Panel Decision for dispute CAC-ADREU-003897

Case number	**CAC-ADREU-003897**
Time of filing	**2006-12-01 13:19:19**
Domain names	**devinci.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**Association Léonard de Vinci**

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

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

1. The Complainant, Association Leonard de Vinci, was created on 10 May 1994 and specialises in training, teaching, organisation of seminars and conferences, the promotion of research and other related activities.

2. The Complainant is the owner of the domain name “devinci.fr”, which was registered on 21 April 1995 and which has been used to present its activities as a university establishment since 1996.

3. The Complainant applied for the domain name “devinci.eu” in respect of a prior right in “devinci” on 13 February 2006, during the second phase of the sunrise period. This application was rejected by Eurid on 24 October 2006 on the grounds that the application did not meet the requirements of Article 19 of the Sunrise Rules. The email indicated that the domain name applied for was not the full title of the Complainant, namely “Association Leonard de Vinci” and therefore was not the complete name of the prior right held.

4. ADR proceedings were formally commenced in respect of that decision on 7 December 2006 and the Respondent filed a Response on 29 January 2006. On 31 January 2007 I, Matthew Harris was appointed as the panellist in this matter having filed the necessary Statement of Acceptance and Declaration of Impartiality and Independence. No person having raised any objection to my appointment, the case file was formally transmitted to me on 5 February 2007.

5. A non standard communication was filed with by the Complainant on 6 February 2007 in which the Complainant sought to answer various contentions made in the Response and which it asked the Panel to accept in accordance with Article B 7 b) and 8 of ADR Rules.

A. COMPLAINANT

The Complainant contended in its Complaint as follows:

(a) The Complainant has ascertained from the email accompanying the rejection of its application that the application was rejected on the basis that the prior right applied for was not the complete prior right held by the Complainant, namely its full denomination, “Association Leonard de Vinci”.

(b) The Complainant maintains that its application is in reality based on its prior right in the “devinci.fr” domain name. The domain name is used to present its activities as a university establishment as well as for other purposes, including online application forms. The

“devinci.fr” domain name was registered in 1995 and has been used for these purposes since 1996.

(c) The domain name “devinci.fr” grants a prior right pursuant to Article 10 of EC Regulation No. 874/2004 (the “Public Policy Rules”). The criteria that must be applied is whether the prior right is one recognised either by national or Community law.

(d) The documentary evidence that the Complainant provided in support of the application shows that French case law recognises the domain name as a prior right. While French national written law does not give an exhaustive list of the prior rights it recognises, the national courts clearly recognise the existence of a right in a domain name that they consider to be an “electronic business sign” and class in the category of business signs. The domain name “devinci.fr” is therefore a prior right recognised by national (in this case French) law.

(e) The Complainant maintains that the Registry has rejected the application on the sole ground that the name of the applicant is Association Leonard de Vinci and that this name is different from the domain name applied for, namely “devinci”. However the prior right claimed by the Complainant in the application is “devinci.fr”, on the basis of their domain name, not “Association Leonard de Vinci”, its denomination. It is asserted by the Complainant that the Registry’s decision is therefore “ill-based”.

In a subsequent non-standard submission (the admissibility of which is addressed in the discussion and findings below the Complainant made the following further submissions:

(a) The e-mail containing the rejection of the application left doubt as to the grounds for the refusal of the application “devinci.eu”. The Complainant could not determine if the Respondent had taken into account the prior right claimed on its domain name.

(b) The Complainant is now satisfied that the Respondent did examine the prior right claimed by the Complainant in the domain name “devinci.fr” and that the basis for the refusal is that the name “devinci.fr” does not fulfil the complete name requirement as the suffix “.fr” was not included in the application for “devinci.eu”.

(c) The prior right must be examined in relation to the law that recognises it. The Complainant maintains that it made clear in the annexes of its Complaint that French courts do not extend the right in a domain name to the extension under which the domain name is registered. The complete name in which the prior right exists under French law is “devinci”.

(d) It is obvious that section 19 (5) of the Sunrise Rules, which claims that “if an Applicant claims a Prior Right to a name that includes an internet top-level domain (such as, but not limited to, .com, .net or .eu), the complete name for which a Prior Right exists includes that domain suffix”, does not apply in the case of a prior right in a domain name and only aims at prior rights such as trade marks.

(e) Sections 19 (3) and (4) are relevant to this issue. These provide that for trade marks, references such as TM, RM or ® and the like do not form part of the complete name for which the Prior Right exists, and for trade names, company names and business identifiers, the company type, such as “SA”, “GmbH”, “Ltd.” or “LLP”, may be omitted in the same way. The complainant asserts that the prior right in the domain name should be examined by analogy with these provisions since the suffix is, like the references for trademark protection and company type, imposed on the domain name holder and the holder has no right over it.

(f) The panel must therefore judge that the prior right in the domain name “devinci.fr” must be understood as relating only relating to the word “devinci” without the suffix “.fr” and that it is the complete name of the domain name “devinci.eu” applied for by the Complainant.

B. RESPONDENT

The Respondent contends as follows:

(a) The Respondent agrees with the Complainant that it did not claim a prior right based on its denomination “Association Leonard de Vinci”. The Complainant in fact claimed a prior right on the basis of its domain name, “devinci.fr”.

(c) Article 10 (2) of the Public Policy Rules 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 right exists”. Pursuant to article 14 of the Public Policy Rules, it is up to the applicant to submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question.

(d) Section 19 (5) of the Sunrise Rules states that “if an Applicant claims a Prior Right to a name that includes an internet top-level domain (such as, but not limited to, .com, .net or .eu), the complete name for which a Prior Right exists includes that domain suffix”.

(e) The documentary evidence provided by the Complainant in its application attempts to demonstrate a prior right in the domain name “devinci.fr”, not “devinci”, and therefore the Respondent maintains that the validation agent correctly found that the domain name applied for, devinci, did not consist of the complete name of the prior right “as written in the documentation which proves that such right exists”.

DISCUSSION AND FINDINGS

1. The Respondent in this case is EURid and for ease of understanding, I will refer to it by its name in this decision. The Complainant has brought proceedings against EURid under Article 22(1)(b) of the Public Policy Rules. Under Article 22(11) of the Public Policy Rules s panel is required to decide whether EURid's decision to refuse the Complainant's application for the Domain Name conflicts with the Public Policy Rules or with Regulation 733/2002 of the European Parliament and of the Council (which is the legislation under which the Public Policy Rules are made).

TREATMENT OF APPLICANT’S NON-STANDARD SUBMISSION

2. Prior to considering the substance of the Complaint, it is necessary to consider whether any notice should be taken of the Complainant’s Non-standard submission on 6 February 2007. It is my view that neither the email sent by Eurid on 24 October 2006 containing the rejection nor the second email dated 27 October 2006 which purported to explain the rejection, were clear as to the grounds for the rejection. The precise reasoning for the rejection was in fact not made clear until EURid issued a Response to the Complaint on 29 January 2007. Therefore, it was not until 29 January 2007 that the Complainant was in a position to form a considered view on whether EURid and/or its validation agent had correctly rejected its application for registration.

3. In the circumstances, not to take notice of the Complainant’s additional submissions in this regard would be unfair. I therefore exercise the discretion granted to me under Section B8 of the .eu ADR Rules to admit this further communication.

RELEVANT PUBLIC POLICY AND SUNRISE RULES

4. Article 10(1) of the Public Policy Rules deals with a party’s eligibility to apply for a domain name “during a period of phased registration before general registration of .eu domain starts” (i.e. the “Sunrise Period”). This states that only holders of “prior rights” which are recognised or established by national or community law shall be eligible to apply for a .eu domain name during this period.

5. The manner in which applications in the Sunrise Period are to be dealt with is set out in Articles 10 to 14 of the Public Policy Rules. Article 12(2) provides that in the first phase of the Sunrise Period “only registered national and Community trademarks[sic], geographical indications, and the names and acronyms referred to in Article 10(3) may be applied for as domain names”.

6. During the second phase of the Sunrise Period, the names that can be registered in the first phase and names based on all other prior rights can be applied for as domain names by holders of prior rights in those names. Article 10(1) provides a non exhaustive list of these other prior rights and refers to “unregistered trademarks[sic], trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works”. However, these are only prior rights for the purposes of the Public Policy Rules “in as far as they are protected under national law in the Member-State where they are held”

7. Article 10(2) requires the domain name to consist of the “complete name for which the prior right exists, as written in the documentation which proves that such a right exists”.

8. Article 12(3) of the Public Policy Rules requires that any request to register a domain name based on a prior right “shall include a reference to the legal basis in national or Community law for the right to the name, as well as other relevant information”.

9. Article 14 provides that all claims for prior rights “must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists”. In addition, the applicant must submit “documentary evidence that shows that he or she is the holder of the prior right claimed”.

10. These provisions are to some extent supplemented by the Sunrise Rules. These Rules were published by EURid pursuant to Article 12(i) of the Public Policy Rules, which provides that the Registry will provide “a detailed description of all the technical and administrative measures that it shall use to ensure a proper, fair and technically sound administration of the phased registration period”.

11. Annex 1 of these Rules provides a list of types of prior rights that EURid accepts are recognised in different European member states. Sections 13 to 18 of the Sunrise Rules also identify the type and nature of evidence that EURid expects an applicant to provide in order to substantiate rights that are identified in Annex 1. The list does not purport to be exhaustive and in those cases where a “prior right” claimed is not listed, section 12 of the Rules sets out a procedure as to how and in what manner a person relying upon such a prior

right should prove its case.

12. Therefore, in general terms it is clear that it is incumbent upon an applicant, in the documentary evidence that accompanies its evidence, to satisfy EURid that:

(a) the type of prior right applied for has its legal basis in national or Community law (although it may be assisted in this respect by Annex 1 of the Sunrise Rules);

(b) the applicant is able to satisfy the conditions necessary to show that it has such a right; and

(c) the domain name is the complete name of the prior right claimed.

PRIOR RIGHT CLAIMED

13. One of the issues in this case is what right the Complainant actually claimed in its application. The original application identified the prior right relied upon as “De Vinci” and the Complainant did not identify the type of right relied upon as company name, business identifier or trade name. Instead, it claimed that the category of right relied upon was “OTHER”. The documentary evidence subsequently provided by the applicant took the form of a detailed and reasoned submission from the Complainant’s lawyer dated 13 March 2006 with the title “Evidence of the Rights in the Domain Name DEVINCI.FR under Art.10 of EC Regulation 874/2004”.

14. From this EURid concludes that the Complainant in fact claimed a prior right on the basis of its domain name, “devinci.fr”. The Respondent maintains that this is sufficient to dispose of this matter since if the prior right relied upon is “devinci.fr” the domain name sought is not the complete name of the prior right claimed. Putting it another way, whilst the material submitted might found an application for the domain devincifr.eu, it is not good enough for devinci.eu.

15. For the reasons I explain below, I do not think it is quite as straight forward as EURid maintains. In Finemccanica spa v EURid Case No. 02671 <selex.eu>, I stated that when assessing what right is relied upon by an applicant in any particular case one must look at the whole of the material that the applicant has submitted. From this EURid must form a sensible and substantive view of what was intended by the applicant. So for example, if it is clear from the evidence what right is relied upon, the fact that there is a clerical error in this respect in the initial application does not necessarily mean that the application must fail.

16. Here, anyone looking at the application and the material together is likely to conclude that there are two possibilities:

(i) That notwithstanding the fact that the original application referred to rights in “devinci” the Complainant intended to rely upon rights in the domain name “devinci.fr” in its entirety. If this is the case, I accept that the application must fail for the reasons given by EURID; or

(ii) The Complainant relied upon the domain name “devinci.fr”, which is alleged under French law to give it sufficient prior rights in the name “devinci” alone for the purposes of the application.

14. Which is correct? In its non-standard submission, the Complainant clearly states that “the complete name on which the prior right exists under French law is ‘devinci’ ”. It, therefore, seems to be asserting that the second of these two possibilities was its position all along.

15. However, this is far from clear from the material itself. The applicant’s material talks of “rights in the domain name ‘devinci.fr’ as a ‘prior right’ ” and states that “the application is based on the ‘devinci.fr’ domain name”. These statements are arguably ambiguous. The material also makes the following statements:

(i) “A prior right protected under French national law, the domain name is a ‘sign used in the course of trade’, protected by Community law”; and

(ii) “[the Complainant] is the owner of rights in the denomination “De Vinci” ….above all under its domain name ‘devinci.fr’.

The first statement does indeed suggest that the right relied upon is the domain name as a whole, but the second suggests otherwise.

17. Given this ambiguity, how is one to proceed? I think that in such a case the starting point must be what the applicant has said in the application. This it seems to me can and should be taken at face value unless it is obvious from the later material filed that a mistake has been made in the original application (as was the case in Finemccania spa v EURid Case No. 02671 <selex.eu>).

18 Therefore, this decision proceeds on the basis that the Complainant did indeed claim rights in “devinci” alone which is alleged as a matter of French law to arise out of the Complainant’s “devinci.fr” domain name. Of course, the fact that I accept that the Complainant claims rights in the name “devinci” does not mean that I accept that the Complainant has shown that it has those rights as a matter of French law. It is to this question that I next turn.

HAS THE COMPLAINANT SHOWN THAT FRENCH LAW RECOGNISES THE RIGHT CLAIMED AND THAT THE COMPLAINANT HAS THAT RIGHT?

19. Arguably it would be preferable at this stage, given my finding that EURid was in error when it concluded that the prior right relied upon in this case was “devinci.fr”, to remit the matter back to EURid to form a view as to whether the documentary evidence provided does indeed support the Complainant’s claim to a prior right in the name “devinci”. However, given the manner in which Article 22 (11) of the Public Policy Rules is drafted, I do not believe that I have that option. I must decide whether EURid’s decision “conflicts” with the relevant Regulations. In other words, I am forced to consider whether as a matter of substance EURid’s decision to reject the Complainant’s application was right.

20. I am therefore left in the unhappy position of having to form a view on the adequacy of the Complainant’s substantive submissions on French law in circumstances where I am not a qualified French lawyer and EURid’s Response simply does not address those legal submissions. I could have called for further submissions on this point from EURid but for the reasons I give below I have reached the conclusion that on this occasion this is not necessary since the Complaint fails in any event.

21. The Public Policy Rules make it quite clear that when an applicant relies upon a prior right, it is essential that the existence of this prior right adequately be proved to exist from the documentary evidence filed at the time of the application. Any inadequacy in that material cannot be made good by further argument or evidence in the Complainant’s submissions in these ADR proceedings. The task an applicant faces in this respect may be eased considerably if the prior right claimed is one that the Sunrise Rules expressly recognised. However, the Complainant does not claim that this is the case here. It relies upon an additional prior right that is said to be recognised by French law.

22. As I have already mentioned above, the documentary evidence in this case took the form of detailed and reasoned submission from the Complainant’s lawyer. The submission argues that although domain names are not specifically identified as prior rights under French statute, the legislator “left the door open” for future prior rights to be included by making the list non-exhaustive. It then goes on to claim that a domain name is “a right recognised by national courts as a right acquired by use in the same way as [a] business sign or trade name”.

23. This may be so. But the issue here is not whether the Complainant domain name <devinci.fr> can be recognised as a business identifier. The issue is whether the domain name <devinci.fr> provides the Complainant with rights in the name “devinci” for the purposes of the Public Policy Rules.

24. This in turn leads on to what seems to be at the heart of the Complainant’s submission. The Complainant refers to three cases (i.e. TGI of Le Mans, 29 June 1999, SARL Microcaz / SARL Oceanet; TGI Nanterre 4 November 2002, Elie S., SARL La société Temesis/Association Afag; and TGI Paris, 3ème, 13 June 2003, Anne Marie B.S. / TI System). These are said to demonstrate that a domain name can be a “prior right” for the purposes of French trade mark law when it comes to attacking the validity of a subsequent trade mark (or possibly the validity of trade mark applications - this is unclear from the Complainant’s explanation). Whilst the Complainant provided copies of each of these decisions, they are in French. However, from the submission that accompanied them, the Complainant appears to allege that in at least two of these cases the domain name was sufficient successfully to oppose marks that took the form of the domain name with the associated TLDs (in these cases .com) removed.

25. In a quotation that is taken from one of the cases relied upon, it would appear that key to the decision was the use made of the domain name. Indeed, in a later part of the Complainant’s submission the Complainant states that in common with the right in a business sign “the domain name is not protected if not actually exploited on the network [presumably the Internet]”.

26. The Complainant’s answer to this is to assert that the domain name has been “regularly exploited since 1996 to present the activity of the Leonard de Vinci university centre” and to provide extracts from the archive.org website that is said to prove that this is the case. It also provides copies of five leaflets, which are said to have been used (to what extent is not explained) since 1996 in which the <devinci.fr> domain name is mentioned.

27. It is at this point that I start to have difficulty with the Complainant’s submissions. I am an English common lawyer. As such, I accept

that it is possible for the owner of a domain name, as a result of the use of the domain name in the form X.com, to become known by the name X.com and to have rights against someone who uses that name. I also do not exclude the possibility that by the use of the name X.com the owner of that domain name becomes known by the name X alone. However, whether or not this is the case in English law is essentially a question of fact. Usually in cases where there are such rights in a domain name, the domain name will have been used more extensively than simply as part of a Url, possibly even being adopted as the name of the company (an example that springs to mind is lastminute.com). Merely showing that a domain name has been used for a period of time as part of a Url to identify a website and is included in some promotional material to indicate where that website can be found is unlikely to be sufficient.

28. It may be that French law is not so exacting. Proof of the fact that a domain name has been used in a website over a period of time (without evidence of its popularity or fame) combined with evidence of five leaflets in which the domain name is used (without evidence of the extent of their dissemination) may be sufficient to provide the owner of that domain name with rights in a name comprising the domain name absent the relevant domain name suffix. I do not know and as a non-French lawyer I am not in a position to judge this. However, the crucial point here is not whether I think that this is correct but whether the Complainant's documentary evidence provides sufficient foundation for that conclusion. The Complainant's submission does not address the degree of "exploitation on the network" that French law requires and I am unable from the submission to form a view as to whether the limited evidence of use of the domain name that has been provided is likely to satisfy whatever standard French law sets. Accordingly it seems to me that the Complaint must fail.

29. The Complainant also makes reference to European law and in particular to Article 8(4) of the Community Trade Mark Regulation. However, this merely refers back to the law of individual Member States. As such, in my opinion, this takes matters no further.

30. In short, the Complainant's documentary evidence does not in my opinion sufficiently establish that the Complainant has by reason of its claimed use of the domain name <devinci.fr> (and that domain name alone) sufficient rights in the name <devinci> so as to provide it with prior rights in that name alone for the purposes of an application under the second phase of the Sunrise procedure.

31. The Complainant's submissions in these proceedings do not persuade me that this approach is wrong. For example, in its non-standard response it maintains "the Complainant already made it clear in the [French cases that were annexed to the submission submitted to EURid in connection with its application] that French Courts did not extend the right in a domain name to the extension under which the domain name is registered". However, for the reasons I have given above I do not think the submission does make this clear. Whether this is so from a fuller reading of the cases themselves I cannot say since they have not been translated for the purposes of these proceedings.

32. I also do not find the Complainant's submissions as to sections 19(3) to (5) of the Sunrise Rules of assistance. They proceed on the assumption that the Complainant has prior rights in the name <devinci.fr> and seek to persuade me that on this basis that the ".fr" aspect of the domain can and should be ignored. However, as I have already explained above, I accept the Complainant's contention that it claims rights as a matter of French law in the name "devinci" as a result of its use of the <devinici.fr> domain name. In the circumstances, the provisions of sections 19(3) to (5) of the Sunrise Rules do not strike me as of relevance.

33. There is one last point that I would make in this case. It does not form the basis of my decision but I mention this for the sake of completeness. It seems clear that the documentary evidence provided in this case did not purport to be (nor has the Complainant claimed it to be) material that falls within the scope of section 13 to 18 of the Sunrise Rules. Therefore, this case falls within the scope of section 12 of the Sunrise Rules. Those rules essentially require an applicant to submit an Affidavit from a legal practitioner (or similar person) to the effect that the prior right claimed is recognised under the relevant local law, identifying the conditions that must be fulfilled in this respect and proving that the applicant satisfies those conditions .

34. The material that I have seen in this case does not appear to me to be an affidavit. This could be said to be a technical point and it raises the issue as to whether the standard of proof required by EURid in this respect is something which can truly be characterised as falling within the scope of Article 12(i) of the Public Policy Rules. Given that neither of the parties have addressed these points in their submissions (nor have I given them an opportunity to do so), I do not think it would be appropriate to make any decisions on these issues. I would merely mention that I can understand why EURid might wish such evidence to take the form of an affidavit. It seems to me that there is potentially a world of difference between evidence from a lawyer in an affidavit in which that lawyer states what he believes and understands to be the law and a piece of written advocacy in which a lawyer argues a legal position on behalf of his client. Indeed, I query whether such a piece of advocacy can be truly characterised as documentary "evidence" at all for the purposes of Article 14 of the Public Policy 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

PANELISTS

Name	Matthew Harris

DATE OF PANEL DECISION 2007-02-28

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Pursuant to Article 22(b) of the Public Policy Rules, the Complainant appealed a decision by EURid not to register the domain name “devinci.eu” in the name of the Complainant in the second phase of the Sunrise Period. In the original application the prior right claimed was in the name "divinci" and the type of right claimed was claimed to fall into the category of "other". The documentary evidence filed in support of that application took the form of a detailed submission on the part of the Coomplainant's lawyer as to the Complainant's rights in the domain name "devinci.fr".

The application was rejected on the basis of Article 10 (2) of the Public Policy Rules which specifies that the registration of a prior right shall consist of the registration of the complete name for which the prior right exists.

The Complainant argued that the complete name of the prior right applied for was in fact “devinci”, as was specified on the application itself.

EURid stated in its Response that the documentary evidence suggested that the complete name applied for was in fact the name “devinci” with the addition of the suffix “.fr” and that therefore the Complainant had not applied for the complete name for which the prior right exists.

The Panel held:

(1) That where there is ambiguity as to the complete prior right claimed by the applicant, one must take a sensible and substantive view of what was intended by the applicant. The starting point must be what the applicant has said in the application. This can be taken at face value unless it becomes clear from material filed subsequently that that a mistake was made in the original application. On this basis, the Panel found that the Complainant did indeed claim rights in “devinci” alone.

(2) That although the French case law submitted as evidence in support of the application allegedly showed that a domain name can be sufficient to successfully oppose marks that take the form of the domain name with the associated TLDs removed, it also appeared from that evidence that the actual use made of the domain name was of significance.

(3) The documentary evidence provided by the Complainant did not satisfy the Panel that what appeared to be relatively limited use of the “devinci.fr” domain name provided the Complainant with rights as a matter of French law in the name "devinci" alone .

(4) That, therefore, the Complainant has not demonstrated that it had acquired prior rights in the name “devinci” under national or Community law and therefore has not satisfied the requirements of Article 14 of the Public Policy Rules; and

Accordingly, the Panel rejected the Complaint.