Panel Decision for dispute CAC-ADREU-000232

Case number	CAC-ADREU-000232
Time of filing	2006-03-17 12:05:17
Domain names	dmc.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	DMC Design for Media and Communication GmbH

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

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain name .

FACTUAL BACKGROUND

1. The Complainant is DMC Design for Media and Communication GmbH a company registered and based in Austria. It was at the relevant times and remains the sole general partner of DMC Design for Media and Communication GmbH & Co KG (“DMC KG”). DMC KG is a limited partnership under the law of Austria.

2. DMC KG is recorded as the owner of Austrian registered trademark AT 202430 for the word DMC (the “Austrian Trade Mark”).

3. On 7 December 2005 the Complainant filed for registration of <dmc.eu> (the "Domain Name"). On 27 January 2006 the Registry rejected the application for registration of the Doman Name because the name of the Domain Name applicant was not identical with the holder of the Austrian Trade Mark.

A. COMPLAINANT

The Complainant contends as follows:

(i) According to Austrian law a limited partnership under Austrian law is not a legal entity. It may only be deemed to acquire rights (e.g. trade mark rights), commit to obligations, acquire property and has standing in legal proceedings. A limited partnership may be described as “joint ownership” (Gesamthandshaft).

(ii) The “general partner” of a limited partnership handles the entire management of the limited partnership within the scope of the ordinary conduct of business. The “general partner” is also solely entitled to represent and sign for and on behalf of the limited partnership. The application of a .eu domain name falls within the scope of the ordinary conduct of business.

(iii) Therefore, in this case the Complainant solely conducts the management and the representation of DMC KG. Accordingly, the “application of the domain name for the organisation of the Complainant is therefore effective for the limited partnership of [DMC KG]”.

(iv) In such circumstances, the complainant and DMC KG should be treated as a single organisation for the purposes of registration of the Domain Name.

(v) Further, DMC KG has granted a licence to the Complainant in relation to the use of the Austrian Trade Mark.

(vi) In the circumstances, the Registry's decision is "unnecessarily formal" and is not "transparent, non-discriminatory and simple" contrary to Article 4, para 1 of EC Regulation 7334/2002 and Recital 2 of the Public Policy Rules (Regulation 874/2004).

(vii) Finally, the Complainant asserts that it "has not been able to enter its full name including all additions (DMC KG) in the text field 'Applicant' on the relevant registrar's website, thus the addition '& Co KG', has been dropped".

B. RESPONDENT

The Respondent (which is the Registry) contends as follows:

(i) The Sunrise Rules, provide under section 13.2 that where a registered trade mark is relied upon the documentary evidence provided by the applicant in support of his application "must clearly evidence that the Applicant is the reported owner of the registered trade mark".

(ii) The copy certificate from the Austrian Trade Mark office provided did not evidence that the Complainant was the owner of the registered trade mark since the reported owner on that certificate was DMC KG.

(iii) The Registry accepts that in this case both the Complainant and DMC KG "form one single business undertaking or organisation in a sense of Section 3.1(i) of the Sunrise Rules". Further, the Registry accepts the Complainant's characterisation of a limited partnership under Austrian law. It consequently accepts that the Austrian Trade Mark, "although formally registered for DMC KG is effective for the Complainant."

(iv) Nevertheless, on the documentary evidence provided the Complainant and DMC KG are prima facie different legal entities. The evidence did not show that the Complainant managed DMC KG, nor that they are one business entity.

(v) Further, the licence agreement referred to in the Complaint was not submitted as evidence at the relevant time.

DISCUSSION AND FINDINGS

1. It is convenient first to address the Complainant's assertions regarding licensing arrangements and the insufficient length of the text field for the name of the applicant in the relevant application.

2. The Complainant's licensing argument can be dismissed relatively rapidly. Whilst evidence of the relevant licence is included with the Complaint it takes the form of a licence declaration dated 6 March 2006. As such it did not and could not have formed part of documentary evidence which was provided to the validation agent in connection with the Domain Name application.

3. As was stated by the Panel in BPW Bergische Achsen KG v EURid CAC Case No. 00127 <bpw.eu>:

"In compliance with the Article 14 of Commission Regulation (EC) No 874/2004 the .eu Registration Policy and the Terms and Conditions, (.eu Sunrise Rules), that apply for all applications during the phased registration period in accordance with art. 3 (d) of the said Regulation provides under Section 13.2, inter alia, that the documentary evidence must clearly evidence that the applicant is the reported owner of the registered trademark.

In other words, where the prior right claimed is a trade mark, the burden of proof is on the applicant (Complainant) side, ownership evidence inclusive."

4. In this case the Complainant neither raised the issue of the licence nor provided the relevant evidence in relation to that licence at the relevant time. In the circumstances neither EURid nor the validation agent can be criticised for not taking the licence into account. This submission fails.

5. The text field complaint is not quite so straight forward. The Complainant alleged that the text field "Applicant" on the relevant registrar's website was not long enough to enable the full name "DMC Design for Media & Communication GmbH & Co KG" to have been entered. At first sight this complaint seems similar to that in Pinel v Eurid CAC Case No. 00181 <oscar.eu> where a complainant encountered similar difficulties with its registrar. In that case the panel concluded as follows:

"In the circumstances, this Panel is satisfied that on the particular facts of this case, a teleological or purposive interpretation of the legislation would classify the problem met by the Complainant in this case as being technical and not legal. The Complainant complied with both the Regulation and the Sunrise Rules insofar as it was possible so to do. The possibility of applying under an acronym was not

available to it under either the Regulation or the Sunrise Rules."

6. A similar problem seems to have been faced by the complainant in Ernst Schoeller GmbH + Co. KG v EURid Case No. 00253 <schoeller.eu>. In that case the panellist declared:

"It would be an unreasonable expectation on the part of either the Validation Agent or the Registry to expect to see a name longer than the system then allowed"

7. Whilst I can understand the reluctance to penalise a complainant as a result of a technical difficulty, I must confess to having some difficulty in following this reasoning. Both in Pinel and in this case the complaint appears to be about a limitation of the system operated by the relevant registrar, not the Registry (in Ernst Schoeller the panel talks about technical difficulties in abstract). The registrar and the Registry are not the same thing. The registrar is the commercial entity through which the domain name was registered (in the current case Globedom Datenkommuniktions GmbH). The Registry (i.e. EURid) is responsible for running the .eu domain and is responsible for processing applications made through registrars, of which over 1,000 are accredited.

8. As far as I am aware at the relevant time there was no technical limitation inherent in the way in which the Registry operated which would have prevented the Complainant from applying with a name as long as "DMC Design for Media & Communication GmbH & Co KG". The Complainant does not suggest otherwise. I also note from a WHOIS search against the Domain Name that DMC KG appears to have been able to make subsequent applications in the sunrise period through other registrars using longer names than that of the Complainant.

9. I therefore question whether the relevant legislation, whether interpreted teleologically, purposively or otherwise, really requires EURid to compensate for a technical problem that arose out of systems for which (as far as I am aware) EURid is not responsible or of which EURid may not have knowledge.

10. However, my technical understanding may be wrong here and, unfortunately, EURid in its Response does not address the question of whether it was responsible for or aware of the 30 character limitation on applicant names that applied in this case. EURid appears also not to have addressed the issue either in Pinel v Eurid CAC Case No. 00181 or in Ernst Schoeller GmbH + Co. KG v EURid Case No. 00253. Therefore, had it been necessary to decide this issue in this case, I would have sought further clarification from EURid in accordance with my powers under paragraph 8 of the ADR Rules.

11. Fortunately this is not necessary on this occasion. The reason for this is that I do not believe that the case currently before me is really one in which the Complainant intended to make an application in the full name of DMC KG but was prevented from doing so. Whilst it maintains that it could not have applied in the full name of DMC KG had it wanted to, the main thrust of the Complainant case is somewhat different. This is that although the application was made in the name of the Complainant it was and is clear as a matter of Austrian law that in the circumstances of this case the application was for and on behalf of DMC KG. Therefore, it is asserted that EURid / the validation agent was wrong to have rejected this application. It is the correctness of this assertion that is the real issue to be decided in this case.

12. Article 4 (2)(iii) of EC Regulation 7334/2002 provides that the Registry shall register domain names in the .eu TLD through any accredited .eu registrar requested by any:

(i) undertaking having its registered office, centrally administration or principal place of business within the Community, or

(ii) organisation established within the Community without prejudice to the application of national law, or

(iii) national person resident within the Community.

13. The Complainant contends, and EURid concedes, that given the operation of Austrian law both DMC KG and the Complainant form one single business undertaking or organisation for the purposes of the Public Policy Rules.

14. EURid then goes on to state that "it is therefore clear" that the trade mark registration "although formally registered for [DMC KG] "is effective for the Complainant, …, which acted alone when filing the trade mark application and now for the domain name application". Insofar as this is a concession that the Complainant was entitled to register the Domain Name, I think this somewhat misunderstands the Complainant's primary contention i.e. that its application is effective on behalf of the DMC KG. However, whether or not that is so, EURid nevertheless appears to be conceding that the Complainant and DMC KG are capable of being treated as one for the purposes of a Domain Name application and prior rights verification.

15. In light of these concessions, the question becomes simply whether EURid and the Validation Agent should have been expected to know that the applicant and rights owner should be treated as one for the purposes of that application or whether the obligation was upon the Complainant to put forward evidence to this effect under Article 14 of the Public Policy Rules. As EURid puts it in its response:

“The validation has to rely on the documentary evidence submitted by the applicant … It did not show that DMC Design for Media and Communication GmbH manages the KG, not that they are one business entity”.

16. Section 21.2 of the Sunrise Rules state that the Validation Agent will “examine 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”. Generally an applicant should not expect the Registry or Validation Agent to engage in speculation and/or embark upon its own enquiry in relation to the exact connection between two entities simply because they have similar names. A Validation Agent can under section 21(3) of the Sunrise Rules conduct its own investigations into an application but this, as the rules make clear, is at its “sole discretion”.

17. Further the assertion in BPW Bergische Achsen KG v EURid CAC Case No. 00127 <bpw.eu> that “where the prior right claimed is a trade mark, the burden of proof is on the applicant (Complainant) side, ownership evidence inclusive” would suggest that EURid’s contention here is correct.

18. However, I do not believe the position in this case is quite the same as in BPW Bergische Achsen KG v EURid CAC Case No. 00127. Here the name of the applicant including its GmbH company type indicator (i.e “DMC Design for Media and Communication GmbH”) is to be found in full in the name of the prima facie rights holder (i.e. “DMC Design for Media and Communication GmbH & Co KG”). Common sense would suggest a very close connection between these “entities”.

19. The position appears to be even starker than this. The Complaint has not maintained that as a matter of Austrian law, an Austrian limited partnership must bear the same name of any limited liability company which is the “general partner of that limited partnership” with the addition “& Co KG”. However, it would appear that this is indeed the case. In the guide to starting business in Austria published by the Austrian Business Agency (and available at the time of this decision at http://www.austriantrade.org/fileadmin/f/cs/Firmengr__ndung/StartingBusiness.pdf) a KG is described as follows:

“.. in a KG there must be at least one partner with unlimited liability for the partnership’s debts (general partner – Komplementär), and at least one partner who is only liable for a specified maximum amount registered in the commercial register (limited partner – Kommanditist). Frequently, the general partner is a corporation, particularly a GmbH. This type of a mixed company is referred to as GmbH & Co KG and is often chosen for tax, liability, and management reasons.

The company name of a KG must contain the name of at least one general partner and an addition indicating the existence of a partnership. The general partners represent and manage the KG."

20. It might be said to be unreasonable to expect EURid and the Validation Agent to be familiar with the intricacies of the national laws of every European Member State. It is noteworthy in this respect that where prior rights other than those identified in sections 13 - 18 of the Sunrise Rules are relied upon, the Applicant is required to provide evidence that those rights are protected by the law of the relevant member state.

21. Nevertheless, I do not believe it is unreasonable to expect EURid and its validation agents to be familiar with the operation of the basic identifiers used to designate different company and business types in different member states.

22. In short, the relationship between the Complainant and DMC KG should on this occasion have been clear to EURid and the Validation Agent and I therefore conclude that there was sufficient evidence in this case before the Validation Agent to justify registration of the domain name in the name of DMC KG.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the EURid's decision be annulled and the domain name <dmc.eu> be registered in the name of DMC Design for Media and Communication GmbH & Co KG.

PANELISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2006-05-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is the sole general partner of an Austrian “KG” whose name comprised the full name of the Complainant with the addition “& Co KG”.

The Complainant’s Domain Name application was rejected by the Registry where the verification material provided gave the name of the Austrian KG and not the Complainant as the owner of the registered Austrian trade mark right relied upon to support the application.

The Complainant contended that:

1. The Complainant and the Austrian KG should be treated as a single organisation for the purposes of the application and that the Registry’s decision not to do so was “unnecessarily formal”;

2. The Complainant was entitled to register the Domain Name as a licensee of the relevant trade mark; and

3. The Domain Name could not have been registered in the full name of the Austrian KG given that the application form used limited the length of the applicant’s name to 30 characters and that the full name of the Austrian KG was longer than that.

In relation to these contentions the Panel held as follows:

A. The Complainant’s contentions so far as its licence was concerned were rejected. The Complainant bore the burden of proof under Article 14 of the Public Policy Rules to supply the Validation Agent with evidence of the relevant licence and no evidence as to this licence had been provided by the Complainant in this case.

B. It was not necessary to decide the issue whether the Registry’s decision should be annulled because of the technical limitation on the number of characters in the relevant application form. The reason for this was that it appeared that the Complaint had not intended to apply for the Domain Name in the full name of the Austrian KG but had applied for the Domain Name using its own name in the belief that this was sufficient.

C. The Registry had accepted in its Response that the Complainant, as the sole general partner of the Austrian KG, and the Austrian KG could be treated as one organisation for the purposes of Article 4(2)(b) of EC Regulation 7334/2002 and for the purposes of the Complainant’s application. The name of the Austrian KG incorporated the full name of the Complainant (with the addition “& Co KG”) and it appeared that as a matter of Austrian law this of itself disclosed the nature of the legal relationship between the Complainant and the Austrian KG. In the circumstances, the trade mark certificate in the name of the Austrian KG provided by the Complainant comprised sufficient evidence of prior rights in this case to justify registration of the Domain Name.

The Panel therefore directed that the decision of the Registry be annulled and that the domain name <dmc.eu> be registered in the name of the Austrian KG.