Panel Decision for dispute CAC-ADREU-003533

Case number	**CAC-ADREU-003533**
Time of filing	**2006-10-25 10:36:45**
Domain names	**hullutpaivat.eu, galnadagar.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**Oy Hullut Päivät - Galna Dagar Ab, Mrs. Tanja Liukkonen**

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

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FACTUAL BACKGROUND

The Complainant is Oy Hullut Päivät - Galna Dagar Ab, Finland.

The Complainant is a limited liability company registered with the Finnish Trade Register in the company name “Oy Hullut Päivät – Galna Dagar Ab”.

The Complainant applied for the registration of the domain names “hullutpaivat.eu” and “galnadagar.eu” during the second part of the Sunrise phase.

The applications were rejected by the Registry, European Registry for Internet Domains (EURID), on the basis that the domain names applied for did not consist of the complete name for which the prior right was claimed.

Againts this decision the Complainant filed a complaint with the Czech Arbitration Court.

A. COMPLAINANT

The Complainant argues that the decisions taken by the Registry conflict with the Comission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implemenation and functions of the .eu Top level Domain and the principles governing registration (hereafter the "Regulation") and the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (“Sunrise Rules”).

According to Section 19(1) of the Sunrise Rules, 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. Now, it should be noted that the company name “Oy Hullut Päivät – Galna Dagar Ab”, for which the Complainant’s prior right exists, consists only of one name which, however, has two parallel manifestations, one in Finnish and other in Swedish language.

The Finnish and Swedish manifestations are literal translations of each other and have exactly the same meaning. “Hullupaivat.eu” domain name applied by the Complainant is, taking into account the provisions of Article 11 of the Regulation in respect of special characters and Section 19(4) of the Sunrise Rules in respect of omission of certain characters, identical to and a complete representation of the Finnish manifestation of the company name, i.e. “Hullut Päivät”. The same is true in respect of “galnadagar.eu” domain name and the Swedish manifestation of the company name, i.e. “Galna Dagar”.

The Panel should pay attention to the difference between obtaining a registration comprising only part of the complete name for which the prior right exists, as referred to in Section 19 of the Sunrise Rules, and the present case where the domain names applied are, respectively, complete and identical representations of the Finnish and Swedish manifestations of the Complainant's company name.

It should also be noted that the parent company of the Complainant is the proprietor of, among others, the following national trademarks: Finnish Trademark No 118719 ("Hullut Päivät"), Estonian Trademark No 22769 ("Hullut Päivät") and Estonian Trademark No 23729 ("Galna Dagar"). Even though these trademarks are not referred to in the original applications made by the Complainant for the domain names in question, it is apparent that they qualify as prior rights for the applied domain names. The existence of these registered trademarks as prior rights of the Complainant should affect the interpretation of the rules of validation under the Regulation and the Sunrise Rules, taken into account the objectives of the phased registration of ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights.

Therefore, the Complainant requests that the Registry's decisions made on September 15, 2006 to reject the applications for registration of the domain names "hullutpaivat.eu" and "galnadagar.eu" for the Complainant shall be annulled and that the domain names in question shall be attributed to the Complainant.

B. RESPONDENT

The Respondent expresses as follows:

The 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 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.

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 (4) of the 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".

The Complainant applied for the domain names HULLUTPAIVAT and GALNADAGAR on 14 March 2006, claiming as prior rights a company name protected in the Finland for the name "HULLUTPAIVAT" in the first application and a company name protected in the Finland for the name " GALNADAGAR" in the second application.

The documentary evidence for both applications was received by the processing agent on 7 April 2006, which was before the 23 April 2006 deadline.

For both applications, the Complainant submitted the same documentary evidence, consisting of: - a certificate from trade register of the "National Board of Patent and Registration in Finland" showing that the company "Oy Hullut Päivät - Galna Dagar Ab" is duly registered in Finland; and - a 90 pages long brochure.

The validation agent concluded from its examination of the documentary evidence that the Complainant did not demonstrate that it was the holder of the prior rights claimed in its two applications because they do not consist of the complete name for which the prior right exists as written in the documentary evidence.

Consequently, the Respondent rejected the applications for the domain names HULLUTPAIVAT and GALNADAGAR.

Pursuant to article 10 (2) of the Regulation, a domain name applied for during the Sunrise Period must consist of the complete name of the prior right on which the application is based. Section 19.4 of the Sunrise Rules provides for a clarification to this rule, by providing 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".

The Complainant submitted documentary evidence substantiating that the Complainant's company name relied upon as a prior right is "Oy Hullut Päivät - Galna Dagar Ab". As correctly pointed out by the Complainant, the part of the Complainant's company name which is composed of "Ab", refers to the company type.

Therefore, this part of the Complainant's prior right could be omitted from the domain name applied for. In short, pursuant to article 10.2 of the Regulation and section 19 of the Sunrise Rules, the domain name based on this prior right must consist of all alphanumerical characters, except for the company type. Therefore, the company name relied upon as a prior right could only serve as a prior right for the domain name “Oy Hullut Päivät - Galna Dagar”, which is the complete name for which the prior right exists, except for the company type.

Nevertheless, in the present case, the Complainant applied for the domain names HULLUTPAIVAT on the one hand and for the domain name GALNADAGAR on the other hand. Both domain names applied for only consist of parts of the company name.

Therefore, the Respondent correctly rejected the Complainant's applications, pursuant to article 10.2 of the Regulation.

The arbitration panels have been consistent in applying article 10.2 of the Regulation. For example in ADR 2471 (TAIYO-YUDEN), the Panel decided that "In the case of the Complainant the complete name shown in the companies register is “Taiyo Yuden Europe GmbH”. If the company type “GmbH” would be omitted the complete name reads “Taiyo Yuden Europe“. Therefore the company name of the Complainant would qualify as priority right for the registration of “taiyo-yuden-europe.eu” but not for “taiyo-yuden.eu””. In ADR 2742 (TELECARE), the Panel decided that: "As the name of the company is TeleCare Systems & Communication GmbH, only the company type GmbH could have been omitted from the complete name. The Complainant applied not for the complete name TeleCareSystemsCommunication but only for part of that complete name- Telecare. According to the Regulation and Sunrise Rules the Complainant was not the holder of a prior right regarding the name "telecare" as the company name of the Complainant was not Telecare GmbH but TeleCare Systems & Communication GmbH. In previous ADR proceedings (01973 ICG and 2297 FENRISULVEN)the Panel has also found that the company name relied on as a prior right must be identical to the domain name sought". The Respondent also refers the Panel to the ADR decisions 1053 (SANTOS), 1438 (ELLISON), 713 (HUETTINGER), 1427 (BONOLLO), 02499 (PSYTECH), 02494 (BPSC), 2297 (FENRISULVEN), 02047 (UNI-C), 2061 (MODLINE), 02093 (MAZUR), 470 (O2), etc.

The Complainant argues that there could be an exception to article 10.2 of the Regulation when the complete name is in fact composed of two translations of the same word in different languages. In this case, the Complainant argues that it could apply for the domain name corresponding only to one of the translations. The Respondent disagrees. It is clear that the Regulation does not require the Respondent to investigate whether some parts of the company name could be redundant or translations of one another. The Regulation only requires the Respondent and the validation to verify that the domain name applied for consists of the complete name of the prior right on which the application is based, as written in the documentation which proves that such a right exists. Since the documentary evidence which proves that the prior right exists clearly shows the name " Oy Hullut Päivät - Galna Dagar ", the Respondent could not allow the application for the domain name comprised only of the name HULLUTPAIVAT in one application and GALNADAGAR in the other. One previous panel decision is particularly illustrative of this issue. In ADR 2224, the applicant applied for the domain name POWERON on the basis of a trademark consisting of the words “POWERON ΠΟΒΕΡΟΝ” (in other words, the name POWERON in Latin characters and its transliteration in Greek characters, since the applicant was doing business in Greece). The Panel decided that the Respondent correctly rejected the application pursuant to the Regulation on the basis that the transliteration of the words appeared to be to POWERON POWERON and not to the domain name applied for which was POWERON. For these reasons, the complaint must be rejected.

Finally, the Respondent wishes to address the Complainant's contention that its parent company is the holder of several trademarks. 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 23 April 2006. The Complainant filed its complaint on 20 October 2006 and submitted this new information with this complaint. Therefore, this information may not serve as documentary evidence for the Complainant's application and 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.).

DISCUSSION AND FINDINGS

According to the Panel`s legal opinion (and the Respondent`s opinion) it is clear that the Regulation does not require the Respondent to investigate whether some parts of the company name could be translations of one another. The Regulation only requires the Respondent and the validation to verify that the domain name applied for consists of the complete name of the prior right on which the application is based, as written in the documentation which proves that such a right exists. Domain name applied for during the Sunrise Period must consist of the complete name of the prior right on which the application is based. Only the company type (f.i. "Ab") could have been omitted from the complete name. The company name is complete if it consists of all parts, even as some part is the translantion of another.

Therefore the company name of Complainant would qualify as priority right for the registration of "hullutpaivat-galnadagar.eu", but not for "hullutpaivat.eu" and "galnadagar.eu" (two applications).

The relevant question within the Sunrise Period is thus not whether the Complainant is the holder of a prior right, but whether the Complainant demonstrated to the validation agent that he is the holder of a prior right.

The Regulation (EC) and the Sunrise Rules give holders of prior rights the opportunity and the great advantage to demonstrate their prior rights during the phased registration, which is an exception to the basic domain name legal principle of first-come first-served. The prior right holder has only conditional right to the registration of domain name which depends on his demonstration of his right by a documentary evidence in time.

Regarding to the legal nature of the phased registration (Sunrise Period), it is appropriete to emphasize the legal principle of concentration of the documentary evidence during a restricted time and the legal principle vigilantibus iura, too.

As to as the Complainant's contention that its parent company is the holder of several trademarks, 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 (art 14 of the Regulation). In the present case, the 40 days period ended on 23 April 2006.

The Complainant filed its complaint on 20 October 2006 and submitted this new information with this complaint. Therefore, this information may not serve as documentary evidence for the Complainant's application.

No additional documents and new information should be accepted after the 40 day period for the submission of documentary evidence.

Any right or any additional advantage given to the Complainant to correct his original defective application at this stage of the procedure would be unfair to the other applicants that may filled for the same domain name immediately after the applicant and would clearly be in breach of the Regulation and 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	Ivo Telec

DATE OF PANEL DECISION 2007-02-01

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

1. The Complainant did not apply for the complete name. The company name is complete if it consists of all parts, even as some part is the translantion of another.

2. The Comission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implemenation and functions of the .eu Top level Domain and the principles governing registration does not require the Respondent to investigate whether some parts of the company name could be translations of one another. The Regulation only requires the Respondent and the validation to verify that the domain name applied for consists of the complete name of the prior right on which the application is based, as written in the documentation which proves that such a right exists.

3. Domain name applied for during the Sunrise Period must consist of the complete name of the prior right on which the application is based.

4. The relevant question within the Sunrise Period is thus not whether the Complainant is the holder of a prior right, but whether the Complainant demonstrated to the validation agent that he is the holder of a prior right.

5. The Comission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implemenation and functions of the .eu Top level Domain and the principles governing registration and the Sunrise Rules give holders of prior rights the opportunity and the great advantage to demonstrate their prior rights during the phased registration, which is an exception to the basic domain name legal principle of first-come first-served. The prior right holder has only conditional right to the registration of domain name which depends on his demonstration of his right by a documentary evidence in time.

6. Regarding to the legal nature of the phased registration (Sunrise Period), it is appropriete to emphasize the legal principle of concentration of the documentary evidence during a restricted time and the legal principle vigilantibus iura, too.

7. No additional documents and new information should be accepted after the 40 day period for the submission of documentary evidence.

8. Any right or any additional advantage given to the Complainant to correct his original defective application at this stage of the procedure would be unfair to the other applicants that may filled for the same domain name immediately after the applicant and would clearly be in breach of the Regulation and the Sunrise Rules.