Panel Decision for dispute CAC-ADREU-004601

Case number	**CAC-ADREU-004601**
Time of filing	**2007-07-19 10:16:37**
Domain names	**xtrack.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**PPU Omega sp z o.o., Jacek Frydrychowicz**

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

none

FACTUAL BACKGROUND

P.P.U. OMEGA sp.z o.o. (hereafter "the Complainant") is a software company in Poland based in Gdansk and holder of the Polish trademark "xtrack" on his own words. The Complainant uses the domains xtrack.pl and others for commercial purposes.
The complainant has instructed a registrar, Naukowa i Akademicka Sie´c Komputerowa NASK, to file an application for the disputed domain name. The application for the domain name XTRACK, claiming as prior right an unregistered trademark protected in Poland for the name "XTRACK".
The application for the domain name was submitted in sunrise period phase 2 on 31th March, 2006 and arrived in seventh position in the queue of the applications made for this domain name. The deadline for submission of the documentary evidence was May, 10th 2006.
The complainant submitted relevant documentary evidence on 2th May, 2006.

The documentary evidence concluded
1 . a confirming document of the application for registration of a trademark "XTRACK" with the POLISH PATENT OFFICE
2. copies of advertising and promotional material
3. copies of invoices
4. documents according which complainant was registered at a Trade fair as XTRACK

The complainant received an e-mail from the Respondant informing him that his application for the domain name xtrack.eu was rejected. In this e-mail the EURid pretended that the documentary evidence received did not sufficiently prove the right claimed. The complainant received no other information during the registration from the respondant, the validation agent or the registrar during the registration procedure. On 10th July 2007, the Complainant filed a Complaint under the .EU Alternative Dispute Resolution (ADR) procedure challenging the Respondent's decision. The Complainant paid the correct amount of fees and the proceeding commenced. The Respondent filed a Response on 24th Aug. 2007 and the Panel was appointed to decide the case.

A. COMPLAINANT

The Complainant contends that the rejection of the application for registration of the Disputed Domain Name was made in contradiction of the .EU Sunrise Rules on the basis that sufficient evidence was submitted to demonstrate a Prior Right in the Disputed Domain Name. The Complainant explains that he had applied for the Polish trademark “XTRACK” on 22-09-2002. The Complainant argues that the Polish Patent Office is a competent authority in the meaning of Section 12.3. According to the Complainant, the Polish Patent Office is “the only competent authority which may give a binding opinion about his rights”.
Furthermore, the Complainant argues that legal practitioners “do not have any authority (and are not used) to claim affidavits in their

own names for any purposes related to their clients".
Therefore, the Complainant argues that he sufficiently demonstrated that he is the holder of the claimed prior right (ie an unregistered trademark on the name XTRACK protected in Poland).
The Complainant pointed out that there was no specific explanation in the sunrise rules what should be missing or any advice. The complainant followed the rules complete and showed the evidences required. According to the registration rules Article 26 he had only the possibility to claim his right at this court ADR.eu.
The Complainant claims that he complied with section 12.3 of the Sunrise Rules "by providing the validation agent with a copy of Complainant's trademark application signed by a public body responsible for matters of intellectual property rights including trademarks – the Polish Patent Office."
The Complainant attached to its Complaint the relevant documentation supporting and proving its arguments.
The Complainant requests the Panel to annul the Respondent's decision and to attribute the domain name to the Complainant.

B. RESPONDENT

The Respondent provided its Response within the required deadline.

The Respondent contends that the documentary evidence submitted by the Complainant consisted of the mentioned factual background didn't satisfy the burden of proof. Contrary to the Complainant's contentions is the Polish Patent Office not a competent authority to establish the protection of the claimed prior right. The Polish Patent Office is on Respondents point of view competent for the registration of trademarks and NOT for issuing affidavits stating that a name meets the conditions of protection as an unregistered trademark.
Furthermore the Respondent said that the letter from the Polish Patent Office did not state that the name XTRACK qualifies for protection as an unregistered trademark under Polish law but merely states that the application for the registration of a trademark had been received.

Pursuant to article 14 of the Regulation, the applicant must to submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. Based on this documentary evidence, the validation agent shall examine whether the applicant has prior rights on the name. It is therefore of crucial importance that the Respondent is provided with all the documentary evidence necessary for it to assess if the applicant is indeed the holder of a prior right. Section 21.2 of the Sunrise Rules clearly stated that the validation agent must examine whether the applicant had a Prior Right exclusively on the basis of a prima facie review of the first set of documentary evidence received.
The Respondent referred to several similar cases (ADR 294 (COLT), 810 (AHOLD), 954 (GMP), 1549 (EPAGES), etc. 3467 (WSBK)), argues that the burden of proof was to the Complainant and rely to Article 10 (1) of the Regulation states that only holders of prior rights recognised or established by national and/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.
In the Respondent's view its decision to reject the Complainant's application did not conflict with the Regulations and so the Complaint should be denied.

DISCUSSION AND FINDINGS

Firstly, the Panel notes that the conflict between the parties is on two levels. On one hand is the meaning of the prior right "unregistered trademark" in the sunrise period the relevant question and on the other hand is the question of satisfying the "burden of proof", the documentary evidence.

1. Therefore it is necessary to interpret the rule in article 15 of the Sunrise Rules because the parties are disputing about and it is the ground for the prior right. Is the Complainant the holder of an unregistered trademark in the meaning of sec. 15?

The Annex1 of the sunrise rules sec. 15 ii for Germany specifies
"In case the Applicant submits an affidavit as referred to in Section 12(3)(i), such affidavit must be accompanied by at least a report of a marketing association"
And the Annex 1 outlines for the U.K. "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."
For example Austria outlays that the documentary evidence as referred to in Section 15 of the Sunrise rules "Affidavit must be signed by a legal practitioner or professional representative."
For Poland exists no specification in the Annex1 to sec. 15. Therefore the Complainant should not be handicapped due to this circumstance.
The useful U.K. interpretation of the sense of the rule demands a prima facie evidence which allows the validation agent to make his

decision. It has to be shown by the applicant that he is holder of an unregistered trademark. But in this case the applicant probably misunderstood this and argued as if an application for a trademark is the same. But it is not equal to a unregistered trademark by national law. If such a unregistered trademark in Poland exists is unproved. The answer to the question what a unregistered trademark is, will be shown with just a similar example: the unregistered Community Design, in some states Domainnames itself.

2.
For the second level of the decision the position of the Registry is strong. The Respondent failed with its argument that the Polish Patent Office is not a competent authority to affidavit the requested proof but the served document did not show the proof.
As the panel clearly summed up in case ADR 1886 (GBG), "According to the Procedure laid out in the Regulation the relevant question is thus not whether the Complainant is the holder of a prior right, but whether the Complainant demonstrated to the validation agent that it is the holder of a prior right. If an applicant fails to submit all documents which show that it is the owner of a prior right the application must be rejected".
As stated in the similar case ADR 3467 (WSBK) : “The respective affidavit should have included a comprehensive statement provided by the legal practitioner confirming that the claimed name WSBK meets the conditions requested by Italian law to be recognized as an unregistered trademark protected by this law.”
In this case the Complainant did not supply the Registry with an affidavit of an legal practitioner or competent authority confirming that the claimed name is an unregistered trademark by Polish Law.

3. Conclusion
Finally, Section 21(2) of the Sunrise Rules provides as follows: “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 […]”
The Contested Decision can only be annulled if Complainant can prove that such a decision conflicts with the European Union Regulations. The burden of proof is clearly on the Applicant to establish a valid prior right, on which it can rely at the time of the domain name application, pursuant to Article 14 of Regulation 874/2004.
The delivered documents, especially the document of the application for registration of a trademark "XTRACK" with the POLISH PATENT OFFICE does not establish that the Complainant is the holder of an unregistered trademark in the meaning of article 15 of the Sunrise Rules; neither does it confirm why the name in question (XTRACK) could qualify for protection under the Polish law protecting unregistered trademarks.
The Panel is satisfied that the Respondent’s decision does not conflict with the European Union Regulations. In the absence of evidence to conclude otherwise, the Panel has no choice, but to dismiss the Complaint.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the Complaint is Denied

PANELISTS

Name	**Harald von Herget**

DATE OF PANEL DECISION 2007-09-12

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed a Complaint against the Respondent claiming that the Respondent didn’t respect the delivered documentary evidence in the sunrise period.

In the present case, the documentary evidence received by the validation agent within the deadline included a document issued by the Polish Patent Office which confirms that the Complainant applied for the registration of the XTRACK trademark with the Polish Patent Office.
The Respondent contends that the documentary evidence submitted by the Complainant consisted of the mentioned factual background didn’t satisfy the burden of proof. Contrary to the Complainant’s contentions is the Polish Patent Office not a competent authority to establish the protection of the claimed prior right. The Polish Patent Office is on Respondents point of view competent for the registration of trademarks and NOT for issuing affidavits stating that a name meets the conditions of protection as an unregistered trademark.
Furthermore the Respondent said that the letter from the Polish Patent Office did not state that the name XTRACK qualifies for

protection as an unregistered trademark under Polish law but merely states that the application for the registration of a trademark had been received.
The Panel notes that the conflict between the parties is on two levels. On one hand is the meaning of the prior right “unregistered trademark” in the sunrise period the relevant question and on the other hand is the question of satisfying the “burden of proof”, the documentary evidence.
It has to be shown by the applicant that he is holder of an unregistered trademark. But in this case the applicant probably misunderstood that and argued as if an application for a trademark is the same. But an application is not equal to a unregistered trademark by national law. If such a unregistered trademark in Poland exists is unproved. Further the Complainant did not supply the Registry with an affidavit of an legal practitioner or competent authority confirming that the claimed name is an unregistered trademark by Polish Law.
In the absence of evidence to conclude otherwise, the Panel has no choice, but to dismiss the Complaint.