

# Validation Services for EURid

## Rules and Procedures for Dot-eu Sunrise

# Objective

Involvement of PwC in .eu launch

Presentation of the Validation Framework for Prior Rights i.e. the Sunrise Rules

Presentation of the Validation Process

Status, Way Forward & Timing

Key messages for .eu Sunrise Domain Name Applicants

Q & A

# Involvement of PwC in .eu launch

## March 2005: EURid selected PwC as its main Validation Agent for .eu Sunrise Applications

- thorough expertise in Intellectual Property Rights
- adequate and efficient validation methodology
  - execute validation in an objective, transparent and non-discriminatory manner, as subcontractor of EURid
- multilingual skills in the 20 official languages of the Community
- geographical presence in all EU Member States

## Responsibilities of the Validation Agent

- time-stamp documentary evidence upon receipt
- validate the existence of a Prior Right regarding the application for a particular domain name that is first in line on the basis of
  - the documentary evidence submitted to PwC within 40 days from the submission of the application for the domain name
  - the Validation Framework approved by EURid (= Sunrise Rules)

## The Validation Framework – The Sunrise Rules

From April till September 2005, PwC has drafted the Sunrise Rules in consultation with:

- the European Commission
- the International Trademark Association (INTA), European Communities Trade Mark Association (ECTA), Association of European Trade Mark Owners (MARQUES), European Brands Association (AIM)
- other specialists in Intellectual Property Rights

On 30 September 2005, EURid has approved and published the Sunrise Rules on its website

# Validation Framework – Sunrise Rules

## Rules with which domain name applicants must comply when applying for a .eu domain name during the Phased Registration (or “Sunrise”) Period

- 1) **General Eligibility Requirements**
  - cf. Article 4(2)(b) of Regulation 733/2002
- 2) **Specific Eligibility Requirements during the Phased Registration Period**
  - cf. Article 10(1) first § of Regulation 874/2004
- 3) **List of acknowledged Prior Rights**
  - cf. Article 10(1) second § of Regulation 874/2004
- 4) **Validation on the basis of documentary evidence to be submitted to the validation agent within 40 days from the submission of the domain name application**
  - cf. Article 14 of Regulation 874/2004



# 1) General Eligibility Requirements

Article 4(2) of Regulation 733/2002

“The Registry shall:

(a) [...]

(b) register domain names in the .eu TLD through any accredited .eu Registrar requested by any:

- (i) undertaking having its registered office, central administration or principal place of business within the Community;
- (ii) organisation established within the Community without prejudice to the application of national law; or
- (iii) natural person resident within the Community.”

## 2) Specific Eligibility Requirements during the Phased Registration Period

Article 10(1) 1<sup>st</sup> § of Regulation 874/2004 (Public Policy Rules)

“Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.”

### 3) List of Acknowledged Prior Rights

Article 10(1) 2<sup>nd</sup> § of Regulation 874/2004 (Public Policy Rules)

phase 1

“Prior Rights” shall be understood to include, *inter alia*,

- registered national and community trade marks,
- geographical indications or designations of origin, and
- in as far as they are protected under national law in the Member-State where they are held:
  - unregistered trade marks;
  - trade names;
  - business identifiers;
  - company names;
  - family names;
  - distinctive titles of protected literary and artistic works

phase 2

### 3) List of Acknowledged Prior Rights

Issues concerning the list of acknowledged Prior Rights

The Public Policy Rules raise a number of interpretation problems

- 1) registered trade marks to be recognised during the Sunrise Period
- 2) “Prior rights” ... “protected under national law in the Member-State where they are held”
- 3) “...the registration of the complete name for which the prior right exists...”

## 1) Acknowledged registered trade marks

### General

Acknowledged registered trade marks:

- national (EU member states) registered trade marks
- Benelux trade marks
- Community trade marks
- international registrations, where at least one of the member states has been designated and the trade mark is registered in such member state(s)

**NOT:** trade marks registered in third countries

Why?

- harmonised legal framework in EU
- in line with the General Eligibility Requirements

## 1) Acknowledged registered trade marks

### Documentary Evidence

- Copy of trade mark certificate / renewal certificate
- Extract from official trade mark register
- Extract (print-out) from official (on line) trade mark register (if available)

## 1) Acknowledged registered trade marks

### Licensees of registered trade marks

Can licensees secure their intellectual property rights in .eu?

*example:* registered trade mark held by Japanese parent company with subsidiary in Spain

Yes – according Article 12(2) of the PPR

- licensees of a registered trade mark can apply for the corresponding domain name
- only during Phase 1, **not** during Phase 2
- practical issues on how to prove existence of a licence

## 1) Acknowledged registered trade marks

### Licensees of registered trade marks

## Practical issues on how to prove existence of a license

- Restrictive interpretation of licences
  - strictly speaking, the licence must state that the licensee is entitled to apply for the corresponding domain name in the .eu TLD
- Same problem in case licence is recorded with the trade mark office (which is rarely done)
- Confidential information included in the Licence

**Conclusion:** requesting licence / notification is mostly not a workable solution



# 1) Acknowledged registered trade marks

## Licensees of registered trade marks

### Proposed approach in the Sunrise Rules:

- electronic declaration form, published on EURid web site
  - to be completed electronically
  - print-out to be signed by licensor and licensee
- other relevant documentary evidence to be added

### Main benefits:

- simple and transparent procedure, enabling trade mark owners to remain in control of licences
- confidentiality of actual license terms remain unimpaired

### Similar procedure for transfers

## 2) “Protected under national law where prior rights are held”

### General Rule

- affidavit
- reference to applicable law
- documentary evidence substantiating the existence of Prior Right

### Per member state, an overview will be given of

- the prior rights that are acknowledged as protected
- the documentary evidence that needs to be provided
- additional conditions that need to be fulfilled (if any)

## 2) “Protected under national law where prior rights are held”

Unregistered trade marks, trade names, business identifiers, company names, family names and distinctive titles of protected literary and artistic works

- little or no harmonisation in the national laws of the EU member states
- conditions for protection are not the same in all countries
  - sometimes registration suffices
  - sometimes the sign must be famous, well-known, notorious, ... (affidavit will be required)
- in certain countries, certain “prior rights” are not protected at all / “cross-over”
- unclear how “family names” are considered “protected”

### 3) “the registration of the complete name for which the prior right exists”

General principle: the domain name applied for must **exactly match** the name for which the prior right exists

- Exception 1: characters and punctuations that cannot form part of a domain name
  - e.g. : & @ “ ‘ ( § ! Ç à ) [ ] . / ; , ? = + %
  - transcribed, omitted or replaced by hyphen
- Exception 2: names in other than standard Latin script
  - generally accepted transliteration standards
  - not for scripts not generally used in an official EU language

### 3) “the registration of the complete name for which the prior right exists”

#### General: examples:

- registered trade mark “*consultants.eu*”
  - Allowed: *consultantseu.eu* or *consultants-eu.eu*
  - Not: *consultants.eu*
- protected company name / trade name / business identifier “*PricewaterhouseCoopers Tax Consultants BCVBA*”
  - Allowed: *pricewaterhousecooperstaxconsultants.eu* or *pricewaterhousecoopers-tax-consultants.eu*
  - Not: *tax.eu* or *consultants.eu*
- registered trade mark “*PricewaterhouseCoopers*”
  - Not: *pwc.eu* or *pricewaterhousecooperstaxconsultants.eu*

### 3) “the registration of the complete name for which the prior right exists”

#### General: examples (cont’d):

- registered trade mark “*price-waterhouse-coopers*”
  - Allowed: *price-waterhouse-coopers.eu*
  - Not: *pricewaterhousecoopers.eu*
- registered trademark “*Coopers & Lybrand*”
  - Allowed: *cooperslybrand.eu*, *coopers-lybrand.eu*, *coopersandlybrand.eu*, *coopersetlybrand.eu*, *coopersundlybrand.eu*, *coopersenlybrand.eu*, ...
- registered trade mark: “*C&L*” (Coopers & Lybrand acronym)
  - Not: *cl.eu* as “cl” is the Alpha-2 country code for Chile

### 3) “the registration of the complete name for which the prior right exists”

#### Signs in a non-standard typeface (device / figurative signs)

- PPR refers to registered trade marks, trade names, etc., without specification  
***but:*** the registration on the basis of a prior right shall consist of the complete name for which the prior right exists (Article 10(2) of the PPR) ...
- Unlike in other TLD launches, device marks will be accepted during the .eu Sunrise, under certain conditions

### 3) “the registration of the complete name for which the prior right exists”

#### Device / figurative signs: conditions

- the sign *exclusively contains a name*, **or**
- the *word element is predominant*, and can be clearly separated or distinguished from the device element, **provided that**
  - (a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the Domain Name applied for, in the same order as that in which they appear in the sign, **and**
  - (b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear.



### 3) “the registration of the complete name for which the prior right exists”

#### Device / figurative signs: examples

- Registered trade mark *PRICEWATERHOUSECOOPERS* for *pricewaterhousecoopers.eu*

- Allowed:

- sign exclusively contains the name “PricewaterhouseCoopers”
- all alphanumeric characters are included in the Domain Name applied for, and
- the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear

### 3) “the registration of the complete name for which the prior right exists”

#### Device / figurative signs: examples

- Registered trade mark



for *pwc.eu*

- Not allowed:

- there is a reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear (i.e. “PCw”)

## 4) Validation on the basis of documentary evidence

### !! Official requirements for documentary evidence:

- can only be couched in the official language of the EU indicated in the application / on the cover page
- administrative requirements
  - no staples, not folded, in A4 or letter format, printed on one side only, ...
- only first set received by PwC within 40 calendar days from the submission of the application for a domain name will be considered

## 4) Validation on the basis of documentary evidence

What can be expected from the Validation Agent?

### Validation done on basis of Documentary Evidence (PPR)

- no obligation to conduct own investigations
- prima facie review of documentary evidence

### To be checked by Validation Agent

- compliance with official requirements
- whether requirement for existence of prior right is fulfilled

# The Validation Process of “Prior Rights”

## Three « Types » of Domain Name **Applicants**

### General Domain Name Applications

- cf. General and Specific Eligibility Requirements
- companies, physical persons, etc.
- **Phase 1:** registered national & Community trade marks, geographic indications and designations of origin
- **Phase 2:** prior rights recognised in Phase 1 + *inter alia* other prior rights referred to in Article 10(2) of the Public Policy Rules

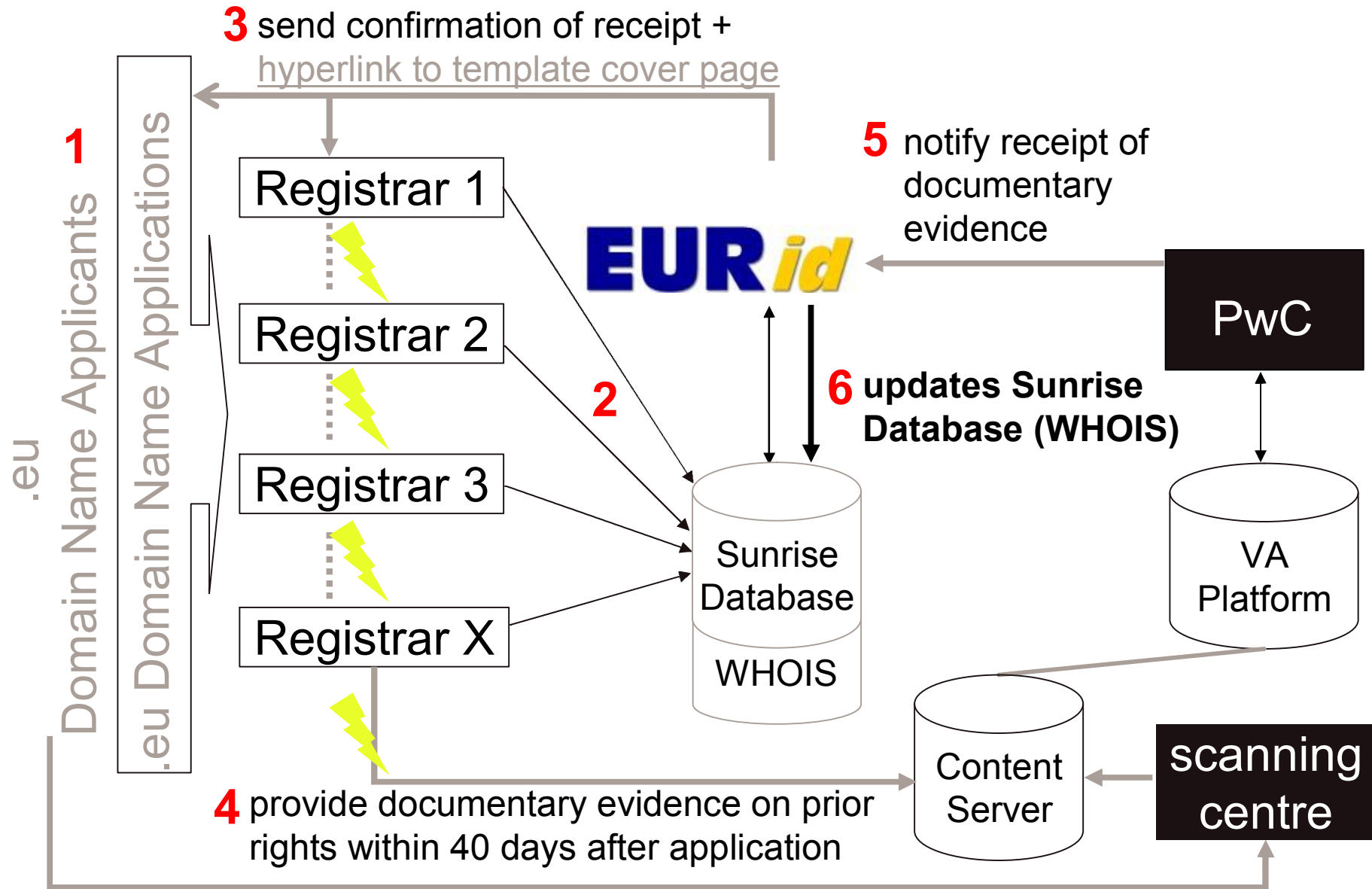
### Names and acronyms of Public Bodies

- validation will be done by Government Validation Points, individually appointed by each Member State / the European Commission

### Names applied for by PwC

- validation will be done by the law firm of Allen & Overy, appointed by EURid

# Validation Process for Domain Name Applications during Sunrise



# Validation Process for Domain Name Applications during Sunrise

In case domain name applicant is first in the queue for the domain name concerned **and** his documentary evidence has been received in time

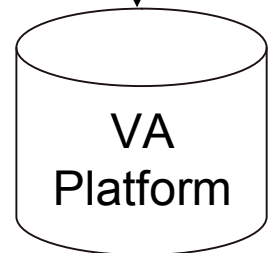
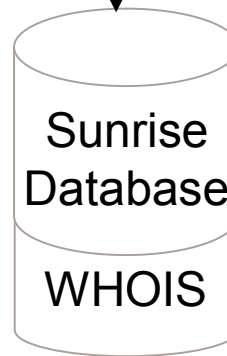
**EURid**

allocate file to PwC employee, native speaker participating in the project, trained to **perform the validation** of prior rights; **quality control** by IP experts

**8** positive or negative notification

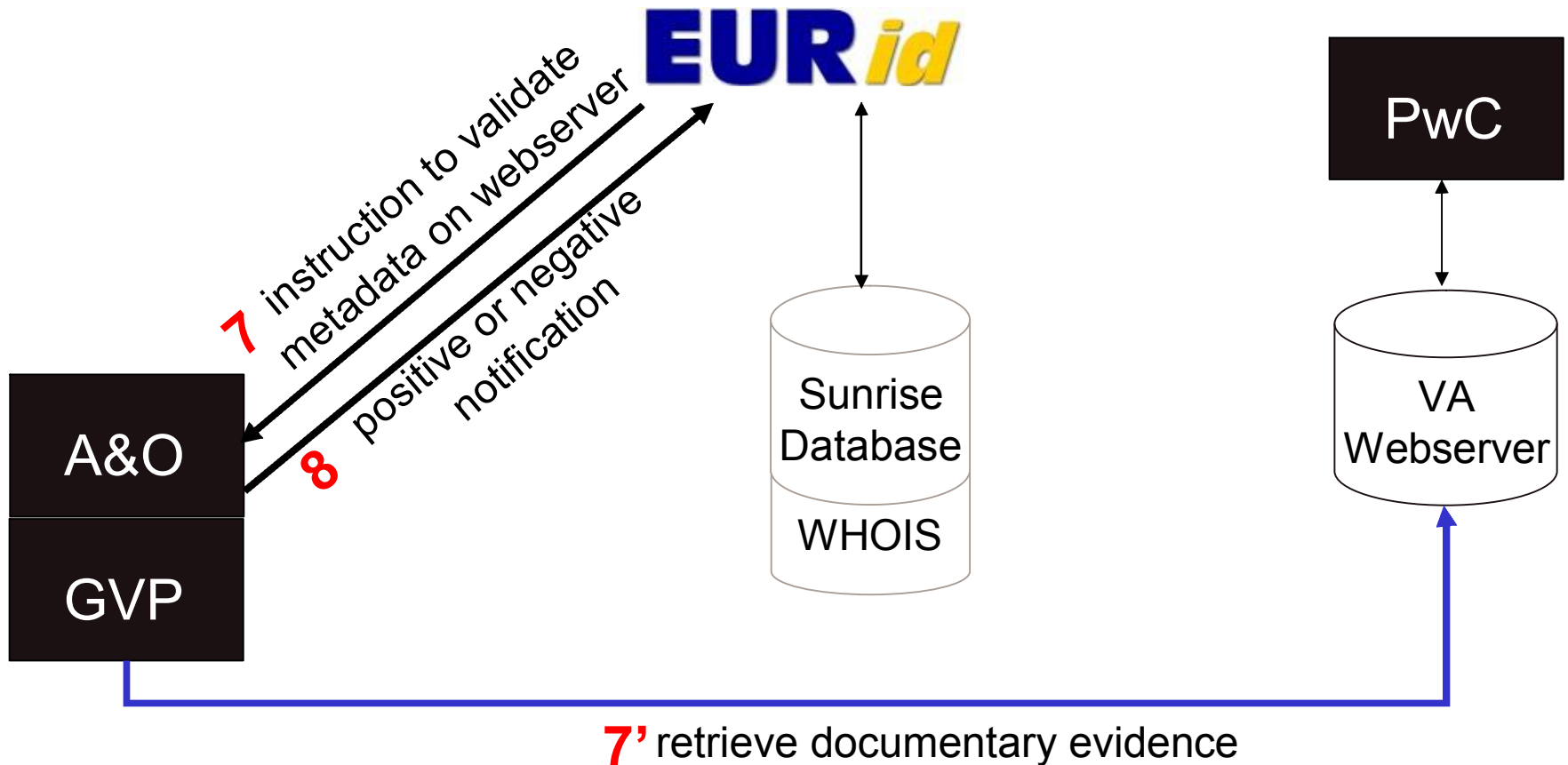
**PwC**

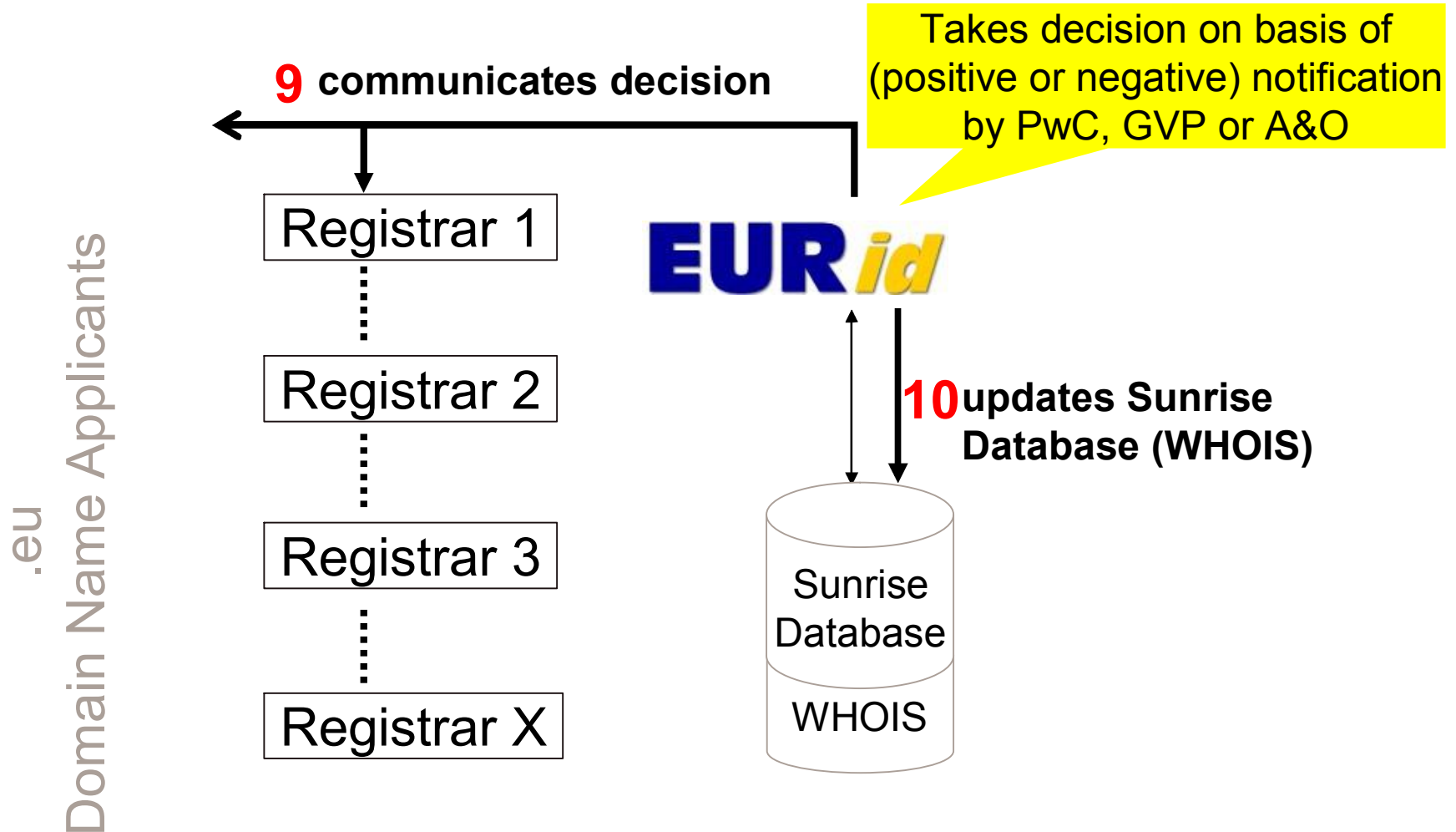
**7** instruction to validate + communicate metadata to VA Platform





In case domain name applicant **invoking a public body name, acronym, PwC name, ...** is first in the queue for the domain name concerned **and** his documentary evidence has been received in time





## Registrars Import Module

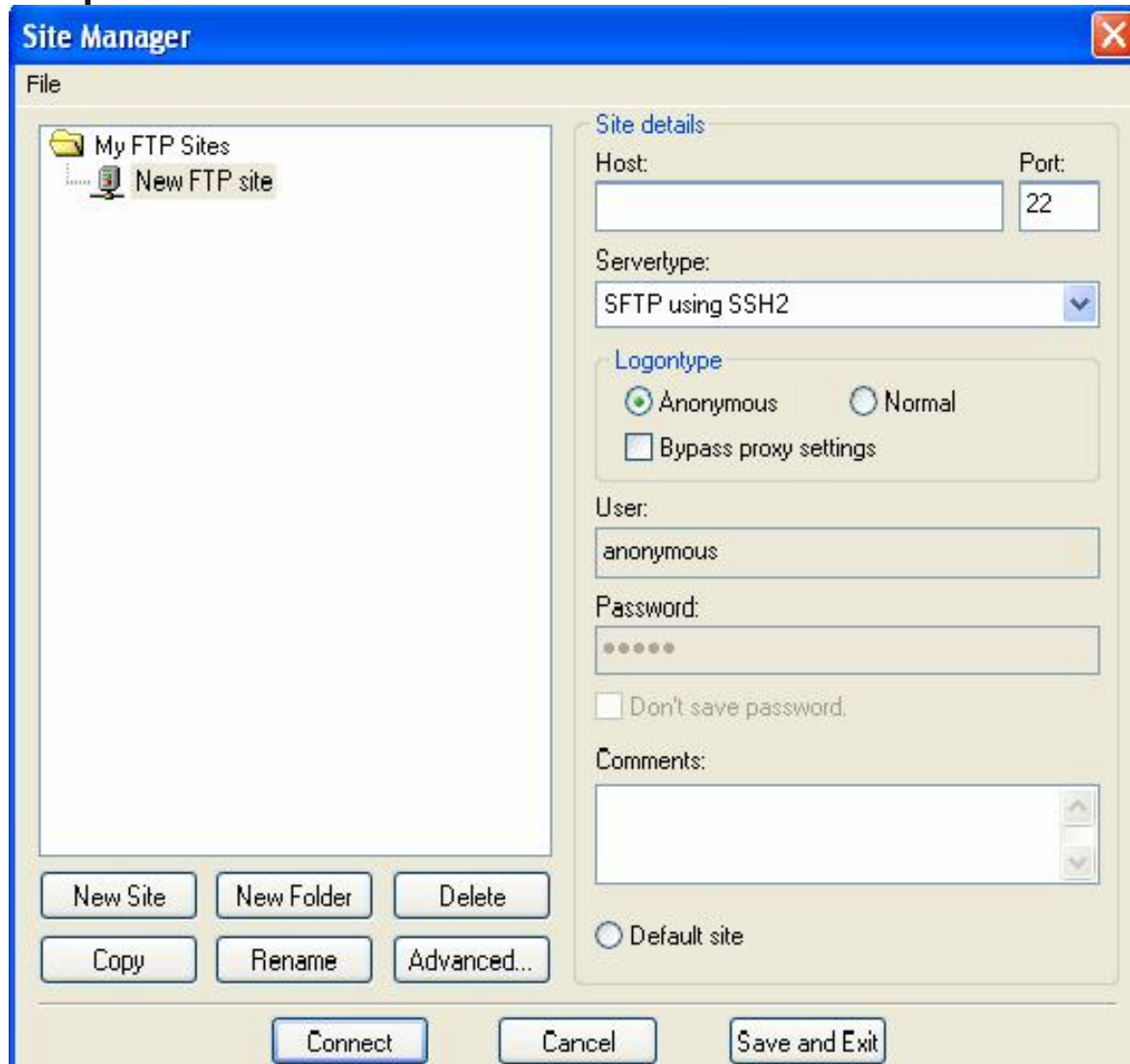
### Registrar Contract

- will soon be put to your disposal
- completed contract to be signed and sent to PwC

### Technical formalities

- Registrar should have sftp client installed
  - Open source – available on internet e.g.  
[http://en.wikipedia.org/wiki/List\\_of\\_SFTP\\_clients](http://en.wikipedia.org/wiki/List_of_SFTP_clients)
- upon receipt of signed contract PwC will provide
  - user ID and password + technical info

# Registrars Import Module – technical info



Local Site: \

- My Computer
  - C:
  - D:

Filename	Filesize	Filetype	Last Modif
C:		Local Disk	
D:		CD Drive	

1 folder.

Remote Site:

Filename	Filesize	Filetype	Date	Time	Permissions
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Local Filename	Size	Direction	Remote Filename	Host	Status
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## Registrars Import Module

### Format of a set of Documentary Evidence

- per set of Documentary Evidence
  - one pdf file containing all pages of the set
  - scanned in 200 dpi
  - scanned Documentary Evidence must be clearly readable
  - size must be DIN A4 (29,7 cm x 21 cm) or letter (27,94 cm x 21,59 cm) format

# Registrars Import Module

## Format of a set of Documentary Evidence

- naming convention for the pdf file
  - barcode\_languagecode.pdf e.g. 22771433133021\_nl.pdf
  - extension .pdf must be written in lowercase
  - \_languagecode to be used only if the language of Documentary Evidence does not correspond with language initially selected in the application
  - all other extensions, names and formats will not be considered

## Registrars Import Module

### Country codes

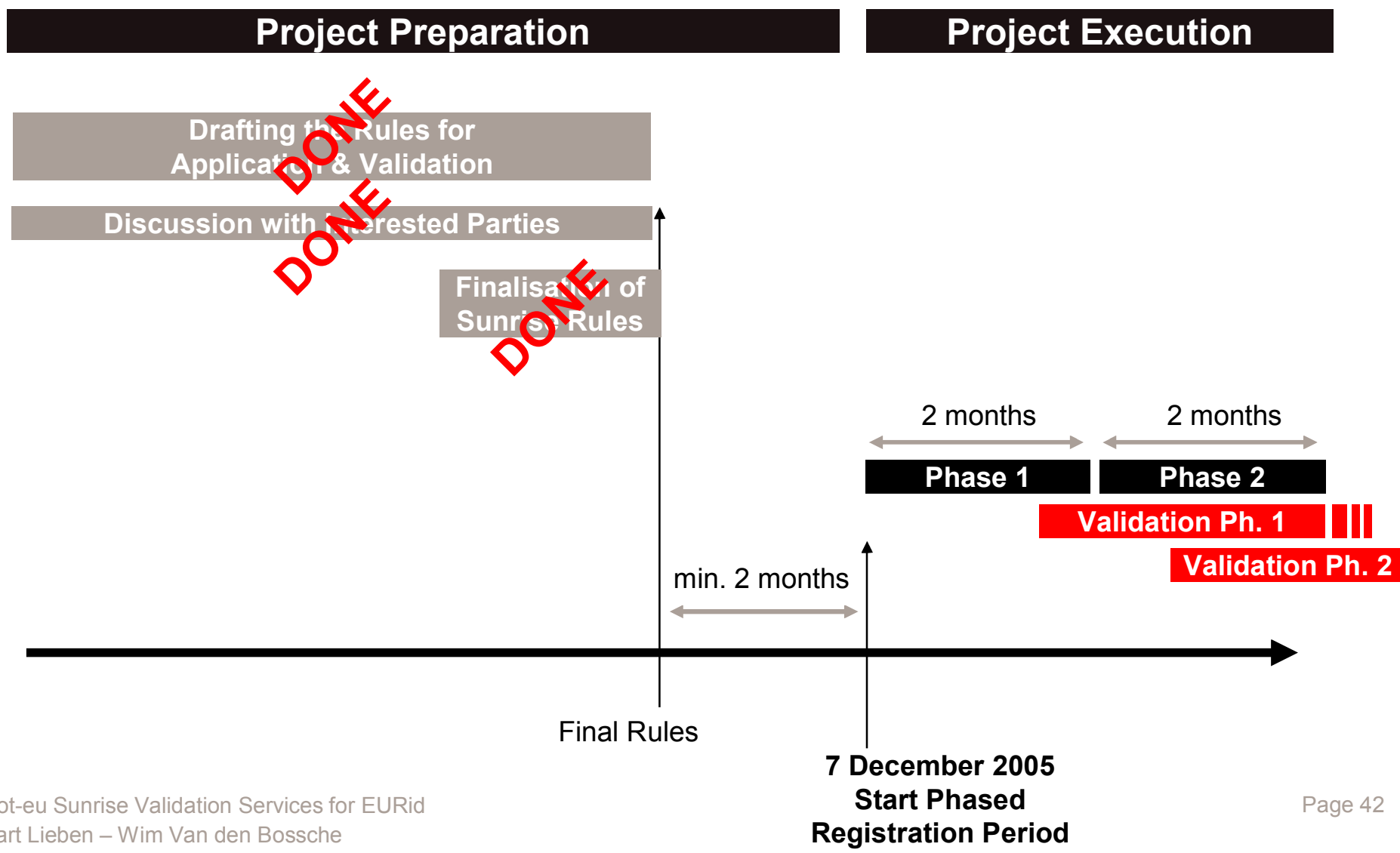
<b>Code</b>	<b>Language</b>	<b>Code</b>	<b>Language</b>
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cs	Czech	lt	Lithuanian
da	Danish	hu	Hungarian
de	German	mt	Maltese
et	Estonian	nl	Dutch
el	Greek	pl	Polish
en	English	pt	Portuguese
es	Spanish	sk	Slovak
fr	French	sl	Slovenian
it	Italian	fi	Finnish
lv	Latvian	sv	Swedish



# Status, Way Forward & Timing

# Timetable



# Key messages for .eu Sunrise Domain Name Applicants

## Conclusion

### Read carefully the Sunrise Rules

#### Clearly indicate in the application

- the type of Prior Right invoked
- the country for which the Prior Right exists
- the language of the Documentary Evidence

### Comply with the administrative requirements for Documentary Evidence

# Q & A

# Thank You

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