Entscheidung der Schiedskommission for dispute CAC-ADREU-000431

Case number	**CAC-ADREU-000431**
Time of filing	**2006-03-28 15:16:44**
Domain names	**cashcontrol.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**CashControl Kassensysteme GmbH**

Respondent

Organization / Name	**EURid**

ANDERE RECHTLICHE VERFAHREN

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

SACHLAGE

1. History of the Request for Registration

1.1. The Complainant is CashControl Kassensysteme GmbH, based in Germany.

1.2. CashControl Kassensysteme GmbH (“the Complainant”) is recorded as the owner of German trademark No 30033053, for the word CashControl (“the Trademark”).

1.3. The Complainant filed an application for registration of cashcontrol.eu (“the Domain Name”) on December 7, 2005 during the phased registration defined at article 10.1 of EC Regulation 874/2004. On February 14, 2006, EURid (“the Respondent”) rejected the application for registration of said name, on the grounds that the evidence the Registry received did not constitute satisfactory evidence of the claimed right.

2. History of the ADR Proceeding

2.1. The Complainant submitted a complaint against EURid to the ADR Center for .eu attached to the Arbitration Court attached to the Economic Chamber of the Czech Republic and Agricultural Chamber of the Czech Republic (“the Court”). The complaint was received on March 28, 2006. The complaint included a request to the Czech Arbitration Court to require EURid to disclose the Documentary Evidence as defined in the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (“the Sunrise Rules”).

2.2. After the Court sent a request for verification to the Registry, the Registry confirmed several pieces of information pertaining to the Domain Name, and attached the documentary evidence that was submitted. According to the information

provided by the Registry, the Domain Name was applied for on December 7, 2005 by CashControl GmbH. The documentary evidence consisted of two documents required at Chapter VIII of the Sunrise Rules, which will be described below.

2.3. Later on, the Court case administrator notified that “proper filing of the complaint wasn’t possible due to technical problems with the online platform.” The case administrator then requested from the Complainant, that the domain name entered in online complaint and the one entered in hardcopy be harmonized, there being a typo in the name subject to the dispute, as well as other deficiencies. Within seven days of receiving such notification, the complaint was duly amended in accordance with Paragraph B.2 (b) of the .eu Dispute Resolution Rules (“the ADR Rules”).
The formal date of commencement of the ADR Proceeding was April 7, 2006.

2.4. The Respondent was properly notified that the Response was to be submitted within thirty working days from the delivery of the notification. The Respondent was also properly notified that, should it fail to send the Response within such period of time, the Respondent would be considered in default, that an ADR Panel would still be appointed to review the facts of the dispute and to decide the case, and that this Panel would not be required to consider a Response filed late, but would have the discretion to decide whether to do so and might draw such inferences from the default as it would consider appropriate, as provided for by ADR Rules, Paragraph B.10. Finally, the notification mentioned the Respondent was entitled to challenge the Notice of Respondent Default according to Paragraph B.3 (g) of the ADR Rules.

2.5. On May 31, 2006, a notification of Respondent’s Default (“the Notification”) was sent to the Respondent, to notify that “[the Respondent has] failed to comply with the deadline indicated in the Notification of Complaint and Commencement of ADR Proceeding for the submission of [its] Response in the above-referenced case and/or that [it has] failed to comply with the deadline indicated in the Notification of Deficiencies in Response in the above referenced case.” The consequences of the default were subsequently listed.
One of the consequences is that the ADR Panel and the Complainant are informed of the default, and that “the ADR Panel will decide in its sole discretion whether or not to consider your defective Response (if submitted) in deciding the case.” Respondent was also notified of its right to challenge the Notification in a written submission to the Court filed within five days from receiving the Notification.

2.6. On June 6, 2006, the Respondent sent two non-standard communication forms: The first one is titled “Response,” the second one consists of two annexes.

A. BESCHWERDEFÜHRER

3. The Complainant contends as follows:

3.1. “The Complainant filed an application for registration of the Domain Name cashcontrol.eu within the Sunrise Period I on December 7, 2005 according to Articles 2, 3, 10 and 14 of Commission Regulation (EC) No. 874/2004 of April 28, 2004. Also, the Complainant has submitted in due time documentary evidence which demonstrates the prior right under Article 10(1) and (2) under the law by virtue of which it exists, namely the certificate of registration of prior German trademark registration no. 30033053 for the word mark CashControl which is registered in the name of the Complainant. The submission of said evidence of prior rights was made according to the EU Sunrise Regulations of the “Register” [the Complainant probably meant “Registry”], especially according to Chapter IV, Section 8. Therefore the decision of Respondent to reject the application of the Complainant for the Domain Name cashcontrol.eu for the reason that the evidence received did not prove sufficiently the claimed rights means a violation of the Commission Regulation (EC) No. 874/2004 of April 28, 2004, especially of the Articles 10 and 14."

3.2. The Complainant seeks the withdrawal of rejection of EURid’s February 14, 2006 decision not to register cashcontrol.eu in the name of the Complainant, and the registration of the Domain Name for the Complainant.

B. BESCHWERDEGEGNER

4. Respondent neither submitted the Response in due time, nor challenged the notification of default.

WÜRDIGUNG UND BEFUNDE

5. Before deciding on the merits of the Complaint, the Panel has to rule on how the documents submitted by the Respondent must be processed.

5.1. Paragraph B.3 (a) of the ADR Rules states that the Respondent shall submit a Response to the Court within thirty working days of the date of the delivery of the Complaint. In the present ADR proceeding, the Respondent failed to submit the Response before the time limit.

5.2. Paragraph B. 3 (f) of the ADR Rules states that "if a Respondent does not submit a Response or submits solely an administratively deficient Response, the Provider shall notify the Parties of Respondent's default. The Provider shall send to the Panel for its information and to the Complainant the administratively deficient Response submitted by the Respondent." Accordingly, the Response was sent to the Panel for its information, and the Panel will use this administratively deficient Response only for informational purposes, in particular to learn on the cause of rejection of the application

5.3. Paragraph 10 (a) of the ADR Rules states that in case of default of one of the Parties, the Panel may consider this failure to comply as grounds to accept the claims of the other Party. The fact that the Respondent did not challenge the annexes attached to the Complaint will be taken into account.

6. The Panel has to assess whether the Respondent lawfully rejected the Complainant's application.

6.1. In the administratively deficient Response sent by the Respondent, the Panel read that CashControl GmbH applied for the Domain Name cashcontrol.eu on December 7, 2005, and that the documentary evidence was received on December 12, 2006, before the January 16, 2006 deadline. Respondent wrote that "it appears from this documentary evidence that a company named Cashcontrol Kassensysteme GmbH is the owner of the invoked prior right (a German trademark). As the name of the Applicant did not match the name of the owner of the trademark invoked as prior right, the Registry rejected the Applicant's application."

6.2. Respondent also wrote that the cover letter to the documentary evidence states that the Applicant is CashControl GmbH, whereas the documentary evidence states the owner of the trademark is Cashcontrol Kassensysteme GmbH. Had it not been attached to the administratively deficient Response, the Panel would have been able to access and examine this documentary evidence, which was disclosed in the verification procedure described above at § 2.2.

6.3. The Registry's rejection decision is consistent with other decisions that were challenged in previous cases.

6.3.1. In Case No. 00127 (BPW), the Registry argued that "the Documentary Evidence must clearly evidence that the applicant is the reported owner of the registered trademark" (after it reviewed the documentary evidence, the Panel ruled that "it [was] clear and in line with the statements of both parties of the dispute that the copy of the trade mark "BPW" presented to the Respondent during application process [did] not state the ownership rights to the trade mark.")

6.3.2. In Case No. 00181 (OSCAR), the Registry alleged that "a material inaccuracy in the name of the applicant constitutes a breach of the terms of registration," under article 3 of EC Regulation 874/2004 (in that case, the Panel found "very relevant" the Complainant's argument "that the identity of the addresses in the application and in the documentary evidence and the similarity in the names of the applicant and of the trademark owner make the name recognisable." To the Panel, these facts "demonstrate that the Complainant was the applicant during the phased registration period and that the Complainant is the owner of the Prior Right on which the application is based.")

6.3.3. In Case No. 00253 (SCHOELLER), one of the issues subject to dispute consisted in determining whether the documentary evidence submitted clearly evidenced that the applicant, Ernst Schoeller GmbH, and the trademark owner, Ernst Schoeller Waeschenfabriken, were one and the same, given that, on the one hand, there was no mention of the word "Waeschenfabriken" in the application, and that, on the other hand, the street address mentioned in the application differed from the one mentioned in the documentary evidence, except for the town (in this case, the Panel found that the facts demonstrated "that the Complainant was the applicant during the phased registration period and that the Complainant [was] the owner of the Prior Right on which the application [was] based.")

6.3.4. In Case No. 00396 (CAPRI), the Registry refused to register the domain name applied for because there were many discrepancies and differences between the documents (although the Panel observed there were many mistakes in the application, it found that in conducting a more accurate review of such application, the Registry could have easily removed all relevant discrepancies therein.)

6.4. In the present case, similarly, the Panel has to assess whether the Respondent lawfully rejected the Complainant's application. Under article 10.2 of EC Regulation 874/2004, "the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists."

6.5. Article 12 states that "the Registry shall publish … before the beginning of the phased registration a detailed description of all the technical and administrative measures that it shall use to ensure a proper, fair and technically sound administration of the phased registration period." The Registry published Sunrise Rules, which applied to all Applications made during the Phased Registration Period, and therefore to the Complainant's application. The Sunrise Rules provide for the obligations of the applicants. Section 8 thereof relates to "Official Requirements for Documentary Evidence." Under sections 8.2 and 8.3, the Applicant has to provide information in a Cover Letter, defined as "the pre-formatted electronic document that the Registry makes available to the Applicant (or the person indicated by the Applicant in the Application, if any) upon receipt by the Registry of an Application."

6.6. Information to be provided in the Cover Letter notably include "the FULL NAME of the applicant" (Section 8.2. (i) (b) - emphasis added). In its Cover Letter, the Complainant only mentioned "CashControl GmbH." However, according to the copy of the trademark registration that was attached, "CashControl Kassensysteme GmbH" is the owner of the trademark CashControl.

6.7. The difference between the name mentioned in the Cover Letter and the name mentioned in the trademark certificate could lead the Respondent to assume two different legal entities were involved: One being named CashControl GmbH, another one being named CashControl Kassensysteme GmbH, the former intending to demonstrate a prior right it does not have by means of a copy of a trademark owned by the latter, which name is similar. Since the Registry shall only allocate a domain name in accordance with EC Regulation 874/2004, article 14 whereof states that "all claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists," the Registry could have a reasonable doubt, therefore sufficient to lead to the rejection of the application.

6.8. Nevertheless, the Cover Letter and the copy of the trademark were attached to a letter of the Complainant submitting the documentary evidence. This letter is annexed by the Complainant to its Complaint. Its header and bottom mention "CashControl Kassensysteme GmbH," and the address is exactly the same as the address mentioned in the Cover Letter. The person who signed the Cover Letter is the very person who wrote the letter submitting the documentary evidence. Had the Registry taken into account these elements, these were not sufficient to allocate the domain name to the applicant. Given that there were conflicting information in the documentary evidence, defined by the Sunrise Rules as "the documentation to be provided by (or on behalf of) the Applicant to the Processing Agent, in accordance with these Sunrise Rules," the Complainant cannot be deemed to have submitted documentary evidence that could give evidence that it was, under article 14, paragraph 4, of the EC Regulation 874/2004, "the holder of the prior right claimed on the name" cashcontrol.eu. According to the last paragraph of this article 14, "the Registry shall register the domain name … 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."

6.9. Though the Respondent was right not to register a name considering that the applicant at issue has not "demonstrated a prior right in accordance with the PROCEDURE" (emphasis added) set out at article 14, ruling that the Respondent's decision is lawful would be contrary to the reason why this procedure was laid down. One of the rationales of EC Regulation 874/2004 is to safeguard prior rights recognized by Community or national law.

6.10. The Complainant attached to its Complaint a "Register extract of German trademark 30033053 CashControl." This

extract of the German Patent and Trade Mark Office Register brings the evidence that the owner of the word mark CashControl is CashControl Kassensysteme GmbH, that this trademark was registered in 2001 and that no opposition was filed by the time the opposition deadline expired. According to Paragraph B.11 (a) of the ADR Rules states, a Panel shall decide a Complaint on the basis of statements and documents submitted.

6.11. The name and seat of the trademark owner as they appear in the extract are identical to the name and seat of the Complainant. Therefore, the Complainant has brought evidence, before the Court, that it holds prior rights on the German word mark CashControl and was eligible to register this name under article 10 of EC Regulation 874/2004. As its request was received first by the Registry, the Domain Name should have been allocated to the Complainant by the Respondent. Therefore, the decision made by the Registry conflicts with EC Regulation 874/2004.

6.12. As provided for by Article 22.11 of EC Regulation 874/2004, the Panel decides that the disputed decision shall be annulled, and that the Domain Name cashcontrol.eu shall be transferred to the Complainant.

ENTSCHEIDUNG

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 CASHCONTROL be transferred to the Complainant

PANELISTS

Name	**Cedric Manara**

DATUM DER ENTSCHEIDUNG DER SCHIEDSKOMMISSION 2006-06-23

Summary

EINE ENGLISCHSPRACHIGE KURZFASSUNG DIESER ENTSCHEIDUNG IST ALS ANLAGE 1 BEIGEFÜGT

The Complainant filed an application for cashcontrol.eu, which was rejected by EURid on the grounds that the applicant’s name did not match the name of the owner of the trademark invoked as prior right. The Complainant challenged this decision. As the Respondent failed to submit its response within thirty working days from the delivery of the notification, it was notified of its default, which remained unchallenged. Its administratively deficient Response was used by the Panel for informational purposes.
The Panel ruled that the Respondent had to reject the Complainant’s application, since the names appearing in the Cover Letter and in the trademark certificate the documentary evidence consisted of were different, and could lead the Respondent to assume that two different legal entities were involved. However, the Complainant gave the evidence before the Court that it was entitled to register the Domain Name. Thus, as the rejection of the Complainant’s application conflicts with the right of an applicant to register a domain name when it has demonstrated a prior right, EURid’s decision is annulled and the name is transferred to the Complainant.