Entscheidung der Schiedskommission for dispute CAC-ADREU-001167

Case number	CAC-ADREU-001167
Time of filing	2006-05-23 14:10:23
Domain names	daddy.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	SUCRE UNION DISTRIBUTION, Mr. MATTHIEU SIMONIN

Respondent

Organization / Name	EURid

ANDERE RECHTLICHE VERFAHREN

None

SACHLAGE

The Complainant is a French GIE called “SUCRE UNION DISTRIBUTION”, with registered address at 27/29, rue Chateaubriand, 75008 Paris, France. The Complainant is the owner of a trademark “DADDY” registered in France since September 2000.

On January, 16, 2006, an application for the domain name “DADDY.EU” was filed. The applicant is: “SUCRE UNION”, with registered address at 27-29, rue Chateaubriand, 75008 PARIS, France.

The applicant provided timely the documentary evidence. It comprises notably:

- the standard cover letter

- a copy of the certificate of registration for the trademark in France, in the name of the French GIE “SUCRE UNION DISTRIBUTION” mentioned here above.

The application was refused by the Registrar based on the fact that the applicant is not the owner of the trademark (the first one is “SUCRE UNION” where the second is “SUCRE UNION DISTRIBUTION”).

A. BESCHWERDEFÜHRER

Complainant mainly refers to article 10 of EC Regulation 874/2004 and is of the view that it is the holder of a prior right and should be awarded the domain name. The Complainant doesn’t really tackle the problem of the discrepancy of the names.

B. BESCHWERDEGEGNER

First argument of Respondent is that the Complaint has been filed too late. Respondent recalls that the Sunrise Appeal period (as defined in the ADR Rules) is 40 days after the Respondents decision to grant/reject a domain name and that the

whois for the disputed domain name shows that this term expired on May 2, 2006, where the complaint was received by e-mail on 2006-05-23 and in hardcopy on 2006-05-29 by the Czech Arbitration Court.

In subsidiary order, the Respondent also mentions that it rejected the application of the applicant as it concluded from the examination of the documentary evidence that he was not the actual owner of the DADDY trademark. The document submitted as documentary evidence stated a different company as the owner of the DADDY trademark: the first one is "SUCRE UNION" where the second is "SUCRE UNION DISTRIBUTION".

WÜRDIGUNG UND BEFUNDE

On the procedure

Having experienced technical problems on the ADR.EU website, the Complainant sent its complaint by e-mail on May, 2, 2006. In order to secure the filing, it also sent it by registered mail on the same day.

On May, 3, 2006, after contact with the Arbitration Court, the latter accepted a prolongation of the delay for the filing, up to May, 8, 2006.

Because the 8th of May 2006 was a public holiday in the Czech Republic, the final date must be postponed to the 9th of May pursuant to the Procedural Rules.

The Complaint was filed again on the platform on May 5, 2006 and a copy of it was sent by registered mail on May 5, 2006. This registered mail reached the Arbitration Court on May, 9, 2006.

The Complaint has been filed on time.

On the ground

There is no doubt on the fact that the applicant could have prepare its case better than it did: the applicant is "SUCRE UNION" where the holder of the trademark is "SUCRE UNION DISTRIBUTION".

The question is whether or not this discrepancy in the name was enough for the Registry to conclude to the lack of prior right or, at least, to the absence of evidence of the prior right.

oOo

As ruled in case 642 (CRUX), the issue is whether the acquisition of rights (based even on prior rights) in the European Union will depend on the question of whether the applicant has filled in correctly a form, or whether such acquisition will depend on sound and thorough assessment of the filings of the applicants, based on communication with the applicants.

The Panel is of the opinion that current legal rules governing the registration process of EU domain names contain sound provisions, which create a balanced situation between the obligations of the applicant and those of the Registry.

Reference is made, on the one side and among others, to the burden of the proof which is clearly on the Applicant's side, as well as to the fact that the ADR is not a second chance to correct deficiencies in the initial application.

Reference is made, on the other side and among others, to Recital 12 of the Regulation 874/2004, under which the aim of the

registration process is to ensure that holders of prior rights have appropriate opportunities to register names on which they hold prior rights. It further follows from this recital that validation agents should assess rights claimed for a particular name properly. Reference is further made to Article 14 of the Regulation No 874/2004, under which the validation agent should "examine" the application.

Under Sunrise Rules, Article 21.3, the validation agent may, at his own discretion, conduct investigation into the circumstances of the respective application.

The Panel appreciates the high number of application received and processed by the Respondent, and the Panel also understands the tendency of the Respondent to apply automated processes or to adopt a formalistic approach to cope with all these applications.

But the Panel also appreciates the respective legal provisions cited above which put the Respondent under a clear legal obligation to "examine" the application (Art. 14 of the Regulation 874/2004) and to "assess" the respective right of the applicant (recital 12 of the Regulation 874/2004.

Without prejudice to the obligations of the applicant, it is clear in the Panel view that these obligations to examine and assess are clearly in conflict with the absolute idea of an uncompromised automated process or a disproportionate formalistic approach.

Also, as cited in MOTORLAND, the Regulation created a thorough legal scheme for ADR. Where would be the sense of this if the Panel was only supposed to verify that a clerical system based on a strict formalistic approach was applied? There was no need for hiring dozens of prominent lawyers and university teachers for such verification, or to develop a comprehensive set of procedure rules. On the contrary, the Panel received the power, under the ADR, to provide the necessary corrections to procedures and decisions of the Respondent, where the facts of the case allows so, and where such procedure is admissible under the ADR Rules and the respective legal provisions governing the registration process.

oOo

When the Panel applies this theory to the facts of the present case, it concludes that:

- As a matter of fact, the Applicant's name did not exactly match the prior right holder's name;

But:

- The name of the Applicant and the name of the trademark holder are differentiated only by one single word "Distribution";

- This differentiation comes at the third position in the name (both begin with "SUCRE UNION");

- The address of the trademark owner is written in whole in the certificate provided to the verification agent and this address is exactly the same as the Applicant's;

- The domain name DADDY.EU reproduces without any subtraction or addition the trademark;

Taking theses facts into consideration, the Panel is convinced that it was within the powers and possibilities of the Respondent to ask the Complainant for explanation of the names used in the application form and the Respondent could have proceeded in compliance with the above mentioned legal provisions.

The Respondent decided, within his discretionary power, not to do so during the registration proceeding.

As a consequence, the Panel decides to provide for the necessary correction of the procedure of the Respondent, to annul Respondent’s decision and to order the registration of the domain name in the name of the Complainant.

ENTSCHEIDUNG

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

the domain name DADDY be transferred to the Complainant

PANELISTS

Name	**Etienne Wery**

DATUM DER ENTSCHEIDUNG DER SCHIEDSKOMMISSION 2006-12-05

Summary

EINE ENGLISCHSPRACHIGE KURZFASSUNG DIESER ENTSCHEIDUNG IST ALS ANLAGE 1 BEIGEFÜGT

When the final day for the filing of a Complaint is a public holiday in the Czech Republic where the Court is established, the final day must be postponed to the next working day in the Czech Republic.

As a matter of fact, the name of the applicant is slightly different from the name of prior right holder. The question is whether or not this discrepancy in the name was enough for the Registry to conclude to the lack of prior right or, at least, to the absence of evidence of the prior right.

The Panel is of the opinion that current legal rules governing the registration process of EU domain names contain sound provisions, which create a balanced situation between the obligations of the applicant and those of the Registry.

Reference is made, on the one side and among others, to the burden of the proof which is clearly on the Applicant’s side, as well as to the fact that the ADR is not a second chance to correct deficiencies in the initial application.

Reference is made, on the other side and among others, to Recital 12 of the Regulation 874/2004, article 14 of the Regulation No 874/2004 and article 21.3 of the Sunrise Rules. The respective legal provisions put the Respondent under a clear legal obligation to “examine” the application and to “assess” the respective right of the applicant.

Based on the facts of the case, the Panel is convinced that it was within the powers and possibilities of the Respondent to ask the Complainant for explanation of the names used in the application form and the Respondent could have proceeded in compliance with the above mentioned legal provisions.