

## Entscheidung der Schiedskommission for dispute CAC-ADREU-000541

Case number **CAC-ADREU-000541**

Time of filing **2006-04-07 10:13:58**

Domain names **ultrasun.eu**

### Case administrator

Name **Josef Herian**

### Complainant

Organization / Name **Ultrasun International B.V.**

### Respondent

Organization / Name **EURid**

MACHEN SIE ANGABEN ZU ANDEREN ANHÄNGIGEN BZW. BEREITS ENTSCHEIDENEN RECHTLICHEN VERFAHREN, VON DENEN DIE SCHIEDSKOMMISSION WEISS, INSOWEIT DIE STREITIGEN DOMAINNAMEN BETROFFEN SIND

The Panel is not aware of any other legal proceedings, which are pending or decided and which relate to the disputed domain name.

#### SACHLAGE

The Complainant was the owner of the Benelux trade mark ULTRASUN from 1986 to 1996. On the basis of this Benelux trade mark, the Complainant registered the International trade mark ULTRASUN with WIPO under the Madrid Agreement and the Madrid Protocol in 1993.

In 1996/1997 the Complainant transferred the Benelux and the international trade mark to an affiliated company of the Complainant, Ultrasun Professional B.V. Subsequently, the Benelux and the International trade mark were transferred to the Complainant's parent company, Zonnepark Holding B.V. Zonnepark Holding B.V. has also filed the Community trade mark ULTRASUN with OHIM under EC Regulation 40/94. Zonnepark Holding B.V., as the current owner of the Benelux, International and Community trade marks then granted the Complainant licences to use those trade marks.

On 8 December 2005, Complainant filed an application with the Respondent for the registration of the domain name ultrasun.eu during the Sunrise period. On 19 December 2005, the Complainant submitted the documentary evidence of its prior rights. The documentary evidence proves that Zonnepark Holding B.V., is the current owner of the Benelux, International and Community trade marks for ULTRASUN and that the Complainant and Zonnepark Holding B.V., are established at the same address. The documentary evidence did not contain any licence declaration(s) as published by the Respondent at Annex 2 to the .eu Registration Policy and Terms and conditions for Domain Name Applications made during the Phased Registration Period "Sunrise Rules" (the "Sunrise Rules").

On 25 February 2006, the Respondent informed the Complainant that it was rejecting the Complainant's application on the grounds that, the documentary evidence did not sufficiently prove the Complainant's prior right claimed.

On 6 April 2006, the Complainant filed a Complaint in respect of the Respondent's decision to reject the Complainant's application for registration of the domain name ultrasun.eu. Annex 5 of the Complaint contained three licence declarations dated 5 April 2006 in respect of the Benelux, International and Community trade mark ULTRASUN respectively, and each was signed by a representative of the Complainant and its parent company, Zonnepark Holding B.V.

#### A. BESCHWERDEFÜHRER

The Complainant submits that pursuant to Article 14 of EC Regulation 874/2004 (the "Public Policy Regulation") the Respondent must register a domain name if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in that article. The procedure includes examination by a validation agent to assess whether the documentary evidence submitted by the applicant substantiates the applicant's prior right.

The Complainant contends that although the documentary evidence submitted by it, at the time of application for ultrasun.eu during the sunrise period, does not expressly mention the Complainant's prior right, the validation agent could have concluded on the basis of the documentary evidence submitted that the Complainant had a prior right. To this end the Complainant is relying on three grounds (i) that the documentary evidence proves that the Complainant's parent company has a prior right, (ii) that the Complainant was the owner of the Benelux and International trade mark ULTRASUN from 1993 to 1996/1997 and (iii) that the Complainant and its parent company (the current owner of the prior right) are established at the same address.

In particular, the Complainant argues that the validation agent should have used its authority under Article 21.3 of the Sunrise Rules to conduct an investigation into the prior right claimed and the documentary evidence submitted by the Complainant. The Complainant contends that such an investigation is customary under the various registries of intellectual property rights and would, in this case, have proved the Complainant's prior right. The Complainant further contends that had the Respondent requested the Complainant to explain why it had submitted only the certificate substantiating the prior rights of its parent company, then this would have given the Complainant the opportunity to submit additional evidence proving the Complainant's licence of the trade marks ULTRASUN.

Finally, the Complainant submits that since the examination conducted by the validation agent with respect to the Complainant's application was inadequate, the Respondent's decision to reject that application is unfounded and therefore contrary to the EU Regulations, in particular Article 14 of the Public Policy Regulation.

#### B. BESCHWERDEGEGNER

The Respondent submits that it appeared from the face of the documentary evidence submitted by the Complainant that a company named Zonnepark Holding BV was the owner of the invoked prior right. Therefore as the name of the Complainant did not match the name of the owner of the trade mark invoked as a prior right, the Respondent rejected the Complainant's application.

In response to the Complainant's submissions that the Respondent should have accepted the Complainant's application for the registration of the ultrasun.eu domain name, on the basis that the Complainant was the holder of the relevant trade marks from 1986 to 1996 and that its parent company is the current owner of the trade marks, the Respondent made the following submissions:

(i) Article 10.1 of the Public Policy Regulation states that only the holder of a prior right is eligible to be granted the corresponding domain name. It is therefore of great importance that the Respondent is provided with all information that allows it to assess if the applicant is the holder of a prior right. Pursuant to Article 14.4 of the Public Policy Regulation, the documentary evidence must clearly show that the applicant is the holder of the prior right claimed.

(ii) The applicant does not need to be the actual owner of a prior right in the corresponding domain name to apply for that domain name. The prior right may be licensed by its actual owner to the applicant to use the prior right in applying for the corresponding domain name. In the case of an actual owner of a prior right the documentary evidence need only consist of evidence of the prior right. However, in the case of a licensed right the applicant is obliged to submit a licence declaration in addition to the evidence of the prior right. The Respondent will only be able to determine if the applicant is the holder of a prior right when all required documents have been submitted as documentary evidence.

(iii) The Complainant agrees that it is no longer the actual owner of the prior right for the trade mark ULTRASUN. The Complainant instead argues that it has been licensed to use the trade marks of Zonnepark Holding B.V., the Complainant's parent company. The documentary evidence to the Complainant's application contained only trade marks registered by Zonnepark Holding B.V. The Complainant failed to submit a licence declaration with its documentary evidence. Thus, the Respondent was unable to determine if the Complainant was the holder of a prior right at the time of the application for the domain name.

(iv) In Case No 119 (NAGEL) the Panel also ruled that: the Complainant (in that case) did not prove the timely substantiation of a prior right. Since the Complainant was not the owner of the alleged right, he would have had to submit documentary evidence that he was a licensee. A simple referral in the Cover Letter of the request for registration cannot be considered documentary.

Finally, the Respondent submits that as the Complainant failed to prove that it is the holder of a prior right, the Respondent's decision to reject the Complainant's application is in line with the Public Policy Regulation and therefore the Complaint must be dismissed.

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#### WÜRDIGUNG UND BEFUNDE

Under Article 22 of the Public Policy Regulation, the Panel has jurisdiction to determine whether the decision taken by the Respondent conflicts with Regulation 733/2002 (the ".eu implementation Regulation") and/or the Public Policy Regulation. Having considered the Factual Background and the Parties' Contentions outlined above, the Panel sets out its decision below.

Article 10.1 of the Public Policy Regulation provides that only holders of prior rights shall be eligible to apply for a domain name during the sunrise registration period. The Complainant is a licensee of the registered trade mark claimed as a prior right (i.e. ULTRASUN) and Article 14.4 of Public Policy Regulation provides that an applicant must submit documentary evidence to show that they are the holder of the prior right claimed. Article 14.4 of the Public Policy Regulation further provides that if the documentary evidence is not submitted within 40 days from the submission of the application for the domain name, then the application shall be rejected.

In the Panel's view, it is not sufficient to merely show that the owner of the prior right has the same address as the applicant, or that the applicant was once the holder of the prior right, as the Complainant has asserted in the Complaint. In accordance with Article 14 of the Public Policy Regulation, the applicant must show that the applicant itself is the owner (or licensee) of the prior right and this must be the case at the time of the application for the domain name. This view is consistent with the view of the Public Policy Regulation taken by the learned Panelist in Case No. 119 (Nagel).

Pursuant to Article 12.1 of the Public Policy Regulation, the Respondent published the Sunrise Rules which contains the technical and administrative measures used by it in the administration of the sunrise period. Section 20 operates according to Section 13.2 of the Sunrise Rules where the applicant is the licensee of a registered trade mark. Section 20.1 of the Sunrise Rules provides that a licensee "must" enclose with the documentary evidence a licensee declaration (signed by both the licensor and the applicant) as contained in Annex 2 of the Sunrise Rules.

Section 4.1 of the Sunrise Rules and Section 4 of the .eu Domain Name Registration Terms and Conditions (the "Terms and Conditions") provide that an applicant must warrant that the documentary evidence submitted is complete and accurate and complies with all applicable Rules (as defined therein). The application form for a .eu domain name makes it clear that in the case of non-compliance with the evidential requirements then the application can be considered invalid.

The Complainant first submitted the licensee declarations with the Complaint on 6 April 2006 and the licensee declarations are dated 5 April 2006, which post dates the 40-day time limit for submission of documentary evidence by an .eu domain name applicant to the Respondent. Being outside the time limit, the Panel considers that the licence declarations could not have formed part of the documentary evidence required under the Sunrise Rules. This interpretation is consistent with the learned Panelist's decision in Case No. 232 (DMC).

As the Complainant did not submit any licensee declaration(s) with the documentary evidence within the time permitted under Article 14 of the Public Policy Regulations, the decision of the Respondent not to allocate the domain name ultrasun.eu to the Complainant does not in this Panel's view conflict with either the .eu implementation Regulation or the Public Policy Regulation, as asserted by the Complainant.

The Complainant submits that the validation agent should have conducted an investigation pursuant to Section 21.3 of the Sunrise Rules to satisfy itself as to ownership of the prior right. However the Panel is of the view that the wording of the relevant section makes it clear that such an investigation is discretionary on the part of the validation agent and by no means mandatory. This interpretation is consistent with previous .eu ADR decisions including Case No. 127 (BPW) and Case No. 294 (Mitsubishi Motors).

Further, Section 21.2 of the Sunrise Rules makes it clear that the validation agent is to carry out a prima facie review of the first set of the documentary evidence received from the applicant to establish whether a prior right exists and Section 21.1 confirms that neither the validation agent nor the Respondent are obliged to notify the applicant if it does not comply with the documentary requirements – in this case failing to submit the required licensee declarations.

In the Panel's view, the fact that the licensor (the Complainant's parent company) and the licensee (the Complainant) are at the same address does not place the onus on the validation agent to undertake further investigation, especially in view of the different names of the licensor and the Complainant. Furthermore, the validation agent is not obliged to investigate whether the applicant did at one stage own the prior right. Under the Sunrise Rules, the validation agent is only concerned with establishing the prima facie ownership of the prior right at the time of the application and based on the documents filed by the applicant.

The Panel notes previous .eu ADR decisions, such as Case No. 253 (Schoeller) and Case No. 431 (Cashcontrol), in which the Panelists held that the validation agent should have investigated the documentary evidence supplied by the applicant further. However, these cases are distinguishable on their facts - unlike the present Complaint, they involved situations where the name of the applicant and the holder of the prior right were almost identical and in the former case involved a system limitation restricting the Complainant's ability to specify its full name so as to correspond with the documentary evidence submitted.

Accordingly, in the Panel's view the validation agent's failure as to investigate the ownership of the prior right in question does not conflict with the .eu implementation Regulation or the Public Policy Regulation.

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#### ENTSCHEIDUNG

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	<b>Ignace Vernimme</b>
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DATUM DER ENTSCHEIDUNG DER SCHIEDSKOMMISSION 2006-07-07

#### Summary

EINE ENGLISCHSPRACHIGE KURZFASSUNG DIESER ENTSCHEIDUNG IST ALS ANLAGE 1 BEIGEFÜGT

The ADR Proceeding relates to a Complaint challenging the decision of the Respondent to reject the Complainant's application for the registration of the domain name ultrasun.eu. The Complainant initially owned trade marks in the name ULTRASUN but the ownership of these trade marks were ultimately transferred to the Complainant's parent company in or around 1996/1997.

On 8 December 2005, the Complainant applied to the Respondent to register the domain name ultrasun.eu. The documentary evidence submitted with the application proved that the Complainant's parent company was the holder of the prior right in the registered trade mark ULTRASUN. The Complainant did not submit any licence declaration(s) with the documentary evidence.

The Complaint was based on the fact that had the validation agent investigated the documentary evidence further then it would have been able to establish the relationship between the Complainant and its parent company, the actual holder of the prior right.

The Panel decided that the Respondent had not acted in conflict with either Regulation 733/2002 or Regulation 874/2004. The Panel considered that on a proper construction of Section 21.3 of the Sunrise Rules, the validation agent was not obliged to investigate the matter further in the absence of a licence declaration being provided by the Complainant within the 40-day time limit set out in Article 14.4 of Regulation 874/2004.

Accordingly, the Panel denied the Complaint.

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