Panel Decision for dispute CAC-ADREU-003899

Case number	**CAC-ADREU-003899**
Time of filing	**2006-12-04 13:34:39**
Domain names	**buyit.eu, pokerpalace.eu, moviestar.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**IDvisie B.V., Johannes Albertus Godefridus de Groot**

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 relating to the disputed domain names.

FACTUAL BACKGROUND

During the second part of the phased registration period (Sunrise II), the Complainant filed three applications with the Respondent for the domain names under <.eu> BUYIT, POKERPALACE and MOVIESTAR claiming that these names were protected as its trade names or business identifiers in the Netherlands.

The applications were filed on 8 Feb 2006 (BUYIT), on 10 Feb 2006 (POKERPALACE) and on 10 Mar 2006 (MOVIESTAR). Documentary evidence for all three applications was received on 17 Mar 2006, which was before the respective deadlines (20 Mar 2006, 22 Mar 2006 and 19 Apr 2006). The evidence for each application consisted of a certificate of registration with the Chamber of Commerce in Rotterdam (Netherlands) for the company “IDvisie B.V.” showing as a registered trade name, amongst 29 trade names, the names BUYIT, POKERPALACE and MOVIESTAR; as well as pages including letterheads with the respective logos (BUYIT, POKERPALACE, MOVIESTAR) at the top and the address of the Complainant at the bottom stating that BUYIT, POKERPALACE, MOVIESTAR, respectively, were trade names of the Complainant.

The validation agent in each of these applications found that the documentary evidence was not sufficient to demonstrate the existence of prior rights regarding these names.

The applications were thus rejected by the Respondent on 26 Oct 2006 (BUYIT), 23 Oct 2006 (POKERPALACE) and 23 Oct 2006 (MOVIESTAR).

The Complainant filed a complaint against the three decisions on 04 Dec 2006 and submitted a set of further evidence in order to demonstrate its rights, namely print-outs of 1 Dec 2006 from the websites http://buyit.1500mb.com, http://pokerpalace.1500mb.com and http://moviestar.1500mb.com; containing each of them the statement that the corresponding website was under construction and that the respective name was a trade name of the Complainant.

A. COMPLAINANT

The Complainant is of the opinion that the documentary evidence submitted by him is sufficient to demonstrate his prior rights in the Netherlands.

The Dutch trade register contains all trade names of the Complainant. It is easily accessible to the public and can therefore show public use of the trade names. It is not unusual in the Netherlands that companies use several trade names, for instance for several parts of

their businesses. The three names applied for by the Complainant represent each a certain business activity of the Complainant.

Furthermore, the company letterheads submitted as evidence are also sufficient to show public use since they fall in the category of advertising or promotional material which is explicitly accepted as evidence according to Section 16.5 (i) b of the Sunrise Rules.

Likewise, the print-outs submitted in the Complaint prove that the trade names at question were used prior to the dates of the applications because these websites, although now under construction, were active and publicly accessible before the dates of application.

The Complainant therefore seeks the following remedies:

A. that the Arbitration Panel decides that the Disputed Decisions conflict with Regulation 874/2004, in particular Article 10(1), Article 10(2) and Article 12(2) thereof, as well as with Section 16.5 in connection with Annex 1 of the .eu Sunrise Rules;

B. that the Arbitration Panel decides that the Applications of the Complainant comply with all the applicable regulations to be granted a domain name, in particular Article 10(1), Article 10(2), Article 12(2), Article 12(3) and Article 14 of Regulation 874/2004, as well as with Section 16.5 in connection with Annex 1 of the .eu Sunrise Rules;

C. that the Disputed Decisions be annulled; and

D. that the domain names <buyit.eu>, <pokerpalace.eu> and <moviestar.eu> be attributed to the Complainant and, pursuant to Section 27 of the .eu Sunrise Rules, that the Respondent be ordered to immediately register such domain names in the name of the Complainant and activate such domain names.

B. RESPONDENT

The Respondent argues that the burden of proof is on the Complainant to demonstrate his prior rights and that only evidence submitted by the Complainant within 40 days from the submission of the application for the relevant domain names can be accepted in order to validate the Complainant's prior rights.

As far as the original documentary evidence is concerned, it was not sufficient to establish the protection of trade names under Dutch law. According to Section 16.5 of the Sunrise Rules in connection with its Annex 1, protection of trade names under Dutch law requires the proof of use of the trade name in the course of trade. The letterheads submitted by the Complainant cannot demonstrate such use.

The Respondent therefore seeks rejection of the Complaint.

DISCUSSION AND FINDINGS

I. As the facts are not in dispute, the case only raises legal issues. Essentially the Parties argue on two points of law, namely, in the first place, whether documentary evidence submitted subsequently after the initial time line of 40 calendar days (namely, print-outs of 1 Dec 2006 from the websites http://buyit.1500mb.com, http://pokerpalace.1500mb.com and http://moviestar.1500mb.com) is permissible in order to validate the rights of the Complainant and, secondly, whether the documentary evidence thus permissible was sufficient in the present case to establish the existence of prior rights on the three domain names for the Complainant.

1. It is not permissible for the Panel to consider documentary evidence which was submitted after the initial time line of 40 calendar days and which was therefore not at the disposal of the validation agent/Registry at the time of its decision. This view is in line with other panel decisions (see Cases 2881 (MRLODGE), 1627 (PLANETINTERNET), 954 (GMP)) and corresponds to the procedural requirements of allocating domain names as set up by EC Regulation 874/2004.

Article 22 (11) of EC Regulation 874/2004 provides that in the case of a procedure against the Registry, the ADR panel shall decide whether a decision taken by the Registry conflicts with this Regulation or with EC Regulation 733/2002. Pursuant to Article 14 paragraph 10 of EC Regulation 874/2004, the Registry decides to register a domain name where it finds that the applicant has demonstrated a prior right on the name.

While it is true that the purpose of the phased registration procedure is to safeguard prior rights as established by Community or national law (cf. Recital 12 of EC Regulation 874/2004), the protection of these rights is procedurally limited to the extent that they are demonstrated to the Registry until the end of a 40 days time limit by the applicant (see Article 14 paragraph 4 of EC Regulation 874/2004). It is on the basis of the evidence thus received within the time limit that the validation agent and the Registry shall examine

each claim in chronological order until a claim is found for which prior rights can be confirmed (Article 14 paragraph 9 of EC Regulation 874/2004). When implementing the first-come-first-served principle, the question is therefore not who the first applicant is having a prior right, but who the first applicant is having demonstrated the right.

The implementation of the first-come-first-served principle is therefore clearly connected by EC Regulation 874/2004 to the evidence received within the original time limit (cf. Case 2881 (MRLODGE)). Allowing applicants to submit evidence at a later stage of proceedings would unduly disadvantage other applicants who might have waited to apply for a domain name until they could be sure to be able to submit all necessary evidence on time. A fair and equal application of the first-come-first-served principle therefore requires considering applications as they are after the deadline and not to allow later rectifications.

It is therefore necessary to apply the 40 days' deadline strictly. It is the responsibility of the applicants to apply due care in preparing their applications (cf. Case 3593 (CENTRIC) No. 4, Case 1627 (PLANETINTERNET) No. 6.i.). Allowing later corrections and additions of further documents would unduly advantage applicants who applied lesser care and who might therefore have been faster sending the application.

Such strict understanding of the first-come-first-served principle inherent in EC Regulation 874/2004 is confirmed by the Sunrise Rules, which every applicant has to accept to be applicable. According to Section 4.1 (iii) of these Rules, applicants represent and warrant that the documentary evidence that they submit will be complete. It would be contradictory to their own warranty if applicants were later allowed to base their claims on further evidence which was not entailed in the original application.

2. Regarding the evidence submitted within the original deadline and alone permissible here to be considered, this evidence was not sufficient to demonstrate that the Complainant was the holder of prior rights regarding the names BUYIT, POKERPALACE and MOVIESTAR.

The Complainant based its claim on the names in dispute on the use of these names as trade names or business identifiers in the Netherlands. According to the Sunrise Rules and its Annex 1, which the Complainant accepted to be applicable, it was necessary for the Complainant to prove public use of the names as trade names prior to the date of application in the relevant Member State (Section 16.5 (i) b of the Sunrise Rules) and use of the names in the course of trade (Annex 1 relating to the Netherlands).

Regardless of the exact differentiation and distinction between public use, on the one hand, and use in the course of trade, on the other hand, the documentary evidence thus submitted by the Complainant is not sufficient to demonstrate either of these criteria.

Public use of a trade name is not yet demonstrated by an extract from the commercial register as it was submitted by the Complainant even if the commercial register is accessible to third parties. If submitting an extract from an official trade register were sufficient in order to show the right, the second condition in Section 16.5 (i) of the Sunrise Rules would be unnecessary since a document fulfilling the first condition would always fulfil the second condition, as well. Obviously, the second condition is intended to substantially add criteria for demonstrating the prior right at issue. Registering a trade name in a commercial register is therefore not a relevant use in the meaning of Section 16.5 (i) b of the Sunrise Rules.

Apart from an extract of the commercial register, the evidence submitted by the Complainant within the original deadline consisted in three letterheads mentioning each of them one of the names in dispute.

However, such letterheads in themselves cannot show the way they were used. They do not allow any conclusions as to whether they have been used at all, nor where, in what territory and at what time. It is perfectly possible that those letterheads have never left the company and have never actually gone public or been used in any way. Such letterheads might therefore, at the most, indicate a certain stage of preparation to use the disputed names in public or in the course of trade, but they cannot show actual use itself.

The indicative value of letterheads or other company stationery might be assessed differently where further evidence is available showing the overall state of development of the business activities of the company and its units. In such a case, it might be self-evident that the stationery has been used.

In the case of the Complainant, however, where the official trade register shows 29 trade names for the Complainant and where the Complainant has argued that these trade names refer to several parts of its business, it is not clear at all in what stage of development these 29 business units are, whether they are already fully developed or still in the process of preparation. In such a company context, the mere stationery without any indications of its use has no indicative value.

II. It results from the foregoing that the Respondent was right in not accepting the evidence submitted by the Complainant within the original time limit as being sufficient to show the existence of prior rights of the Complainant on the names in dispute.

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	**Gonzalo Gállego**

DATE OF PANEL DECISION 2007-02-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, a Dutch company, filed three applications for the domain names under <.eu> BUYIT, POKERPALACE and MOVIESTAR during Sunrise II. It claimed prior rights on these names due to their use as trade names in the Netherlands. In order to demonstrate these rights, the Complainant submitted for each of its applications the following documentary evidence: a certificate of registration with the Chamber of Commerce in Rotterdam (Netherlands) for the company showing the names in dispute as registered trade names (amongst 29 trade names altogether) combined with a letterhead showing the respective logos (BUYIT, POKERPALACE, MOVIESTAR) at the top and the address of the Complainant at the bottom stating that BUYIT, POKERPALACE, MOVIESTAR, respectively, were trade names of the Complainant. In a second set of evidence, contained in the Complaint, the Complainant submitted further evidence in order to show the use of the names in the course of trade.

The Respondent rejected all three applications on the ground that the rights of the Complainant were not sufficiently demonstrated.

The Complainant sought annulment of the three decisions.

The Panel denied the Complaint. It disallowed to consider the second set of evidence submitted with the Complaint on the ground that such additional evidence is not permissible. A fair and equal application of the first-come-first-served principle requires that all applications are considered on the basis of the evidence submitted within the original 40 days' deadline, no later rectifications or additions being allowed. Allowing later rectifications or additions would unduly disadvantage applicants who have taken the appropriate care from the beginning.

On the basis of the evidence submitted by the Complainant within the original deadline – alone permissible in the case –, the Panel came to the conclusion that the Respondent was correct in regarding this evidence as insufficient to demonstrate the prior rights of the Complainant.

An extract from an official commercial register, even if the register is publicly accessible, cannot be a proof of public use of a trade name. Such construction of Section 16.5 (i) of the Sunrise Rules would render the second condition of this provision superfluous. Registering a trade name is therefore not a relevant use according to Section 16.5 (i) b of the Sunrise Rules.

Likewise, mere letterheads or company stationery, though mentioning the disputed names, are in itself not sufficient to prove the public use of such names or their use in the course of trade since mere letterheads or other company stationary are, in general, not sufficiently indicative to the way they are used, when and in what territory. In general and without further evidence, such blank letterheads cannot even prove whether they have been actually used, at all. At the utmost, they might demonstrate a certain preparation of use.