Panel Decision for dispute CAC-ADREU-003685

Case number	**CAC-ADREU-003685**
Time of filing	**2006-11-03 11:55:52**
Domain names	**pippi.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Pippi A/S, Erik Andreæ**

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

This Panel is not aware of any other pending or decided legal proceedings which relate to the disputed domain names.

FACTUAL BACKGROUND

The Complainant is the Danish company Pippi A/S. The Respondent is the .eu domain name Registry, EURid.

On 7 December 2005 the Complainant applied for the domain name <pippi.eu>.

The documentary evidence was received in time on 13 January 2006.

The Respondent apparently rejected the application on 25 September 2006.

The Complainant filed its Complaint against this rejection on 31 October 2006, annexing 17 appendices. The Complainant requested the Czech Arbitration Court to require EURid to disclose the documentary evidence as defined in the Sunrise Rules.

On 13 November 2006, the Czech Arbitration Court, in accordance with article B2(b) of the ADR Rules, informed the Complainant that the Complaint did not comply with the ADR procedural rules.

On 14 November 2006, the Complainant submitted an amended Complaint to the Czech Arbitration Court.

On 15 November 2006, the Case Administrator undertook a Complaint check. The Case Adminstrator verified that the Complaint met all the formal requirements of the ADR Rules. On the same day, the ADR Proceeding formally commenced.

On 21 December 2006, EURid responded to the Complaint.

On 27 December 2006, the Czech Arbitration Court acknowledged the receipt of the Response. On the same day, the Czech Arbitration Court undertook a Response check and verified that the Response met all the formal requirements of the ADR Rules.

On 2 January 2007, Wolter Wefers Bettink was appointed single Panelist. On the same day, the parties were notified of the Appointment of the ADR Panel. The Projected Decision Date was set at 21 January 2007.

On 5 January 2007, the Case was transferred to the Panelist.

A. COMPLAINANT

The Complainant submits that it has been using the business trademark PIPPI since 1957. According to the Complainant, under the Danish Trademark Act, such use can constitute trademark rights. It registered PIPPI as a trademark in Denmark in 1997.

The Complainant further submits that its name has changed several times since it registered PIPPI as a trademark, but that it is still the same legal entity.

The Complainant notes that the domain name has been attributed to the next applicant in line, the company Saltkrakan AB. The Complainant submits that this company has not acquired better rights to the trademark than the Complainant. The Complainant is currently opposing Saltkrakan AB's intended registration of the mark PIPPI as a Community trademark.

The Complainant requests the Panel to annul the decision of Respondent or to award the contested domain name to it.

B. RESPONDENT

The Respondent points out that during the period of phased registration, only the holders of prior rights are eligible to apply to register an .eu domain name. When applying for a domain name during the period of phased registration, the applicant must submit documentary evidence that shows that it is the holder of the prior right claimed on the name in question. According to the Respondent, the burden of proof therefore rested on the Complainant to substantiate its prior right to the name 'Pippi'.

According to the Respondent, the documentary evidence did not demonstrate that the Complainant was the holder of a prior right to the name 'Pippi'. The documentary evidence submitted by the Complainant indicated that a company by the name 'Pippi Børnetøj Herning A/S' is the owner of the trademark PIPPI. The company name of the applicant was Pippi A/S.

DISCUSSION AND FINDINGS

Procedural aspects of the Complaint
According to article B1(b)(8) of the ADR Rules, the Complaint must identify the Registry's disputed decision. The Complaint indicates that the disputed decision is no. 26790, which apparently (the Complaint does not mention this) is EURid's decision not to attribute the domain name to Complainant.

According to article B1(b)(11) of the ADR Rules, the Complaint must specify the remedies sought. The Panel notes that the Complainant seeks the annulment of the Registry's decision, or alternatively the attribution of the disputed domain name to the Complainant. The Panel points out that in accordance with article B11(c) of the ADR Rules, attribution of the domain name without annulment is not possible. Furthermore, the Panel points out that, since the domain name has been attributed to a third party, the domain name, upon annulment, would have to be transferred to Complainant. The Panel has therefore assumed that the Complainant seeks annulment of decision no. 26790 and transfer of the domain name to it.

Substantive aspects of the Complaint

1. Relevant rules

Pursuant to Article 10 of Commission Regulation (EC) No. 874/2004 of 28 April 2004 (hereafter: "the Regulation"), during the period of phased registration it was possible for holders of prior rights to apply for the registration of domain names.

Pursuant to Article 14 of the Regulation, the applicant for a domain name must prove that it is the holder of the prior right claimed.
Article 14, paragraph 4 of the Regulation states:
"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."
Thus, the applicant for a domain name bears the burden of proof to demonstrate that it is the holder of a prior right claimed on the name in question (Case 219 (ISL), Case 1071 (ESSENCE), Case 2881 (MRLODGE) and Case 1886 (GBG).

Section 20.3 of the Sunrise Rules provides that if the documentary evidence provided does not clearly indicate the applicant's name as being the holder of a prior right claimed, the applicant must, within 40 days of the date of application, submit official documents substantiating that it is the same company as - or the legal successor to - the company indicated in the documentary evidence as being the holder of the prior right. Failing to submit such official documents means failing to show that the applicant is the holder of the prior right claimed on the name in question.

2. The Documentary Evidence submitted

The Panel finds that the documentary evidence provided by the applicant within 40 days of the date of application does not demonstrate that it is the holder of a prior right.
The documentary evidence of its prior right on which the applicant relies is an extract from the Danish Trademark Register, which states that Pippi Børnetøj Herning A/S is the owner of the word mark PIPPI (reg.no. VR 1997 01813, registered on 18 April 1997). The applicant for the disputed domain name is Pippi A/S. Therefore, the documentary evidence does not substantiate that the applicant for the domain name <pippi.eu> (the company Pippi A/S) is the holder of a prior right to the name 'Pippi'.

3. Could the Validation Agent be required to conduct its own investigation?

According to section 21.3 of the Sunrise Rules, the Validation Agent is not obliged, but, on the basis of his sole discretion, is permitted to conduct its own investigation into the circumstances of the application, the prior right claimed and the documentary evidence produced (Case 218 (ISL), Case 551 (VIVENDI) and Case 1483 (SUNOCO)). As this is a discretionary power, it should be considered whether, in the circumstances of this case, the Validation Agent can reasonably be required to use this power. In previous cases it has for instance been decided that the Validation Agent should have made such an investigation where there was an obvious spelling mistake or a minor difference between the two names (see e.g. Case 2298 (LEVIS) and Case 2534 (STICKERS)), that they had the same address. In the present case, both the name of the applicant and the holder of the previous right differ considerably (Pippi Børnetøj Herning A/S and Pippi A/S), and they are located at different addresses. In these circumstances the Validation Agent cannot reasonably be required to undertake further investigation.

4. Can documentary evidence annexed to the Complaint demonstrate prior rights?

The Complainant annexed to its Complaint an extract from the Danish Chamber of Commerce showing that the Complainant and the applicant are in fact the same company. In view of article 14 of the Regulation, the Panel can not take this document into account in its decision, as this document was not submitted to the Validation Agent within 40 days of the application being filed (Case 294 (COLT) and Case 2124 (EXPOSIUM)).

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	**Wolter Wefers Bettink**

DATE OF PANEL DECISION 2007-01-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Pursuant to Article 10 of the Regulation, during the period of phased registration it was possible for holders of prior rights to apply for the registration of domain names. The Complainant, the company Pippi A/S, applied for registration of the domain name <pippi.eu> on 7 December 2005. It relied on a prior right in the trademark PIPPI, registered in Denmark.

Pursuant to article 14 of the Regulation, the applicant for a domain name bears the burden of proof to demonstrate that it is the holder of a prior right claimed on the name in question. The documentary evidence submitted by the Complainant to the Validation Agent demonstrated that the word mark PIPPI was owned by a company with another name than the name of the applicant.

According to section 20.3 of the Sunrise Rules, in case of a discrepancy between the name of the applicant and the name of the holder of the prior right, the applicant must submit within 40 days of its application official documents substantiating that it is the same company as - or the legal successor to - the company indicated in the documentary evidence as being the holder of the prior right. Because the Complainant failed to do so, it has not demonstrated before the Validation Agent that it is the holder of a prior right.

Under the circumstances of this case, the Validation Agent could not reasonably be required to conduct its own investigation, as the documentary evidence not only showed a substantial difference between the names of the trademark owner and the applicant, but also that they were located at different addresses.

The Panel dismisses the Complaint.