Panel Decision for dispute CAC-ADREU-001115

Case number	CAC-ADREU-001115
Time of filing	2006-05-09 17:07:15
Domain names	aventis.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	SANOFI AVENTIS, Carole TRICOIRE

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 other legal proceedings which are pending, or have been decided, and which relate to the disputed Domain Name.

FACTUAL BACKGROUND

The complainant is owner of several trademarks and toplevel domain “AVENTIS”. The Complainant is actively defending his trademark rights on the term AVENTIS.

In accordance with the “.eu Sunrise Rules”, the Complainant has instructed a Registrar, Register.com, to file applications the domain name aventis.eu among many other domain names in “.eu”.

The application for domain name aventis.eu was applied on December 7, 2005 at 11:02:39.463 and arrived in first position in the queue of the applications made for this domain name.

The deadline for submititon of the documentary evidence was January 16, 2006. The Compliant submitted relevant documentary evidence and the processing agent received the documentary evidence on January 16, 2006.

On March 23, the Complainant received an e-mail from EURid informing him that his application for the domain name aventis.eu was rejected. In this e-mail EURid pretended that the documentary evidence received did not sufficiently prove the right claimed.

The Complainant has immediately contacted his Registrar in order to obtain information concerning the documents sent to EURid. The Registrar, that concluded an agreement with Price WaterHouseCoopers Business Advisors BCBVA and EURid in order to transmit documentary evidences electronically, said that there was an error that occurred with the script used by the Registrar to rename the trademark files with the appropriate application code (“barcode”) in order to submit the documentation to the Validation Agent since the Validation Agent required that Registrars submit documentation named with corresponding application code.

The script actually submitted two trademark documents for the application for domain name aventis.eu. Both files received the same application code because the script automatically found two files with the word “Aventis” in it. As both files were labeled with the same application code therefore the script submitted two PDF formatted files with two separate trademark documents in each.
The Validation Agent only took in consideration the file first arrived which contained “Sanofi-Aventis” trademark and EURid rejected the application while the file second arrived contained “aventis” trademark.

A. COMPLAINANT

The AVENTIS trademark of the Complainant is world famous, and the Complainant is actively defending his trademark rights on the term AVENTIS.

The Complainant submited all necessary Documentary evidence proving his prior rights in due time following the “Sunrise Rules”.

The Complainant contends, that the error in automated process of application could not be influenced by the Complainant. However all requirements for the registration were fullfiled by the second arrived file.

The Complainant contends that the Respondents desicision is contradiction with the Regulation (EC) No. 874/2004.

The Complainant asks the Panel to reconsider EURid decision concerning its application for the domain name aventis.eu.

B. RESPONDENT

The Respondents contends that, The Complainant's SANOFI-AVENTIS trademark conflicts with article 10 (2) of the Regulation whereas the Article 10 (2) of the Regulation states, that the domain name applied for must correspond to the complete name of the trademark. The Respondent contends that, In this case, the Complainant's trademark consisted of the sign SANOFI-AVENTIS. Pursuant to article 10 (2) of the Regulation, the corresponding domain name for that trademark is sanofi-aventis.eu, whereas the Complainant applied for aventis.eu.

Article 14 (4) of the Regulation states that every applicant must submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question. The Respondent therefore correctly applied the rules set forth in the Regulation.
The Respondent further contends that the Respondent did consider all the documentary evidence it received.

The Respondent note that exhibit 20 of the Complainant is an affidavit signed by the Complainant's registrar. In this affidavit, the Complainant's registrar accepts that a technical error had occurred in its own electronic filing system. The result of this error, the Complainant's registrar states, was that the two trademarks which the Complainant allegedly submitted were given the same document number. However, the Complainant's registrar appears to be saying that the two documents, although they carried the same number, were both sent to the Respondent as documentary evidence. Its error, the Complainant's registrar appears to be arguing, could not have had any effect on the validity of the documentary evidence.

The Respondent futher noted that the Complainant did not submit any evidence that its registrar actually submitted the AVENTIS trademark, in the line of the confirmation notice, which the Complainant submitted as exhibit 15. It merely filed an affidavit of its registrar.

The Respondent contends that it did not receive the AVENTIS trademark the Complainant refers to. The Respondent only received the SANOFI-AVENTIS trademark. The Respondent now submits all documentary evidence it has received for the Complainant's application. This documentary evidence clearly shows that only a certificate for the SANOFI-AVENTIS trademark was submitted.

The Respondent refers to article 22 (1) b of the Regulation. Pursuant to this article, an ADR procedure may be initiated by any party where a decision taken by the Respondent conflicts with this Regulation or with Regulation (EC) No 733/2002. In the case at hand, the mistake was made by the Complainant's registrar, not by the Respondent. The Respondent’s decision was correct and may not be annulled as a result of an error made by the Complainant. Indeed, the Complainant's registrar's mistakes cannot be attributed to the Respondent. If no valid documentary evidence is submitted to the Respondent, the Respondent will not be able to asses if the applicant is the holder of a prior right.

Finally, the Respondent refersl to article 21 (2) of the Sunrise Rules which 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.
For the reasons mentioned above, the Complaint must be rejected.

DISCUSSION AND FINDINGS

The Complainant proved, that he is, the owner of several national, community and international registered trademarks AVENTIS. The AVENTIS trademark of the Complainant is world famous, and the Complainant is actively defending his trademark rights including active defence of AVENTIS Top Level Domain names against cybersquater.

The Complainant has, in accordance with the “Sunrise Rules”, instructed a Registrar, Register.com, to file applications of many .eu

domain names. One of them is the domain name AVENTIS. The application arrived in first positon in the queue of the applications made for this domain name.

The Complainant submitted necessary Documentary evidence in time to the processing agent, before deadline, on January 16, 2006.

On March 23, the Complainant received an e-mail from EURid informing him that his application for the domain name aventis.eu was rejected. In this e-mail EURid pretended that the documentary evidence received did not sufficiently prove the right claimed.

It has been proved that there was an error that occurred with the script used for submition of documentation to the Validaton Agent the trademark files with the appropriate application code ("barcode") in order to submit the documentation to the Validation Agent since the Validation Agent required that Registrars submit documentation named with corresponding application code.

The script actually submitted two trademark documents for the application for domain name aventis.eu. Both files received the same application code because the script automatically found two files with the word "Aventis" in it.

As both files were labeled with the same application code therefore the script submitted two PDF formatted files with two separate trademark documents in each.

The Validation Agent only took in consideration the file first arrived which contained "Sanofi-Aventis" trademark and EURid rejected the application while the file second arrived contained "aventis" trademark.

The Registrar chosen by the Complainant has been accredited by the Registry and the Complainant was entitled to trust in its technical abilities.

The Complainant met all the requirements set forth in the Regulation by sending in time the correct set of Documentary Evidence proving his prior rights on the trademark to the approved Registrar.

The Complainant did all reasonable and necessary actions compliant with the Regulation to protect its prior rights and did not make any error or mistake except from entrusting the a Registrar fully accredited by EURid and the automated process of the application.

Taking in consideration the fairness and reliability principles stated out in" Sunrise rules" and Regulation EC 733/2002, and in consideration of the aim of the phased registration procedure stressed out by paragraph 12 of Regulation EC 874/2004 which is to "safeguard prior rights recognized by Community or national law" the Respondent should have considered the second set of documents sent by the Complainant's accredited registrar.
Therefore the Panel finds that the Respondent decision is in contrary to the aim defined in Regulation EC No 874/2004 in its paragraph 12.

DECISION

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

PANELISTS

Name	**Premysl Libal**

DATE OF PANEL DECISION 2006-07-30

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant has, in accordance with the "Sunrise Rules", instructed a Registrar, to file applications of many .eu domain names. One of them is the domain name AVENTIS. The application arrived in first positon in the queue of the applications made for this domain name. The Complainant submitted necessary Documentary evidence in time to the processing agent, before deadline.

An an error that occurred with the script used for submition of documentation from the Registrar to the Validaton Agent. The script actually submitted two trademark documents for the application for domain name aventis.eu. Both files received the same application code because the script automatically found two files with the word “Aventis” in it. As both files were labeled with the same application code therefore the script submitted two PDF formatted files with two separate trademark documents in each.

The Validation Agent only took in consideration the file first arrived which contained “Sanofi-Aventis” trademark and EURid rejected the application while the file second arrived contained “aventis” trademark.

The Complainant met all the requirements set forth in the Regulation by sending in time the correct set of Documentary Evidence proving his prior rights on the trademark to the approved Registrar.
Taking in consideration the fairness and reliability principles stated out in” Sunrise rules” and Regulation EC 733/2002, and in consideration of the aim of the phased registration procedure stressed out by paragraph 12 of Regulation EC 874/2004 which is to “safeguard prior rights recognized by Community or national law” the Respondent should have considered the second set of documents sent by the Complainant’s accredited registrar.
Therefore the Panel finds that the Respondent decision is in contrary to the aim defined in Regulation EC No 874/2004 in its paragraph 12.