Panel Decision for dispute CAC-ADREU-003406

Case number	**CAC-ADREU-003406**
Time of filing	**2006-10-23 11:28:13**
Domain names	**metaphor.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**Metaphor Limited, Mr Stephen Greenberg**

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 Panel is aware that are pending or decided and that relate to the Disputed Decision or the Disputed Domain Name.

FACTUAL BACKGROUND

1. On 2006, 9th February, Metaphor Limited (hereinafter, also, “Metaphor”) applied for registration of the domain name “METAPHOR” (hereinafter, also, the “Disputed domain name”), claiming as prior right a company name, trade name or business identifier protected in the United Kingdom, for the name “METAPHOR”.
2. The Validation Agent received the documentary evidence on 2006, 27th February, which was before the deadline (2006, 21st March). The Applicant submitted documentary evidence consisting of a certificate of incorporation dated 2000, 10th November, and stating that "METAPHOR LIMITED" is incorporated as a private limited company under the Companies Act 1985.
3. On the ground of the documentary evidence received, the Validation Agent found that the Applicant did not clearly establish that it was the holder of the claimed prior right: in fact, the Applicant did not submit any relevant final judgment or affidavit that would clearly establish that it is the holder of a trade name, company name or business identifier protected in the United Kingdom and that rights in passing off exist.
4. Based on Validation Agent’s review, EURID rejected the Applicant's application (Decision n. 2854102721801560, dated 2006, 14th September).
[Information sub 1, 2, 3 and 4 are included – only – in the Response]
5. On 2006, 20th October, Metaphor Limited (hereinafter, also, the “Complainant”) filed a Complaint before this Czech Arbitration Court (hereinafter, also, the “Court”). The Complaint was related to the domain names: “METAPHOR”. The Complainant intends to challenge EURID’s Decision about the above mentioned Domain Name, in order to obtain the registration on its behalf.
6. The Complainant attached to the Complaint copy of the following documents:
1. Metaphor Company registration;
2. Metaphor invoice as proof of activity;
3. Metaphor cover letter from EURID;
4. Metaphor Company Brochure.
7. The Court acknowledged Complaint’s receipt on 2006, 23rd October. The Court notified EURID on the Complaint and its time of filing.
8. The Court asked EURID for some information for verification of the Complaint’s administrative compliance. On 2006, 27th October, EURID answered to the request with a Non-standard Communication, pointing out some deficiencies. EURID also attached documentary evidence related to the Disputed Domain Name (EURID’s cover letter – signed by Stephen Greenberg on behalf of the Complainant - n. 2854102721801560).
9. On 2006, 30th October, the Court checked the Complaint and notified to the Complainant its deficiencies, on the basis of EURID’s Verification: in particular, it has not been “identified the correct Registrar”.

10. On 2006. 2nd November, Metaphor filed an amended Complaint, that was checked by the Court on 2006, 9th November.
11. On 2006, 9th November, EURID has been notified on the formal date of the commencement of the ADR Proceeding (2006, 9th November) and it has been invited to submit a Response within 30 working days from the delivering of the notification. It has been also advised of the consequences in case the Response would not have been sent within the deadline or if it would not have complied with all administrative requirements mentioned in the ADR Rules and the ADR Supplemental Rules.
12. On 2006, 21st December, EURID filed the Response to the Complaint asking for its rejection. On 2006, 27th December, the Court acknowledged the receipt of the Response and checked the Response.
13. On 2006, 28th December, the Court appointed as Panelist Luis de Larramendi, who declined to serve as a Panelist in the present case (2006, 28th December).
14. On 2006, 29th December the Court appointed this Panel (Marco Vincenti), who accepted to serve as a Panel under .eu Dispute Resolution Rules and Supplemental Rules of the Court (2006, 29th December).
14. On 2006, 29th December, the Court notified to the parties that this Panel had been appointed and that he had submitted the Statement of Acceptance and Declaration of Independence and Impartiality.
15. The Case File was transmitted to the Panel on 2007, 3rd January.
16. The Panel was required to forward his decision within 2007, 21st January.

A. COMPLAINANT

In support of its position, Complainant contests as follows.
In particular, it asserts that, according to EU Rules and Regulations, it had submitted proof of its company name in the form of a copy of its Certificate of Incorporation from the Registrar of Companies for England and Wales as indicated in Section 16 (4ii) of the .eu Sunrise Rules.
It was incorrect EURID' rejection of the application on the grounds that the documentary evidence provided did not sufficiently prove the right claimed: in fact, the Complainant, making clear that "it is a registered company in England and Wales, part of the EU, since 2000 and has been practicing in the Great Britain and the EU since 2001", deems to have submitted sufficient proof of this: company registration (Annex 1), invoice (Annex 2), company brochure (Annex 4).
Without taking into consideration those rules, the Complainant asserts that EURID (the Registry) incorrectly rejected the application on the grounds that the documentary evidence provided did not sufficiently prove the right claimed.
Finally, the Complainant asks for:
- "the annulment of the disputed decision taken by EURID (the Registry) not to attribute the metaphor.eu domain to Metaphor Limited during the Sunrise phase",
- "the attribution of the metaphor.eu domain to Metaphor Limited under its prior right under the category Company name / Tradename / Business Identifiers as stipulated in the .eu Sunrise Rules".

B. RESPONDENT

In support of its position, Respondent contests as follows.
Respondent pointed out that it was correct to reject Metaphor's application as far as "METAPHOR" Domain Name is concerned, on the basis of Validation Agent's examination and Applicant's documentary evidence submitted.
In fact, the Complainant applied for the domain name Metaphor on 9 February 2006, claiming as prior right a company name, trade name or business identifier protected in the United Kingdom for the name "METAPHOR".
The Validation Agent received the documentary evidence on 27 February 2006, which was before the 21 March 2006 deadline.
The Applicant submitted documentary evidence consisting of a certificate of incorporation dated 10 November 2000 and stating that "METAPHOR LIMITED" is incorporated under the Companies Act 1985 as a private limited company (Annex 1 to the Complaint).
The Respondent asserts that Applicant did not submit any relevant final judgment or affidavit that would clearly establish that the Complainant is the holder of a trade name, company name or business identifier protected in the United Kingdom and that rights in passing off exist.
On the base of the review of the documentary evidence received, the Validation Agent found that the Applicant did not clearly establish that it was the holder of the claimed prior right.
As consequence, the Respondent rejected the Applicant's application [Decision 2006, 14th September (2854102721801560)].
As far as Complaint is concerned, Respondent contests as follows.
In particular, the Complainant didn't provide sufficient documentary evidence to establish the claimed prior right, submitting a certificate of incorporation: it is incorrect reference to section 16 (4.ii.) of the Sunrise Rules.
As Complainant claimed a prior right in the form of a Company name / Trade name / Business Identifiers protected in the United Kingdom, it would have born the burden of submitting documentary evidence that shows that it is the holder of those claimed prior rights, pursuant to article 14 of the Regulation.
Respondent asserts that "Section 16 (4) of the Sunrise Rules is not applicable to company names in all Member States. The laws in the various Members States differ and, therefore, the conditions under which prior rights are recognised or established by national law

pursuant to article 10 (1) of the Regulation also differ".
It is necessary to make reference to Annex 1 to the Sunrise Rules, that takes into account the differences between the laws recognizing or establishing prior rights: in particular, as far as United Kingdom is concerned, it is established that "trade names, company names or business identifiers may serve as prior rights "only to the extent that rights in passing off exist".
According to these considerations, "the rights in passing off may not be demonstrated merely by the certificate of incorporation": the Respondent asserts that "Annex 1 (to the Sunrise Rules) 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)".
As the Complainant did not submit any relevant final judgment or affidavit that would clearly establish that the it is the holder of a trade name, company name or business identifier protected in the United Kingdom by rights in passing off, pursuant to section 12.3 of the Sunrise Rules, therefore, the Validation Agent correctly found that the Applicant did not meet its burden of proof pursuant to article 14 of the Regulation.
As consequence, the Respondent correctly rejected the Complainant's application for the domain name METAPHOR pursuant to the Regulation, because the domain name METAPHOR may not be attributed to the Complainant.
The Respondent makes reference to Case n. 127 (BPW), n. 219 (ISL), n. 294 (COLT), n. 551 (VIVENDI), n. 984 (ISABELLA), n. 843 (STARFISH), n. 1931 (DIEHL, DIEHLCONTROLS), n. 370 (KANE) and n. 1674 (EBAGS), as precedents as far Applicant's burden to clearly demonstrate that he or she is the holder of the prior right claimed on the name in question; and to Case n. 2957 (GAYROMEO), as far as the compliance of the documentary evidence submitted with the specific requirements of the Sunrise Rules and Annex 1 to the Sunrise Rules for the protection in the specific country where a prior right was claimed.

DISCUSSION AND FINDINGS

First of all, this Panel has to observe, that it is not submitted by the Complainant copy of the EURID's decision to be annulled.
It can also be useful to remind rules that can be applied to the case at issue.
Pursuant to art. 10.1 Reg. (CE) 874/2004, "Holders of prior rights recognised or established by national and/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."; in particular, 'Prior rights' shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.". And par. 2 of the same article 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.".

As far as validation and registration of application received during the phased registration are concerned, art. 14.1 Reg. (CE) 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."; and art. 14.4 Reg. (CE) 874/2004 states: "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 documentary evidence shall be submitted to a validation agent indicated by the Registry. 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. If the documentary evidence has not been received by this deadline, the application for the domain name shall be rejected.". Art. 14.7 (final part) Reg. (CE) 874/2004 states that: "If (…) the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this.".
Pursuant to Section 3.1 par. 1 Sunrise Rules, as far as an Application to be considered complete, it has to include, inter alia: "(…) the Domain Name applied for [point (v)], (…) the complete name for which a Prior right is claimed [point (vii)]; the type of Prior Right claimed by the Applicant, as referred to in Article 10(1), second paragraph, of the Public Policy Rules [point (viii)]; the country in which the Prior Right claimed is protected [point (ix)]". In particular, information ex points (viii) and (ix) are deemed "to constitute the legal basis in national or Community law for the claimed Prior Right to the name" (ex Section 3.1, par. 2 Sunrise Rules). It is important to consider Section 3.2 Sunrise Rules: "The Domain Name applied must consist of the complete name for which a Prior Right is claimed, however taking into account (i) Article 11 of the Public Policy Rules, and (ii) Section 19 hereof.".
In particular, Section 19.1 Sun rise Rules states that: "(…) registration of a Domain Name on the basis of a Prior Right consists in the registration of the complete name for which the Prior Right exists, as manifested by the Documentary Evidence. It is not possible for an Applicant to obtain registration of a Domain Name comprising part of the complete name for which the Prior Right exists.", and art. 19.2 – as far as documentary evidence is concerned, states that: "Documentary Evidence must clearly depict the name for which a Prior Right is claimed." Section 19.4 Sunrise Rules states that: "For trade names, company names and business identifiers, the company type (such as, but not limited to, "SA", "GmbH", "Ltd.", or "LLP") may be omitted from the complete name for which the Prior Right exists.".
In the case at issue, this Panel observes that the prior right refers to "METAPHOR LIMITED" and the application refers to the Domain Name "METAPHOR". This particular could not be considered an obstacle, as stated also in other ADR proceedings [for example, case n. 03153 (PREMIERPRODUCTS)].
Pursuant to Section 16.1 (par. 2) Sunrise Rules, "If an Applicant claims a Prior Right to a name on the basis of a company name protected under the law of one of the member states mentioned in Annex 1 as being a member state protecting company names, it is

sufficient to prove the existence of such Prior Right in accordance with Section 16(4) below.”.
Pursuant to Section 16.2 Sunrise Rules, “Since trade names are protected in all member states of the European Union, it is sufficient to provide the Validation Agent with the Documentary Evidence referred to in Section 16.5 below”.
Pursuant to Section 16.3 Sunrise Rules, “If an Applicant claims a Prior Right to a name on the basis of a business identifier protected under the law of one of the member states mentioned in Annex 1 as being a member state protecting such business identifier, it is sufficient to prove the existence of such Prior Right in accordance with Section 16(5) below.”.
As far as documentary evidence for Company names is concerned, Section 16.4 Sunrise Rules states that:
“Unless otherwise provided in Annex 1 hereto, it shall be sufficient to submit the following Documentary Evidence for company names referred to under Section 16(1):
- (i) an extract from the relevant companies or commercial register;
- (ii) a certificate of incorporation or copy of a published notice of the incorporation or change of name of the company in the official journal or government gazette; or
- (iii) a signed declaration (e.g. a certificate of good standing) from an official companies or commercial register, a competent public authority or a notary public.
Such Documentary Evidence must clearly indicate that the name for which the Prior Right is claimed is the official company name, or one of the official company names of the Applicant.”.
As far as documentary evidence for Trade Names and Business Identifiers is concerned, Section 16.5 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.
The Documentary Evidence for a trade name or a business identifier must clearly indicate that the name for which the Prior Right is claimed is the trade name or business identifier of the Applicant.”.
As far as Documentary Evidence’s General Substantive Requirements are concerned, Section 12 Sunrise Rules states: “ Unless otherwise provided under Sections 13 to 18 of these Sunrise Rules, the Applicant must submit Documentary Evidence containing:
(i) an affidavit signed by a competent authority, legal practitioner or professional representative declaring that the type of Prior Right claimed by the Applicant is protected under the laws of the relevant member state, including:
a. references to the relevant legal provisions, scholarly works and court decisions and
b. the conditions required for such protection; and
(ii) proof that the complete name for which a Prior Right is claimed meets all of the conditions set forth in such laws, including the relevant scholarly works and court decisions, and that such name is protected by the relevant Prior Right claimed.
2. It is in any case sufficient to submit a copy of 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 Applicant has protection for the complete name for which a Prior Right is claimed.
3. 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.
4. Any affidavit submitted in accordance with this Chapter must clearly state or include evidence that the signatory qualifies as a competent authority, legal practitioner or professional representative, as referred to in the foregoing paragraphs of this Section.”.
As far as United Kingdom is concerned, Annex 1 to Sunrise Rules states that:
- if the prior right is a “Trade Name”, the protection is acknowledged “only to the extent that rights in passing off exist”; as documentary evidence, it is requested the “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)”; as Additional Conditions and / or remarks, it is specified 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.”.

- if the prior right is a “Business Identifier”, the protection is acknowledged “only to the extent that rights in passing off exist”; as documentary evidence, it is requested the “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)”; as Additional Conditions and / or remarks, it is specified 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.”.
- if the prior right is a “Company Name”, the protection is acknowledged “only to the extent that rights in passing off exist”; as documentary evidence, it is requested the “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)”; as Additional Conditions and / or remarks, it is specified 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.”.
On the basis of all the above mentioned rules and documentary evidence submitted by the Complainant, this Panel has to observe:
- as far as Annex 1 to the Complaint:
o it certifies that “METAPHOR LIMITED” is “incorporated” as a “private limited company”,
o it is dated 2000, 10th November.
According to Section 11.3 Sunrise rules, “The Applicant must be the holder (or licensee, where applicable) of the Prior Right claimed no later than the date on which the Application is received by the Registry, on which date the Prior Right must be valid, which means that it must be in full force and effect.”.
Annex 1 to the Complaint does not prove that the prior right is valid on the date which the Application is received.
- Furthermore, in any case, documentary evidence submitted by the Complainant is not sufficient regarding what it is established by the above mentioned rules (Annex 1 Sunrise rules – as far as provisions about United Kingdom; 12.3 Sunrise rules).
This Panel agrees with what is stated in CASE n. 02957 (GAYROMEO), as far as valid proof of the existence of the prior right is concerned.
It can also be useful to refer to:
- case n. 127 (BPW), n. 219 (ISL), n. 294 (COLT), n. 331 (VIVENDI), n. 984 (ISABELLA), n. 843 (STARFISCH), n. 1931 (DIEHL, DIEHLCONTROLS), n. 1886 (GBG), n. 910 (REIFEN), as far as burden of proof (on the Applicant / Complainant) is concerned,
- case n. 2268 (EBSOFT), n. 2455 (TRAVEHORIZON). n. 3366 (CIAO),
- case n. 3226 (CARAVANCLUB - submitted material did not establish the claimed prior right, the company name - trademark registration extracts insufficient proof of the existence of the company name - certificate of incorporation submitted at later stage is to be considered inadmissible),
- case n. 3281 (QOSMIO, REGZA) and n. 1886 (GBG), that states that: "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 (…).”.

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	**Marco Vincenti**

DATE OF PANEL DECISION 2007-01-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

An U.K. firm (Metaphor Limited) applied for the Domain Name “METAPHOR”, claiming as prior right “a company name, trade name or business identifier” and submitting, as documentary evidence, a certificate of incorporation stating that “METAPHOR LIMITED” is incorporated as a private limited company under the Companies Act 1985.
Because the Applicant didn’t submit any relevant final judgment or affidavit that would clearly establish that it is the holder of the trade name, company name or business identifier protected in the U.K. and that right in passing off exists, the Validation Agent found that the Applicant did not clearly establish that it was the holder of the claimed prior right. Based on this review, EURID rejected the Application.
The Applicant filed a Complaint, asking for the annulment of EURID’s Decision and the attribution of the domain name on the base of the prior right Company name / Trade Name / Business Identifiers.
The Complaint didn’t respect its burden of proof, because it submitted only a certificate of incorporation, dated 2000, 10th November,

that doesn’t prove that it is the holder of the prior right at the time of the Application is submitted (as required by par 11.3 Sunrise Rules). In any case, documentary evidence submitted does not respect requirements ex Annex 1 and Sunrise rules (in particular, par. 12.3). EURID’s Decision does not conflict with pertinent rules: as consequence, the Panel denies the Compliant.