Panel Decision for dispute CAC-ADREU-003545

Case number	CAC-ADREU-003545
Time of filing	2006-10-30 15:02:14
Domain names	dll.eu, loving.eu, motoring.eu, counsel.eu, contacting.eu, meeting.eu, inventors.eu, texting.eu, marrying.eu, actuaries.eu, auctioning.eu, inventing.eu, eprocurement.eu, phoning.eu, portables.eu, holidaying.eu, collaborate.eu, photocopiers.eu, photocopier.eu, solicitors.eu, e-procurement.eu, thecommission.eu, conferencing.eu, advocates.eu, videocast.eu, advocate.eu, journalism.eu, lending2.eu, retailing.eu, introductions.eu, gardendesign.eu, forensic.eu, vault.eu, investigate.eu, podcaster.eu, retailer.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Startupz Limited (Holding Company as Stated in Annex), N Lockett

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 other legal proceedings that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant by the name “Startupz Limited” established in the United Kingdom is a holding company which has several tens of its subsidiaries in that country. The 36 subsidiaries of the Complainant each applied for one .eu domain name in the second part of phased registration (Sunrise 2). All of these 36 applicants claimed prior rights in a form of their company names consisting either of the subsidiary’s company name without the identifier “Limited” or “Ltd”, or the subsidiary’s company name excluding special characters pursuant to Article 11 of Regulation (EC) No. 874/2004 (namely % and &) and the aforementioned identifier.

The 36 applied domain names including company names without their identifiers in brackets are as follows: dll (DLL), loving (Lo%ving), motoring (Motoring%), counsel (Cou%nsel), contacting (Contacting), meeting (Meeting), inventors (Inventors), texting (Texting), marrying (Marrying), actuaries (Actuaries), auctioning (Auctioning), inventing (Inventing), eprocurement (Eprocurement%), phoning (Phoning), , portables (Portables), holidaying (Holidaying), collaborate (Collaborate%), photocopiers (Photocopiers%), photocopier (Photocopier), solicitors (Solicitors%), e-procurement (E-Procure&ment), thecommission (Thecommission), conferencing (Conferencing), advocates (Advocates%), videocast (Videocast), advocate (Advocate%), journalism (Journalism%), lending2 (Lending2), retailing (Retailing%), introductions (Introductions), gardendesign (Garden%design), forensic (Forensic%), vault (Vault%), investigate (Investigate), podcaster (Podcaster) and retailer (Retailer%).

The Respondent being EURid rejected all of the 36 applications on the ground that the documentary evidence submitted by the Applicants did not demonstrate that they are holders of claimed prior rights, and the Complainant challenges the Respondent’s decisions in these ADR proceedings.In its quite short complaint, the Complainant on behalf of its 36 subsidiaries asserts that the documents adequately evidenced the rights for the domain applied for. In each case, a copy (certified and notarised by dl legal solicitors) of the certificate of incorporation together with an extract from the UK company register was included.

Where an article 11 character was incorporated into the company name, the document included an Article 11 statement requesting removal of the character. The Complainant contends that this documentation proved the rights claimed at the time of application, and as a remedy, it seeks for the attribution of each domain name to its respective Applicant.

A. COMPLAINANT

In its quite short complaint, the Complainant on behalf of its 36 subsidiaries asserts that the documents adequately evidenced the rights for the domain applied for. In each case, a copy (certified and notarised by dl legal solicitors) of the certificate of incorporation together with an extract from the UK company register was included.

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B. RESPONDENT

The Respondent first points out the pertinent provisions of Regulation (EC) No 874/2004 of 28 April 2004 (hereinafter Regulation 874/2004), namely its Article 10 (1) and 14. It emphasizes the importance of documentary evidence in assessing the existence of Applicant's prior rights and the burden of proof in that respect.

All the Applicants claimed a prior right in the form of a company name protected in the United Kingdom, and therefore, the Applicants, in order to bear the burden of proof, had to submit documentary evidence showing that they are holders of a company name protected in the United Kingdom. The Respondent argues that with regard to documentary evidence, the Applicants fulfilled the requirements only of Section 16 (4)(ii) of the Sunrise Rules by submitting certificates of incorporation. In addition to that, some of them also provided a printout from the online database Company House containing the same information as in a certificate of incorporation and documents regarding their name change (often from Name.eu Limited to Name% Ltd, for example, Investigate% Ltd or Advocates% Ltd).

However, Section 16 (4) of the Sunrise Rules is not applicable to company names in all Member States and for this reason, it referrs to Annex 1. Annex 1 takes into account the diversity of the laws recognizing or establishing prior rights and provides that in the United Kingdom, trade names, company names or business identifiers may serve as prior rights "only to the extent that rights in passing off exist".

The rights in passing off may not be demonstrated merely by the certificate of incorporation. This is the reason why Annex 1 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)".

The Respondent alleges that the Applicants did not present documents according to Section 12 (3) of the Sunrise Rules, i.e., an affidavit or final judgment that would clearly establish that the Applicants are the holders of a trade name, company name or business identifier protected in the United Kingdom by rights in passing off.

Based on the documentary evidence, the Respondent is of the opinion that the Applicants could not provide documents establishing that rights of passing off exist in the United Kingdom because:
- most (if not all) of the company names are purely generic terms: loving, contacting, auctioning, conferencing, etc. ;
- most (if not all) of the companies have been established only shortly before the application for the domain name (for example the company Auctioning was established on March 24, 2006 and the domain name "auctioning" was applied for on March 26, 2006).

Consequently, the Respondent correctly rejected the Applicants' applications pursuant to Regulation 874/2004.

For support of the Respondent's conclusion, it furthermore refers to several previous ADR decisions.

DISCUSSION AND FINDINGS

1. Eligibility of the Complainant to be Party to these Proceedings
The preliminary question the Panel examined was whether the Complainant is entitled to act in these ADR proceedings. In this context, the Panel referrs to a previous decision ADR 1919 (FIJINATURALMINERALWATER) and cited subsequent ADR 596 (RESTAURANTS) herein, where Article 22 (1) of Regulation 874/2004 and Paragraph B1 (a) of the ADR Rules related to that issue are interpreted. The Panel in the present case is satisfied with the signed Power of Attorney attached to the complaint, where it is declared that the Complainant is a holding company of all 36 subsidiaries being Applicants of the domain name in question and is empowered to act on behalf of them. Thus, it is apparent that the complaint was filed with the consent of the right holders concerned.

2. Prior Right Claim and Documentary Evidence
At the outset, the Panel notes that whereas the factual situation and legal nature are almost identical to all 36 applied domain names, they will be dealt with in common and referred to as "domain names".

The Complainant does not attempt to present new documentary evidence in this ADR proceeding, which would not be helpful anyway due to the clear wording of Article 14 (4) of Regulation 874/2004 and the settled practice invoked by a majority of the Panelists of the Czech Arbitration Court, but instead, it presents reasons for acceptance of the applications filed by its subsidiaries by arguing that the submitted documents demonstrated prior rights. Thus, the proper documentary evidence sufficient for demonstrating prior rights is at issue and will be analyzed hereafter.

Article 10 (1) of Regulation 874/2004 provides that holders of prior rights recognized 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 and that prior rights shall be understood to include, inter alia, company names in as far as they are protected under national law in the Member State where they are held.

According to Article 14 (1) of the aforementioned Regulation, 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. It is of vital importance to determine what documents satisfy these requirements for proving claimed rights to company names protected under the law of the United Kingdom. The Sunrise Rules including its Annex 1 set forth, inter alia, the types of documents that suffice to evidence rights to company names with respect to the laws of Member States.

However, this poses a question of applicability of the Sunrise Rules in ADR proceedings. The Panel of course keeps in mind that by virtue of Article 22 (1) (b) in conjunction with paragraph (11) of the same article of Regulation 874/2004 (B11 (d)(2) of the ADR Rules respectively), the ADR panel is entitled only to decide whether a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002 of 22 April 2002 (hereinafter Regulation 733/2002). But the Panel is of the view that this does not mean that the Panel is entirely prevented from taking the Sunrise Rules into account while considering the aspects of the case. The Panel is aware of various ADR decisions dealing with that matter and fully concurs with the opinion expressed in ADR 2150 (DUTCHORIGINALS) in which the Panelist states: "If and insofar as the Sunrise Rules conflict with the Regulations, the Regulations must prevail. However, the Sunrise Rules are also expressly contemplated and mandated by the Regulation. They are the means through which the Regulation's requirement that there be a "proper, fair and technically sound administration" of all Sunrise applications should be effected. In the circumstances, I think it will usually be appropriate for a panel to take into account compliance or non-compliance with those aspects of the Sunrise Rules which set down the procedures and processes to be followed by a Sunrise applicant." In the opinion of the Panel, as far as documentary evidence for company names is concerned, the requirements set out by the Sunrise Rules are in compliance with the Regulations that will be subsequently discussed. Having mentioned that, the Panel will now focus on the issue of documentary evidence in the present case.

Pursuant to Paragraph 4 of Article 14 of Regulation 874/2004, 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. There is no doubt that the Applicants must carry the burden of proof in that respect and within the prescribed period furnish adequate documents to the Validation Agent showing that it possesses the prior right concerned, i.e., the right in a company name within the scope of the law under which it is protected, being the law of the United Kingdom in this case.

Paragraph 4 of Section 16 of the Sunrise Rules gives the list of documentary evidence for company names being applicable "unless otherwise provided in Annex 1 hereto". Annex 1 to the Sunrise Rules is designed to reflect a variety of conditions under which different types of prior rights are protected in Member States and to inform the Applicants of these conditions together with setting forth what documentary evidence, respectively what provisions of the Sunrise Rules apply to demonstrate that rights. With regard to protection of company names in the United Kingdom, it states that company names may be claimed as prior rights "only to the extent that rights in passing off exist". For this reason, it makes Section 16 (4) of the Sunrise Rules inapplicable by providing that "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)". Therefore, in order to demonstrate claimed prior rights, the Applicants had to provide documents within the meaning of Section 12 (3) of the Sunrise Rules. This is understandable and logical because one of the three pivotal elements to establish right in passing off under law of the United Kingdom is the reputation or goodwill of the names in question.

Accordingly, Section 12 (3) of the Sunrise Rules reads as follows: "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."

However, the Applicants provided none of the documents anticipated in Section 12 (3) of the Sunrise Rules, and documentation submitted under Section 16 (4), e.g., certificates of incorporation, printouts from the online database Company House, are thus irrelevant. Documentary evidence prescribed under Section 12 (3) of the Sunrise Rules do not contradict the meaning of Article 14 of Regulation 874/2004. Regardless of section 12 (3) of the Sunrise Rules, the Complainant (its subsidiaries being the respective Applicants) did not provide proper documentary evidence within the meaning of that provision. In order to satisfy the requirements of Article 14 (1) of that Regulation with respect to sufficient documentary evidence capable of demonstrating the existence of prior rights (rights in company names) under the law of the United Kingdom, the Applicants in any case had to submit such documentation proving the reputation or goodwill of the names, which it did not do.

In consideration of the facts mentioned above, the Panel comes to the conclusion that the Respondent's decisions not to accept 36 domain name applications are in conflict neither with Regulation 733/2002 nor Regulation 874/2004.

3. Conclusion
In view of the fact that the Complainant (its subsidiaries) failed to produce the required documentary evidence and Respondent's decisions to refuse all of the 36 .eu domain name applications do not conflict with Regulation 733/2002 or 874/2004, the Panel must reject 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	**Radim Charvat**

DATE OF PANEL DECISION 2007-01-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant by the name "Startupz Limited" established in the United Kingdom is a holding company which has several tens of its subsidiaries in that country. Thirty-six subsidiaries of the Complainant each applied for one .eu domain name in the second part of a phased registration (Sunrise 2). All of these 36 applicants claimed prior rights in a form of their company names consisting either of the subsidiary's company name without the identifier "Limited" or "Ltd", or the subsidiary's company name excluding special characters pursuant to Article 11 of Regulation (EC) No. 874/2004 (namely % and &) and the aforementioned identifier.

The Respondent being EURid rejected all of the 36 applications on the ground that the documentary evidence submitted by the Applicants did not demonstrate that they are holders of claimed prior rights and the Complainant challenged the Respondent's decisions in these ADR proceedings.

1. Eligibility of the Complainant to be a Party to these Proceedings
The Panel in the present case is satisfied with the signed Power of Attorney attached to the complaint, where it is declared that the Complainant is a holding company of all 36 subsidiaries being Applicants of the domain name in question and that it is empowered to act on behalf of them. Thus, it is apparent that the complaint was filed with the consent of the right holders concerned.

2. Prior Right Claim and Documentary Evidence
It is of vital importance to determine what documents satisfy the requirements of Article 14 of Regulation 874/2004 for proving of claimed rights to company names protected under the law of the United Kingdom. The Sunrise Rules including its Annex 1 set forth, inter alia, the types of documents that suffice to evidence rights to company names with respect to the laws of Member States.

With respect to applicability of the Sunrise Rules in ADR proceedings, the Panel is of the view that the Panel is not entirely prevented from taking the Sunrise Rules into account while considering the aspects of this case.

With regard to the protection of company names in the United Kingdom, Annex 1 to the Sunrise Rules states that company names may be claimed as prior rights "only to the extent that rights in passing off exist". For this reason, it makes Section 16 (4) of the Sunrise Rules inapplicable by providing that "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)". Therefore, in order to demonstrate claimed prior rights, the Applicants had to provide documents within the meaning of Section 12 (3) of the Sunrise Rules.

However, the Applicants provided none of the documents anticipated in Section 12 (3) of the Sunrise Rules, and documentation submitted under Section 16 (4), e.g., certificates of incorporation, printouts from the online database Company House, are thus irrelevant. Documentary evidence prescribed under Section 12 (3) of the Sunrise Rules do not contradict the meaning of Article 14 of Regulation 874/2004.

3. Conclusion
In view of the fact that the Complainant (its subsidiaries) failed to produce required documentary evidence and Respondent's decisions to refuse all of the 36 .eu domain name applications do not conflict with Regulation 733/2002 or 874/2004, the Panel must reject the complaint.