Panel Decision for dispute CAC-ADREU-000706

Case number	**CAC-ADREU-000706**
Time of filing	**2006-04-12 09:58:05**
Domain names	**auto-welt.eu, autowelt.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Autowelt Grosshandels GmbH Wilfried Wilhelm Anclam**

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

The Panel is not aware of any pending or decided legal proceedings which may affect the disputed domain names.

FACTUAL BACKGROUND

All capitalized terms not defined herein are used by reference to the various regulations and rules identified in this decision.

This complaint arises out of the interpretation and application of Commission Regulation (EC) No 874/2004 of 28 April 2004 (“Regulation”), European Parliament and Council Regulation (EC) No 733/2002 of April 22, 2002 (“EU Regulation”) and the .eu Domain Name Terms and Conditions and phased registration rules for domain name applications made during the phased registration period (“the Sunrise Rules” and the “Conditions”).

Autoland Deutschland (“Applicant”) applied for the registration of the domain names “autowelt.eu” and “auto-welt.eu” (“the Domain Names”) on 13 December 2005, relying on a German trademark registered under number 303 62 152. A copy of this trademark was enclosed in the documentary evidence pursuant to 14(4) of the Regulation (“the Documentary Evidence”) sent by Applicant and received by Respondent on 22 December 2005. The copy of the trademark is the only evidence included in the Documentary Evidence supporting the application for the Domain Names. Registration of the Domain Names was thereafter denied by EURID (“Respondent”).

On April 11, 2006 Autowelt Grosshandels GmbH (“Complainant”) filed a complaint against Respondent’s decisions 2193101265418034 and 2870101274154368 in which Respondent declined the registration of the Domain Names.

Complainant lodged its complaint pursuant to Section 26 (1) of the Sunrise Rules, which provides that following a decision by the Registry to register a .eu domain name, an interested party may initiate an ADR Proceeding (as defined therein) based on the .eu dispute resolution rules (“ADR Rules” and “Supplemental ADR Rules”), before the ADR body (“the ADR Center”) against the Registry with regard to that decision.

On April 21, 2006, the ADR Center sent Complainant, a Notification of Deficiencies in the Complaint. This Notification specified that following Section 16.3 of the Conditions any ADR proceeding initiated against the Registry was to be conducted in the English language which is not the language in which the Complaint was submitted. As a result and pursuant to B2(b) of the ADR Rules the Notification invited the Complainant to correct such deficiencies and submit an amended Complaint within seven days of receiving the notification. On April 26, 2006, Complainant filed an amended complaint in the English language. In accordance with Paragraph B2 (a) of the ADR Rules, ADR Center verified that the Complaint satisfied the formal requirements of the ADR Rules and ADR Supplemental Rules of the ADR Center and on May 2, 2006, confirmed compliance of the Amended Complaint and confirmed the commencement of the ADR proceedings.

On May 2, 2006, the ADR Center notified Respondent that it had thirty working days to submit a Response according to the requirements described in ADR Rules.

On June 23, 2006, the ADR Center notified the parties of Respondent's default ("Notification of Default"). On June 28, 2006 Respondent challenged the Notification of Default ("the Challenge"). The Challenge was in fact a request for a three working day extension.

On July 3, this Panel was appointed. The same day, Respondent filed a Nonstandard Communication.

Complainant requests that the Respondent's decisions be annulled and that the Domain Names be attributed to either the Complainant or the Applicant.

A. COMPLAINANT

The following is a summary of the main submissions of the Complainant.

Complainant asserts that Respondent violated the Regulation and the EU Regulation.

The Complainant asserts it is the owner of the Prior Right and that as such it was Complainant who was supposed to be the applicant for the Domain Names and not the Applicant.

Complainant states that both Complainant and Applicant are part of the same group of companies belonging to the same person and that Applicant is the entity in charge within the group of domain name registration and management. It also states that Applicant is a licensee of Complainant's trademark as it was authorized to act on Complainant's behalf.

The Complainant explains that domain names are generally registered in the name of Complainant with Applicant as technical contact and that in the application process for the Domain Names a mistake must have been committed, leading to the Applicant applying for the Domain Names instead of the Complainant.

As a result the Complainant states that, absent this mistake that it cannot explain, it should have been the applicant and that as the applicant and owner of a validly registered trademark in Germany, it would have obtained the Domain Names being the first in line to submit the application.

The Complainant also states that in any case the Applicant is a licensee of Complainant and that as such the application as it stands should be accepted. The Complainant attached a License Declaration to the complaint in the form prescribed by the Sunrise Rules.

The Complainant thus asks the Panel to attribute the Domain Names to Complainant as owner of the Prior Right or alternatively to attribute the Domain Names to Applicant as Licensee of Complainant.

B. RESPONDENT

Respondent has failed to provide a response.

DISCUSSION AND FINDINGS

A. Respondent failed to file a response.

Article 22(8) of the Regulation states that the Respondent has thirty working days from the date of receipt of the complaint to submit its response. The date of receipt of the complaint was May 2, 2006. Respondent had until June 13, 2006 to file its response. It failed to do so.

Pursuant to B(3)(f), on June 23, 2006, the ADR Center notified the parties of Respondent's default.

Pursuant to B(3)(g), the Respondent filed a document styled as a Challenge. The Challenge did not explain why a response had been filed. It did not challenge the Notification of Default. Instead it was in fact a request for an extension of time to file a response. It is thus not a proper challenge to the Notification. As a result and pursuant to B(3)(g), the Panel rejects the Challenge.

B. Respondent's Nonstandard Communication.

On July 3, 2006, Respondent filed a Nonstandard Communication, ostensibly as its response. Pursuant to B(3)(g) of the Rules, the Panel will not admit the Nonstandard Communication as the Respondent failed to provide a reasonable explanation for this belated response.

Pursuant to B(3)(g) and B(7)(d) of the Rules, the Panel confirms that the response as provided on July 3, 2006 by respondent, in the form of a Nonstandard Communication is administratively deficient and because it was submitted late, without explanation. No proper application to file the response late was made in advance of the response deadline. The regulations prescribing filing times exist to ensure the proper functioning of the ADR Center and due fairness to all parties. It would be neither proper nor fair to allow such disregard for the rules by Respondent. Accordingly, the Nonstandard Communication and purported response will not be admitted by the Panel.

C. Complainant’s assertions.

Complainant acknowledges that a mistake was made and that the Documentary Evidence cannot by itself support Applicant’s application for the registration of Domain Names. Complainant states that regardless of this, Complainant, as the owner of the Prior Right provided in the Documentary Evidence, should be granted registration and benefit from Applicant’s place in the queue because Complainant and Applicant are part of the same group of companies.
Complainant then goes on to state that should the above proposition not be accepted, then Applicant should be attributed the Domain Names because Applicant is a licensee of Complainant.

The Panel sympathizes with the Complainant’s view point. However, the Panel is bound by the EU Regulation and the Regulation and all rules that derive from them.

The Regulation, the Sunrise Rules and the Conditions govern all .eu domain name applications made during the phased registration period. The main obligations of Respondent regarding registrations of .eu domain names during the phased registration are set out in Article 14 of the Regulation. Article 14 obliges the Registry to register .eu domain names on a first come first served basis, if it finds that the Applicant has demonstrated a prior right in accordance with that Article.
There are thus two conditions: to be the first and to own a prior right.
The first application received gets a chance to demonstrate its prior right. If it succeeds in doing so within the defined framework, it will obtain registration. If it fails, the second application received will then get a chance to demonstrate its prior right, and so on.

Pursuant to Article 14 of the Regulation, the onus of proving the Prior Right is on Applicant. See Cases 00119 and 00232. Applicant must also be the holder of the prior right. Article 14(4) states that “applicant shall submit documentary evidence that shows that he or she is the holder of the prior right…” (emphasis added). Applicant must make this submission within forty days from the submission of the application for the domain name. Article 14(4) goes on to state that “If the documentary evidence has not been received by this deadline, the application for the domain name shall be rejected” (emphasis added).

The Applicant’s application was submitted on December 13, 2005. It was the first application for both Domain Names. The Applicant thus had until January 22, 2006 to submit the Documentary Evidence to demonstrate its prior right. Applicant filed Documentary Evidence with Respondent on December 22, 2005. This Documentary Evidence contains two documents. These documents were printed by Applicant and then sent to Respondent who received them on December 22, 2005. On the first document the name of the Applicant is clearly stated as the Applicant for the Domain Names. The second document is a trademark owned by Complainant but not Applicant. This means that contrary to what was stated by Complainant, not one mistake but two mistakes were made. Applicant mistakenly applied in its name. It then reiterated the mistake by sending the Documentary Evidence which clearly showed that it was not the holder of a Prior Right and failed to show any link, relationship or license between itself and the Complainant. Applicant had a chance to review this before sending it and add other evidence, such as a license to demonstrate its right in the trademark. It did not do so and let its chance lapse.

Respondent made appropriate decisions based on the Documentary Evidence.

Complainant attaches a Declaration of License (the “Declaration”) to the Complaint. Article 12(2) of the Regulation provides that “during the first part of phased registration, only registered national and Community trademarks, geographical indications, and the names and

acronyms referred to in Article 10(3), may be applied for as domain names by holders or licensees of prior rights…" (emphasis added). Complainant's Declaration of License conforms to the prescriptions of Article 12(2) of the Regulation and Section 20(1) of the Sunrise Rules. However, the Declaration is dated April 11, 2006. It is thus clear to the Panel that the proof of the Prior Right was not submitted within the time-frame set by Article 14(4). This is as such sufficient to reject the Complaint.
Further and in general, it must be clear that the License existed and was valid prior to and on the date of the application. Similarly in case of a trademark, the trademark must be validly registered at the time of the application. If the trademark owner fails to show that it has renewed the trademark, its application will be refused. As a result the Declaration should have been signed and effective on or before the date of the application or should have provided more details as to the terms and conditions of the License.

Respondent could not have known of the License based on the Documentary Evidence submitted to it and thus made appropriate decisions.

Finally, it should be made clear that this procedure is not an appeal against Respondent's decisions whereby the application may be presented afresh to the Panel. The Panel's function is merely to check that, given the Documentary Evidence, as received on December 22, 2005, in support of the initial application, the Respondent made the appropriate decisions. Should the Panel consider new evidence now, it would treat unfairly any other applicant that may have filed for the Domain Names immediately after the Applicant.

The Panel cannot annul the Respondent's decisions as these decisions were made in full compliance with the Regulation and derived 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	**Jean Albert**

DATE OF PANEL DECISION 2006-08-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Applicant failed to show that it was either a holder or a licensee of a Prior Right in the Domain Names.

Complainant is the holder of a Prior Right in the Domain Names and claims that Applicant and Complainant are part of the same group of companies. However, the Documentary Evidence provided to the Respondent by Applicant failed to show that both parties were part of the same group but also that Applicant was a Licensee of Complainant's Prior Right.

A Declaration of License signed April 11, 2006 is no substitute for the documentary evidence that needs to be provided during the time-frame imposed by Article 14(4) of the Regulation.

The Panel holds that the Respondent fulfilled its obligations under the Regulation and Sunrise Rules in its decision to deny registration of the Domain Names to Applicant. The Respondent's obligations are to register .eu domain names on a the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with Article 14 of the Regulation.

The Panel thus refuses to annul the decision of Respondent.