Panel Decision for dispute CAC-ADREU-002087

Case number	**CAC-ADREU-002087**
Time of filing	**2006-07-03 14:07:15**
Domain names	**plextor.eu, plextalk.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Plextor Europe, Mr Ruben Nauwelaers**

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 Complainant indicates that one of the domain names that is the subject of this proceeding was originally commenced as a separate proceeding under Case Nº 2091 and then joined in the present case. The Panel is not aware of any other pending or decided legal proceedings which relate to the disputed domain names.

FACTUAL BACKGROUND

The Complainant in these proceedings is 'Plextor Europe' and the Respondent is EURid. The Panel assumes from the totality of the submissions that the Complainant is the same entity as originally applied for the disputed domain names: that is, Plextor SA/NV, a company incorporated under the laws of Belgium and a subsidiary of Shinano Kenshi Kabushiki Kaisha ('Shinano') a company incorporated and organized under the laws of Japan.

The Complainant submitted applications for registration of plextor.eu and plextalk.eu (the 'Applications') on 7 December and 12 December 2005 respectively. The processing agency received documentary evidence on 28 December 2005, before the deadline of 16 January 2006. The Applications were based on the Benelux registered trademark PLEXTOR and the United Kingdom trademark PLEXTALK (the 'Trademarks').

The documentary evidence submitted with the Applications recorded that: (i) the Trademarks are registered in the name of Shinano; (ii) the registration in the United Kingdom Patent and Trademark Office of the trademark PLEXTALK expired on 16 December 2005; (iii) an application had been made by Shinano for a figurative trademark for PLEXTALK in the United Kingdom, without demonstrating that the trademark had been registered.

The Complainant did not provide any documentary evidence to show that it was either the the owner of a registered trademark for PLEXTOR or PLEXTALK, or had a license, assignement or other contractual rights in the Trademarks derived from Shinano.

Based on the documentary evidence received, the validation agent found that the Complainant had not substantiated a prior right within the meaning of Article 10 (1) of Commission Regulation No. 874/2004 (the 'Regulation') and therefore by decisions dated 24 and 25 May 2006 (the 'Decisions') the Respondent rejected the Applications.

The Complaint was filed on 29 June 2006 and notified to the Respondent on 14 July 2006. The Complainant seeks the annulment of the Decisions and that the disputed domain names be granted to the Complainant. The Respondent submitted its Response to the statements and allegations made in the Complaint on 4 September 2006. On 5 September 2006 Dr. David J. A. Cairns was appointed as single panellist, and the file was transmitted to the Panel on 8 September 2006.

A. COMPLAINANT

The Complainant states "…Plextor SA/NV is a subsidiary of Shinano Kenshi Co. Ltd, that Plextor SA/NV is targeted for the European market and that Shinano Kenshi Co. Ltd grants Plextor SA/NV the right to use the registered trademarks 'PlexTalk' and 'Plextor' at will in Europe." Therefore, the Complainant contends that it is a legitimate holder of the Trademarks and has a right to register the domain names in Sunrise Period 1.

The Complainant submits new documents, including two certificates from Shinano confirming that Plextor SA/NV (i) is one of Shinano's subsidiaries with the role of selling and marketing Plextor products in the European market; and (ii) has a right to use the PLEXTOR and PLEXTALK trademarks. The Complaint further includes other documents confirming that Shinano is the proprietor of the Trademarks.

The Complainant requests that the Decisions should be annulled and the Domain Names be granted to the Complainant.

B. RESPONDENT

The Respondent states that the Application was rejected because the documentary evidence submitted by the Complainant did not demonstrate that the Complainant was the holder or the licensee of a prior right.

In particular, the Respondent contends that (i) the Complainant had the burden of proving that it was the holder or the licensee of the Trademarks; (ii) The documentary evidence submitted by the Complainant with the Applications did not demonstrate that it was the holder or licensee of a prior right; and (ii) the new documents submitted by the Complainant may not be taken into consideration because they were not enclosed with the Applications.

For all these reasons, the Respondent requests that the Complaint be rejected

DISCUSSION AND FINDINGS

The Regulation establishes a phased registration procedure for .eu Top Level Domain Names. Registration is based on validation of rights, performed by appointed validation agents. Only holders of prior rights recognised or established by national and/or Community law –or authorized parties– and public bodies are eligible for phased registration. The applicable rules to these proceedings include the Regulation and the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period ('Sunrise Rules').

From the evidence submitted and the provisions of the applicable rules, the Panel considers the Applications of the Complainant did not satisfy the requirements of the Regulation and the Sunrise Rules. The validation agent found that no prior right was substantiated by the documentary evidence submitted with the Applications, and the Respondent refused the Applications.

Article 10 (1) of the Regulation provides that "…holders of prior rights recognized 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 name starts…." Holders of prior rights under the meaning of Article 10(1) of the Regulation also include licensees of those rights.

The burden of proof is on the applicant (Complainant) to submit with the application to register a domain name, "…documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question…. The applicant shall submit the evidence in such a way that it shall be received by the validation agent within forty days from the submission of the application for the domain name…." (Article 14 of the Regulation). Therefore, the central question is not whether the Complainant is the holder of prior rights or entitled to use the Trademarks, but whether the Complainant substantiated by documentary evidence submitted at the appropriate time that it is the holder or licensee of those rights. If the applicant fails to prove that, the application shall be rejected (see Case no. 1886 – GBG).

According to Section 21.1(ii) of the Sunrise Rules, the validation agent shall verify "…whether the requirement for the existence of a Prior Right to the name claimed by the Applicant in the Application is fulfilled…." Pursuant to Section 21.2 of the 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…." Where the applicant asserts a prior right based on being the licensee of a registered trademark then Section 20.1 of the Sunrise Rules provides that the documentary evidence must include "…an acknowledgement and declaration form….duly completed and signed by both the licensor of the relevant registered trademark and the Applicant (as licensee)…."

In the present case, the documentary evidence did not demonstrate that the Complainant was the holder or licensee of prior rights –i.e. the Trademarks. It did not include the acknowledgement and declaration required by Section 20.1 of the Sunrise Rules or any comparable evidence of a license agreement with Shinano or other authorisation to use the Trademarks. Accordingly, the documentary evidence did not demonstrate a prior right within the meaning of Article 10 of the Regulation, and was properly rejected by the

Respondent.

There remains the question of the status of the evidence submitted by the Complainant in this proceeding confirming that Plextor is one of Shinano's subsidiaries in Europe and has a right to use the PLEXTOR, and PLEXTALK trademarks, currently valid and owned by Shinano. This new evidence suggests that the Complainant did in fact have a prior right within the meaning of Article 10 of the Regulation at the time of the Applications.

Previous panels have stressed that even if the new documents submitted by the Complainant were to adequately demonstrate that it is the holder of the trademark at stake, these new documents may not be take into consideration to evaluate the Respondent's decision. (See, for example, Case 1627 – Planetinternet). ADR proceedings initiated under Article 22 of the Regulation shall not serve as a second chance to remedy defects of an application attributable to the applicant. An applicant cannot use ADR proceedings in order to amend or perfect a Sunrise application that was properly rejected (See Case no. 551 – Vivendi). It was the Complainant's responsibility to ensure that all the documentary evidence necessary to establish the prior right and therefore the registration of the domain names were submitted in the proper form at the proper time.

The Panel is required by Article 22.11 of the Regulation to decide whether the decision taken by the Registry conflicts with the Regulation or with regulation (EC) Nº 733/2002. The Panel must consider the decision in fact taken by the Registry on the basis of the documentary evidence submitted within the prescribed period, and not speculate as to the decision the Registry might or should have taken if other evidence had been made available at the appropriate time. Accordingly, the Panel finds that the new evidence submitted by the Complainant cannot be considered in this proceeding against the Registry, and the Complaint is rejected.

The only courses of action available to an applicant that failed in its application during the Sunrise period for deficiencies in its documentary evidence are: (i) to re-apply for registration or, (ii) if the domain name has already been taken, to seek to recover the domain name from its holder where the registration is speculative or abusive within the meaning of Article 21 of the Regulation.

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	David Cairns

DATE OF PANEL DECISION 2006-10-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

An application during the Sunrise period was properly rejected by the Registry on the basis that the documentary evidence submitted with the application did not substantiate a prior right. In this ADR proceeding the Complainant submitted additional evidence to demonstrate its prior right.

The Panel is required by Article 22.11 of Commission Regulation No. 874/2004 to decide whether the decision taken by the Registry conflicts with this Regulation or with regulation (EC) Nº 733/2002. The Panel must consider the decision in fact taken by the Registry on the basis of the documentary evidence submitted within the prescribed period, and not speculate as to the decision the Registry might or should have taken if other evidence had been made available at the appropriate time. Accordingly, the Panel finds that the new evidence submitted by the Complainant cannot be considered in this proceeding against the Registry, and the Complaint is rejected.