Panel Decision for dispute CAC-ADREU-003549

Case number	**CAC-ADREU-003549**
Time of filing	**2006-10-24 14:33:42**
Domain names	**blueflag.eu, blue-flag.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**blueflag Ltd, mr stuart harry robertshaw**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

On February 7, 2006 the company under the name Blue Flag Ltd., applied for the domain name BLUEFLAG.EU and BLUE-FLAG.EU claiming as prior right its company name protected in the United Kingdom for the name “BLUE FLAG”. Said company filed documentary evidence to the Respondent acting as Validation Agent consisting of 1) an affidavit signed by Frank William Baker, 2) certificates of incorporation, 3) a page showing the Complainant’s letterhead, 4) UK Companies House registration details, 5) advertising materials, and 6) not readable photocopies.

The Respondent rejected the application for the domain name BLUEFLAG.EU and BLUE-FLAG.EU because said company did not prove clearly and sufficiently that it was the holder of the claimed prior right.

The company under the name Blue Flag Ltd., filed a complaint against the Respondent on October 24, 2006, and thus he became Complainant. The Respondent filed a response to the Complainant which was received by the Czech Arbitration Court on January 19, 2007. Henceforth, the Czech Arbitration Court appointed the undersigned herewith as a Panelist on January 22, 2007.

A. COMPLAINANT

1. Blue Flag Ltd. has a prior right on the basis of its company name according to article 16(1) and 16(4) of the Sunrise Rules
2. As documentary evidence of its prior right the Complainant filed the Certificate of Incorporation, Blue Flag’s letterhead, and the UK Companies House’s registration details.
3. In the amended Complaint the Complainant added: “In addition, we are enclosing with further documents and evidence by “who is” and “EuroDNS” for the following domain names blueflag.pl, blueflag.ch, blueflag.mobi, blue-flag.mobi.”

B. RESPONDENT

1. According to article 10(1) of EC Regulation 874/2004 of April 28, 2004: “only holders of prior rights which are 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 names.”
2. According to article 14 of EC Regulation 874/2004 of April 28, 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…"
3. According to article 16(1) of the Sunrise Rules: "a company name is an official name of a company, i.e. the name under which the company is incorporated or under which the company is registered. In member states where no company name protection exists, the name of the company may still be protected as a trade name (as referred to in Section 16(2)) or a business identifier (as referred to in Section 16(3)). 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)."
4. The provision of article 16(4) of the Sunrise Rules starts by stating that "unless otherwise provided in Annex 1 hereto…."
5. As far as the United Kingdom is concerned and according to Annex 1 of the Sunrise Rules, a company name may be protected in the United Kingdom as a prior right only to the extent that rights in passing off exist.
6. According to Annex 1 and Section 12(3) of the Sunrise Rules, a company name protected under the law of the United Kingdom may only be relied upon as a prior right to the extent that rights in passing off exist, which must be demonstrated by:
a. an affidavit signed by a competent authority, legal practitioner, or professional representative, stating that the name meets the conditions provided for in law (including relevant court decisions, scholarly works and such conditions as may be mentioned in Annex 1 (if any)) or
b. 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.
7. The Complainant for the applications regarding the domain names BLUEFLAG.EU and BLUE-FLAG.EU during the Sunrise Period submitted the following documents:
a. An affidavit signed by Frank William Baker stating that:
i. He is an accountant employed by Blue Flag Ltd.
ii. Blue Flag Ltd. has been trading under the name Blue Flag Ltd.
iii. Blue Flag Ltd. has exclusive rights on its company name to best of Frank William Baker's knowledge, information and belief.
iv. The name has not been challenged in court so far.
b. Certificates of incorporation showing that Blue Flag Ltd. is incorporated in the United Kingdom under the number 2817155
c. Photocopies which were not clear and legible.
d. A page showing the Complainant's letterhead.
e. Advertising materials
8. Regarding the above mentioned documentation submitted by the Complainant it is worth noticing that said affidavit neither is it signed by a legal practitioner, nor can it be considered as a legal analysis appropriate to provide sufficient piece of evidence that the rights in passing off exist.
9. The Respondent did not accept said affidavit furnished to him by the Complainant. As relevant prior decisions are mentioned the following:
i. Decision no. 3226 (CARAVANCLUB) according to which a "mere registration extract is not enough to establish a sufficient prior right to a company name in the UK."
ii. Decision no. 3146 (ESTHETYS) according to which "the legal position in the United Kingdom is recognized by the Sunrise Rules which provides that applicants claiming company name/trade name/business identifier rights under the law of the United Kingdom can do so only to the extent that rights in passing off exist."
10. Regarding documentation and evidence concerning "who is" and "EuroDNS" for the domain names blueflag.pl, blueflag.ch, blueflag.mobi, and blue-flag.mobi submitted by the Complainant, the Respondent contents that these documents could not be used by the Complainant according to article 22(1) of EC Regulation 874/2004 of April 28, 2004, stating that "a decision taken by the Respondent may only be annulled when it conflicts with the Regulation". The verification is the only task for the Panel in these proceedings, which may not in any case serve as a second chance or an additional round providing applicants an option to remedy their application. (see ADR 551(VIVENDi), 810(AHOLD) and 1194(INSURESUPERMARKET)

DISCUSSION AND FINDINGS

1. According to article 10§1, of EC Regulation 874/2004 of April 28, 2004, "Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain names. '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 Member State where they are held: unregistered trademarks, trade names, business identifiers. ”
2. The Sunrise Period ran from December 7, 2005, and up to April 7, 2006. In particular, the first phase of the Sunrise Period run from December 7, 2005 and up to February 6, 2006; the second phase run from February 7, 2006 and up to April 7, 2006.
3. According to article 12§2 of EC Regulation 874/2004 of April 28, 2004, “applications for .eu domain names submitted during the first stage of the Sunrise Period may only be based to (a) registered trademarks (b) geographical indications and (c) names and acronyms of public bodies. Said applications may be accepted provided that there is sounding evidence on prior rights for the applied domain name. During the second part of phased registration, the names that can be registered in the first part as well as names based on all other prior rights can be applied for as domain names holders of prior rights on those names.”
4. According to article 16§1 of the Sunrise Rules, “a company name is an official name of the company, i.e. the name under which the company is incorporated or under which the company is registered. In member states where no company name protection exists, the name of the company may still be protected as a trade name (as referred to in Section 16 (2)) or a business identifier (as referred to in Section 16(3)). 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).”
5. According to article 16§4 of the Sunrise Rules “unless otherwise provided in Annex 1 hereto, it shall be sufficient to submit the following Documentary Evidence for company names referred under Section 16(1)
a. an extract from the relevant companies or commercial register;
b. 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
c. 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”.
6. According to Annex 1 of the Sunrise Rules for company names used in the United Kingdom company names are protected as prior right only to the extent that rights in passing off exist. “Rights in passing off do not strictly speaking confer rights in anything. They constitute rights to restrain misrepresentations which are likely to damage the claimant’s goodwill. Passing off is a tort based upon the proposition that it is unlawful to represent contrary to fact that one’s goods or services are the goods or services of another. Commonly, such misrepresentations are made by using a name or mark, which identifies the claimant or is otherwise a symbol of his goodwill” (WIPO Arbitration and Mediation Center, Case no. D 2002-0122). “The three fundamental elements to passing off are reputation, misrepresentation and damage to goodwill, which are sometimes known as the classical trinity, as restated by the English House of Lords in the case of Reckitt & Colman Ltd. v Borden Inc. [1990] 1 RPC 341 1 (the jiff Lemon case). Lord Oliver stated the matters which a successful plaintiff must establish, as follows: “First, he must establish a goodwill or reputation attached to the goods or services… Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether intentional) leading or likely to lead the public to believe that the goods or services offered by him are goods or services of the plaintiff. Third, he must demonstrate that he suffers [loss or damage as a consequence of the erroneous belief that the goods or services of the defendant are the goods or services of the plaintiff).”
7. According to Annex 1 of the Sunrise Rules the documentary evidence required to be filed is 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). According to article 12§3 of the Sunrise Rules “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 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 meet 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.”

8. According to article 21§2 of Sunrise Rules, the Validation Agent examines whether the Applicant has a Prior Right to the name exclusively on the basis of a prima facie review of the first set of Documentary Evidence received and scanned by the Processing Agent (including the Documentary Evidence received electronically, where applicable) and in accordance with the provisions of the Sunrise Rules.
9. The Complainant which is a Limited Liability Company registered in United Kingdom filed an application for the registration of domain names BLUEFLAG.GR and BLUE-FLAG.GR on February 7, 2006, based on its company name i.e. during the second phase of the Sunrise Period which started in February 7, 2006.
10. According to article 16 & 1 of 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)." Regarding the required documents in accordance with article 16§4 of the Sunrise Rules they are the mentioned documents therein unless otherwise provided in Annex 1 thereto. Further according to Annex 1 of the Sunrise Rules, company names used in United Kingdom are protected as prior right only to the extent that rights in passing off exist. Required documents to be filed are (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 as described therein.
11. The Complainant filed as documentary evidence an affidavit but this affidavit is not in accordance with the provisions of article 12§3 of the Sunrise Rules for the following reasons:
a. The affidavit filed by the Complainant to the Respondent as Validation Agent was signed by Frank William Baker, accountant employed by Blue Flag Ltd., as it is therein stated, and not by a legal practitioner
b. In the context of said affidavit it is not stated that the name for which a Prior Right is claimed meet the conditions provided for in the English law, and it does not describe the arguments for which the company name Blue Flag Ltd. has a passing off right under the English law (§6). Additionally, in the context of said affidavit there is not even a bare ascertainment for the existence of a passing off right (Nominet UK Dispute Resolution Service DRS 03890).
c. Regarding the letterhead of the company and the company registration certificate filed as supporting documents to the affidavit it is noticeable that the letterhead of the company and the company registration certificate are not sufficient pieces of evidence to prove that a passing off right exists. "In English law, the incorporation of a company under a particular name, does no more than block others from registering the same name with the Registrar of Companies; it does not, of itself, prevent others from using that name in business. The copy of the company name's letterhead is no evidence of reputation nor the geographical extent of the same." (Nominet UK Dispute Resolution Service DRS 03890, Decision 03226, (CARAVANCLUB), Decision 03146 (ESTHETYS)).
12. The contentions of the Complainant regarding the registration of the domain names blueflag.pl, blueflag.ch, blueflag.mobi and blue-flag.mobi provided for the first time during the ADR Proceeding should not be taken into account according to article 22§1(b) of the EC Regulation 874/2004 of April 28, 2004, stating that "a decision taken by the Respondent may only be annulled when it conflicts with the Regulation". New documents submitted by a Complainant may not be taken into consideration by the Panel stating that a decision taken by the Respondent may only be annulled when it conflicts with the applicable rule and regulations [relevant cases: Case 551 (VIVENDI), Case 810 (AHOLD), Case 1194 (INSURESUPERMARKET), Case 294 (COLT), Case 954 (GMP), Case 01549 (EPAGES), and Case 1422 (PORTAS)].
13. According to article 21§2 of Sunrise Rules the Validation Agent examines whether the Applicant has a Prior Right to the name exclusively on the basis of a prima facie review of the first set of Documentary Evidence received and scanned by the Processing Agent (including the Documentary Evidence received electronically, where applicable) and in accordance with the provisions of the Sunrise Rules, the Respondent could not decide that the Complainant has a prior right following EC Regulation 874/2004 of April 28, 2004, 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

Relevant decisions: Case 03226 (CARAVANCLUB), and Case 03146 (ESTHETYS).

PANELISTS

Name	**Alexandra Kaponi**

DATE OF PANEL DECISION 2007-02-16

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed a complaint against the Respondent regarding the rejection of his application filed during the Sunrise Period concerning the registration of the domain names BLUEFLAG.EU and BLUE-FLAG.EU. That decision which denies the registration of said domain names is taken pursuant to EC Regulation 874/2004 of April 28, 2004, and EC Regulation 733/2002 of April 22, 2002, and the Sunrise Rules in consideration of the following premises:

1. The applications of the Complainant considered as a company registered in the United Kingdom for the registration of said domain names filed during the Sunrise Period were relied upon to its company name. However, the claims of the Complainant regarding its “prior right” based on its company name were not sufficiently substantiated. Furthermore its “prior right” on its company name should have been based on the provisions of Annex 1 and article 12§3 of the Sunrise Rules according to which company names used in the United Kingdom are protected as prior right only to the extent that rights in passing off exist rather than on the provisions of article 16§§1 and 4 of the Sunrise Rules.
2. Furthermore the documentary evidence filed by the Complainant is not in accordance with article 12§3 of the Sunrise Rules, meaning that:
a. The Complainant filed to the Respondent an affidavit which is not in accordance with article 12§3 of the Sunrise Rules because
i. the affidavit is signed by an accountant of the company Blue Flag Ltd. and not by a competent authority, legal practitioner or professional representative of the company.
ii. the affidavit does not state clearly that the name for which a Prior Right is claimed meet the conditions provided for in the English law and does not describe the arguments for which the company has a passing off right under the English law
b. The letterhead of the company and the company registration certificates filed as supporting documents to the affidavit are not sufficient pieces of evidence to prove that a passing off right exists.
3. The contentions of the Complainant regarding the registration of the domain names blueflag.pl, blueflag.ch, blueflag.mobi and blue-flag,mobi for the first time during the ADR proceeding cannot be taken into account according to article 22§1 of EC Regulation of April 28, 2004.
4. The Respondent could not decide that the Complainant has a prior right following EC Regulation of April 28, 2004, and the Sunrise Rules, according to article 21§2 of Sunrise Rules stating that the Validation Agent examines whether the Applicant has a Prior Right to the name exclusively on the basis of a prima facie review of the first set of Documentary Evidence received and scanned by the Processing Agent and in accordance with the provision of the Sunrise Rules.