

Panel Decision for dispute CAC-ADREU-003985

Case number	CAC-ADREU-003985
Time of filing	2006-12-07 13:30:56
Domain names	ultimatesurrender.eu, wiredpussy.eu, buttmachineboys.eu, meninpain.eu, realfuckingcouples.eu, behindkink.eu, hogtied.eu

Case administrator

Name	Tereza Bartošková
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Complainant

Organization / Name	CNE Data International, BV, Peter Acworth
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Respondent

Organization / Name	EURid
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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.

The Complaint originally included also the domain name waterbondage.eu. As it was accepted for registration on December 18, 2006 the Complainant withdrew the Complaint as regards waterbondage.eu on December 18, 2006.

FACTUAL BACKGROUND

History of the Request for Registration

On 8 February 2006 Mr. Peter Acworth (hereinafter “the Applicant”) filed requests for the registration of the domain names <ultimatesurrender.eu>, <wiredpussy.eu>, <buttmachineboys.eu>, <meninpain.eu>, <realfuckingcouples.eu>, <behindkink.eu> and <hogtied.eu> (hereinafter “the Domain Names”) within part two of the phased registration period.

The Applicant claimed the following prior rights for the applications: <ultimatesurrender.eu> / Titles of art – Netherlands to ULTIMATESURRENDER, <wiredpussy.eu> / Titles of art – Netherlands to WIREDPUSSY, <buttmachineboys.eu> / Titles of art – Netherlands to BUTTMACHINESBOYS, <meninpain.eu> / Titles of art – Netherlands to MENINPAIN, <realfuckingcouples.eu> / Titles of art – Netherlands to REALFUCKINGCOUPLES, <behindkink.eu> / Titles of art – Netherlands to behindkink.com and <hogtied.eu> / Titles of art – Netherlands to HOGTIED.EU.

On February 28, 2006 the Applicant submitted documentary evidence to substantiate the existence of the prior right claimed over the names. The documentary evidence was the same document in each seven application, namely a certificate of registration with the Chamber of Commerce in Amsterdam in Dutch language showing that a Dutch company CNE Data International B.V. is the owner of the trade names corresponding to the Domain Names.

EURid (hereinafter “the Respondent”) rejected the Applicant’s requests for registration on the grounds that the documentary evidence did not demonstrate that the Applicant was the holder of the claimed prior rights on the Domain Names.

History of the ADR Proceeding

On 7 December 2006 at 13:30:56 CNE Data International BV, Peter Acworth (hereinafter “the Complainant”) filed a Complaint with the Czech Arbitration Court (hereinafter “CAC”) to contest EURid’s decision to reject the registration of the Domain Names. The language of the proceedings is English. The annexes of the Complaint consist, inter alia, of the same trade name certificate in Dutch language which the Applicant submitted as the documentary evidence. No English translation is enclosed to the certificate.

In response to Complainant’s request to the CAC to require EURid to disclose the documentary evidence as defined in the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter “Sunrise Rules”), the Respondent

disclosed the documentary evidence on 13 December 2006.

The formal date of the commencement of the ADR Proceeding is 13 December 2006. The CAC notified EURid of the Complaint and invited the Respondent to issue its Response within 30 working days from the delivery of the notification.

On 18 December 2006 the CAC informed the Complainant that the sunrise application for the domain name <waterbondage.eu> was accepted and on the same date the Complainant withdrew any complaint pertaining to the domain name <waterbondage.eu> but requested the Panel to examine the application for <waterbondage.eu> and the applications for the other Domain Names.

On 5 February 2007 the Respondent filed its Response with the CAC.

A. COMPLAINANT

The Complainant is the holder of a prior right, recognized by the Netherlands Chamber of Commerce. As a matter of Dutch law, rights may be claimed under Dutch trading name law. Under Dutch Law, unregistered trade names (even of foreign companies) are afforded protection under the Handelsnaamwet of 1921. Registration is not a requirement in the Netherlands for protection under this law; actual use is required.

Additionally, names which would not qualify as trade names in the Netherlands (such as the name of a foundation), could be protected under the article 6:162 of the Civil Code.

The names “ultimate surrender”, “water bondage”, “wired pussy”, “buttmachineboys”, “hogtied”, “meninpain”, “realfuckingcouples” and “behind kink” have been used worldwide on the world wide web by the Complainant for many years under the top level domain “.com”.

It is true that the applicant applied for the domain names in question under the name of its principal shareholder and president, Mr. Peter Acworth. Mr. Acworth was not assisted by counsel when applying for the domains, and presumed that as a U.K. citizen owning and operating a Dutch corporation, he had every right to apply for a .eu domain name during the Sunrise Period.

The Complainant's trade names are titles of artistic works protected by both trademark law and international principles of copyright law. As unregistered trademarks are also provided for in the Regulations, the Complainant's rights to the names should also be established by the common law trademark rights that inure to the benefit of the Complainant – even if the Complainant's US division is the owner of the common law rights at issue.

The Complainant will accept the possibility that the applications may have contained technical deficiencies. Nevertheless, neither EURid nor the validation agent carried out any due diligence in this case. When faced with a situation such as this, the validation agent should, pursuant to Section 21(3) of the Sunrise Rules, conduct its own investigation into the circumstances of the application, the prior right claimed, and the documentary evidence produced.

At least one panel decision has held that denial on technical grounds is improper, and the validation agent should act reasonably prior to imposing the penalty of non-registration (ADR No. 00253 <schoeller.eu>). In that case, the panel agreed that since the validation agent has great discretion, the validation agent should engage in a higher standard of care and reasonableness.

The purpose of the phased registration is to safeguard prior rights recognized by the community or national law. It follows that holders of prior rights should not be denied such applications, especially when such denial would leave the owners of prior rights subject to the whims of cybersquatters, of which the Complainant has already been a victim. The Complainant filed sunrise applications and provided supporting documentation which showed that he possessed prior rights to the names. Most importantly, no competing applications were filed.

A failure by this panel to recognize these prior rights and to grant registration to the Complainant will result in a scenario whereby cybersquatters, already cognizant of the Complainant's well-known trademarks, recognizable under Article 6bis of the Paris Convention, are likely already waiting to register these domains. The Complainant has been the victim of similar tactics in multiple Top Level Domains that did not exercise the option of a Sunrise Period.

The Complainant requests that the Panel annuls the Respondent's decision to reject the requests for registrations and orders the Respondent to allow the registrations of the Domain Names in the name of the Complainant. Alternatively, the Complainant requests that the Panel order the registration of the Domain Names in the name of the Complainant, independently of the Panel position on the requests for the registration and the reasons for rejection.

The Complainant argues that, even if the Panel was to decide that the documentary evidence submitted by the Applicant did not establish the claimed prior rights, the Panel should nevertheless transfer the domain name to the Complainant because the Applicant was the only applicant for this domain name during the Sunrise Period.

B. RESPONDENT

The Respondent rejected the Applicant's applications on the grounds that the Applicant did not clearly and certainly demonstrate that he was the holder of the claimed prior rights in the form of "Distinctive Titles of Protected Literary and Artistic Works" protected in The Netherlands. The burden of proof was on the Applicant to substantiate that he is the holder of the claimed prior rights.

The Respondent referred to Articles 12, 14 and 22 of the Regulation (EC) No 874/2004, Sections 3, 16, 18, 21 of the Sunrise Rules and Annex 1 to the Sunrise Rules as well as to Article B 11 (c) of the ADR Rules.

The documentary evidence submitted by the Applicant did not contain any copy of any literary or artistic work or any affidavit signed by a legal practitioner. The Applicant provided absolutely no document besides a certificate of registration showing that the Complainant had registered 57 trade names, among which names corresponding to the 7 Domain Names applied for.

However, in order to establish a protected trade name, the Applicant must also establish the public use of the trade names by the Applicant to identify himself in the course of trade. The Applicant has failed to demonstrate his public use of the trade names to identify himself in the course of trade. He has submitted only the certificate of trade name registration as the documentary evidence. The Panel does not take into consideration any documentary evidence received after the deadline for the Applicant's application.

To that regard, it is reminded that the Dutch Chamber of Commerce will register any name with only limited examination. The website of the Dutch Chamber of Commerce, www.kvk.nl/artikel/artikel.asp?artikelID=44366, states: "When you register with the Trade Register, the Chamber of Commerce examines if there is a company with exactly the same trade name. (...) the Chamber of Commerce (can) also have a national trade name examination performed. Such a paid national examination not only looks at trade names which are written in the exact same way, but also to trade names which sound the same." (translation by the Respondent).

Thus, the only thing the Chamber of Commerce examines is whether the same trade name is already registered. The Chamber of Commerce does not examine whether the concerned trade name is actually being used in public in the course of trade. This is why in addition to a certificate of registration, the Sunrise Rules require documentation showing the public use of the trade names in the course of trade.

Therefore, even if the Applicant had claimed a prior right in the form of a trade name and even if the certificate of registration actually showed that the Applicant was the holder of the trade name registration, the applications should nevertheless have been rejected because the Applicant did not provide any evidence that the trade names are used in the course of trade.

Furthermore, it is not the purpose of section 21 (3) of the Sunrise Rules to impose on the validation agent the task to gather documentary evidence for the applicants if the documentary evidence received was not sufficient to establish the claimed prior right.

Therefore, the validation agent correctly found that the Applicant did not meet its burden of proof to establish the claimed prior rights.

The Complainant also attaches new documents to its complaint, thereby trying to add those documents to the documentary evidence. Documents that were not part of the documentary evidence submitted for this application may not be considered as documentary evidence to establish the claimed prior right. 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.

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 No. 00294 <colt.eu>, No. 00954 <gmp.eu>, No. 01549 <epages.eu>, No. 01674 <ebags.eu>, No. 02124 <exposium.eu> 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.

Even if the Panel was convinced that the Respondent's decision should be annulled, the Panel would have no right to transfer the Domain Names to the Complainant, which even did not apply for them and is not in the queue in the second place.

DISCUSSION AND FINDINGS

In consideration of the Factual Background and the Parties' Contentions stated above, I come to the following conclusions:

1. The relevant provisions

Article 12(3) of the Commission Regulation (EC) No 874/2004 states: "During the second part of phased registration, the names that can be registered in the first part as well as names based on all other prior rights can be applied for as domain names by holders of prior rights on those names."

Article 14 of the Regulation 874/2004 states: "All claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists. (...) 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 by this deadline, the application for the domain name shall be rejected. (...) 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".

Section 3 (1) i of the Sunrise Rules states: "Where no name of a company or organisation is specified, the individual requesting registration of the Domain Name is considered the Applicant; if the name of the company or the organisation is specified, then the company or organisation is considered the Applicant".

Annex 1 to the Sunrise Rules requires for Documentary Evidence for Distinctive Titles of Protected Literary and Artistic Works in the Netherlands the following: "Documentary evidence as referred to in Section 18(2) of the Sunrise Rules."

Annex 1 to the Sunrise Rules requires for Documentary Evidence for Trade Names in the Netherlands the following: "Documentary evidence as referred to in Section 16(5) of the Sunrise Rules. Use of the company name in course of trade must be demonstrated."

Annex 1 to the Sunrise Rules requires for Documentary Evidence for Company Names in the Netherlands the following: "Documentary evidence as referred to in Section 16(5) of the Sunrise Rules (and not Section 16(4) of the Sunrise Rules). Use of the company name in course of trade must be demonstrated (cf trade names)."

Section 16 (5) of the Sunrise Rules states: "Unless otherwise provided in Annex 1 hereto, it is sufficient to submit the following Documentary Evidence for trade names and business identifiers referred to in Section 16(2) respectively 16(3): where it is obligatory and/or possible to register the relevant trade name or business identifier in an official register (where such a register exists in the member state where the business is located):

- a. an extract from that official register, mentioning the date on which the trade name was registered; and
- b. proof of public use of the trade name or business identifier prior to the date of Application (such as, but not limited to, proof of sales volumes, copies of advertising or promotional materials, invoices on which the trade name or business identifier is mentioned etc., proving public use of the name in the relevant member state); (...)"

Section 18 (2) of the Sunrise Rules states for Documentary Evidence for Distinctive Titles of Protected Literary and Artistic Works the following: "Unless otherwise provided for in Annex 1 hereto, it is sufficient to submit the following Documentary Evidence for a distinctive title of a literary and artistic work referred to under Section 18(1): (i) a copy of the cover or image of the literary and artistic work containing the title concerned (together with a brief description of (a) the work, or (b) the content of the work, a photograph of the work, etc.); and (ii) an affidavit signed by a competent authority, legal practitioner or professional representative stating that the Applicant holds the claimed rights in respect of the said title on the date of the Application, that the work in question has lawfully been made public and that the title is distinctive whereby such Documentary Evidence must clearly indicate that the Applicant is holder of the distinctive title of the literary and artistic work."

Section 21 (1) of the Sunrise Rules states: "On the instructions of the Registry, the Validation Agent appointed by the Registry shall verify: (i) whether the official requirements set out in Section 8 have been complied with; and (ii) whether the requirement for the existence of a Prior Right to the name claimed by the Applicant in the Application is fulfilled."

Section 21 (2) of the Sunrise Rules states: "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 and scanned by the Processing Agent and in accordance with the provisions of these Sunrise Rules."

Section 21 (3) of the Sunrise Rules states: "The Validation Agent is not obliged, but it is permitted in its sole discretion, to conduct its own investigations into the circumstances of the Application, the Prior Right claimed and the Documentary Evidence produced."

Article 22.11 (2) of the Regulation 874/2004 states: "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 Regulation (EC) No 733/2002. The ADR panel shall decide that the decision shall be annulled and may decide in appropriate cases that the domain name in question shall be transferred, revoked or attributed, provided that, where necessary, the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002 are fulfilled."

Article A 3 (c) of the ADR Rules states: "All documents including communications made as part of the ADR Proceeding shall be made in the language of the ADR Proceeding. The Panel may disregard documents submitted in other languages than the language of the ADR Proceeding without requesting their translation. Any communication by the Provider which, from its content, cannot be regarded as amounting to procedural documents (such as cover letters with which the Provider sends procedural documents or automatic system notifications generated by the Provider's application) shall be made in the language of the ADR Proceeding or in English."

Article B 11 (c) of the ADR Rules states: "The main remedy available pursuant to an ADR Proceeding where the Respondent is the Registry shall be the annulment of the disputed decision taken by the Registry. The Panel may decide in appropriate cases pursuant to the Procedural Rules, Registration Policy, Sunrise Rules and/or the Terms and Conditions that the domain name in question shall be transferred, revoked or attributed. However, with regard to any Registry decision relating to a prior right invoked during the phased registration period such measures of transfer and attribution will only be granted by the Panel if the Complainant is the next applicant in the queue for the domain name concerned and subject to the decision by the Registry that the Complainant satisfies all registration criteria set out in the European Union Regulations and to the subsequent activation by the Registry of the domain name in the name of the Complainant who is the next applicant in the queue."

2. Conclusions

This Panel wants to stress the point, that following Article 22.11 of the Regulation 874/2004 the ADR Panel shall decide whether the decision at hand taken by the Registry conflicts with Regulation 733/2002 or Regulation 874/2004. Therefore, the Panel considers it has to assess whether there is "documentary evidence which demonstrates the right under the law by virtue of which it exists" under Article 14 of Regulation 874/2004.

The Panel considers that the Applicant of the disputed Domain Names is the individual, Mr. Peter Acworth. This view is clearly supported by Section 3 (1) i of the Sunrise Rules and in amongst others decisions ADR No. 1686 <protool.eu>, No. 2592 <tanos.eu>, No. 3042 <wewalka.eu>, No. 3141 <bano.eu>. and No. 3534 <carstenmaschmeyer.eu>, <carsten-maschmeyer.eu>.

It is the Panel's view that for showing prior rights the applicant has to submit documentary evidence to show that he is the holder of the prior right claimed on the name in question within forty days from the submission of the application to the indicated validation agent. Although the applicant is allowed to submit additional evidence, this only is true, if the additional evidence will be submitted within the forty day period since the submission of the application. This view is also supported by the first-come-first-served principle.

From the wording of Regulation 874/2004 it is clear, that the evidence that shows the prior right claimed must be a documentary evidence and must show that the applicant is the holder of the prior right claimed on the name in question.

With regard to Article 13 in Regulation 874/2004 the validation agent shall examine applications with regard to the submitted documentary evidences. It is moreover in the validation agents sole discretion (Article 21(3) Sunrise Rules) to do further investigation. With respect to the fact that the validation agent shall have appropriate expertise it has also the duty to examine the application and the supported documents materially but only to the extend, that it shall verify/conform obvious errors between the application and the documentary evidence (e.g. the applicant indicated the wrong country at the cover letter – iura novit curia); but this shall not amount to verifying/confirming a difference in legal forms regarding the applicant and the evidence documentation - that would be against Regulation 874/2004 and the principle first-come-first-served.

The documentary evidence did not demonstrate that the Applicant is the holder of the claimed prior rights, namely Distinctive Titles of Protected Literary and Artistic Works. The documentary evidence did not include any required copy of the cover or image of the literary and artistic work containing the title concerned (together with a brief description of (a) the work, or (b) the content of the work, a photograph of the work, etc.) nor the required affidavit signed by a competent authority, legal practitioner or professional representative.

The Complainant has stated that the Complainant's trade names are titles of artistic works protected by both trademark law and international principles of copyright law, and referred to common law trademark rights, even if the Complainant's US division is the owner of the common law rights at issue. The Applicant has indicated "Distinctive Titles of Protected Literary and Artistic Works" in the Netherlands as the type of the prior right claimed in his applications. Thus, the Registry's task was to decide if the documentary evidence fulfilled the requirements set out for proving such prior right, not other types of prior rights.

The printouts of the corresponding .com web sites attached to the Complaint are not admissible as proof of the claimed prior rights as the Registry and the Panel may only consider if the documentary evidence attached to the original applications and filed within the 40-day time limit, proved the claimed prior right. Even if said printouts would have been part of the original documentary evidence, it would not have fulfilled the requirements set for documentary evidence of Distinctive Titles of Protected Literary and Artistic Works or for Trade Names.

Even if the applications would have been filed in the name of CNE Data International BV, who is the owner of the Dutch trade names corresponding to the Domain Names, and the prior right claimed would have been Company Name or Trade Name, the documentary evidence would not have fulfilled the requirements. No required documents, affidavits or proof of use was included in the documentary evidence and printouts of the web sites attached to the Complaint are not admissible as documentary evidence.

The Panel notes that the Complainant is familiar with domain name cybersquatting and has been faced with it earlier with other domain names. As someone with previous domain name registrations and knowledge on cybersquatting, the Panel considers that the Applicant was in a position to have knowledge on the importance of filing the applications correctly in order to avoid rejection based on errors in the application or deficiency in the documentary evidence.

The Panel also notes that an English translation of the annexed certificate from the Dutch Chamber of Commerce was not included in the Complainant. Based on the Article A 3 (c) of the ADR Rules the Panel disregards the documents in Dutch language that were not translated into the language of the proceedings, namely English. The Panel does not feel necessary to request translation of the certificate, because the certificate alone does not fulfill the requirements for proving the prior right claimed. The Panel refers to decisions ADR No. 01047 <festool.eu> and No. 00317 <lumena.eu>.

Based on the above stated the Panel has no possibility but to consider that the rejection decisions made by the Registry do not conflict with the EC Regulation No 733/2002 or No. 874/2004.

In addition, the Panel states that the Complainant's alternative request to order the registration of the Domain Names in the name of the Complainant, independently of the Panel position on the requests for the registration and the reasons for rejection, would not be possible to be approved as the requirements for such an order set out in Article 11 (c) of the ADR Rules and Article 22.11 (2) of the Regulation are not fulfilled in this present case.

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	Elina Koivumäki
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DATE OF PANEL DECISION 2007-03-08

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The disputed domain names were applied during the second part of the phased registration into the name of an individual person. The applicant claimed to have prior right based on “Distinctive Titles of Protected Literary and Artistic Works” protected in The Netherlands. The documentary evidence included a certificate of registration with the Chamber of Commerce in Amsterdam showing that the Complainant, i.e. company CNE Data International B.V., whose principal shareholder and president the individual applicant is said to be, is the owner of Dutch trade names corresponding to the Domain Names.

EURid rejected the registration requests on the grounds that the documentary evidence did not demonstrate that the applicant was the holder of the claimed prior rights on the Domain Names.

The Panel considers that the Applicant of the disputed Domain Names is the individual, Mr. Peter Acworth, and not the Complainant company CNE Data International B.V.

The documentary evidence did not demonstrate that the Applicant is the holder of the claimed prior rights, namely Distinctive Titles of Protected Literary and Artistic Works. The documentary evidence did not include any required copy of the cover or image of the literary and artistic work containing the title concerned (together with a brief description of (a) the work, or (b) the content of the work, a photograph of the work, etc.) nor the required affidavit signed by a competent authority, legal practitioner or professional representative.

Even if the applications would have been filed in the name of CNE Data International BV, who is the owner of the Dutch trade names corresponding to the Domain Names, and the prior right claimed would have been Company Name or Trade Name, the documentary evidence presented would not have fulfilled the requirements. No required documents, affidavits or proof of use was included in the documentary evidence and printouts of the web sites attached to the Complaint are not admissible as documentary evidence, as they were not included in the documentary evidence filed with the Registry within the 40-day period.

The Panel considers that the rejection decisions made by the Registry do not conflict with the EC Regulation No 733/2002 or No. 874/2004.

In addition, the Panel states that the Complainant's alternative request to order the registration of the Domain Names in the name of the Complainant, independently of the Panel position on the requests for the registration and the reasons for rejection, would not be possible to be approved as the requirements for such an order set out in Article 11 (c) of the ADR Rules and Article 22.11 (2) of the Regulation are not fulfilled in this present case.