# Panel Decision for dispute CAC-ADREU-001325

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| Case number | **CAC-ADREU-001325** |
| Time of filing | **2006-06-13 11:20:18** |
| Domain names | **kohlpharma.eu** |

## Case administrator

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| Name | **Eva Zahořová** |

## Complainant

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| Organization / Name | **Kohlpharma GmbH, Thilo Bauroth** |

## Respondent

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| 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, KOHLPHARMA GmbH, submitted the application for registration (hereinafter the “Application”) of the .eu domain name “KOHLPHARMA.EU” (hereinafter the “Domain Name”) on 20 December 2005. The Application ranked no. 1 and no other applications for registration of the Domain Name were filed in Sunrise 1 or Sunrise 2. Thus only one application was filed for the DOMAIN NAME, namely the application which is the subejct of this Complaint.

The Application was based on German national trademark registration 398 69 729.9 “kohlpharma”. The documentary evidence consisted of: the Certificate of Registration issued by German Patent and Trademark Office for the German national trademark “398 69 729.9 “kohlpharma” in the name of KOHL MEDICAL AG. It will be noted that the trademark owner is not the same name as the Complainant, KOHLPHARMA GmbH.

Respondent EURid rejected the Application because the documentary evidence as provided by the Complainant was considered insufficient to demonstrate the Prior Right of the Complainant to the Domain Name within the meaning of Article 10 (1) of the Public Policy Rules for the reason that the Applicant was different from the trademark owner.

Complainant filed a timely Complaint.

A. COMPLAINANT

In essence, the Complainant asserts as follows:

1) The Complainant and the Trademark Owner are related and they are identical as to the persons involved. They are parties to a corporate control agreement, a profit transfer agreement as well as to an assumption of loss agreement. Complainant KOHLPHARMA GmbH and KOHL MEDICAL AG should be treated as a single organisation for the purposes of the registration of the domain name. Complainant has filed the necessary license documentation as well as an assignment establishing the trademark right in the name of the Complainant.

2) After the "sunrise" period it will be difficult to register the Domain Name due to the fact that the formal rejection will be published and thus attract abusive and speculative registration

B. RESPONDENT

In essence, the Respondent asserts as follows.

1) It is well settled that where the trademark owner and the domain name applicant are not identical, Respondent did not err in rejecting the sunrise application

2) The Complainant did not file proper documentation within the 40 day period, and the documentation filed after that date as part of this ADR proceedingshould be ignored.

3) The Complainant's assertions concerning abusive and speculative registrations are misplaced in that it is well settled that Respondent is not concerned with abusive and speculative registration.

DISCUSSION AND FINDINGS

Even though the names are not identical, there is clearly a relationship between both the Trademark Owner KOHL MEDICAL AG and the Applicant KOHLPHARMA GmbH as well as between these entities and the Domain Name KOHLPHARMA.EU.

The great majority of the citations recited by Respondent, in particular Cases 00119 (NAGEL), 954 (GMP), 219 (ISL), 294 (COLT), all involved domain names for which there were more than one sunrise applicant. A similar case not cited by the Respondent is 551 (VIVENDI), where there likewise were multiple applicants. In such cases this Panel agrees that it is necessary for the validation agent very strictly to consider the sunrise documentation, due to the "first-come, first served" principle which was applicable as between two or mare sunrise applicants for the same domain name, pursuant to Art. 14(2) of the Public Policy Rules (see also Recitals 11 and 12).

That is not the situation in the case before the Panel, though. Here there was (and still is) only one applicant for the Domain Name.

The reason for the sunrise period was to afford trademark owners and holders of other prior rights the opportunity to secure the registration of their domain names, see Regulation (EC) No. 733/2002 of 22 April 2002, Recital 16. Pursuant to this policy the Complainant filed a sunrise application and filed supporting documentation which showed that a related company owned a proper trademark registration. Complainant has subsequently filed both a license agreement and an assignment. The fact that the sunrise documentation was not acceptable to the validation agent was thus clearly due to an oversight on the part of the Complainant.

The consequences of a rejection of a sunrise application will be the release of the domain name on a "landrush" basis, i.e. "first come, first served", with no sunrise. This would be potentially harmful to the trademark owner, disproportionate to Complainant's oversight, in particular in light of the above-mentioned purpose of the sunrise period.

A similar case involving a single applicant, where there was a discrepancy between the name of the trademark owner and the domain name applicant is Case 1047 (FESTOOL). There the Complainant was an employee of the trademark owner. The Panel found that the Respondent EURid was correct in rejecting the sunrise application, but that rejecting the transfer of the domain name from the Complainant to the trademark owner would have been in contravention of Regulation (EC) No. 733/2002 of 22 April 2002

The Respondent EURid did not err in rejecting the sunrise application due to the fact that the sunrise applicant was not the same entity as the owner of the trademark registration on which the sunrise application was based. However, a ruling which does not transfer the Domain Name to the Complainant will mean that the Domain Name is returned to the pool of available domain names released at some point in the future. In this particular case, there was only one sunrise applicant, namely the Complainant, and there is little doubt that EURid would have registered the Domain Name to the Complainant, had the Complainant timely filed the proper documentation. Bearing in mind that the sunrise procedure was instituted to assist trademark owners against abusive and speculative registrations, and the consequences of not transferring the Domain Name would mean that the domain name would be transferred to the general pool of available names and thus subject to abusive and speculative registrations, this Panel finds that justice is best served by ordering that the Domain Name be transferred to the Complainant, pursuant to Art. 22 (11) of Regulation (EC) No. 733/2002 of 22 April 2002. It is so ordered.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name KOHLPHARMA be transferred to the Complainant within thirty calendar days of the notification of this decision.

## PANELISTS

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| Name | **Peter Gustav Olson** |

DATE OF PANEL DECISION 2006-09-05

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The sunrise applicant was KOHLPHARMA GmbH but the trademark was registered in the name of KOHL MEDICAL AG. EURid had rejected the sunrise application because the sunrise applicant was not the same entity as the owner of the trademark registration on which the sunrise application was based. Only one sunrise application was filed for the domain name. Bearing in mind that the sunrise procedure was instituted to assist trademark owners against abusive and speculative registrations, and the consequences of not transferring the domain name would mean that the domain name would be transferred to the general pool of available names and thus subject to abusive and speculative registrations, the panel ordered the domain name transfered to the Complainant.