Panel Decision for dispute CAC-ADREU-004303

Case number	**CAC-ADREU-004303**
Time of filing	**2007-02-20 12:13:50**
Domain names	**hattrick.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Hattrick Limited, Managing Director Johan Gustafson**

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 other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

On February 7, 2006, the Complainant filed an application for the registration of the domain name <hattrick.eu> during Phase II of the phased registration period. This application is subject to the Commission Regulation (EC) No 874/2004 of 28 April 2004 ("Public Policy Rules") and the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (the "Sunrise Rules").

The Complainant's Application was rejected by the Respondent.

The Complainant submitted its Complaint under the .eu Alternative Dispute Resolution Rules ("ADR Rules") by email on February 20, 2007.

On February 22, 2007, the ADR Center formally notified the Respondent of the Complaint and the commencement of the ADR proceeding. The Respondent submitted its Response on February 27, 2007.

Pursuant to Article 4 of the ADR Rules, the ADR Center contacted the Undersigned requesting his services as a sole Panelist to consider and decide this dispute. The Undersigned having accepted, signed and sent his Statement of Acceptance and Declaration of Impartiality, on March 2, 2007, the ADR Center appointed the Undersigned.

On March 14, 2007, the Complainant submitted an unsolicited communication and the Respondent on March 23, 2007, responded informing the Panel it was seeing legal advice with a qualified lawyer in Gibraltar and requested the Panel to allow 15 working days to do so.

After having reviewed the case file and having taken into consideration the communications of the Parties, the Panel issued an order on April 2, 2007, offering the Respondent to submit an additional Response before April 20, 2007 and the Complainant to submit a reply to the additional Response before April 27, 2007. The Respondent submitted its additional Response on April 5, 2007. The Complainant did not reply to this communication by the deadline set by the Panel, i.e., April 27, 2007.

A. COMPLAINANT

The Complainant requests attribution of the disputed domain name <hattrick.eu> to the Complainant.

The Complainant asserts as follows as a basis for such transfer request:

“Hattrick Ltd submitted the documentary evidence on February 27, 2006, in due time before the deadline on March 19, 2006. EURid rejected Hattrick Ltd’s application for the domain Hattrick.eu under the Sunrise rules. Hattrick Ltd is a company registered in Gibraltar (see attached notarised copy of Certificate of Incorporation, Annex 2). Gibraltar is part of the EU as a dependent territory of the United Kingdom. Hattrick Ltd is also the registered owner of the European Community trademark “Hattrick” (see attached notarised copy of Certificate of Registration, Annex 3). Both these facts should separately give Hattrick Ltd the right to the domain hattrick.eu under the EURid Sunrise rules.”

On March 14, 2007, the Complainant submitted a non-standard communication and stated:

“EURid bases their rejection on the fact that company-name protection does not exists in the United Kingdom and that the Certificate of Incorporation from the Registrar of Companies in Gibraltar that we presented therefore was not sufficent to establish prior right. We would like to point out to the panel that the decision cannot be based on the laws on the United Kingdom, since Gibraltar has its own constitution and its own legal code, which are wholly separate from the laws of the Unites Kingdom and more modern, since they came into being in the 1960s. Company names are protected under Gibraltarian law.”

B. RESPONDENT

The Respondent’s Response may be summarized as follows:

a) The Complainant did not demonstrate that it was the holder of a prior right in the name HATTRICK.
b) Article 10 (1) of 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.
c) The Complainant claimed to be the holder of a prior right in the form of a company name established in Gibraltar, which is a dependent territory of the United Kingdom.
d) Pursuant to article 14 of the Regulation, article section 12.3 of the Sunrise Rules and Annex 1 to the Sunrise Rules, a company name protected under the law of the United Kingdom may only be relied upon as a prior right to the extent that rights in passing off exist, which must be demonstrated by :

(i) an affidavit signed by a competent authority, legal practitioner, or professional representative, stating that the name meets the conditions provided for in the law (including relevant court decisions, scholarly works and such conditions as may be mentioned in Annex 1 (if any)) or
(ii) a relevant final judgment by a court or an arbitration decision of an official alternative dispute resolution entity competent in at least one of the member states.

e) The documentary evidence received by the validation agent within the deadline did not include any affidavit drafted by a legal professional or relevant final judgement stating that the name meets the conditions provided for in the UK law of passing off.
f) Therefore, the validation agent correctly found that the Complainant did not sufficiently establish that the prior right relied upon in its application pursuant to article 14 of the Regulation, because no rights in passing off had been demonstrated.

DISCUSSION AND FINDINGS

The Complaint is filed against the Registry for its decision to reject the Complainant’s application to register the disputed domain name <hattrick.eu> made during the phased registration period.

Paragraph B11(d) of the ADR Rules states that “[t]he Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complaint proves […] (2) In ADR Proceedings where the Respondent is the Registry that the decision taken by the Registry conflicts with the European Union Regulations.” Article 14 of the Public Policy Rules on “Validation and registration of application received during phased registrations” states that “[…] 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.”

The Panel shall examine whether or not the Registry’s decision to reject the Complainant’s application for the disputed domain name was in accordance with the Regulations.

Prior Right

The details of the disputed domain name application, as provided in EURID's verification of February 15, 2007, show the type of prior right claimed by the Complainant as " company name / trade name/ business" identifiers", the complete name for which a prior right is claimed as "Hattrick Ltd", and the country in which the prior right claimed is protected as "Gibraltar".

Company Name

Complainant states in its Complaint that "Hattrick Ltd is a company "registered in Gibraltar" and attaches to the Complaint a copy of a Certificate of the Incorporation of a Company issued by the Gibraltar Registrar of Companies on October 22, 2003, certifying that Hattrick Limited is incorporated under the Companies Ordinance.

The relevant provisions on Company Names under the Sunrise Rules are:

Section 16.1 which states that: "[…] If an Applicant claims a Prior Right to a name on the basis of a company name protected under the law of one of the member states mentioned in Annex 1 as being a member state protecting company names, it is sufficient to prove the existence of such Prior Right in accordance with Section 16(4) below."

Section 16.4 which states that: "Unless otherwise provided in Annex 1 hereto, it shall be sufficient to submit the following Documentary Evidence for company names
referred to under Section 16(1):
(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 (e.g. a certificate of good standing) from an official companies or commercial register, a competent public authority or a notary public.
Such Documentary Evidence must clearly indicate 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."

Annex 1 of the Sunrise Rules provides under United Kingdom that protection in "Company Names" will be acknowledged "only to the extent that rights in passing off exist" and that the applicable Documentary Evidence would be "the documentary evidence as referred to in Section 12(3) of the Sunrise Rules and not the documentary evidence referred to in Section 16 of the Sunrise Rules." It is further clarified that "Where documentary evidence is submitted as referred to in Section 12(3)(i) of the Sunrise Rules, the documentary evidence must enable the Validation Agent to validate the existence of a protected prior right (under the law of Passing Off) on the basis of a prima facie review of the documentation as set out in Section 21(2) of the Sunrise Rules."

Section 12.3(i) of the Sunrise Rules states that: "If, under the law of the relevant member state, the existence of the Prior Right claimed is subject to certain conditions relating to the name being famous, well known, publicly or generally known, have a certain reputation, goodwill or use, or the like, the Applicant must furthermore
submit
(i) an affidavit signed by a competent authority, legal practitioner, or professional representative, accompanied by documentation supporting the affidavit or
(ii) a relevant final judgment 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 relevant court decisions, scholarly works and such conditions as may be mentioned in Annex 1 (if any)) of the relevant member state in relation to the type of Prior Right concerned."

The documentary evidence submitted by the Complainant consisted of the Certificate of Incorporation, and did not include evidence as described in Sections 12.3(i)/16.4 of the Sunrise Rules. The Respondent accordingly rejected the Complainant's application.

The Complainant states in its Nonstandard Communication of March 14, 2007, that the Panel's "decision cannot be based on the laws on the United Kingdom, since Gibraltar has its own constitution and its own legal code, which are wholly separate from the laws of the Unites[sic] Kingdom". The Respondent in response provided on April 5, 2007, with a letter from Hassans International Law Firm, based in Gibraltar, stating inter alia that "[t]he position under Gibraltar law is similar to that expressed to be the position under UK law […]. Mere registration of a company name at Companies House in Gibraltar does not give the registrant any rights per se." The Respondent reaffirmed that "the ADR decisions based on UK law remain applicable by analogy".

The Complainant did not respond to the Respondent's submission of April 5, 2007, described above, although it was explicitly given an

opportunity to do so.

Under such circumstances, the Panel finds that the Complainant's submission of a Certificate of Incorporation of a Company, issued by the Gibraltar Registrar of Companies is insufficient to evidence a prior right in a "Company Name" for the purposes of the Sunrise Rules. Accordingly, the Panel finds that the Respondent correctly concluded in its determination to reject the Complainant's application for the disputed domain name during the phased registration period.

Trademark

While the Complainant's application for the disputed domain name during the Phased Registration Period does not appear to have claimed trademark right in "Hattrick" as a Prior Right, the Complainant states in its Complaint that the Complainant is "the registered owner of the European Community trademark 'Hattrick'" and attaches to the Complaint a copy of the details of the trademark registration for the Community trademark (CTM) for the trademark name "hattrick".

The details of the CTM available from the CTM online database show the filing date of the trademark "hattrick" as August 23, 2005, and the date of the trademark registration as August 2, 2006. It is therefore clear that at the time the Complainant filed its application for the disputed domain name on February 7, 2006, the Complainant could not claim a prior right for a registered trademark. Section 13.1(ii) explicitly states that "[a] trademark application is not considered a prior right".

DECISION

For the reasons stated above and in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint is denied.

PANELISTS

Name	**Felipe Lorenzo**

DATE OF PANEL DECISION 2007-05-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant submitted its Complaint against the Respondent, the Registry, for the Registry's decision to reject the Complainant's application to register the disputed domain name during the phased registration period. The Complainant, in its domain name application, asserted prior right in HATTRICK as right in "company name/trade name/business identifier" and submitted as documentary evidence the Certificate of Incorporation of a Company issued by the Gibraltar Registrar of Companies on October 22, 2003. The Panel finds that such evidence is insufficient to evidence a prior right in a "company name" for the purposes of the Sunrise Rules (Sections 12.3(i) and 16.4 specifying the additional evidence required). The Complainant in its Complaint also asserts that it is the registered owner of the European Community trademark "Hattrick". Such registration having been granted after the application of the disputed domain name, and Section 13.1(ii) of the Sunrise Rules explicitly stating that a "trademark application is not considered a prior right", the Panel finds the Registry's decision to reject the Complainant's application was made in accordance with the Regulations.

Accordingly, the Complaint is denied.