Panel Decision for dispute CAC-ADREU-000961

Case number	CAC-ADREU-000961
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Domain names	esser.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	David A Cohen

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 legal proceedings which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a licensee of a holder of the trade mark ESSER. He applied for the registration of the domain name esser.eu. The official certificate of the respective trade mark office was submitted as the part of the Documentary Evidence only. The EURid rejected the application for registration of the disputed domain name stating that the documentary evidence did not sufficiently prove the right claimed.

A. COMPLAINANT

Honeywell SA (the Complainant), as a licensee of Novar GmbH, applied for the domain name esser.eu. The application was based on German trademark registration 1056272 for ESSER. Details of the German registration for ESSER in the name of Novar GmbH was filed to the validation agent well in time, together with a signed license declaration and the signed pdf frontpage. Therefore, the application fulfilled the requirements of article 12 (of COMMISSION REGULATION (EC) No 874/2004 of 28 April 2004) - "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." Regardless of this, the application was rejected.

In Complainant's opinion there are only 3 logical explanations:

1. There has been made a mistake by the validation agent:
The applicant can not be hold responsible.

2. (Part of) the submitted documents were lost:
There is no reason to believe that any document has been lost, the validity of the right claimed could be easily investigated at the website of the German Patent and Trademarks Office: https://dpinfo.dpma.de/ - ESSER, registration number 1056272

3. The submitted documents do not meet the requirements of article 12:
There is no reason to believe that any of the submitted documents did not meet the requirements of article 12, the applicant submitted sufficient details in order to validate the claim at the website of the German Patent and Trademarks Office: https://dpinfo.dpma.de/ - ESSER, registration number 1056272

The Complainant furthermore argued that should a mistake have been made in the application, this should have been considered as a ‘minor’ mistake. The Complainant refers to the Managing Intellectual Property magazine article with information about the enormous

amount of ‘common mistakes’ that were made during Sunrise 1 and 2. According the representant of the validation agent "Strict implementation of the rules could lead to a shock for many applicants. Validation agend is being slightly relaxed about those rules or he would have to reject 50% of those applications." In consultation with EURid, the validator is adopting a more lenient approach, filling in missing information and doing additional investigation in 30% of cases."

The Complainant concluded that the applicant has submitted information about its prior right. This alone should be sufficient, but if some information has been missing, it could have been very easily filled in by the validation agent by doing some additional investigations at the website of the German Patent and Trademarks Office: https://dpinfo.dpma.de/

The Complainant finally asked to reverse the decision of Eurid and accept the application of Honeywell SA after all.

B. RESPONDENT

The Response to Complaint was received on June 28, 2006. As the Commencement of the ADR Proceeding was addressed to the Respondent on May 5, 2006, the Respondent has failed to submit a Response to Complaint within the time limit of 30 working days from the delivery of the notification. The Respondent’s default was notified on May 29,2006. The Nonstandard Communication of the Respondent with the same consent as the Response to Complaint was received on June 29, 2006.

The main arguments contained in the Response to Complaint (being sent in default by the Respondent) and the Nonstandard Communication are:

Article 10 (1) of the of Commission Regulation (EC) No 874/2004 of 28 April 2004 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 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 license declaration in addition to the evidence of the prior right. This license declaration must be signed by the actual owner of the trademark pursuant to section 20 (1) of the Sunrise Rules.

The ESSER trademark certificate which the Complainant filed as documentary evidence mentions Novar GmbH as the owner. It is very clear that the actual owner of the ESSER trademark did not apply for the ESSER domain name. Indeed, the name of the owner and the name of the Complainant are different. Moreover, in contrast to the Complainant's statement in its Complaint, it did not file a license declaration with its application. As the Complainant is not the owner of the ESSER trademark and as the Complainant failed to submit a license declaration with regard to the ESSER trademark with its application, the Registry concluded that it was not the holder of a prior right. The Panels in cases n° 00119 (NAGEL) and 00232 (DMC) both stated that article 14 of the Regulation puts the burden with the applicant to prove that it holds a prior right. If an applicant fails to prove that it is the holder of a prior right, the application must be rejected. Therefore, the Complaint was rejected.

DISCUSSION AND FINDINGS

1. LEGAL GROUNDS

According article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (Public Policy Rules), the holders of prior rights and public bodies are eligible to apply to register domain names during a period of phased registration. Prior rights are understood to include, inter alia, registered national and community trademarks. According article 14 (4) of Public Policy Rules, 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.

According Section 13 of the .eu Registration Policy and the Terms and Conditions (Sunrise Rules) a copy of an official document issued by the competent trade mark office indicating that the trade mark is registered is sufficient to submit as a documentary evidence. This provision is not applicable in the case when the applicant is a licensee of respective trade mark. According Section 20.1 of the Sunrise Rules, if an Applicant is a licensee 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 (template of such License Declaration is contained in Annex 2 of the Sunrise Rules) duly completed and signed by both the licensor and the applicant (as licensee).

2. APPLICATION

Honeywell SA submitted a copy of an official document issued by Deutsches Patent- und Markenamt (German Patent and Trade Mark

Office) indicating that the trade mark ESSER is registered for Novar GmbH. As expressly stated in the Complaint, the Complainant is a licensee of Novar GmbH and these two companies are different bodies. The Complainant (as a licensee) had to enclose with the documentary evidence a License Declaration duly completed and signed by both the licensor (Novar GmbH) and licensee (Honeywell SA). As confirmed by EURid in Response to Complaint (and again in Nonstandard Communication from July 17, 2006, requested by the ADR Panel) the Complainant failed to submit a License Declaration with regard to the ESSER trademark with its application. The Panels in other cases (00119 – NAGEL or 00232 - DMC) stated that article 14 of the Public Policy Rules puts the burden with the applicant to prove that it holds a prior right. If an applicant fails to prove that it is the holder of a prior right, the application must be rejected.

Therefore, Honeywell SA did not comply with the conditions stated in the Public Policy Rules and Sunrise Rules and EURid had to reject the application.

3. ARGUMENTS OF THE COMPLAINANT

Ad 1) - "There has been made a mistake by the validation agent".
As stated above, there was no mistake of a validation agent found. The validation agent is entitled to review the submitted documents and if it finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this - see Article 14 (7) of the Public Policy Rules. In this case, the provided documentary evidence did not substantiate a prior right of an Applicant. Arguments that the validation agent made an extensive research of the provided information in other domain names registrations are not relevant in this case. The validation agent has no opportunity how to identify a licensee of a trade mark without the license agreement or declaration. In other cases mentioned by the Complainant, the additional investigations of the validation agent were limited to such kind of "minor" mistakes as the spelling mistakes or errors in the names. The missing document (License Declaration) cannot be considered to be such a "minor" mistake. Besides this, ADR Panel reviewed the website of the German Patent and Trademarks Office at https://dpinfo.dpma.de/ as suggested by the Complainant and there is no mention of the Honeywell SA as a licensee regarding ESSER trademark.

Ad 2) - "(Part of) the submitted documents were lost".
On the basis of the ADR Panel request, EURid confirmed that the License Declaration was not provided as a part of Documentary Evidence. There are no doubts that some part(s) of documents could be lost during the process of their delivery or review. But the Complainant did not offer any evidence (e.g. copy of fax, e-mails or letters) that the License Declaration was filled to the validation agent. Moreover, despite EURid’s explicit confirmation from July 17, 2006, that the License Declaration has not been provided, the Complainant did not provide such evidence during the ADR Proceeding.

Ad 3) - "The submitted documents do not meet the requirements of article 12."
As stated above, the only one submitted document (German Patent and Trade Mark Office certificate) did not meet the requirements of Article 12 of Public Policy Rules as it did not prove the prior right of the Applicant regarding trade mark ESSER and there was not any other document provided by the Applicant stating that the Applicant was a licensee and had the prior right to register domain name esser.eu.

4. RESPONDENT’S DEFAULT

The Respondent failed to comply with the deadline for the submission of the Response to the Complaint.

The ADR Panel emphasize that the Respondent, especially being the EURid itself, is bound by the ADR Rules and by the official terms prescribed therein like any other party. Article 4 of Regulation EC No. 733/2002 of April 22, 2002 states very clear that “the Registry must observe the rules, policies and procedures laid down in this Regulation and the contracts referred to in Article 3”. The ADR Panel is of the opinion that the Respondent even though it has been afforded sufficient time and opportunity to respond to the Complaint, has ignored the official time limits imposed by the Rules and filed arguments lately.

It belongs to the ADR Panel, in its sole discretion, to accept or not out-of-time submissions by virtue of Paragraph 8 of ADR Rules. The ADR Panel carefully reviewed the arguments of the Respondent (contained in Response to Complaint and Nonstandard Communication from June 29, 2006) and having the above mentioned Respondent’s default in mind, decided to consider Respondent’s arguments in deciding the case from the following reasons: (1) The domain name cannot be registered in the favor of the Applicant if Applicant’s prior rights are not proved according to the Public Policy Rules and the Sunrise Rules. This conclusion cannot be affected by the late Response to Complaint. (2) Besides that the failure of the Applicant to submit License Declaration follows from the EURid’s Response to the Czech Arbitration Court Request for EURid Verification from April 27, 2006, the annex of which was the Documentary Evidence related to the disputed domain name including the official certificate of German Patent and Trade Mark Office indicating that the trade mark ESSER is registered for Novar GmbH only.

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	**Petr Hostas**

DATE OF PANEL DECISION 2006-07-13

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Applicant as the licensee of the holder of the trade mark ESSER applied for the registration of domain name esser.eu. The Applicant failed to submit all necessary documents related to the registration – he submitted the official certificate of the German Patent and Trade Mark Office only, but the certificate did not include anything about license or other rights of the Applicant to the respective trade mark. According Section 20.1 of the Sunrise Rules, if an Applicant is a licensee 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 (License Declaration) duly completed and signed by both the licensor and the licensee. As the Applicant failed to submit the License Declaration, he did not prove his prior rights and the domain name could not be registered for him.

The argument, that the submitted documents were lost, is not relevant as the EURid expressly confirmed that the License Declaration was not provided as a part of Documentary Evidence and the Complainant did not offer any evidence that the License Declaration was really filed to the validation agent.

The arguments that there has been made a mistake by the validation agent and that the validation agent should investigate the missing information or documents are not relevant too. The validation agent is entitled to review the submitted documents and if it finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this. In this case, the provided documentary evidence did not substantiate a prior right of an Applicant. The validation agent has no opportunity how to identify a licensee of a trade mark without the license agreement or declaration.

From all of these reasons the Complaint was denied.