Panel Decision for dispute CAC-ADREU-001186

Case number	**CAC-ADREU-001186**
Time of filing	**2006-05-10 12:01:41**
Domain names	**erdgas.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**E.ON Ruhrgas AG, Dirk Bauer**

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

I am unaware of any other legal proceedings related to the disputed domain name

FACTUAL BACKGROUND

During the Sunrise Period I, the Complainant (then the Applicant) applied for registration of the domain “erdgas.eu”. The Complainant supported its application with a certified copy of its German Trade Mark registration for the word mark “Erdgas” (the Trade Mark”). Importantly, the Trade Mark registration certificate was in the name of “Ruhrgas Aktiengesellschaft” whereas the name of the Applicant was shown as “E.ON Ruhrgas AG”.

The Complainant maintains that it also filed with its application an Essen Court extract (the ‘Extract’) which documented the Applicant’s previous change of name from Ruhrgas Aktiengesellschaft to E.ON Ruhrgas AG. The Respondent denies that the Extract was ever received.

It is not disputed that the Applicant was, in fact, the legal entity which owned the said Trade Mark registration.

A. COMPLAINANT

The Complainant applied for the domain name registration of “erdgas.eu” during Sunrise period I. The Complainant in support of its application submitted an authenticated certificate of registration of the German trademark No. 39819426 in due time. The name of the trademark owner, printed on the certificate of registration is “Ruhrgas AG”. The Complainant states that this legal entity has changed its name to “E.ON Ruhrgas AG” on 1 July 2004.

The Complainant also maintains that it submitted in due time in the Sunrise period I an extract from the Essen Local Court Commercial Register which proves the change of the name of owner (legal entity No. HRB 83) of the Trade Mark.

The Complainant states that "Independent from the proof of the change of the name, legally, the owner of the German trademark No. 39819426 is identical with the applicant for the domain name “erdgas”, because the applicant for the domain name and the trademark owner of the German trademark No. 39819426 is the same legal entity HRB 83. The extract from the Essen Local Court Commercial Register that proves the change of the name of the owner of the trademark No. 39819426 has obviously been ignored by the EURid...".

The Complainant seeks the decision, taken by the Registry to be annulled, "because the Complainant has proved in due time that he is the holder of at least one prior right in the meaning of Article 10 (1) of Commission Regulation No. 874/2002, i. e. the registered German trademark No. 39819426 “erdgas”."

As part of its Complaint, the Complainant submitted further evidence of its ownership of a number of registered "erdgas" trade marks, all of which showed E.ON Ruhrgas AG as the owner. However, this evidence was not submitted in the application and is therefore not relevant to this decision.

B. RESPONDENT

The Respondent maintains that the burden of proof is with the Complainant; Article 10 (1) of the Regulation stating that only the holder of a prior right is eligible to be granted the corresponding domain name. A type of prior rights accepted by the Regulation is a registered trademark.

The Respondent states that 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 Panel in case n° 00119 (NAGEL) clearly 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. That the burden of proof is with the applicant is also clear from section 21 (3) of the Sunrise Rules, which states that the validation agent is not obliged, but 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. Thus, it should be clear that the documentary evidence submitted by the Complainant should stand on its own and prove that the Complainant is the holder of a prior right.

The Respondent states that thePanel in case n° 541 (ULTRASUN) agreed that: the validation agent is not obliged to investigate whether the applicant did at one stage own the prior right. Under the Sunrise Rules, the validation agent is only concerned with establishing the prima facie ownership of the prior right at the time of the application and based on the documents filed by the applicant.

The Respondent states that the documentary evidence did not prove that the Complainant was the holder of the ERDGAS trademark. 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 states that it appears from the documentary evidence submitted by the Complainant that a company named Ruhrgas Aktiengesellschaft is the owner of the ERDGAS trademark which was invoked as prior right in the application whereas the Complainant's name is E. ON Ruhrgas AG.

The Respondent draws attention to section 21.2 of the Sunrise Rules that expressly state that the Validation Agent will examine 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. It means that an applicant should not expect the Registry or Validation agent to engage in speculation and/or embark upon its own enquiry in relation to the exact connection between two entities

The Respondent relies on the decision in case n° 294 (COLT).

The Respondent maintains that it did not receive an extract from the Companies Register showing that the name of the Trade Mark owner had changed. As the Respondent was in no position to assess if the Complainant was actually the holder of a prior right in the ERDGAS trademark, the Respondent considers it was correct to reject the Complainant's application.

New documents submitted by the Complainant, namely evidence of trade mark ownership, were first seen in the context of these ADR proceedings. In the present case, the Respondent considers that the Complainant did not prove the timely substantiation of the Prior Right and a copy of the articles of incorporation, enclosed with the Complaint, was submitted too late to be considered.

The Respondent requests the Panel in the case at hand to disregard the extract of the register of the Companies House as it was submitted for the first time to the Respondent in the framework of the present ADR proceedings. For the reasons mentioned above, the Complaint must be rejected.

DISCUSSION AND FINDINGS

Despite requests, the Complainant has not been able to prove that the Extract was ever filed with the application or within the relevant timeframe. Had they been able to do so, this decision would have had to favour the Complainant. However, in their response to a request for evidence of the submission of the Extract, the Complainant was of the view that even if it had not filed the Extract it was nevertheless entitled to registration of the erdgas.eu domain. Given the Complainant’s position and in view of the fact that the Complainant has not been able to prove that the Extract was submitted, I must proceed on the basis that the Extract was never submitted.

The key issue concerns the difference between the name shown on the Trade Mark certificate and that shown on the application (i.e.

“Ruhrgas Aktiengesellschaft” as opposed to “E.ON Ruhrgas AG”).

The Complainant relies on Article 10 of the Commission Regulation No. 874/2004 which it maintains entitles it to registration of the erdgas.eu domain by virtue of the fact that the applicant was the actual owner of the trade mark.

However, Article 10(1) simply states that holders of prior rights “shall be eligible to apply to register domain names..”, such that this Article gives rise to a right to apply (which the Complainant duly exercised) rather than an automatic right to registration. This principle is also reflected in the preamble to the same Regulation, which refers to giving the holders of prior rights the “opportunity” to register the names in which they hold rights.

I therefore reject the Complainant's submission that Article 10 alone was sufficient to entitle the Complainant to registration of the erdgas.eu domain.

In the same Regulation (No. 874/2004) the standards for applications are referred to in Articles 14(1) and 14(4) which state, respectively, that “claims for prior rights under Articles 10(1) and 10(2) must be "verifiable by documentary evidence” and that “Every applicant shall submit evidence that he or she is the holder of the prior right claimed on the name in question”. From this it seems plain that the onus of proof is on the applicant and that the duty extends to showing that they are the holder of that right.

This view is further evidenced in the Sunrise Rules. Section 13(2) states that the documentary evidence submitted must “clearly evidence that the Applicant is the reported owner of the registered trade mark”. Section 4(1)(iii) states that the documentary evidence should be “..complete, accurate, up-to-date..”

The Complainant was aware, or should have been aware, of these requirements at the point of filing its application and in my view has failed to demonstrate in the documentary evidence submitted that it, the then applicant, was the owner of the prior right claimed. I am conscious that the Regulations and the Rules make reference to the applicant and do not qualify that as meaning the actual underlying legal entity, which is the interpretation the Complainant would seem to prefer. The documentary evidence submitted was incomplete and was out of date.

It appears that at the time of the application the Complainant was the owner of a number of trade mark registrations for various "erdgas" marks and it submitted evidence of these with its Complaint. These marks all appear to show the Complainant (i.e. E.ON Ruhrgas AG) as the owner of these marks but as this information was first submitted in the course of these ADR proceedings, they are not relevant to the application filed by the Complainant.

The Complainant has not raised the issue of the conduct of the validation agent in their Complaint, so I do not feel bound to consider this. Nevertheless, I think it is worth briefly considering the role of the validation agent. Section 21(2) of the Sunrise Rules states that the validation agent shall base their examination of prior rights “..exclusively on the basis of a prima facie review of the first set of Documentary Evidence received..” and Section 21(3) makes it clear that the validation agent has no obligation to conduct its own investigations into the circumstances of the application.

In the circumstances, and bearing in mind the duty of the validation agent to try to ensure that the applicant, as shown on the application, demonstrates the appropriate ownership of the prior right, I am of the view that the validation agent in this case was not presented with documentary evidence which on a prima facie review demonstrated the right of the applicant to ownership of the Prior Right. As to whether they should have carried out further investigations, I am conscious that this is specifically called out in the Rules as not being an obligation and to be done in their sole discretion. In the circumstances of this case, I do not consider that the validation agent acted so unreasonably as to justify overriding the exercise of that discretion.

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	**James Mitchell**

DATE OF PANEL DECISION 2006-08-11

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant has not been able to prove that an Essen Court extract was ever filed with the application or within the relevant timeframe and I must therefore proceed on the basis that the extract was never submitted. The absence of the extract creates a difference between the name shown on the Trade Mark certificate and that shown on the application (i.e. “Ruhrgas Aktiengesellschaft” as opposed to “E.ON Ruhrgas AG”).

The Complainant relies on Article 10 of the Commission Regulation No. 874/2004 which it maintains entitles it to registration of the erdgas.eu domain by virtue of the fact that the applicant was the actual owner of the trade mark. However, I consider that Article 10(1) gives rise to a right to apply (which the Complainant duly exercised) rather than an automatic right to registration. I therefore reject the Complainant's submission that Article 10 alone was sufficient to entitle the Complainant to registration of the erdgas.eu domain.

I further consider that Articles 14(1) and 14(4) of Regulation No. 874/2004 place the onus of proof on the applicant and that the duty extends to showing that they are the holder of the prior right. This view is further evidenced in the Sunrise Rules, section 13(2) and section 4(1)(iii). The Complainant was aware, or should have been aware, of these requirements at the point of filing its application and in my view has failed to demonstrate in the documentary evidence submitted that it, the then applicant, was the owner of the prior right claimed. The documentary evidence submitted was incomplete and was out of date.

In the circumstances, and bearing in mind the duty of the validation agent to try to ensure that the applicant, as shown on the application, demonstrates the appropriate ownership of the prior right, I am of the view that the validation agent in this case was not presented with documentary evidence which on a prima facie review demonstrated the right of the applicant to ownership of the Prior Right. As to whether they should have carried out further investigations, I am conscious that this is specifically called out in the Rules as not being an obligation and to be done in their sole discretion. In the circumstances of this case, I do not consider that the validation agent acted so unreasonably as to justify overriding the exercise of that discretion.