Panel Decision for dispute CAC-ADREU-001299

Case number	CAC-ADREU-001299
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Domain names	4ce.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Vattenfall Europe Netcom GmbH, Boris Rogowski

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

None

FACTUAL BACKGROUND

The Complainant was formerly named “VEAGCOM Telekommunikationgesellschaft mbH” but changed its name to its present name, “Vattenfall Europe Netcom GmbH” on 23 March 2004. The Complainant registered the trademark “4cE” in Germany pursuant to an application dated 20 October 2000 which was granted on 16 February 2001. The application for and registration of the trademark were made under its former name.

The Complainant applied through a provider to register the domain name 4ce.eu on 7 December 2005 during the Sunrise Period, giving its name as “VEAGCOM Kommunikationgesellschaft mbH”. The Complainant subsequently filed documentary evidence consisting of a certificate of registration of the trademark “4cE” in Germany under its former name “VEAGCOM Telekommunikationgesellschaft mbH”.

No other party applied to register the same domain name during the Sunrise Period.

The Respondent rejected the application on the ground that the name of the owner of the prior right according to the evidence (VEAGCOM Telekommunikationgesellschaft mbH) differed from the name of the applicant according to the application (VEAGCOM Kommunikationgesellschaft mbH).

A. COMPLAINANT

The Complainant identifies articles 3 and 14 of Regulation 874/2004 (“the Regulation”) as the applicable legal provisions.

The Complainant contends that the inaccuracy in its name on the application was immaterial, being merely the omission of the letters “Tele” from the descriptive part of the name which does not serve to distinguish the Complainant from other companies. Furthermore, there has never been a company called “VEAGCOM Kommunikationgesellschaft mbH”, so it was apparent that there was merely a typographical error in the application for the domain name.

The Complainant points out that it is clear from the evidence filed with its Complaint that it is the lawful holder of the trademark “4ce” and therefore eligible for registration on the basis of prior rights pursuant to article 10(1) of the Regulation.

The Complainant submits that to uphold the Respondent’s rejection of the Complaint would be contrary to the spirit of the Regulation, which should be interpreted in a manner congruent with its objectives, including the first-come-first-served principle identified in its recital 11 and the safeguarding of prior rights identified in its recital 12. The Complainant also contends that article 14 of the Regulation

does not prevent the correction of non-material errors during the ADR procedure.

The Complainant points out that no other party sought to register the domain name during the Sunrise Period and thus there is no conflict with another party claiming a prior right which needs to be resolved. On the other hand, if the rejection is upheld, there is a risk that the domain name might be registered by a third party with no lawful interest.

Following the Response, the Complainant filed a Nonstandard Communication containing additional submissions. In these submissions, the Complainant explains that its agents had sought to make the application in the Complainant's former name because they were confused by the poor quality German translation of the Sunrise Rules. However, the former name was still the name of the Complainant since it continued to identify the Complainant.

The further submissions go on to draw attention to the decisions in cases nos. 174 DOMAINE, 253 SCHOELLER and 768 DELCAM as upholding the proposition that, where a minor discrepancy is identified, the validation agent should make simple inquiries to determine the true position.

B. RESPONDENT

The Respondent contends that the documentary evidence did not establish that the applicant for the domain name was the owner of the prior right relied upon since the name of the applicant according to the application differed from the name of the proprietor of the trademark relied upon according to the submitted certificate of registration. The Respondent points out that the two entities could have been different companies and refers to cases nos. 810 AHOLD and 1625 TELEDRIVE as confirming that an application should not be accepted in these circumstances.

The Respondent adds that the inaccuracy in the application was all the more material in that the name given for the applicant did not at all resemble the Complainant's current name.

The Respondent notes that it is not the purpose of the ADR procedure to correct mistakes made by the Applicant in the application and refers to the observation of the Panel in case no. 219 ISL that "One could argue that sympathy is overruled by the applicable Regulations serving among other purposes the (cost-effective) functionality of the phased registration and the principles hereof".

The Respondent does not accept the argument that allowing the application would accord with the spirit of the Regulation, given that no other party has sought registration on the basis of a prior right. According to the Respondent, the Rules should not be interpreted differently depending on the number of applicants in the queue. The Respondent points out that the Complaint is made against the Respondent and is not concerned with a hypothetical speculative or abusive registration.

DISCUSSION AND FINDINGS

It is appropriate to consider first whether the Complainant's additional submissions should be taken into consideration. Article 8 of the .eu Alternative Dispute Resolution Rules ("the Rules") provides that "In addition to the Complaint and the Response, the Panel may request or admit, in its sole discretion, further statements or documents from either of the Parties".

The circumstances in which additional submissions should be admitted have been considered in numerous cases decided under the Uniform Domain Name Dispute Resolution Policy and Rules, which likewise provide for a single written submission from either party. The principles developed in that case-law were summarised in WIPO Case No. D2003-0447 COMMERCIALAPPEAL.COM as follows:

"… that additional evidence or submissions should only be admitted in exceptional circumstances, such as where the party could not reasonably have known the existence or relevance of the further material when it made its primary submission; that if further material is admitted, it should be limited so as to minimise prejudice to the other party or the procedure; and that the reasons why the Panel is invited to consider the further material should, so far as practicable, be set out separately from the material itself.

"These principles are based on the purpose of the Policy and Rules of providing an expeditious and relatively inexpensive procedure for determining a certain type of domain name dispute, in which each party is entitled to make just one submission. One of the matters which the Panel has to bear in mind is that the admission of a further submission from one party may lead the other party to submit a further document in reply, which may lead to a further submission by the first party, and so on, thereby compromising the procedural economy sought to be established by the Policy and the Rules."

In the Panel's view, similar considerations apply in the .eu ADR procedure. In this case, the Complainant did not set out reasons for admitting the further submission separately. The submission essentially comprises (a) an explanation of why the application for the

domain name was not made in the Complainant's current name and why this does not matter and (b) further submissions based on pertinent decisions in the .eu Alternative Dispute Resolution Procedure.

The Panel considers that point (a) should have been addressed in the Complaint and will disregard the observations on this point in the supplementary submission. As regards point (b), the Panel notes that the decisions in question were published after the Complaint was filed, although the Complainant does not make this point itself. The Complaint was in fact filed on the date of publication of the third decision under the .eu ADR procedure. Since then there have been a number of decisions addressing the treatment of Sunrise applications containing mistakes. The Complainant could not have known of these decisions when it filed the Complaint. In these circumstances, the Panel has decided to exercise its discretion under Article 8 of the Rules to admit the Complainant's supplementary statement to the extent that it contains submissions based on decisions since the Complaint was filed.

The Respondent has not asked for an opportunity to reply to the Complainant's supplementary submission, if admitted. Furthermore, the decisions on which the Complainant relies in its supplementary submission were published prior to the Response. The Respondent was no doubt familiar with them and can be expected to have addressed them in its Response if it considered them helpful. In these circumstances, the Panel does not consider it necessary to invite the Respondent to make a further submission.

Turning now to the substance, the Panel notes firstly that, in accordance with Article 22(11) of Regulation 874/2004, it has to decide whether the decision of the Registry conflicts with Regulation 874/2004 or Regulation 733/2002. As to the relevance of the "Sunrise Rules", the Panel adopts the illuminating observations of the Panel in Case 1071 ESSENCE.

As rightly stated by the Complainant, the relevant provisions are articles 3 and 14 of Regulation 874/2004. Article 3 of Regulation 874/2004 provides that "The request for domain name registration shall include … (a) the name and address of the requesting party …". It goes on to say, "Any material inaccuracy in the elements set out in points (a) to (d) shall constitute a breach of the terms of registration".

However, the Regulation does not clearly specify the consequences of a breach of the terms of registration. For the reasons set out in case no. 1539 SETRA, the Panel considers that it does not automatically invalidate an application and that the deficiency may be remedied in an appropriate case, for example by the documentary evidence duly filed in support of a Sunrise application.

In this case, there was an inaccuracy in the name of the applicant, which was given as VEAGCOM Kommunikationsgesellschaft mbh instead of the correct name, Vattenfall Europe Netcom GmbH. The Panel considers that this inaccuracy was material and that there was accordingly a breach of the terms of registration. Even if the former name VEAGCOM Telekommunikationsgesellschaft mbh had been accurately rendered, the Panel considers that it would have been incorrect, since the name of a registered company is quite clearly the name under which it is registered at the time of the application.

The deficiency was not rectified in the documentary evidence or otherwise by the time the Respondent took the decision to reject the application. In case no. 1539 SETRA it was held that the deficiency could not be rectified after the expiry of the period for filing documentary evidence, since this would compromise the procedure and timetable laid down by Article 14 of Regulation 874/2004. In that case there were other applicants for the domain name in question during the Sunrise period who would have been adversely affected by a late correction of the name of the applicant. That consideration does not apply in this case. Nevertheless, the Respondent was required by Article 14 of Regulation 874/2004 to take a decision. It would compromise the procedure laid down by that provision if a decision which was correct when it was made could be invalidated by a subsequent request to amend the application, even if such a request could be inferred from the Complaint in this proceeding.

The Panel concludes that the rejection was justified under Article 3 of Regulation 874/2004.

As discussed in case no. 1539 SETRA, Article 14 of Regulation 874/2004 must be interpreted as requiring the applicant to provide documentary evidence which establishes that it is the owner of the prior right relied upon. This interpretation is further confirmed by Recital 12 of the Regulation, which states: "On the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name".

The reference in Section 21.3 of the Sunrise Rules to the Validation Agent having a discretion to carry out is own investigations cannot detract from the requirements of Article 14 of Regulation 874/2004. Section 21.3 should in any case be read in context together with the preceding Section 21.2, which states that the Validation Agent examines whether the applicant has a prior right on the basis of a prima facie review of the documentary evidence. The meaning of the provisions taken together is that the Validation Agent will normally make the assessment on the basis of a prima facie review of the documentary evidence but may carry out further investigations at its discretion.

In this case, the documentary evidence did not establish that the Applicant owned the prior right relied upon, since the name of the Applicant according to the Application differed from the name of the owner of the prior right according to the certificate of registration. Even though the apparent difference was relatively small, the names could have referred to different companies and there was no evidence that they were the same company. The Panel is satisfied that the Respondent was justified in rejecting the Application under Article 14 of Regulation 874/2004.

The Panel is aware of some cases such as no. 174 DOMAINE and no. 253 SCHOELLER where it was held that the Respondent should have carried out further investigations even though the documentary evidence submitted did not itself establish that the applicant owned the prior right relied upon. The Panel considers that these cases were wrongly decided. The Panel prefers the approach followed in cases such as nos. 127 BPW, 294 COLT, 541 ULTRASUN, 865 HI, 984 ISABELLA, 1625 TELEDRIVE and 1930 MODELTRAIN.

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	**Jonathan Turner**

DATE OF PANEL DECISION 2006-09-12

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant had made a sunrise application for 4ce.eu in the name of VEAGCOM Kommunikationgesellschaft mbH. The documentary evidence was a registered trademark certificate for “4cE” in the name of VEAGCOM Telekommunikationgesellschaft mbH. By the date of the application, the Applicant had changed its name to Vattenfall Europe Netcom GmbH. There was no other sunrise application for this domain name.

The Complainant sought to make a supplemental submission in reply to the response. Following WIPO case D2003-0447 COMMERCIALAPPEAL.COM decided under the UDRP Rules, the Panel admitted this in part.

On the substance, the Panel upheld the rejection of the application under articles 3 and 14 of Regulation 874/2004, following cases such as 294 COLT and 1930 MODELTRAIN.