Panel Decision for dispute CAC-ADREU-003548

Case number	**CAC-ADREU-003548**
Time of filing	**2006-10-25 10:55:53**
Domain names	**costacruise.eu, costacruises.eu, costacroisieres.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Costa Crociere S.p.A.**

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 filed three applications in the phased registration, the so-termed Sunrise II period. The applications were filed on 7.02.2006, i.e. on the first day of the Sunrise II period. The Complainant submitted to the validation agent the following documents meant to substantiate his “Prior Rights” to the unregistered trademark:

- On the territory of Great Britain – COSTACRUISE and COSTACRUISES: an abstract from the Companies House register showing that the company (No 2482631) "Costa-O.C.L. Lines UK Limited" changed its name to "Costa Cruise Lines UK Limited" on 29 January 1999; and an air travel organiser's license showing that the company "Costa Cruise Lines UK Ltd" is authorized to sell and advertise flights and air package holidays, and is also trading under the name "Costa Cruises”.
- On the territory of France – COSTACROISIERES: company register of the Commercial Court of Nanterre (France) showing that the company "Compagnie Française de Croisières" (identification number 339 516 478 R.C.S. NANTERRE) was liquidated on 7 November 2005 and removed from the company register on 5 December 2005.

The applications were rejected by the Respondent for not sufficiently demonstrating the “Prior Rights” in the phased registration (Respondent decisions: 2797102102961720 - COSTACRUISE, 2123102103792231 - COSTACRUISES and 2243102406008676 - COSTACROISIERES). The Complainant now seeks annulment of the disputed decisions and, as a consequence, registration and attribution of the disputed domain names in accordance with Section 27 paragraph 3 of the .eu Sunrise Rules and section B.11 (c) of the ADR Rules, with subsequent activation of the claimed domain names. The Complainant further submitted evidence aiming to substantiate his proprietary rights to the domain names in question, i.e.:

- 1 - Financial Reports and Group Structure
- 2 - Court Certificate for the Compagnie Française de Croisières
- 3 - French certificate of registration of Costa Crociere S.p.A.
- 4 - French trademark
- 5 - Benelux trademark
- 6 - Domain name - costacroisieres.fr
- 7 - Domain name - costacroisieres.com
- 8 - US trademark
- 9 - Domain names - costacruise.co.uk/costacruises.co.uk
- 10 - Domain names - costacruise.com/costacruises.com

The Complainant initiated ADR proceedings against the decision of the Respondent (the Registry) filed in the ADR court on September 25, 2006 at 10:55:53. The formal date of the commencement of the ADR proceeding is November 04, 2006 at 18:44:54.

A. COMPLAINANT

The Complainant considers that there is a clear “link” between his company name, i.e. Costa Crociere S.p.A., and the claimed domain names. The Complainant affirms to have been the parent company of twenty other companies based throughout the world. He furthermore affirms that it is not true that the applicant differs from the holder of the “Prior Rights”, as requested in Section 16.6 of the Sunrise Rules. He further states that the Company Register of the Commercial Court of Nanterre proves in the case of the domain name COSTACROISIERES that the Complainant WAS (AND IS) the sole shareholder of the Compagnie Française de Croisières, and therefore an identity link exists between the Complainant and the holder in regard to the “Prior Rights”. The mark “costa croisieres” was filed for trademark registration on the territory of France under the pending registration no. 063413940 and, therefore, the Complainant is able to claim his “Prior Rights” to this unregistered trademark. As regards the domain names COSTACRUISE and COSTACRUISES, the Complainant considers that the company Costa Cruise Lines UK is the formal owner of the trade name “costa cruise”. The Complainant is the parent company of the Costa Cruise Lines UK.

B. RESPONDENT

The Respondent claims that the Complainant submitted several documents for the first time in the framework of these ADR proceedings and, therefore, they cannot serve as documentary evidence establishing Prior Rights of the Complainant, since, pursuant to article 14 of Regulation No 874/2004/EC, the Respondent may only accept, as documentary evidence, documents that are received by the validation agent within 40 days from the submission of the domain name application. The deadline for such submission expired on 19 March 2006. The document first filed within the period starting February 7, 2006, and ending March 19, 2006, did not sufficiently prove the “Prior Rights” of the Complainant, i.e. the domain names differed from the company name of the Complainant on the basis of a prima facie review by the validation agent.
Company names mentioned in documentary evidence first received by the validation agent in the Sunrise II period were "Compagnie Française de Croisières" and "Costa Cruise Lines UK Limited". When the name of the applicant and the name of the holder of the prior right differ, Section 20 of the Sunrise Rules clearly lists the necessary documents that the applicant needs to provide in order to demonstrate how he is entitled to rely upon the claimed prior right pursuant to article 14 of the Regulation. Section 20 of the Sunrise Rules is, therefore, intended to cover all situations where provided documentary evidence does not clearly indicate the name of the applicant as being the holder of the claimed Prior Right. The Complainant bears the burden of proof to substantiate that he was the holder of the license or of a Prior Right at the time of filing an application for registration. Documentary evidence submitted by the Complainant for the three domain names did not contain any affidavit or final judgment stating that the unregistered trademarks meet the conditions provided for in the law of the relevant member state (France and the United Kingdom). Finally, the Respondent states that the Respondent or the validation agent cannot be expected or forced to speculate whether the Complainant was a holder of the claimed Prior Right. The Sunrise II period registration procedure with reference to Prior Rights shall be understood very strictly as it constitutes an exception to the standard procedure, i.e. to the so-termed “First Come, Fist Served” rule. The Respondent therefore correctly rejected the Complainant's applications.

DISCUSSION AND FINDINGS

I. The law
1. In such cases, the Panel can only decide a Complaint on the basis of submitted statements and documents, and in accordance with the Procedural Rules, i.e.:
- ADR Rules,
- Provider’s Supplemental ADR Rules, and;
- European Union Regulations, i.e.: Regulation No 733/2002 of the European Parliament and Council of 22 April 2002 on the implementation of the .eu Top Level Domain, and Commission Regulation No 874/2004/EC 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, as amended by Commission Regulation No. 1654/2005/EC.

2. Regulation No 733/2002/EC (Recital 16 and art. 5 (1b) foresees that the holders of so-termed Prior Rights, that is rights recognized or established by national or Community law and public bodies, will TEMPORARILY (an indirect indication for EXCEPTIONALLY) and APPROPRIATELY benefit from a special phased registration i.e. a period (‘sunrise period’) during which the registration of their domain names is exclusively reserved to them.

In turn, Recital 20 of the same Regulation stipulates that public policy principles related to registration, including the ‘First Come, First Served’ method (hereinafter referred to as FCFS) should be considered when registration policy is formulated. Public registration policies

have been formulated by Regulation No 874/2004/EC and the “Sunrise Rules”, which laid down the .eu Registration Policy and Terms and Conditions for Domain Name Application made during the phased registration period.

It should be mentioned that in case of conflict between any of these rules, European Union Regulations take precedence.

3. Regulation No 874/2004/EC made FCFS the basic rule for the .eu domain name allocation and, as an exception to this rule, introduced the principle of “prior rights” as referred to hereinabove. After expiry of the phased registration (Sunrise period I and II), the principle of FCFS, also known as the “Land Rush” principle, should apply in allocation of domain names (see: Recital 11, 12 and art. 2, 14 of Regulation No 874/2004/EC).

The commonly known Latin and legal principle of exceptiones not sunt extendae demands that all the rules established by way of exception must be interpreted strictly and narrowly, and that no widening interpretation methods can be applied when using the law of exception.

This legal reasoning has also been applied by the Panel when deciding upon this case.

3. It clearly stems from the above provisions that all evidence which is to be taken into account during registration proceedings must be provided by the applicant within the prescribed period of 40 days from application filing. Any evidence submitted thereafter is not to be taken into account (art. 14 par. 4 of Regulation No 874/2004).

For that reason, the Panel did not take into consideration any of the the documents submitted by the Complainant in the course of these ADR proceedings.

II. Legal assessment of the claim
1. The Complainant being an Italian entity applied for three registrations in the Sunrise II period, requiring establishment of his Prior Right to unregistered French and UK trademarks. The Sunrise period ended, according to article 12 (2) of Regulation no 874/2004/EC, on April 7, 2006, after the lapse of four months starting on December 7, 2005. The phased registration allowed the Complainant to establish his Prior Rights by submitting all relevant documents to enable the validation agent to make a prima facie review thereof in accordance with Section 21 (2) of the Sunrise rules. On that basis, the validation agent would be able to substantiate (confirm) the PRESENT existence of the Complainant’s Prior Rights (argumentum from art. 14 par. 1, 7 in fine of Regulation No 874/2004/EC). Apart from documents submitted to the validation agent on March 19, 2006 (COSTACROISIERES) and March 17, 2006 (COSTACRUISES and COSTACRUISE), the Complainant did not deliver any further evidence supporting the claimed Complainant’s Prior Rights.

2. In accordance with the Sunrise Rules, the Complainant was required to submit the following documents evidencing the present existence of Prior Rights for the domain name:

a. COSTACROISIERES – documents necessary for the protection of Prior Rights to unregistered trademarks under the French law in the absence of any other provisions stipulated differently in the Annex 1 to the Sunrise Rules, are:
- an affidavit signed by a competent authority, legal practitioner, or professional representative, accompanied by documentation supporting the affidavit, or
- 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 (Section 12(3) of the Sunrise Rules).

The above mentioned documents may only prove a well-known unregistered trademark as provided for in Article 6bis of the Paris Convention on the Protection of Industrial Property (as amended), or an unregistered trademark other than the well-known one, but that is protected under the law of one of the member states referred to in Annex 1 as being a member state protecting unregistered trademarks.

b. COSTACRUISE and COSTACRUISES – documents necessary for the protection of Prior Rights to unregistered trademarks under the English law are first of all mentioned in Annex 1 to the Sunrise Rules. To claim his Prior Rights, an applicant has to submit documentary evidence as referred to in Section 12(3) of the Sunrise Rules. Annex 1 foresees also 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.

3. Regarding the domain name COSTACROISIERES, the Complainant submitted only one document i.e. the Company Register of the Commercial Court of Nanterre (France) showing that the company "Compagnie Française de Croisières" (identification number 339 516 478 R.C.S. NANTERRE) was liquidated on 7 November 2005 and removed from the Register on 5 December 2005.

4. Apart from the circumstance that the validation agent is only allowed to evaluate the existence of Prior Rights, which should be understood as the CURRENT existence of these rights, at the time of validation (art. 10 (2) of Regulation No 874/2004/EC), the Company Register of the Commercial Court of Nanterre (France) could not be considered as fulfilling the obligations set forth in Section 12 (3) of the Sunrise Rules. The register deed is neither an affidavit signed by a competent authority, legal practitioner, or professional representative, accompanied by documentation supporting the affidavit, nor 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. Furthermore, nothing states in the Register of the Commercial Court of Nanterre that the type of Prior Right claimed by the Complainant is protected under the law of France.

5. The Panel also considered the possibility of establishing protection of the Prior Right for the Complainant's company - trade name or business identifiers under Section 18 of the Sunrise Rules. The Panel is of the opinion that it was also not possible for the validation agent to accept the application of the Complainant on the basis of his company or trade name. The name COSTACROISIERES differs from the Complainant's name, i.e. COSTA CROISIERE S.p.A and the liquidated French company i.e. COMPANIE FRANCAISE DE CROISIERES.

6. Section 19 (4) of the Sunrise Rules provides a clear regulation whereby, for trade names, company names and business identifiers, only 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 Claimant also did not prove the "use" of the trade name or company name "croisieres" as stipulated in Section 16 (5) and (b) of the Sunrise Rules, since the company Compagnie Française de Croisières was liquidated on 7 November 2005 and removed from the Company register on 5 December 2005.

7. Moreover, the documents submitted by the Complainant cannot be taken into consideration because the Complainant is an Italian entity and it did not prove the link between Costa Crociere S.p.A and its subsidiaries as described in Section 20 of the Sunrise Rules, especially no Declaration of a Transfer of a Prior Right, as stated in Annex 3 to the Sunrise Rules, has been attached to the application.

8. Regarding the domain names COSTACRUISE and COSTACRUISES, the Complainant submitted two documents, i.e. an abstract from the Companies House register showing that the company (No 2482631) "Costa-O.C.L. Lines UK Limited" changed its name to "Costa Cruise Lines UK Limited" on 29 January 1999; and an air travel organiser's license showing that the company "Costa Cruise Lines UK Ltd" is authorised to sell and advertise flights and air package holidays, and is also trading under the name "Costa Cruises".

According to Annex 1 of the Sunrise Rules, to claim his Prior Rights, the Complainant had to submit documentary evidence as referred to in Section 12(3) of the Sunrise Rules (and not documentary evidence referred to in Section 15 of the Sunrise Rules), as already mentioned hereinabove.

Neither the first nor the second document could serve to establish Prior Rights of the Complainant for the reasons presented above (see: point II 1-7 of this decision).

9. The above mentioned reasoning means that the Complainant did not sufficiently prove his Prior Rights, for the following reasons in particular:

- The period of time for submitting of any material (including additional documents) supporting the registration and this complaint is time-barred and is strictly limited to 40 days. This term cannot be restored in any form on account of its legal nature (so termed: "final term" pursuant to general provisions of civil law).
- The documents submitted by the Complainant in the phased registration did not substantiate his Prior Rights pursuant to the Regulation 874/2004/EC and the Sunrise Rules, which must, in this respect, be interpreted strictly and narrowly as phased registration constitutes the law of exception;
- There is no clear and obvious connection between the Complainant and the disputed domain names in respect of the transfer of Prior Rights.
- There is no evidence regarding the current existence and use of Prior Rights for the validation agent to prima facie review them, as described by Sunrise Rules and the Regulation 874/2004/EC.

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	Wlodzimierz Szoszuk

DATE OF PANEL DECISION 2006-12-30

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

On 7 February, 2006 the Complainant, Costa Crociere S.p.A., an Italian operator of sea cruises, applied, under the Sunrise Rules, for registration of COSTRACROISIERES, COSTACRUISES and COSTACRUISE domain names. The Complainant stated in its applications that he relies on his prior rights to unregistered trademarks. By virtue of decisions no. 2797102102961720 (dated 2006-09-12), 2123102103792231 (dated 2006-09-19), 2243102406008676 (dated 2006-10-06) (hereinafter "the Decisions") EURID refused to register COSTRACROISIERES, COSTACRUISES and COSTACRUISE domains, stating that the Complainant filed to clearly establish existence of its prior rights.EURID issued its decission solely on basis of documents submitted by the applicant within 40 days from the submission of the application for the domain name. On 25 September 2006 the Complainant filed a complaint to the Decisions, requesting their annulment and, consequently, registration of COSTRACROISIERES.eu, COSTACRUISES.eu and COSTACRUISE.eu domains for its benefit and their subsequent activation. Documents submitted by the Complainant could have served only as a proof of prior rights of entities for which those documents were issued, that is Compagnie Française de Croisières (the French company) and Costa Cruise Lines UK Limited (the UK company). A prima facie analysis of those documents showed that those entities are different than the Complainant, which is the Italian company. The fact that they are the Complainant's subsidiaries is irrelevant, as for purposes of the law they are completely separate legal entities, with rights and obligations different than that of the Complainant.

The Complaint is therefore denied for the following reasons in particular:
- The period of time for submitting of any material (including additional documents) supporting the registration and this complaint is time-barred and is strictly limited to 40 days.
- The documents submitted by the Complainant in the phased registration did not substantiate his Prior Rights pursuant to the Regulation 874/2004/EC and the Sunrise Rules;
- There is no clear and obvious connection between the Complainant and the disputed domain names in respect of the transfer of Prior Rights.
- There is no evidence regarding the current existence and use of Prior Rights for the validation agent to prima facie review them, as described by Sunrise Rules and the Regulation 874/2004/EC.