Panel Decision for dispute CAC-ADREU-003715

Case number	CAC-ADREU-003715
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Domain names	jst.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	JST Import Europe NV, Mr. Tom Smets

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 any other legal proceedings in relation to the disputed domain name <jst.eu>.

FACTUAL BACKGROUND

JST Import Europe NV (hereinafter “the Complainant”) applied for the domain name <jst.eu> on 7 February 2006 during the second phase of the phased registration period, i.e. the Sunrise II period.

The validation agent received the documentary evidence for the application on 20 February 2006, which was before the deadline of 19 March 2006.

The documentary evidence consisted of an abstract from the Belgian official journal indicating, inter alia, that the company J.S.T. Real Estate NV had on 21 August 2001 changed its name to J.S.T. Import Europe NV.

EURid (hereinafter "the Respondent") refused the Complainant’s application on grounds that the documentary evidence was not sufficient to prove the claimed prior right.

The Complainant initiated ADR proceedings by filing its Complaint on 8 November 2006.

The Respondent filed a Response to the Complaint on 28 December 2006.

A. COMPLAINANT

The Complainant makes the following contentions:

The Complainant states that by supplying additional evidence for the registered trademark JST they would like to claim their prior right to the domain name <jst.eu> and thereby revert to the decision made by the Respondent.

As the additional evidence the Complainant submits at this stage a copy of the Community trademark registration certificate for the mark JST held by Japan Solderless Terminal Manufacturing Co. Ltd. in Japan and a License Declaration form, executed on 6 February 2006, duly signed by the licensor Japan Solderless Terminal Manufacturing Co. Ltd. and the Complainant, the licensee.

The Complainant points to Section 13 and to Section 20 (1) of the Sunrise Rules and contends that by the annexed supplemental evidence they can demonstrate that JST is an internationally recognized registered trademark and that the Complainant is the licensee of the trademark JST.

Based on the above contentions, the Complainant states that it claims prior right to the domain name <jst.eu>.

B. RESPONDENT

The Respondent makes the following contentions:

“1. GROUNDS ON WHICH THE RESPONDENT REJECTED THE APPLICATION BY JST IMPORT EUROPE NV FOR THE DOMAIN NAME JST.EU

Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") states that only holders of prior rights which are recognised 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.

Article 10 (2) of the Regulation states that the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation, which proves that such a right exists.

Article 14 of the Regulation states that "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. (…) If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this. (…) The Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in the second, third and fourth paragraphs".

JST IMPORT EUROPE NV (hereafter "the Complainant") applied for the domain name JST on 7 February 2006. The Applicant claimed a prior right in the form of a company name protected in the Belgium. The processing agent received the documentary evidence on 20 February 2006, which was before the 19 March 2006 deadline.

The Applicant submitted documentary evidence consisting of an abstract from the Belgian official journal showing that the company "J.S.T. Real Estate", amongst other things, changed its name to "J.S.T. Import Europe" on 14 August 2001. Based on the documentary evidence, the validation agent found that the Applicant did not demonstrate that it was the holder or the licensee of a prior right on the name JST.

Therefore, the Respondent rejected the Applicant's application.

2. COMPLAINANT'S CONTENTIONS

The Complainant does not argue that the decision taken by the Respondent conflicts with the Regulation. Instead, the Complainant supplies additional documents according to which the Complainant received a license from the holder of the Community trademark "JST". The Complainant attaches those documents to its Complaint.

The Complainant requests the Panel to annul the Respondent's decision and to grant the domain name JST to the Complainant.

3. RESPONSE

3.1 Documents submitted for the first time in the framework of the present proceedings may not be considered as documentary evidence to establish the claimed prior right

Pursuant to the Regulation article 14 of the Regulation, the Respondent may only accept, as documentary evidence, documents that are received by the validation agent within 40 days from the submission of the application for the domain name. In the present case, the 40 days period ended on 19 March 2006.

The Complainant filed its Complaint on 6 November 2006 and submitted these new documents with its Complaint.

These documents may not serve as documentary evidence for the Complainant's application, since those documents are submitted almost 8 months after the end of 40 days period set forth by the Regulation. Accepting these documents as documentary evidence would clearly violate the Regulation.

Furthermore, article 22 (1) b of the Regulation states that a decision taken by the Respondent may only be annulled when it conflicts with

the Regulation.

Therefore, only the documentary evidence, which the Respondent was able to examine at the time of validation of the application, should be considered by the Panel to assess the validity of the Respondent's decision (see notably cases ADR 294 (COLT), 954 (GMP), 1549 (EPAGES), 1674 (EBAGS), 2124 (EXPOSIUM), etc.).

This 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 imperfect original application that was rejected during the Sunrise Period (see cases Nr. 551 (VIVENDI) and Nr. 810 (AHOLD)).

The validation agent did not receive the new documents, attached to the present Complaint, during the 40 days period, which means that the Respondent could not use this information in taking its decision. Therefore, this new information may not be taken into consideration to evaluate whether the Respondent's decision conflicts with the Regulation, which is the only purpose of the present ADR proceedings.

This was clearly summarised by the Panel in ADR 2881 (MRLODGE): " the Panel has no authority to validate the Complainant’s application retrospectively based on additional documentary evidence which was submitted in the ADR proceedings but which was not submitted to the validation agent within the applicable time limits (see cases 219 (ISL), 294 (COLT), 706 (AUTOWELT), 954 (GMP), and 1627 (PLANETINTERNET)). Previous ADR decisions, with which this Panel concurs, concluded that the ADR procedure is not intended to correct domain name applicants’ mistakes (see cases 551 (VIVENDI), 810 (AHOLD), 1194 (INSURESUPERMARKET), and 1627 (PLANETINTERNET)).”

In ADR 1262 (NATIONALBANK), the Panel decided that: " It is not for the Panel to perform the task of the validation agent retrospectively and examine new evidence relating to prior rights. In the Panel's opinion to allow a Panel to do this would in effect be giving a Respondent a second bite at the cherry, contrary to Article 14 of the Regulation ".

Furthermore and for the sake of completeness, the Respondent notes that the documents attached to the Complainant's Complaint (i.e. a trademark registration and a license form) do not constitute appropriate documentary evidence to demonstrate the prior right claimed in the Complainant's application (i.e. a company name protected in the Belgium).

3.2 The company name does not consist of the complete name of the domain name applied for

Even though the Complainant does not argue that the Respondent's decision conflicts with the Regulation, the Respondent will nevertheless defend its decision.

Pursuant to article 10 (2) of the Regulation, a domain name applied for during the Sunrise Period must consist of the complete name of the prior right on which the application is based, as written in the documentation which proves that such a right exists.

Section 19 (1) of the Sunrise Rules states that: " As stated in Article 10(2) of the Public Policy Rules, registration of a Domain Name on the basis of a Prior Right consists in the registration of the complete name for which the Prior Right exists, as manifested by the Documentary Evidence. It is not possible for an Applicant to obtain registration of a Domain Name comprising part of the complete name for which the Prior Right exists.”

The Complainant submitted documentary evidence substantiating that the company name relied upon as a prior right is " J.S.T. IMPORT EUROPE", pursuant to a name change of the company "J.S.T. Real Estate". Therefore, the company name relied upon as a prior right could only serve as a prior right for the name “J.S.T. IMPORT EUROPE”, which is the complete name for which the company name exists as written in the documentary evidence.

Therefore, the Respondent correctly rejected the Complainant's application for the domain name JST, pursuant to article 10 (2) of the Regulation.

This rule has been consistently applied by numerous Panels. For example in ADR 2471 (TAIYO-YUDEN), the Panel decided that " In the case of the Complainant the complete name shown in the companies register is “Taiyo Yuden Europe GmbH”. If the company type “GmbH” would be omitted, the complete name reads “Taiyo Yuden Europe“. Therefore the company name of the Complainant would qualify as priority right for the registration of “taiyo-yuden-europe.eu” but not for “taiyo-yuden.eu”. The Panel disagrees with the Complainant´s argument that the word “Europe” in “Taiyo Yuden Europe“ is descriptive and should be disregarded. There is no EU Regulation or Sunrise Rule concerning the implementation of the .eu Top Level Domain that supports this opinion brought forward by the Complainant. In this context also German Trade Mark Law cannot support the Complainant’s argument as it is a company name, not a

trademark, which has been the basis for the Complainant's application."

The Respondent also refers to ADR 2061 (MODLINE), 02093 (MAZUR), 3032 (SEGHORN), 02499 (PSYTECH), 02494 (BPSC), 2297 (FENRISULVEN), 02047 (UNI-C), etc.

3.3 Conclusion

The Regulation and the Sunrise Rules give all the holders of prior rights the opportunity to demonstrate their prior rights during the phased registration, which is an exception to the basic principle of first-come first-served.

In order to benefit from this opportunity to demonstrate its prior rights, the applicant must comply with the strict procedure laid out by the Regulation for dealing with the thousands of applications received during the phased registration and making sure that these applications are substantiated.

The Complainant in the present case did not seize this opportunity, because its application did not correctly fulfill the substantial requirements of this procedure.

Any right given to the Complainant to correct its defective application at this stage of the procedure would be unfair to the other applicants who are standing in the line and would clearly be in breach of the Regulation and the Sunrise Rules, as stated in ADR 706 (AUTOWELT) and 1710 (PARLOPHONE, EMI, EMIMUSIC, EMIRECORDS, ANGEL, THERAFT).

For these reasons, the Complaint must be rejected."

DISCUSSION AND FINDINGS

Article 10 (1) of the Commission Regulation (EC) 874/2004, 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, states that only the holder of a prior right or a licensee of such a right is eligible to be granted the corresponding domain name.

Article 10 (2) of the Commission Regulation (EC) 874/2004 states that the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.

Article 14 of the Commission Regulation (EC) 874/2004 further provides that 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. 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. If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this.

Where the prior right claimed by the applicant is a registered trademark, Section 13 (2) of the Sunrise Rules provides that it is sufficient to submit the following documentary evidence in order to demonstrate the prior right, as long as the documentary evidence clearly proves that the applicant is the reported owner of the registered trademark, unless the applicant is a licensee or transferee of the registered trademark:
(i) a copy of an official document issued by the competent trademark office indicating that the trademark is registered; or
(ii) an extract from an official (on-line) database operated and/or managed by the relevant national trademark office, the Benelux Trademarks Office, the OHIM or the WIPO.

Where the prior right claimed by the applicant is a company name protected under the law of a member state, Section 16 (4) of the Sunrise Rules provides that it is sufficient to submit the following documentary evidence in order to demonstrate the prior right, as long as the evidence clearly indicates 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:
(i) an extract from the relevant companies or commercial register;
(ii) 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
(iii) a signed declaration form an official companies or commercial register, a competent public authority or a notary public.

Where the prior right claimed by the applicant is a trade name or a business identifier protected under the law of a member state, Section 16 (5) of the Sunrise Rules provides that it is sufficient to submit the following documentary evidence in order to evidence the prior right, as long as the evidence clearly indicates that the name for which the prior right is claimed is the trade name or business identifier of the

applicant:
(i) where it is obligatory and/or possible to register the relevant trade name or business identifier in an official register:
a. an extract from that register, mentioning the date on which the name was registered; and
b. proof of use of the trade name or business identifier prior to the date of application:
(ii) where registration is not obligatory:
a. an affidavit signed by a competent authority, legal practitioner or professional representative, accompanied by documentation supporting the affidavit; or
b. a relevant final judgement 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 the relevant scholarly works and court decisions and certain other conditions of the relevant member state in relation to the type of prior right concerned.

Section 20 (1) of the Sunrise Rules states that in case the applicant has obtained a license for a registered trademark in respect of which it claims a prior right, the applicant must enclose with the documentary evidence an acknowledgement and a license declaration form evidencing its right.

Section 21 (2) of Sunrise Rules states that the validation agent shall examine whether an applicant has a prior right to the name exclusively on the basis of a prima facie review of the documentary evidence it has received, and at the same time Section 21 (3) of the Sunrise Rules gives the validation agent a possibility to conduct further investigations into the circumstances of the application.

When applying for the domain name <jst.eu> the Complainant relied on its prior right to the company name, trade name or business identifier (all of the afore mentioned are included under the same prior right type code in the application) JST. The registration of the complete name for which the prior right exists, as set forth in Article 10 (2) of the Commission Regulation (EC) 874/2004, for the company name JST Import Europe NV would have been, for instance, jstimporteurope.eu or jstimporteuropenv.eu, not <jst.eu>. Consequently, the Complainant's company name could not serve as a prior right claimed for the domain name <jst.eu>. The Complainant did not submit any conclusive evidence on its prior right to the letter combination JST when providing the documentary evidence to the validation agent.

At the time of submitting the documentary evidence to the validation agent, the Complainant did not submit evidence of the Community trademark registration certificate for the mark JST nor a license Declaration form granting a licensed right to the Complainant.

The Complainant has, however, at the time of filing the Complaint, attached to the Complaint a copy of the Community trademark registration certificate for the mark JST, held by Japan Solderless Terminal Manufacturing Co. Ltd. in Japan, together with a License Declaration form, executed on 6 February 2006, duly signed by the licensor Japan Solderless Terminal Manufacturing Co. Ltd. and the Complainant, the licensee.

In accordance with the Commission Regulation (EC) 874/2004 and the Sunrise Rules, the burden of proof on demonstrating that the Applicant of a .eu domain name is the holder of the prior right claimed in the application is on the Applicant. The documentary evidence submitted by the Complainant within the 40 day deadline, set forth in Article 14 of the Commission Regulation (EC) 874/2004, was not sufficient to prove that the Complainant (i.e. the Applicant) was the holder of the prior right it had claimed in its application for the domain name <jst.eu>, and the Complainant has thus failed to prove the existence of its claimed prior right in accordance with the Commission Regulation (EC) 874/2004 and the Sunrise Rules. The Community trademark registration certificate for the mark JST and the License Declaration, provided only at the time of filing the Complaint, do not alter the above conclusion.

Even if the validation agent had conducted investigations of its own, it could not have been able to conclude that the Complainant actually had a prior right on the name JST by virtue of the license, since this fact was not evident or to be found to the validation agent by any reasonable means or resources.

Based on the foregoing, the Panel finds that the decision made by the Respondent to reject the application made by the Complaint was justified and therefore rejects 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	Sanna Aspola

DATE OF PANEL DECISION 2007-01-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant applied for the domain name <jst.eu> on 7 February 2006 during the Sunrise II period. The documentary evidence, received by the validation agent in within the 40 days deadline given, consisted of an abstract from the Belgian official journal indicating, inter alia, that the company J.S.T. Real Estate NV had on 21 August 2001 changed its name to J.S.T. Import Europe NV. The Respondent, EURid, refused the Complainant's application on grounds that the documentary evidence was not sufficient to prove the claimed prior right.

The Complainant has, together with its Complaint, supplied additional evidence for the registered Community trademark JST together with a License Declaration and stated that by doing so they would like to claim their prior right to the domain name <jst.eu> and thereby revert to the decision made by the Respondent. The additional evidence consists of a copy of the Community trademark registration certificate for the mark JST held by Japan Solderless Terminal Manufacturing Co. Ltd. in Japan and a License Declaration form, executed on 6 February 2006, duly signed by the licensor Japan Solderless Terminal Manufacturing Co. Ltd. and the Complainant, the licensee.

When applying for the domain name <jst.eu> the Complainant relied on its prior right to the company name, trade name or business identifier JST. The registration of the complete name for which the prior right exists, as set forth in Article 10 (2) of the Commission Regulation (EC) 874/2004, for the company name JST Import Europe NV would have been, for instance, jstimporteurope.eu or jstimporteuropenv.eu, not <jst.eu>. Consequently, the Complainant's company name could not serve as a prior right claimed for the domain name <jst.eu>.

The Complainant did not submit any conclusive evidence on its prior right to the letter combination JST when providing the documentary evidence to the validation agent.

In accordance with the Commission Regulation (EC) 874/2004 and the Sunrise Rules, the burden of proof on demonstrating that the Applicant of a .eu domain name is the holder of the prior right claimed in the application is on the Applicant. The documentary evidence submitted by the Complainant within the 40 day deadline, set forth in Article 14 of the Commission Regulation (EC) 874/2004, was not sufficient to prove that the Complainant (i.e. the Applicant) was the holder of the prior right it had claimed in its application for the domain name <jst.eu>, and the Complainant has thus failed to prove the existence of its claimed prior right in accordance with the Commission Regulation (EC) 874/2004 and the Sunrise Rules. The Community trademark registration certificate for the mark JST and the License Declaration, provided only at the time of filing the Complaint, do not alter the above conclusion.

Based on the foregoing, the Panel finds that the decision made by the Respondent to reject the application made by the Complaint was justified and therefore rejects the Complaint.