Panel Decision for dispute CAC-ADREU-003514

Case number	CAC-ADREU-003514
Time of filing	2006-10-26 12:16:22
Domain names	netcards.eu

Case administrator

Name	Tomáš Paulík

Complainant

Organization / Name	COURNOT ASSOCIATION D'AVOCATS, breban yann

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 in relation to the disputed domain name <netcards.eu>.

FACTUAL BACKGROUND

The Complainant, GIE GESAM-VITALE (the Complainant's representative Cournot Assocition D'Avocats, Breban Yann, has been mistakenly inserted in the Complaint as the Complainant but the Panel has decided to ignore this minor formal error and consider GIE SESAM-VITALE as the true Complainant), has requested annulment of the decision made by the Respondent, EURid, regarding the domain name <netcards.eu>. The Complainant has further requested the disputed domain name to be attributed to the Complainant.

The disputed domain name <netcards.eu> was applied by the Complainant during the second phase of the phased registration period, i.e. the Sunrise II period, on 14 March 2006. In the application the Complainant claimed prior right to the name NETC@RDS protected in France. The type of the prior right was marked as "Other" in the application.

The Complainant submitted documentary evidence to the validation agent timely within the 40 day deadline given.

The Respondent refused the Complainant's application on grounds that the documentary evidence was not sufficient to prove that the Complainant (i.e. the Applicant) was the holder of the claimed prior right.

The Complaint was first filed on 26 October 2006 and upon the request by ADR Centre later filed in English. The formal date of the commencement of the ADR proceedings is 13 November 2006.

The Respondent filed a response to the Complaint on 28 November 2006.

A. COMPLAINANT

The Complainant has made the following contentions:

GIE SESAM-VITALE is the European Coordinator of a specific project called "Demonstrators of Smart Cards and Network Solutions for European Health Insurance Card Electronification- Netcards". The project is governed by the European Commission.

Within the scope of the afore-mentioned project, GIE SESAM-VITALE has filed an application for the domain name <netcards.eu>.

The application has been made in a non-profit making purpose and it is in the general interest of the European community at large. The registration of the domain name <netcards.eu> for GIE SESAM-VITALE is a high priority for the protection of this project and the

European community at large.

B. RESPONDENT

The Respondent has made the following contentions:

“1. GROUNDS ON WHICH THE RESPONDENT REJECTED THE APPLICATION BY GIE SESAM-VITALE FOR THE DOMAIN NAME NETCARDS

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 (1) of the Regulation further states that “‘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.”.

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".

GIE SESAM-VITALE (hereafter "the Complainant") applied for the domain name NETCARDS on 14 March 2006, claiming a prior right on the name "NETC@RDS" protected in France.

The processing agent received the documentary evidence on 10 April 2006, which was before the 23 April 2006 deadline.

The Complainant submitted documentary evidence consisting of :
- a grant agreement under the eTen program from the European Commission for a project of market validation entitled "Netc@rds for eEHIC - Demonstrators of Smart Cards and Network Solutions for European Health Insurance Card Electronotification";
- amendments to this grant agreement;
- an agreement establishing an economic interest grouping: GIE SESAM-VITALE (the Complainant).

Based on its 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.

Therefore, the Respondent rejected the Applicant's application.

2. COMPLAINANT'S CONTENTIONS

The Complainant explains that it is the coordinator of the project, known as " Demonstrators of Smart Cards and Network Solutions for European Health Insurance Card Electronification- Netcards".

Then, the Complainant explains that it applied for the domain name NETCARDS within the scope of this project and that the registration of the domain name has a non profit making purpose and is in the general interest of the European community at large.

The Complainant requires the Panel to attribute the domain name to the Complainant.

3. RESPONSE

Article 10 (1) of the Regulation makes it clear that only holders of prior rights which are recognised or established by national or Community law or public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.

Therefore, there are only two ways to be eligible to apply for a domain name during the sunrise period:
- being a public body and registering a domain name pursuant to Article 10.3 of the Regulation; or

- being the holder of a prior right and demonstrating a prior right pursuant to Article 14 of the Regulation.

The Complainant does not fall in any of those categories.

First, the Complainant is not a public body in the meaning of Article 10 (1) Nothing in the documentary evidence contradicts this finding and the Complainant does not claim either to be a public body in its application or in its Complaint. Furthermore, a registration by a public body may only consist of the complete name of the public body or the acronym that is generally used.

Second, the Complaint did not establish that it is the holder of a prior right. Pursuant to Article 10 (1) of the Regulation, '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.

Based on the documentary evidence received by the validation agent, the Complainant did not establish any prior right in the meaning of the Regulation.

Although nothing in the Complaint or in the application seems to suggest that the Complainant intended to demonstrate a prior right in the form of a "distinctive title of protected literary and artistic works", the Respondent still mentions, for the avoidance of doubts, that such a prior right should be demonstrated by
(i) a copy of the cover or image of the literary and artistic work containing the title concerned (together with a brief description of (a) the work, or (b) the content of the work, a photograph of the work, etc.), and
(ii) an affidavit signed by a competent authority, legal practitioner or professional representative stating that the Applicant holds the claimed rights in respect of the said title on the date of the Application, that the work in question has lawfully been made public and that the title is distinctive.

This documentary evidence is required by Section 18 (1) of the Sunrise Rules and Article 14 of the Regulation and the Complainant did not provide such documentary evidence. Furthermore, even if the title of the project could be considered as a prior right (quod non), the title of the Complainant's project is " Demonstrators of Smart Cards and Network Solutions for European Health Insurance Card Electronification- Netcards", which is not the complete name of the domain name applied for (Article 10 (2) of the Regulation).

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.

Based on the documentary evidence received by the validation agent and the Complaint submitted by the Complainant, the Respondent fails to see any legal argument that would support that the Respondent's decision conflicts with the Regulation.

The Respondent has sympathy for the Complainant's project and understands the Respondent's desire to register a domain name, especially since this project received a grant from the European Commission.

However, accepting the Complainant's application would clearly be in breach of the Regulation, since the Complainant did not demonstrate any prior right on the name NETCARDS in the meaning of the Regulation.

Consequently, the Respondent correctly rejected the Complainant's application and the Complaint should be denied."

DISCUSSION AND FINDINGS

Article 10 (1) of Commission Regulation (EC) No 874/2004, of 28 April 2004 laying down public policy rules concerning the implementation and functions of the.eu Top Level Domain and the principles governing registration, 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 (1) of Commission Regulation (EC) No 874/2004 further provides that '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.

Article 14 of the Commission Regulation (EC) 874/2004 states that the Applicant must submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. Based on the Article 14, 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 Article 14.

Section 21 (2) of the Sunrise Rules states that the validation agent determines exclusively on the basis of a prima facie review of the submitted documentary evidence if the applicant has a valid prior right to the applied domain name. Additionally, the Section 21 (3) gives the validation agent a right in its sole discretion to conduct further investigations into the circumstances of the application.

Chapter V. of the Sunrise Rules, Sections 12 to 18, provides for the lists of acceptable forms of documentary evidence by means of which a prior right should be demonstrated. The forms of acceptable documentary evidence vary depending on the type of prior right claimed in the application.

The Article 10 (1) of Commission Regulation (EC) No 874/2004 does not define an exhaustive list of acceptable prior rights. However, whichever the prior right, which the applicant has claimed in its application, is, the applicant is obliged to submit acceptable documentary evidence showing that he or she is the holder of the prior right claimed on the name in question.

The acceptable documentary evidence for prior rights marked as “Other” in the application are, in accordance with Section 12 (1) of the Sunrise Rules, the following:
(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
b.the conditions required for such protection; and
(ii) proof that the complete name for which prior right is claimed meets all 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.

Section 12 (2) of the Sunrise Rules further provides that it is in any case sufficient to submit a copy of a relevant final judgement 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.

Finally, Section 12 (3) of the Sunrise Rules provides 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 by a competent authority, legal practitioner or professional representative, accompanied by documentation supporting the affidavit or
(ii) a relevant final judgement 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 the relevant scholarly works and court decisions and certain other conditions of the relevant member state in relation to the type of prior right concerned.

The type of the prior right was marked as “Other” by the Complainant in the application. Therefore, the above listed documentary evidence indicated in Section 12 of the Sunrise Rules would have been sufficient evidence to prove the existence of the prior right the Complainant claimed in its application for the domain name <netcards.eu>.

The documentary evidence provided by the Complainant consisted of the following documents:
1) a grant agreement under the eTen program from the European Commission for a project of market validation entitled "Netc@rds for eEHIC - Demonstrators of Smart Cards and Network Solutions for European Health Insurance Card Electronotification";
2) amendments to this grant agreement;
3) an agreement establishing an economic interest grouping GIE SESAM-VITALE.

Consequently, the documentary evidence submitted by the Complainant did not meet the criteria set forth in the Commission Regulation (EC) No 874/2004 and the relevant Sunrise Rules Sections 12 (1), 12 (2) or 12 (3)

For the sake of completeness, the Panel wishes to clarify that neither did the documentary evidence meet any other criteria set for in the Commission Regulation (EC) No 874/2004 and the Sunrise Rules Section 12 for acceptable forms of documentary evidence to prove any other type of prior right that could be claimed during the Sunrise II period.

In accordance with the Commission Regulation (EC) No 874/2004 and the Sunrise Rules the burden of proof is on the applicant to provide conclusive information to the validation agent to enable it to make a prima facie decision on the matter. The documentary

evidence submitted by the Complainant was not sufficient to prove that the Complainant (i.e. the Applicant) was the holder of the prior right it had claimed in its application for the domain name <netcards.eu> and the Complainant has thus failed to prove the existence of its claimed prior right.

Based on the foregoing, the Panel finds that the decision made by the Respondent to reject the application made by the Complaint was justified and therefore rejects the Complaint.

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	**Sanna Aspola**

DATE OF PANEL DECISION 2007-01-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, GIE GESAM-VITALE has requested annulment of the decision made by the Respondent, EURid, regarding the domain name <netcards.eu>. The Complainant has further requested the disputed domain name to be attributed to the Complainant.

The disputed domain name <netcards.eu> was applied by the Complainant during the second phase of the phased registration period, i.e. the Sunrise II period. The Complainant claimed prior right to the name NETC@RDS protected in France. The type of the prior right was marked as “Other” in the application. The Complainant timely submitted the documentary evidence to the validation agent. The Respondent refused the Complainant’s application was refused on grounds that the documentary evidence was not sufficient to prove that the Complainant was the holder of the claimed prior right.

The Article 10 (1) of Commission Regulation (EC) No 874/2004 does not define an exhaustive list of acceptable prior rights. However, whichever the prior right, which the applicant has claimed in its application, is, the applicant is obliged to submit acceptable documentary evidence showing that he or she is the holder of the prior right claimed on the name in question.

The type of the prior right was marked as “Other” by the Complainant in the application. However, the documentary evidence submitted by the Complainant did not meet the criteria set forth in the Commission Regulation (EC) No 874/2004 and the Sunrise Rules Section 12 for acceptable forms of documentary evidence by means of which a prior right to a right marked in the Complainant’s application should be demonstrated. Neither did the documentary evidence meet any other criteria set for in the Commission Regulation (EC) No 874/2004 and the Sunrise Rules Section 12 for acceptable forms of documentary evidence to prove any other type of prior right that could be claimed during the Sunrise II period.

In accordance with the Commission Regulation (EC) 874/2004 and the Sunrise Rules the burden of proof on demonstrating that the Applicant of a .eu domain name is the holder of the prior right claimed in the application is on the Applicant. Without conclusive documentation, in accordance with the Sunrise Rules Section 12, evidencing that the Complainant was the holder of a prior right in the name <netcards.eu> in the meaning of Article 10 (1) of Commission Regulation (EC) No 874/2004, the Respondent could not make a decision to accept the Complainant’s application for the domain name <netcards.eu>.

Based on the foregoing, the Panel finds that the decision made by the Respondent to reject the application made by the Complaint was justified and therefore rejects the Complaint.