Panel Decision for dispute CAC-ADREU-000294

Case number	**CAC-ADREU-000294**
Time of filing	**2006-03-21 09:33:09**
Domain names	**colt.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Mitsubishi Motors Europe B.V.**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

1. The request for registration
On December 7, 2005 - 11:28:44 - , the Complainant filed a Request for the Registration of the domain name “colt.eu” within part one of the “so called” Sunrise Period.
On December 21, 2005 the Respondent received Documentary Evidence showing that:
(i) The mark COLT was applied for in France on July 19, 1968 (application number 49.940) in the name of the Japanese company MITSUBISHI JUKOGO KABUSHIKI KAISHA; such an application was successfully registered (registration number 760358).
(ii) On August 11, 1970, the above trademark was assigned from MITSUBISHI JUKOGO KABUSHIKI KAISHA to the Japanese company MITSUBISHI JIDOSHA KOGYO KABUSHIKI KAISHA.
(iii) The above trademark was renewed in the name of MITSUBISHI JIDOSHA KOGYO KABUSHIKI KAISHA (the last renewal available number is 1.472.322)
(iv) On November 29, 2005, the French trademark n. 1.472.322 was licensed from the Japanese company MITSUBISHI MOTORS CORPORATION to the Dutch company MITSUBISHI MOTORS EUROPE B.V.
With decision of January 31, 2005 the Respondent rejected the Request for Registration on the grounds that the documentary evidence presented by the Complainant did not substantiate the Prior Right claimed in the Request for Registration.
2. The ADR proceeding
On March 10, 2006, the Complainant filed the Complaint; the Complainant enclosed (twice), with the Complaint, a document titled ARTICLES OF INCORPORATION. Said documentation shows that the name of the Japanese Corporation MITSUBISHI KOGYO KABUSHIKI KAISHA shall be expressed in English as MITSUBISHI MOTORS CORPORATION.
On March 21, 2006 the Czech Arbitration Court (hereinafter referred to as CAC) communicated that the fixed fees, provided for in Paragraph A/6 a of the ADR Rules, were duly paid.
On March 28, 2006, CAC, in accordance with Paragraph B/2 b of the ADR rules, notified the Complainant that there were deficiencies in the Complaint and informed the Complainant that he was requested to correct the deficiencies and submit an Amended Complaint within seven (7) days of receiving the notification.
On April 10, 2006 the Complainant submitted said Amended Complaint, requesting the cancellation of the decision of the Respondent. The Complainant enclosed, with the Amended Complaint of April 10, 2006, a copy of the ARTICLES OF

INCORPORATION identical to the one enclosed with the Complaint.
On April 12, 2006 the CAC indicated that the Complaint was completed and issued the Notification of Complaint and Commencement of ADR proceeding, declaring that the formal date of the commencement of the ADR proceeding was April 12, 2006; on the same date the CAC, by way of a nonstandard communication, confirmed that they had previously prolonged the deadline of the administrative compliance Complaint in this case.
On May 30, 2006 the Complainant, by way of a nonstandard communication, communicated that, to his understanding, the time allowed to the Respondent for the issuance of the Response had elapsed and therefore he asked for the appointment of the Panelist.
On June 2, 2006 the CAC informed that the term for submitting the response expired on that same day (i.e. June 2, 2006)
On June 5, 2006 the CAC notified the Respondent that he failed to comply with the deadline indicated in the Notification of Complaint and Commencement of ADR proceeding
On June 8, 2006, by way of a nonstandard communication, the Respondent sent a Response
On June 12, 2006 the Complainant, by way of a nonstandard communication, communicated that in his understanding the defective response of the Respondent could not be used because it had been submitted four working days after the fixed deadline

A. COMPLAINANT

The Complainant argues that his Prior Right was substantiated in compliance with section 20 of the Sunrise Rules. The Complainant considered that the trademark owner, as resulting from the trademark registration document issued by the French Patent and Trademark Office (MITSUBISHI JIDOSHA KOGYO KABUSHIKI KAISHA), is the same company (MITSUBISHI MOTORS CORPORATION) resulting from the Licence Declaration document. The fact that MITSUBISHI MOTORS CORPORATION is the English name which expresses the Japanese company MITSUBISHI JIDOSHA KOGYO KABUSHIKI KAISHA is sufficiently substantiated with the submission of the ARTICLES OF INCORPORATION

B. RESPONDENT

The Respondent argues that when the Complainant applied for the domain name COLT.EU during the phase one of the Sunrise Period, he did not clearly state that he was the licensee of the French mark COLT. The Respondent considered that the Licence Declaration submitted by the Complainant was not signed by the owner of the trademark. Moreover, he considered that the name of the licensor did not correspond with the name of the owner of the trademark. The fact that the Complainant argues that the licensor and the owner of the trademark are the same entities is not relevant due to the fact that it was evidenced only in the framework of the ADR proceedings.

DISCUSSION AND FINDINGS

The first consideration shall start from the Complainant’s assertion regarding the delay of the Respondent in submitting his Response.
First of all, the Panel considers that the Response of the Respondent, sent by way of a nonstandard communication on June 8, 2006, is not relevant in deciding the present case, since it was submitted after the fixed deadline.
Actually, according to the ADR Rules, in case the Respondent does not submit a response within the given deadlines, it is up to the Panel to decide whether or not the Response may be accepted and considered in deciding the dispute.
This finding is confirmed by the content of the Notification of Respondent Default sent by CAC to the Respondent on June 5, 2006 (see paragraph 2).
Thus, it is important to underline that, even if the Response is not considered as acceptable in this case, it does not mean that the Complaint must be necessarily accepted.
Indeed, even if article 22 paragraph 10 of Commission Regulation no. 874/2004 states that failure of any of the parties involved in an ADR procedure to respond within the given deadlines or appear to a panel hearing may be considered as grounds to accept the claims of the counterparty, the Panel finds appropriate to recall the parties attention also upon the following paragraph 11 of the same article.
According to article 22 paragraph 11 of Commission Regulation no. 874/2004, the ADR panel shall decide whether a decision taken by the registry conflicts with this Regulation or with Regulation (EC) 733/2002.
All the above stated, the Panel is of the opinion that, although the Response of the Respondent cannot be accepted, in order to establish whether or not a decision in the merit has to be taken in the present case it must be considered if there exist

sufficient elements for issuing a decision.
After having examined all the admissible documents related to the present case, in particular the Application for the domain name colt.eu and the Complaint, the Panel is of the opinion that, in the present case, there are sufficient elements for a decision in the merit, as requested by the above article 22 paragraph 11 of Commission Regulation no. 874/2004.
The Complainant argues that the Application for the domain name COLT.EU, filed during the first phase of the Sunrise Period, was correct according to section 20 of the Sunrise Rules.
Therefore, it is important to carefully analyze the documents that were submitted by the Complainant (Documentary Evidence) on December 21, 2005 in order to prove his Prior Right related to the Colt trademark.
The Complainant showed that:
(i) The mark COLT was applied for in France on July 19, 1968 (application number 49.940) in the name of the Japanese company MITSUBISHI JUKOGO KABUSHIKI KAISHA; such an application was successfully registered (registration number 760358).
(ii) On August 11, 1970, the above trademark was assigned from MITSUBISHI JUKOGO KABUSHIKI KAISHA to the Japanese company MITSUBISHI JIDOSHA KOGYO KABUSHIKI KAISHA.
(iii) The above trademark was renewed in the name of MITSUBISHI JIDOSHA KOGYO KABUSHIKI KAISHA (the last renewal available number is 1.472.322)
(iv) On November 29, 2005, the French trademark n. 1.472.322 was licensed from the Japanese company MITSUBISHI MOTORS CORPORATION to the Dutch company MITSUBISHI MOTORS EUROPE B.V.
The analysis of the above documents clearly shows that the owner of the trademark has a different name from the name of the licensor.
In compliance with the Article 14 of Commission Regulation no. 874/2004, the documentary evidence must clearly indicate the existence of the Prior Rights mentioned in article 10 of the same Regulation. Furthermore, according to section 20.1 of the Sunrise Rules, if an Applicant has obtained a licence for a registered trademark referred to in Section 13.1 (i) above, in respect of which it claims a prior right, he must enclose, with Documentary Evidence, an acknowledgment and declaration form, (….) duly completed and signed by both the licensor of the relevant registered trademark and the the Applicant (as licensee).
According to the above rules it is clear that the burden of proof, regarding the Prior Right claimed, is on the Applicant (Complainant) side (see also the decision of the panel in case BPW Bergische Achsen KG v EURid CAC Case no. 00127 [BPW.eu]).
The Panel is of the opinion that section 20.1 of the Sunrise Rules requires that the Licence Declaration, in the absence of specific circumstances to be demonstrated by the Applicant, must be signed by the registered trademark owner (as resulting from the documents proving the existence of the mark) in his quality of licensor.
Otherwise, the possible substantiation of a prior right on the basis of a document showing a possible serious lack of legitimation on the licensor’s side would be admissible. This, of course, cannot be accepted by the Panel.
The above finding is confirmed by the fact that, according to section 20.1 of the Sunrise Rules, in case the Applicant is a sublicensee, a document completed and signed by the owner of the registered trademark is always required in order to complete the Documentary Evidence.
It is the Panel’s understanding that the above specification is not explicitly mentioned where the Applicant is a licensee (whereas it is only stated that the Document must be completed and signed by the licensor of the relevant registered trademark) since it is normal that the licensee acquires the right to the mark from the registered trademark owner.
In this case the Complainant did not provide the relevant evidence regarding the relation between the companies MITSUBISHI MOTORS CORPORATION (on the one side) and MITSUBISHI JIDOSHA KOGYO KABUSHIKI KAISHA (on the other side).
In consideration of the above and in the absence of any evidence showing that MITSUBISHI MOTORS CORPORATION is the English name which expresses the Japanese company MITSUBISHI JIDOSHA KOGYO KABUSHIKI KAISHA, the result is that the licensor appears, prima facie, as a company different from the owner of the registered trademark and that the licence agreement is not signed by the trademark owner in his quality of licensor.
Since the name of the licensor, in the absence of any further explanations to be offered by the Applicant (Complainant), must correspond to the name of the trademark owner, the Applicant (Complainant) should have produced Documentary Evidence that such a registered owner granted a licence to him, or, at least, Documentary Evidence showing that licensor and registered trademark owner are the same entity.
The Respondent, as well as the Validation Agent, cannot be criticized for not taking the Documentary Evidence into account.

Actually, according to the above, considering the documents submitted by the Applicant, the Respondent and the Validation Agent were not in the position of accepting the Applicant (Complainant) request, in consideration of the incomplete documentation submitted by Respondent.
In the absence of the ARTICLES OF INCORPORATION, submitted only in the framework of the ADR proceedings, they could only understand that the Complainant derived its rights on the trademark COLT by a company (MITSUBISHI MOTORS CORPORATION) different from the registered trademark owner (MITSUBISHI JIDOSHA KOGYO KABUSHIKI KAISHA).
In this respect, the attention must be drawn on section 21.2 of the Sunrise Rules that expressely 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. It means that 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 investigation into an application but this, as the rules make clear, is at its “sole discretion” (see also the decision of the panel in case DMC Design for Media and Communication GmbH KG v EURid CAC Case no. 00232 [DMC.eu])
In the present case, the Complainant did not prove the timely substantiation of the Prior Right and a copy of ARTICLES OF INCORPORATION, enclosed with the Complaint, was submitted too late to be considered.
According to the above, the Panel is of the opinion that the application for the domain name COLT.EU, filed during the first phase of the Sunrise Period, in consideration of the clearly incomplete Documentary Evidence, was not correct according to section 20 of the Sunrise Rules

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	**Guido Maffei**

DATE OF PANEL DECISION 2006-07-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested the rejection made by Respondent to the Applicant’s (Complainant) Application for the domain name COLT.EU under the Sunrise Period.

Rejection was based upon the fact that Complainant failed to produce sufficient Documentary Evidence that the registered owner of the French mark COLT granted a licence to him. This in consideration of the fact that the Documentary Evidence submitted showed that the licensor was a company with a different name with respect to the registered trademark owner.

Since the burden of proof is on the Applicant (Complainant) side, he would have had to submit, with the request of the domain name registration, together with the other Documentary Evidence filed, the proof of the fact that the name of licensor is the English name which expresses the name of the registered trademark owner.

The proof, consisting in copies of the ARTICLES OF INCORPORATION, was submitted only in the framework of the ADR proceedings and, therefore, too late to be considered.

The documents which serves as evidence in order to substantiate a Prior Right must be submitted within the Sunrise Period, otherwise the Application must be rejected.