

## Panel Decision for dispute CAC-ADREU-000843

Case number **CAC-ADREU-000843**

Time of filing **2006-04-21 09:51:55**

Domain names **starfish.eu**

### Case administrator

Name **Josef Herian**

### Complainant

Organization / Name **International Lifestyles (Europe) Limited**

### 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

None that the Panel is aware of.

#### FACTUAL BACKGROUND

On 7 December 2005 the Complainant, through its agents Nabarro Nathanson, filed an application for the domain name starfish.eu in the Sunrise 1 period.

The Complainant was the first applicant in the queue for the domain name.

The prior right claimed was a registered Community Trade Mark (CTM) No. 003238359 and the Complainant claimed the domain name as the Licensee of the Trade Mark.

The deadline for providing the Validation Agent with documentation of the prior right claimed was 16 January 2006 and the Complainant provided the documentary evidence to the Validation Agent on 11 January 2006.

The applicant submitted a copy of the trade mark certificate for CTM No. 003238359. This identified the trade mark owner as "VRL INTERNATIONAL LIMITED" with the following address:

Royal Bank of Canada Trust Co LTD RBC Building, Cardinal Avenue  
Georgetown, Grand Cayman  
KY

The copy certificate also identified Nabarro Nathanson as trade mark agents for the trade mark owner.

The Complainant also submitted the required Licence Declaration. This identified the Licensor as "VRL International Limited" with the following address:

PO Box 61, 2 St Lucia Avenue  
Kingston  
4  
JAMAICA

On 10 March 2006 the Respondent rejected the Complainant's application.

The deadline for initiating the ADR proceeding was 19 April 2006. The Complainant filed the Complaint 19 April 2006.

#### A. COMPLAINANT

The Registry's decision to reject the application is in conflict with European Union Regulations (EC) No. 733/2002 and (EC) No. 874/2004 because:

- 1) the Complainant is and was an eligible party pursuant to Article 4(2)(b) of Regulation (EC) No. 733/2002;
- 2) the Complainant was eligible to register the Domain Name during Sunrise Phase 1; and
- 3) the Complainant was the first party to file an application for <starfish.eu> with the Registry in the technically correct manner and in accordance with the provisions of Regulation (EC) No. 874/2004.

The Complainant is therefore entitled to the Domain Name and requests that the Registry's decision to reject its application be annulled and that the <starfish.eu> domain name be registered in the name of the Complainant International Lifestyles (Europe) Limited and attributed to the Complainant.

REPLY of the Complainant to the Respondent's Nonstandard Response

1. As the Respondent accepts, documentary evidence supporting the Complainant's application for the Domain Name under the Sunrise Rules was received by EURid on 11 January 2006, before the 17 January deadline.

2. The evidence comprised:

(a) the Cover Letter signed on behalf of the Applicant/Complainant by Matthew Brown a solicitor with Nabarro Nathanson, the solicitors and document handling agents for the Complainant. The Cover Letter included the standard declarations, signed by the lawyer for the Complainant, that "The Applicant meets the requirements set forth in Article 4(2)(b) of Regulation (EC) No. 733/2002 of 22 April 2002 on the implementation of the .eu Top Level Domain." and that "The Applicant is the owner, right-holder or licensee of the claimed (prior) right."

(b) a copy of the OHIM certificate of registration of Community trademark No. 003238359 STARFISH in the name of VRL International Limited (the "Trade Mark"); and

(c) a duly completed Licence Declaration in the form published by the Respondent in Annex 2 to the Sunrise Rules.

3. The Licence Declaration:

(a) was in the names of VRL International Ltd as Licensor and the Complainant as Licensee;

(b) was signed on behalf of the Licensor by Cameron Burnet, a director of VRL International Ltd, the registered owner of the Trade Mark;

(c) included the standard provision whereby "The Licensor hereby...represents and warrants that it is the owner or right holder of the Trade Mark, and the Trade Mark is a legally valid right."

4. The address for VRL International Limited in the OHIM certificate was shown as the registered office address of VRL International Limited at the time of the prosecution of the Community trademark application. The Trade Mark was registered on 4 October 2004. The address was c/o Royal Bank of Canada Trust Co Ltd, RBC Building, Cardinal Avenue, Georgetown, Grand Cayman. Grand Cayman is in the Cayman Islands – not Kentucky, USA as suggested by the Respondent.

5. In the Licence Declaration, the address for VRL International Ltd was stated to be PO Box 61, 2 St Lucia Avenue, Kingston, Jamaica. This is the business address of VRL International Limited, the owner of the Trade Mark, whose European licensee is the Complainant.

6. In its Nonstandard Response, the Respondent submits that because the address for the owner of the Prior Right as shown in the OHIM certificate is different from the address for the Licensor shown on the Licence Declaration then the Licensor is not the owner of the Trade Mark. This is simply not the case. The name of the owner of the Prior Right is the same as the name of the Licensor and it is in fact the same company.

7. The Respondent relies on the decision of the Panel in Case No. 00119 (NAGEL) which stated that:

"Article 14, Section 4 of the Regulation 874/2004 states that every Applicant shall submit documentary evidence that he or she is the holder of the Prior Right...Contrary to the Complainant's contention, it is not sufficient to prove that the Prior Right exists but it must, additionally, be substantiated that the Applicant is the holder of the right. In case that the registered owner of the submitted trademark is not identical to the Applicant, the Applicant has to produce documentary evidence that the registered owner either granted a licence to the Applicant or assigned the trademark to the Applicant."

8. In NAGEL, however, the Applicant was "Nagel Verwaltung & Logistik GmbH" whereas the name of the owner of the trade mark was "Ernst Nagel Beteiligungen GmbH & Co. KG" and no documentary evidence was submitted as to a licence or assignment until a Licence Declaration was lodged with the Amended Complaint in the ADR proceedings.

9. In this case, the owner of the Trade Mark and the Licensor named in the Licence Declaration were both VRL International Limited.

10. Section 20.1 of the .eu Sunrise Rules provides that "If the Applicant has obtained a licence for a registered trade mark...in respect of which it claims a Prior Right, it must enclose with the Documentary Evidence an acknowledgement and declaration form, a template of which is contained in Annex 2 hereto, duly completed. As the Respondent accepts, in this case Documentary Evidence in the required form including a Licence Declaration was received by EURid before the relevant deadline.

11. Furthermore:

(a) the agents for the owner of the Trade Mark whose details were specified in the OHIM certificate in respect of the Trade Mark (included in the Annex to the Complaint) were Nabarro Nathanson who were also the solicitors and document handling agents for the Complainant. They signed the Cover Letter which included the representation and warranty that "The Applicant is the owner, right-holder or licensee of the claimed (prior) right."

(b) this constituted evidence from the lawyers for the Trade Mark owner that the Licensor who signed the Licence Declaration was the same company as the owner of the Trade Mark

(c) furthermore, the Licence Declaration included the standard representation and warranty by the signatory on behalf of the named Licensor VRL International Limited that it was the owner or right holder of the Trade Mark.

12. In the circumstances, the Documentary Evidence supporting the Complainant's application for the Domain Name was valid, sufficient and uncontrovertible and proved that the Complainant was entitled to register the Domain Name during Sunrise Phase 1. The Respondent ought not therefore to have rejected the application.

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## B. RESPONDENT

The Registry concluded from its examination of the documentary evidence that the Complainant was not the actual owner of the STARFISH Trade Mark nor that it was licensed to use this trademark. The licence declaration submitted by the Complainant was not signed by the actual owner of the trademark. The Registry therefore rejected the Complainant's application.

### 1. COMPLAINANT'S CONTENTIONS

The Complainant argues that the Registry's decision to reject its application is incorrect as it was properly licensed to use the STARFISH Trade Mark.

### 2. RESPONSE

Article 10 (1) of the 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 Registry is provided with all information that allows it to assess if the Applicant is the holder of a prior right. Pursuant to article 12 (2) of the Regulation licensees of Trade Mark owner may also apply for the corresponding domain name. Pursuant to article 14 (4) of the Regulation, the documentary evidence must clearly show that the applicant is the holder of the prior right claimed on the name in question.

The applicant must not necessarily be the actual owner of a prior right in the corresponding domain name, it may be licensed by the actual owner to use the prior right in applying for the corresponding domain name. Whereas in the first situation the documentary evidence must only consist of the evidence of the prior right, the second situation requires the applicant to submit a licence declaration in addition to the evidence of the prior right. This licence declaration must be signed by the actual owner of the Trade Mark pursuant to section 20 (1) of the Sunrise Rules.

Thus, the name and address of the licensor must correspond to the name and address of the owner of the prior right. Indeed, the Registry will only be able to determine if the applicant is the holder of a prior right when the licence declaration is signed by the actual owner of the prior right.

It appears from the documentary evidence submitted by the Complainant that a company based in Georgetown, Kentucky (United States of America) is the owner of the STARFISH Trade Mark, whereas a company based in Kingston (Jamaica) signed the licence declaration as licensor of the Trade Mark. As the licensor is not the owner of the Trade Mark, the Complainant was not licensed to use the STARFISH Trade Mark.

In case n° 00119 (NAGEL); the Panel stated that: "Article 14, Section 4 of the Regulation 874/2004 states that every Applicant shall submit documentary evidence that shows that he or she is the holder of the Prior Right (my emphasis). Contrary to the Complainant's contention, it is not sufficient to prove that the Prior Right exists but it must, additionally, be substantiated that the Applicant is the holder of the right. In case that the registered owner of the submitted Trade Mark is not identical to the Applicant, the Applicant has to produce documentary evidence that the registered owner either granted a licence to the Applicant or assigned the trademark to the Applicant."

Therefore the Complaint must be rejected.

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## DISCUSSION AND FINDINGS

Procedural:

First, the Panel would like to point out its concern to the fact that the Respondent – being EURid – in this and in several other ADR proceedings did not respect the deadlines for filing its Response.

In this case the Respondent was given a term of 30 days to file its Response - according to the Regulation (EC) No. 874/2004 Article 22(8) – starting on 25 April 2006.

On 21 June 2006 the ADR Centre had still not received a Response from the Respondent and it sent a default notice to the Respondent.

Later that day the Respondent filed its Response without any explanation about the reason(s) for the late filing.

EURid's attitude does unnecessarily delay the registration process of the domain name to the disadvantage of the first or the later applicants for a particular domain name.

The Regulation (EC) No. 874/2004 in Article 22(10) and the ADR Rules paragraph B10 provides the Panel with the power to determine the consequences of not respecting filing deadlines.

The Panel in this respect admits the late Response of EURid, as well as the Complainant's reply of 5 July 2006.

The Respondents rejection of the application:

Article 10(1) in the chapter IV "Phased registration" in the aforementioned Regulation states that holders of prior rights (as for example and in this case a CTM) recognized or established by national and/or Community law shall be eligible to apply to register domain names during the phased registration periods.

In the same chapter IV Article 12 "Principles for phased registration" section (2), 2 states that right holders or their licensees can apply and section (3) states that the request to register a domain name in the phased period based on a prior right shall include a reference to the legal basis in national or Community law for the right to the name, "as well as other relevant information".

Further in the same chapter IV Article 13 "Selection of validation agents" states: "The Registry shall require the validation agent to execute the validation in an objective, transparent and non-discriminatory manner".

Article 14 "Validation and registration of applications received during phased registration" states: "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."

and

"Every applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question."

and

"The relevant validation agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name. If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this."

and

"The Registry shall register the domain name, on the first come first served basis, 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."

Section 13(2) in the Sunrise Rules states regarding registered Trade Marks that "...Documentary Evidence must clearly evidence that the Applicant is the reported owner of the registered trade mark. In case the Applicant is a licensee or transferee of a registered trade mark referred to in Section 13(1) above, Section 20 hereof shall apply."

The use of the word "clearly" suggests that in a case where section 13(2) of the Sunrise Rules applies the burden of proof placed upon the applicant is a high one.

Section 20 regarding licenses, transfers and changes to the applicant states in 20(1) that "If an Applicant has obtained a license for a registered trade mark referred to in Section 13(1)(i) above in respect of which it claims a Prior Right, it must enclose with the Documentary Evidence an acknowledgement and declaration form, a template of which is contained in Annex 2 hereto, duly completed and signed by both the licensor of the relevant registered trade mark and the Applicant (as licensee)."

Section 20(3) states that “If, for any reasons other than as are referred to in Section 20(1) and 20(2) hereof, the Documentary Evidence provided does not clearly indicate the name of the Applicant as being the holder of the Prior Right claimed (e.g. because the Applicant has become subject to a name change, a merger, the Prior Right has become subject to a de iure transfer, etc.), the Applicant must submit official documents substantiating that it is the same person as or the legal successor to the person indicated in the Documentary Evidence as being the holder of the Prior Right.”

Section 21 “Examination by the Validation Agent” states that the Validation Agent “...examines 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 and scanned by the Processing Agent (including the Documentary Evidence received electronically, where applicable) and in accordance with the provisions of these Sunrise Rules.”

The Panel notes that exclusively means “only” and Prima facie means “on its first appearance”.

Further section 21(3) states: “The Validation Agent is not obliged, but it is permitted in its sole discretion to conduct its own investigations into the circumstances of the Application, the Prior Right claimed and the Documentary Evidence produced.”

From these references the Panel concludes that the burden of proof lies upon the Applicant for a domain name in the Sunrise Periods and that the formalities of the Regulation and the Sunrise Rules must be strictly complied with to secure a cost and time-effective and reasonable handling of over 100.000 applications under the first Sunrise Period.

Further the Panel is of the view that the Validation Agent and in such evaluation also EURid – the Respondent – shall only take into account the documentary evidence received.

The Validation Agent is permitted at its sole discretion – and is thus not obliged - to conduct its own investigations to evaluate the Application and the evidence provided.

The majority of the Panel in this case are therefore of the view that the documentary evidence submitted by the Complainant in this case had to clearly show that the licensor was in fact the registered owner of the Trade Mark in question but that the different addresses in the Trade Mark certificate and Licence declaration were such that the Complainant failed to do so.

In some cases in .eu ADR-proceedings the Panels have concluded that the Validation Agent should not have refused to register domain names in case of “technical or obvious mistakes” in the application.

The case presented here before the Panel, however, is not caused due to a “technical” mistake.

It can be debated whether the case falls under the term “obvious” mistake, but this notion should not be interpreted broadly, according to the Panel.

A “obvious” mistake could be, for example, a miss-spelling or something written but not meant by the Applicant .

The Panel does not find that the mistake in this case was of the kind “written but not meant” by the Complainant, caused for instance by hitting the “wrong” button on the keyboard or the like.

The mismatch in the addresses of the Licensor and the Trade Mark owner does not appear to be a “miss-spelling”.

The Panel has noticed the Complainant’s contention that it is the same law firm handling the Trade Mark registration and the documentary evidence. This, however, in the opinion of the majority of the Panel is irrelevant in the assessment of the error or mistake.

The documentary evidence shows that the right holder is located in Cayman Islands, an overseas territory of the United Kingdom.

The Licensor in the documentary evidence is located in Jamaica, which since 6 August 1962 has been an independent country.

Company laws in most countries state that there can not be more than one registered company in that country with the same name.

One could argue that if had the jurisdiction been the same, the mere fact that the addresses are different while the names of the Licensor and the Trade Mark owner are the same, could lead to the conclusion that the Licensor and the Trade Mark owner were the same legal entity and that the prior right was established.

In this case, however, the Licensor and the Trade Mark owner are established in different jurisdictions, which leads to the conclusion that it is not shown that they are the same entity and therefore the prior rights are not established.

It is not uncommon that a legal person has its registered office address in one jurisdiction and its business office in an other jurisdiction(s). But this does not “lower the bar” of submitting correct and complete documentary evidence showing that both parties are in reality one and the same undertaking.

Even if the Validation Agent would have further examined the application, the Panel notes that it is not easy for the Validation Agent to collect evidence showing that the right holder and the licensor are one and same legal person. The same applies for the Panel which has, for example, not found a website of the Complainant on which both addresses appear together.

The majority of the Panel would like to refer to the not exhaustive list below of relevant cases handled under the .eu ADR-proceedings.

OSCAR (181) – mistake due to technical matters regarding the length of the applicant’s name, thus the rejection by EURid was annulled.

COLT (294) – mistake in the licensor’s name which differed from the name of the right holder’s as a result of translation to English, thus the complaint was denied.

DMC (232) – mistake in the name of the applicant’s name which differed from the right holder’s name as an explainable result of the Austrian Law, hence the law within a member state in the EC, which the Panel found that the Validation Agent should be expected to know (argument 21), thus the rejection by EURid was annulled.

ISABELLA (984) – Applicant’s name differed from the right holders name but the addresses where the same and a quick research could state that the company operated and had registered several company names in which the applicant’s name seemed to be a confused mix of those. Nevertheless the complaint was denied as there were no technical or obvious mistakes which should have put EURid on notice as to the need to make further enquiries.

BPW (127) – The documentary evidence did not show that the applicant was the owner of the trade mark, thus the complaint was denied.

SCHOELLER (253) – Mistake in the name of the applicant/right holder due to technical matters, mistake in addresses of the applicant/right holder but same city and one simple search would have cleared the mistakes made, thus the rejection by EURid was annulled.

ULTRASUN (541) – Applicant’s name differed from the right holders name. The right holder was the applicant’s parent company. The complaint was denied.

CAPRI (984) – Applicant’s name differed from the right holder’s name. The Panel/the Panelist therefore tested that the validation of the application could have been done easily and properly towards correct verification of the data provided by the complainant/the applicant, thus EURid rejection was annulled.

These examples show that the Panels in some cases find that the Validation Agent should to some extent seek to clear minor mistakes due to technical or obvious errors. If there are such technical or obvious errors, a quick investigation should be performed and if such a quick investigation could lead to the satisfaction of the documentary duty of the applicant, the domain name should have been granted and not rejected.

The main principle of the Regulation and the Sunrise Rules, applied in the majority of the case law on issues regarding breach of formalities and material discrepancies, is that the burden of proof is on the applicant and that the sole discretion of the Validation Agent to investigate is in fact “sole”, even though this might lead to disappointment of the applicant, ISL (219).

The majority of the Panel finds therefore that the Complainant did not in due time submit satisfactory documentary evidence to establish prior rights and the decision by the Respondent to reject the application was not in violation of the applicable Regulations nor of the Sunrise Rules.

#### DISSENTING JUDGMENT OF PANELIST MATTHEW HARRIS

1. I have respectfully reached a different conclusion to my fellow panelists in this case and I set out my reasons for this below.

2. Before I do so, and given that I am not aware of a dissenting judgment having previously been given in CAC proceedings under the .eu ADR procedure, an immediate question is whether it is appropriate for me to issue a dissenting judgment at all. Paragraph 12(3) of the ADR Rules provides that in the case of a three-member panel, the panel's decision shall be made by simple majority. In contrast to the ADR regimes that apply in relation to some other TLDs (see for example paragraph 15 of the UDRP Rules) the CAC ADR rules do not expressly provide for dissenting decisions.

However, they do not prohibit them either.

3. In my view there is no reason why where there is difference in reasoning between panelists that disagreement should not be made public. Indeed, there are good reasons why it should be made public. Whilst it is clearly advantageous that there be consistency amongst ADR decisions, this is more likely to be achieved where competing views amongst panelists are open to public scrutiny, comment and criticism. Therefore, whilst clearly a dissenting panelist is not obliged to issue a dissenting judgment in any particular case, he should not be prevented from doing so if he so wishes. I choose to do so in this case.

4. The Complainant in this case has commenced proceedings under Article 21(b) of Commission Regulation 874/2004 (the "Regulation"). The role of the panel in those proceedings is to determine whether a decision of the Registrar (i.e. EURid) conflicts with the Regulation or Regulation (EC) No 733/2002 of the European Parliament and Council.

5. The starting point in any assessment of whether EURid was right to reject the Complainant's application in this case is Article 14 of the Regulation. This provides that an applicant for a domain name in the Sunrise Period and in reliance upon a prior right must provide documentary evidence that "demonstrates the right under the law by virtue of which it exists". In other words (and has been held in a large number of previous ADR proceedings), when it comes to an assessment of the material before the validation agent and EURid, it is the applicant that bears the burden of proof.

6. Whilst the role of a panel in a case such as this is to decide whether a decision conflicts with the Regulations, I do not think that this is the sole document to which a Panel may look in any case. Under Article 12(2) of the Regulation, EURid was required to:

"publish on its website two months 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."

7. Pursuant to this requirement the Sunrise Rules were published. The Sunrise Rules set out at times highly detailed rules as to the procedures to be followed and the evidence to be provided so far as different types of prior rights are concerned.

8. In *Cosnova GmbH v EURid CAC Case No 01071 <essence.eu>*, the panel (disagreeing with the approach taken by the panel in *von Gerkan Marg und Partner v EURid CAC Case No. 0954 <gmp.eu>*) held that EURid was not entitled to reject applications simply for failing to comply with the Sunrise Rules "regardless of whether the applications comply with the Regulations". Clearly if and insofar as the Sunrise Rules conflict with the Regulations, the Regulations prevail. However, the Sunrise Rules are expressly contemplated and mandated by the Regulations and it is clear that the Regulations require a "proper, fair and technically sound administration" of all Sunrise applications. In the circumstances, I think it will usually be appropriate for a panel to take into account compliance or non-compliance with the Sunrise Rules.

9. Given the large number of forecast and actual .eu applications it is not surprising that EURid's position is that the Sunrise Rules should be complied with strictly so as to ensure that the Sunrise phases be implemented in an orderly, efficient and consistent manner (i.e. a "fair" and "proper" manner as prescribed by the Regulation). Also, the requirement that the process be "fair" is in my opinion not simply to be judged between an applicant and EURid alone. In many cases more than one entity will have applied under the Sunrise procedure. Whilst an applicant may not think it is "fair" that it has been denied a domain name because it has failed to comply with a "technical" or "formal" requirement of the Sunrise Rules, any entity that is next in line for that domain and that has taken the trouble to properly comply with the Sunrise Rules requirements is likely to see matters very differently.

11. In this present case, however, I do not think it is necessary to consider this issue further. This is because, for the reasons that I will explain, I am not convinced that there was any failure to comply with the provisions of the Sunrise Rules in this case.

12. There is obviously a discrepancy between the address provided for the trade mark owner on the trade mark certificate and on the licence declaration. However, the Sunrise Rules although laying down strict rules regarding a number of matters do not contain any express provision in relation to addresses.

13. The majority of the Panel in this case point to sections 13(2) and 20(3) of the Sunrise Rules, but in my opinion these provide limited assistance. Section 20(3) sets down requirements where the documentary evidence provided "does not clearly indicate the name of the Applicant as being the holder of the Prior Right claimed". However, this is not the case here. Both the trade mark certificate and the licence declaration refer to VRL International Limited. Section 13(2) is potentially of greater relevance. It states that documentary evidence "must clearly evidence that the Applicant is the reported owner of the registered trade mark." Of course, in this case the applicant is not the trade mark owner, but section 13(2) also makes it clear that these provisions are subject to the provisions of section 20. In the circumstances, the only sensible interpretation of section 13(2) is that references to the applicant should be read as referring to the licensor in circumstances where the applicant is a licensee.

14. Given this, could it be said in this case that the evidence submitted by the Complainant with its differing addresses does not "clearly" show that the licensor is the owner of the mark? Perhaps, but this still does not mean that there is non-compliance with the Sunrise Rules. Section 13(2) is not expressed in mandatory or exclusive terms (it arguably contains a prohibition on the use of commercial databases but this is not relevant to this case). It merely sets out what shall be "sufficient" to show trade mark rights. It is to be contrasted, for example, with section 20 that declares that where the prior rights relied upon are rights under a licence then the documentary evidence "must" include an acknowledgement and declaration in the proscribed form.

15. Given that there is therefore no failure by the applicant in this case to comply with any requirements of the Sunrise Rules, I believe that the question for the Panel in this case becomes somewhat more straight forward; i.e. whether the Complainant did or did not comply with Article 14 of the Regulation.

16. The discrepancy in addresses in this case does not necessarily involve any error or misrepresentation on the part of the Complainant. It is common practice for companies to use different addresses for different purposes. A company will frequently have a registered office and a main business address that differ. The fact that in this case the addresses were on two different Caribbean territories is to my mind not that relevant. Indeed, the Complainant has now confirmed that the address on the trade mark certificate was a previous registered address of the trade mark owner and licensor, whilst the address on the licence declaration was the licensor's business address. Further, the licence declaration required by Section 20 of the Sunrise Rules does not require the applicant to enter its registered address.

17. Of course, any difference in addresses is undoubtedly unfortunate. In isolation it raises a doubt as to whether the VRL International Limited in both documents is indeed one and the same company. However, crucially this was not the only evidence before the validation agent in this case. The additional evidence included:

(a) a trade mark certificate that showed that the trade mark owner's trade mark agents were Nabarro Nathanson;

(b) a licence declaration submitted by Nabarro Nathanson on behalf of the applicant in which the Licensor "represents that it is the owner or right holder of" CTM 3238359;

(c) a cover letter signed by Nabarro Nathanson declaring that the Complainant was the licensee of the claimed prior right and that the enclosed documentary evidence "provides proof of the existence of [the] claimed prior right".

18. In such circumstances, one needs to apply a degree of common sense to the assessment of compliance with the Article 14 obligation. When one looks at the evidence as a whole before the validation agent in this case, I believe that the only reasonable conclusion that can be reached is that the trade mark owner and the licensor are one and the same. For this reason, I believe that the applicant did in this case satisfy the burden placed upon it by Article 14 of the Regulation. It therefore follows that EURid's decision to reject the application in this case was not in compliance with the Regulation and should be annulled.

19. Having come to this conclusion, I wish to make a number of points clear. I am not saying that in all cases where there is a discrepancy between the address given for a trade mark holder on a trade mark certificate and for a licensor on a licence declaration, that discrepancy can be ignored. That discrepancy may be such that the applicant has failed to satisfy his burden as required by Article 14 and in such circumstances EURid / the validation agent will be quite entitled to reject the application. In this case, however, the other evidence before the validation agent was such that the burden was satisfied.

20. Further, I am not saying that a signed declaration filed on behalf of an applicant can be treated in isolation as an adequate substitute to evidence of prior rights. It is not. However, its contents and the fact that it was signed by an entity that also appeared on the evidence provided to be trade mark agents for the trade mark owner are matters that I am entitled to take into account in conjunction with other material when assessing whether or not the Complainant has complied with obligations under Article 14.

21. Lastly, I agree with my fellow panelists that neither EURid nor the validation agent had any obligation to undertake an independent investigation in this matter. The discrepancy in addresses was such that this may have been a good case in which to have made that enquiry, but it was under no obligation to do so. However, absent that investigation, the Complainant in my opinion had nevertheless brought forward sufficient evidence before the validation agent to comply with Article 14 of the Regulation.

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#### DECISION

For these reasons the Panel in accordance with Paragraphs B12 (b) and (c) of the ADR Rules, the Panel orders that

the Complaint is Denied.

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#### PANELISTS

Name	<b>Matthew Harris</b>
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DATE OF PANEL DECISION 2006-08-21

#### Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

On 7 December 2005 the Complainant, through its agents Nabarro Nathanson, filed an application for the domain name starfish.eu in the Sunrise 1 period.



The Complainant was the first applicant in the queue for the domain name.

The prior right claimed was a registered Community Trade Mark (CTM) No. 003238359 and the Complainant claimed the domain name as the Licensee of the Trade Mark.

The applicant submitted a copy of the Trade Mark certificate for CTM No. 003238359. This identified the Trade Mark owner as "VRL INTERNATIONAL LIMITED" based in Cayman Islands and the submitted License Declaration transferring the license to the Complainant had "VRL International Limited" based in Jamaica.

The agents Nabarro Nathanson were involved with both the Trade Mark registration (the prior right) and the submitting of the documentary evidence before EURid.

On 10 March 2006 the Respondent rejected the Complainant's application.

The majority of the Panel ordered the complaint to be denied as the Complainant did not in due time submit satisfactory documentary evidence to establish prior rights and the decision by the Respondent to reject the application was not in violation of the applicable Regulations nor of the Sunrise Rules and that this mistake was not easily removed due normal investigations performed by the Panel.

The dissenting Panelist argued that in his belief and based on the circumstances in the case the applicant did in this case satisfy the burden placed upon it by Article 14 of the Regulation. The Panelist therefore found that EURid's decision to reject the application in this case was not in compliance with the Regulation and should be annulled.

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