Panel Decision for dispute CAC-ADREU-000479

Case number	CAC-ADREU-000479
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Domain names	metalock.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Metalock Industrie Service 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 names.

FACTUAL BACKGROUND

This decision arises from a complaint filed by the German company Metalock Industrie Service GmbH ("the Complainant"), against the decision by EURid ("the Respondent"), to register the domain name metalock.eu (“the disputed Domain Name”) to a third party, Metalock Denmark A/S ("Metalock Denmark").

On 07 December 2005 at 11:21:52 am, Metalock Denmark applied for the disputed Domain Name under the first part of the phased registration period. The mark on which Metalock Denmark relied was the Danish trade mark registration No. VR 1952 00565 "METALOCK" (word), which was applied for on 21 November 1951 and registered on 26 April 1952. Documentary evidence of the registered trademark was submitted to the Respondent by the Complainant in due time. The evidence consisted of a registration excerpt of the prior Danish trade mark registration. According to the registration excerpt, the owner of the Danish mark was a company called Gränges Metalock AB with seat in Göteborg, Sweden. Metalock Denmark was mentioned as representative of Gränges Metalock AB for the Danish trade mark.

The Respondent accepted the application on the basis that the right of Metalock Denmark to the name had been proven.

On 07 December 2005 at 11:25:25 am and on 13 January 2006 at 07:08:52 am, the Complainant also applied for the disputed Domain Name under the provisions of the first part of the phased registration period. The Complainant is now the next applicant in the queue for the disputed Domain Name (position two and three).

On 28 March 2006, the Complainant filed a complaint with the Czech Arbitration Court, asking to cancel the decision of the Respondent in accepting the application for the disputed domain name filed by Metalock Denmark.

On 04 April 2006, the Czech Arbitration Court notified the Complainant of some deficiencies relating to his Complaint (Paragraphs B2 (b), B1 (b)(10)(15) of the ADR Rules, Paragraph B1 (c) of the ADR Supplemental Rules). The deficiencies were corrected by the Complainant within the time limit set by the Czech Arbitration Court.

On 07 April 2006, the ADR proceedings commenced.

On 31 May 2006, the Czech Arbitration Court notified the Respondent that it failed to comply with the deadline for submitting a response.

On 06 June 2006, the Respondent submitted a non-standard communication with the Czech Arbitration Court.

On 09 June 2006, the Czech Arbitration Court appointed Mr. André Pohlmann as sole Panelist in this matter. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence in compliance with Paragraph B5 of the ADR Rules and Paragraph B(5) of the Supplemental ADR Rules.

A. COMPLAINANT

In support of its position Complainant contends as follows:

1. The application of Metalock Denmark was filed under violation of Article 12 No. 2 of the EC Regulation No. 874/2004 and thus should not have been accepted by the Respondent. Metalock Denmark is neither the owner of a Trademark Registration "METALOCK" nor has a licence to such right. According to the details provided by the Respondent on its web site, Metalock Denmark based its right to apply for the disputed domain during the first sunrise period on a registered national Danish trademark. However, there does not exist any national Danish trademark to the sign "METALOCK" registered in the name of Metalock Denmark.

2. The Danish trade mark registration No. VR 1952 00565, which is assumed to be the basis of the application filed by Metalock Denmark, in fact belongs to the Swedish company Metalock Sweden AB, formerly named Gränges Metalock AB. This can be seen from the online register printout provided by the Danish Patent and Trademark Office (attached by the Complainant as A4). The printout depicts the Swedish company Gränges Metalock AB as the owner of the mark. The status of the printout was 23 March 2006. The fact that Metalock Denmark is named as representative for this trademark registration does not mean it is the owner of or owns any license to this right.

3. The right to the Danish trademark registration No. VR 1952 00565 “Metalock” has not been transferred from the current owner Metalock Sweden AB (Gränges Metalock AB) to Metalock Denmark. Metalock Denmark and Metalock Sweden AB (Gränges Metalock AB) are completely separate companies. As Metalock Denmark does not own any trade mark rights to the name “METALOCK” it did not have the right to apply for the disputed Domain Name during the first part of the sunrise period which was exclusively reserved to those applicants owning trademark rights with respect to the domain name. The application thus should have been rejected and dismissed by the Respondent as being filed during a time period in which only applications for a domain registration based on registered trademark rights were admissible. Consequently, Metalock Denmark was set to the No. 1 position in the list for the disputed Domain Name without any valid request being filed. Consequently, the decision of the Respondent to allow the application of Metalock Denmark has to be annulled.

B. RESPONDENT

The Respondent failed to file a response before the time limit set by the Czech Arbitration Court.

On 06 June 2006, the Respondent filed a non-standard communication, making the following observations:

While Metalock Denmark was mentioned as the representative of Gränges Metalock AB on the records from the Danish Trademark Office with regard to the invoked prior right, the Respondent acknowledges that this does not amount to the necessary status of owner of the invoked prior right. As Gränges Metalock AB, a separate legal entity, is the owner of the invoked prior right and does not seem to have granted Metalock Denmark a licence, Metalock Denmark does not have the required legal standing to have its application accepted.

DISCUSSION AND FINDINGS

The Complainant’s application is made pursuant to Article 22(1)(b) of EC Regulation No. 874/2004, which provides that an ADR procedure may be initiated by any party where a decision taken by the Registry conflicts with this Regulation or with EC Regulation No. 733/2002. Pursuant to Article 22(11) second subparagraph of EC Regulation 874/2004, the sole purpose of these proceedings is accordingly to determine whether the decision taken by the Respondent was in accordance with the EC Regulation No. 874/2004 or EC Regulation No. 733/2002.

The relevant provisions of EC Regulation No. 874/2004 which require particular consideration are as follows:

Article 10(1) first subparagraph: Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.

Article 12(2) third subparagraph: During the first part of phased registration, only registered national and Community trademarks,

geographical indications, and the names and acronyms referred to in Article 10(3), may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in Article 10(1).

Article 14 first paragraph: All claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists.

Article 14 fourth paragraph: Every applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question. The documentary evidence shall be submitted to a validation agent indicated by the Registry. The applicant shall submit the evidence in such a way that it shall be received by the validation agent within forty days from the submission of the application for the domain name. If the documentary evidence has not been received by this deadline, the application for the domain name shall be rejected.

It is clear from the above-mentioned provisions of EC Regulation No. 874/2004 that Metalock Denmark was eligible to apply to register the disputed domain during the first part of the phased registration only if it demonstrated that it was either the holder or the licensee of the Danish trade mark used as basis for the application. According to the registration certificate submitted by Metalock Denmark, the owner of the Danish mark No. VR 1952 00565 "METALOCK" was the Swedish company Gränges Metalock AB with seat in Göteborg, Sweden. This company is legally independent from Metalock Denmark. Metalock Denmark was only mentioned as representative of Gränges Metalock AB but not as the right holder.

Evidence showing that the Danish mark had been transferred to Metalock Denmark or that Metalock Denmark was a licensee of the mark was not filed by Metalock Denmark before the deadline for submitting such documentary evidence.

Consequently, Metalock Denmark was not eligible to apply for the disputed Domain Name during the first part of the phased registration. The decision of the Respondent to accept the application was in conflict with Article 10(1) first subparagraph, Article 12(2) third subparagraph and Article 14 first and fourth paragraph of EC Regulation No. 874/2004.

DECISION

For the reasons given above, and in accordance with Article 22(11) second subparagraph of EC Regulation No. 874/2004 and Paragraph B11(c) of the ADR Rules, the Panel orders that

- the decision of the Respondent to allow the application for the domain name metalock.eu filed by Metalock Denmark A/S shall be annulled, and
- the domain name metalock.eu be attributed to the Complainant – being the next applicant in line for the registration of the disputed Domain Name - subject to its compliance with the general eligibility criteria set out in EC Regulation No. 874/2004 and EC Regulation No. 733/2002.

PANELISTS

Name	**André Pohlmann**

DATE OF PANEL DECISION 2006-06-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

This case concerns a Complaint lodged against the decision by EURid to allow the application by a company that was not eligible to apply for a domain name during the first part of the phased registration period. The applicant failed to demonstrate that it was the holder or the licensee of the claimed prior national trade mark right used as basis for the domain name application. The company mentioned as owner in the registration certificate of the national mark submitted by the applicant was legally independent from the applicant. The decision of EURid was in conflict with Article 10(1) first subparagraph, Article 12(2) third subparagraph and Article 14 first and fourth paragraph of EC Regulation No. 874/2004. Consequently, the Panel decided to annul the disputed decision and to attribute the disputed Domain Name to the Complainant, subject to its compliance with the general eligibility requirements for registration.