Panel Decision for dispute CAC-ADREU-001195

Case number	**CAC-ADREU-001195**
Time of filing	**2006-05-10 11:54:25**
Domain names	**diehl-controls.eu, ako.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Diehl Informatik GmbH**

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 other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

On December 7th 2005, the company “Diehl Informatik GmbH” applied for registration of the disputed domain names “AKO.EU” and “DIEHL-CONTROLS.EU” pursuant to article 10 (1) of Commission Regulation EC n. 874/2004, April 28, 2004 (phased registration).
The trademarks used for the registration application are DIEHL CONTROLS (trademark no. 30076257.7 registered on 13.09.2001, International Classes 7, 9, 11 and 12) and AKO (trademark no. 1187894 registered on 15.07.1993, International Classes 7, 9, and 11), both registered in the name of Diehl AKO Stiftung & Co. KG.

On January 10th 2006 Applicant sent documentary evidence to the Validation Agent, that refused the validation on 30.03.2006 (DIEHL-CONTROLS.EU) and 27.04.2006 (AKO.EU) on the basis that the Applicant did not include any evidence of its ownership (or license agreement) of the trademarks.

On May 9th 2006 the Complainant filed a complaint with the Czech Arbitration Court against the decision of EURid not to validate the applications for domain names DIEHL-CONTROLS.EU and AKO.EU.

The formal date of commencement of the ADR proceeding was May 10th 2006.

The ADR proceeding was commenced pursuant to the Regulations (EC) No. 733/2002 and No. 874/2004 (the Regulations).
In accordance with Paragraph B2 (a) of the EU Dispute Resolution Rules (ADR Rules), the Czech Arbitration Court has verified that the complaint satisfies the formal requirements of the ADR Rules and ADR Supplemental Rules of the Czech Arbitration Court.

Diehl Informatik GmbH opted to have the dispute decided by a single-member panel.

The undersigned Mr. Davide Luigi Petraz was chosen as panelist for the present case, and accepted the Statement of Acceptance and Declaration of Impartiality and Independence.

A. COMPLAINANT

Diehl Informatik GmbH in its complaint simply observed that Complainant is licensee of the trademarks "Diehl Controls" and "AKO" of "Diehl AKO Stiftung & Co. KG", attaching copies of licence declarations for such trademarks.

Therefore, Complainant requests that the decision by EURid not to validate the domain names DIEHL-CONTROLS.EU and AKO.EU in his

name has to be annulled.

B. RESPONDENT

Respondent argues that:

1) The owner of AKO and DIEHL CONTROLS trademarks is Diehl AKO Stiftung & Co. KG , not the Complainant. The documentary evidence which the Complainant submitted to the Validation Agent did not contain any licence declarations.

2) 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 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. On this basis, Applicant failed to demonstrate his rights.

3) The licence declarations, which the Complainant submitted to the respondent for the first time in the framework of the present ADR proceedings, were signed on April 27/28, 2006 whereas the domain names were applied for on December 7, 2005 (nearly 5 months later). The Complainant was therefore not licensed to use these trademarks at the time of application. Pursuant to Article 10 (1) of the Regulation, the Complainant was therefore not entitled to apply for the AKO and DIEHL-CONTROLS domain names.

For the reasons mentioned above, Respondent claims that the complaint must be rejected.

DISCUSSION AND FINDINGS

Complainant mentions the fact that Diehl Informatik GmbH is a licensee of the trademarks DIEHL CONTROLS and AKO, registered by Diehl AKO Stiftung & Co. KG. However, Complainant did not include evidence of this fact in the documentary evidence sent to Validation Agent at the time of validation.

Article 10 (4) of Commission Regulation (EC) No 874/2004 states that the documentary evidence must clearly show that the applicant is the holder of the prior right claimed on the name in question.
This means that the Applicant could not necessarily be the actual owner of the prior right in the corresponding domain name, as it may be licensed by the actual owner to use the prior right in applying for the corresponding domain name.
In the latter case, Article 20 (1) of the Sunrise Rules states that if an Applicant has obtained a licence for a registered trademark in respect of which it claims a Prior Right, it must enclose with the documentary evidence a license declaration, a draft of which EURid also made publicly available with Sunrise Rules.
In this procedure, it is clear that Complainant, acting as a licensee from the actual owner of the trademarks, did not fulfil this requirement.

On the matter of lack of documentary evidence, there are a set of cases that could be quoted to summarize the most common interpretation of above-mentioned Regulation and Sunrise Rules.
In particular, Panelist in case no. 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.”
In this specific case, that could be assumed as the most similar to the one discussed here, Complainant did not submit any licence declaration as documentary evidence, and this led to the denial of the complaint.
Moreover, in case no. 294 (COLT), the Panelist stated that:
“In this respect, the attention must be drawn on 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.”
Also this Complaint has been denied.

Finally, on the matter of license declarations sent by Complainant during this ADR proceeding, Panelist finds himself in agreement with the colleague in case no. 894 (BEEP), where the Panelist stated:
“If there would be exceptions in favour of the Applicant, allowing additional submissions of evidence after the forty day period, it would affect the legitimate expectancy of the next Applicant in the queue for the domain name in question and conflict with the first come first served principle set out in Article 14 of the Commission Regulation (EC) No 874/2004. Consequently, the license declaration submitted by the Complainant in this ADR proceeding cannot be admitted as evidence substantiating a Prior Right.”

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	**Davide Luigi Petraz**

DATE OF PANEL DECISION 2006-08-01

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Company “Diehl Informatik GmbH” applied for registration of the disputed domain names “AKO.EU” and “DIEHL-CONTROLS.EU”. The trademarks used for the registration application are DIEHL CONTROLS and AKO, both registered in the name of Diehl AKO Stiftung & Co. KG.
Validation Agent refused the validation of both domains on the basis that the Applicant did not include any evidence of its ownership (or license agreement) of the trademarks.

Article 10 (4) of Commission Regulation (EC) No 874/2004 states that the documentary evidence must clearly show that the applicant is the holder of the prior right claimed on the name in question.
This means that the Applicant could not necessarily be the actual owner of the prior right in the corresponding domain name, as it may be licensed by the actual owner to use the prior right in applying for the corresponding domain name.
In the latter case, Article 20 (1) of the Sunrise Rules states that if an Applicant has obtained a licence for a registered trademark in respect of which it claims a Prior Right, it must enclose with the documentary evidence a license declaration, a draft of which EURid also made publicly available with Sunrise Rules.
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For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint is Denied.