonstrate that it is the holder of the prior right and that it is not the duty of the validation agent to speculate as to the identity of the correct applicant. Further, these proceedings should not serve as a second chance or an additional round providing an option to remedy an imperfect original application that was rejected during the Sunrise Registration Period. Under Section 21(1) of the Sunrise Rules the validation agent and the registry are not obliged to notify the Complainant where the requirements for proving the existence of the prior right to the name have not been complied with. In the circumstances, the Panel finds that the validation agent was under no duty to request further documentation from the applicant or to speculate as to the correct identity of the applicant. It was therefore reasonable for the validation agent to conclude that the documentary evidence supplied by the applicant did not establish a prior right under the Regulation or Sunrise Rules. As such the validation agent was under no obligation to investigate the correct identity of the owner of the prior right.

(b) Given the conclusion reached in paragraph (a) above it is not necessary for the Panel to consider whether the documentation provided by the applicant was sufficient to establish a prior right under the Sunrise Rules. However, since the issue has been raised and been the subject of argument in these proceedings, the Panel will consider the issue. Firstly, the Panel notes that the Domain Names in

question are in some respects sexually explicit words and phrases. A considerable body of law has developed in the United Kingdom regarding the extent to which rights can be conferred on marks of this type. It is, however, accepted that certain jurisdictions may adopt a more relaxed attitude to such issues. The Panel is, however obliged to consider the evidence, and only the evidence submitted at the time of the application for the Domain Names. In this case the only evidence that was supplied was the evidence of registration of such names at the Dutch Chamber of Commerce. It is the Panel's view that this documentation alone does not provide sufficient evidence of the existence of an unregistered prior right in the Domain Names as claimed by the Complainant. The mere registration of such names does not demonstrate use in itself nor does it demonstrate that there is any trading goodwill in such names. Such evidence is admissible in order to help make out a case that there is use of the names or existence of trading goodwill, however, more information is required in order to make out that case. In these circumstances, notwithstanding the discrepancy between the identity of applicant and Complainant, the Panel considers that the Complainant is not entitled to the registration of the Domain Names in accordance with the Sunrise Procedure.

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	Simon Bennett

DATE OF PANEL DECISION 2007-02-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant applied during the Sunrise Registration Period for the Domain Names on sexandsubmission.eu (20/9/2006), fuckingmachines.eu (27/9/2006), devicebondage.eu (29/9/2006), free-hardcore.eu (27/9/2006), kinkcinema.eu (20/9/2006), kinkgirls.eu (20/9/2006), latexbondage.eu (29/9/2006), wiredpenis.eu (12/9/2006), (the "Domain Names"). The Applications were rejected due to the fact that the documentary evidence provided by the Complainant was considered insufficient to establish a prior right namely:

(a) the name of the Applicant was different from the evidence provided of the holder of the prior right; and

(b) the evidence of the prior right was not sufficient to demonstrate that such a prior right existed. The Complainant submitted with its Complaint new documents demonstrating that it had the prior rights. These documents did not form part of the original documentary evidence submitted during the Sunrise Period.

The Panel rules as follows:-
The Complainant failed to demonstrate that it was a holder of the prior right because it did not submit documents proving that it was the owner of the prior right and it was required to do so under Section 13 of the Sunrise Rules. It was therefore, not entitled to take advantage of the Sunrise Registration procedure. The Complainant submitted that the validation agent was under a duty to request further documents from the Complainant or investigate the reasons why the documentary evidence was efficient. However, the Panel found that under Section 21(1) of the Sunrise Rules the validation agent and the Registry are not obliged to notify the Complainant where the requirements for proving the existence of the prior right to the name have not been complied with.
In the circumstances, the Panel dismisses the Complaint.