Panel Decision for dispute CAC-ADREU-001525

Case number	**CAC-ADREU-001525**
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Domain names	**espo.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**European Social Projects Office, Buyuksarac**

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 13 December 2005, the Complainant applied to register the domain name <espo.eu> during the phased registration period. In the application, the name was stated as “Buyuksarac”, organisation “ESPO” and address “Balsemkruid 81, 3068 DB Rotterdam, Netherlands”.

The Complainant submitted in support of its application a printout from the Benelux Trademarks Office for Benelux Trademark 0775556 dated 14 September 2005 for the word “ESPO”. The printout gave the name of the trade mark owner as “Güler Buyuksarac-Esgikan h.o.d.n. European Social Projects Office” and an address of “Balsemkruid 81, 3068 DB Rotterdam, Nederland”.

On 18 April 2006, the Respondent rejected the application on the grounds that the evidence received was insufficient to demonstrate the existence of the right claimed.

On 24 May 2006, the Complainant filed a Complaint requesting annulment of the Respondent’s decision.

On 2 June 2006, the Arbitration Court notified the Complaint to the Respondent.

On 20 July 2006, the Arbitration Court notified the Respondent that it had defaulted in filing a Response.

On 22 July 2006, the Respondent filed a non-standard communication which was in fact a late Response.

A. COMPLAINANT

The Respondent has wrongfully rejected the application of espo.eu.

The Respondent informed the Complainant that it had compared the trade mark owner (“Güler Buyuksarac – Esgikan h.o.d.n. European Social Projects Office”) with the domain name applicant (“ESPO”) and that there is no indisputable evidence that it concerns the same person. The Respondent further stated that if there was no complete similarity between the domain name applicant and the trade mark owner, either a licence agreement must be added to the evidence, or a document must be added to the evidence that the trade mark owner and the applicant are one and the same person.

A reasonable interpretation of the information would have made it clear that the applicant and the owner of the trade mark are the same person.

The legal entity that has applied for the domain name is a natural person (family name Buyuksarac). The name is identical to the name of the trade mark owner, which is “(first name) Buyuksarac – (maiden name) doing business under the name European Social Projects Office”.

European Social Projects Office or ESPO is only a trade name. The Dutch abbreviation in the trademark registration “h.o.d.n.” stands for “handelend onder de naam” meaning “doing business under the name”. ESPO (the name in the domain name application) is clearly the abbreviation for European Social Projects Office.

Moreover, the address and zip code of the applicant and the trade mark owner are identical.

In any case, a lack of complete similarity calls for further evidence. One simple email to the Complainant would have been sufficient to clarify the situation. Although the Complainant informed the Respondent the same day that the applicant and the trade mark owner are the same person, the Respondent informed the Complainant that the file was validated and closed.

The disputed decision to reject the domain name application should be annulled and domain name <espo.eu> should be awarded to the Complainant.

B. RESPONDENT

The Respondent’s validation agent concluded from the documentary evidence that the Complainant was not the holder of a prior right. Therefore the Respondent rejected the application.

Any applicant should be well-acquainted with the relevant rules which will be applied by the validation agent.

The Complainant failed to submit the proper evidence. It is for the applicant to submit all documents. The relevant question is not whether an applicant is the holder of a prior right but whether an applicant fully proves to the validation agent that it is the holder of a prior right.

Article 14 of Regulation 874/2004 puts the burden with the applicant to prove that it holds a prior right.

There must be no room in the documentary evidence for speculation or interpretation. A difference between the name of the applicant and the name of the holder of the prior right would leave room for speculation or interpretation.

The trademark which the Complainant submitted as documentary evidence mentioned Güler Buyuksarac-Esgikan, trading under the name of European Social Projects Office as the owner of the trademark. The name of the Complainant however is ESPO. It is undisputed that there is a difference between the names on the trademark certificate and domain name application form. ESPO may well have been an abbreviation but it could also have been a different entity.

The Complainant accepted that it has made a mistake. The mistake was made by the Complainant not by the Respondent. The Respondent’s decision was correct and may not be annulled as a result of a failure to submit the documentary evidence which the validation agent needed.

Section 21 (2) of the Sunrise Rules states that the validation agent will examine the prior right to the name exclusively on a prima facie review of the first set of documentary evidence received. An applicant should not expect the Respondent to engage in speculation and/or embark upon its own enquiry in relation to the exact connection between two entities. Information provided after the first set of documentary evidence should not be considered

Section 21 (3) of the Sunrise Rules states that the validation agent is not obliged, but is permitted in its sole discretion, to conduct its own investigations

Section 20(3) of the Sunrise Rules states that documentary evidence explaining differences in name must be submitted even when the entity mentioned as the holder of the prior right and the entity mentioned as the applicant are in fact one and the same.

DISCUSSION AND FINDINGS

1. Preliminary issues.

There are two preliminary issues.

First, a number of documents attached to the Complaint were not translated from Dutch into English, the language of the ADR Proceeding. These consisted of some emails between the parties and the trade mark printout.

Paragraph A3(c) of the ADR Rules states: ".. The Panel may disregard documents submitted in other languages than the language of the ADR Proceeding without requesting their translation ..."

Paragraph A3(d) states: "The .. Panel by itself ... may order than any documents submitted in languages other than the language of the ADR Proceeding be accompanied by a translation in whole or in part into the language of the ADR Proceeding."

Paragraph B7(d) states: "The Panel shall determine in its sole discretion the admissibility, relevance, materiality and weight of the evidence".

The Panel disregarded the emails without requesting a translation as it felt that the later correspondence was unlikely to add much to the core issue which concerned the Respondent's assessment of the documentary evidence submitted with the domain name application. As to the trade mark printout, there was only one term of relevance in Dutch, namely "h.o.d.n", the meaning of which was not in dispute between the parties (see below).

The second preliminary issue is as to the admissibility of the Respondent's non-standard communication which is formulated as if it were a Response but was filed after the Response deadline.

Paragraph B3(f) of the ADR Rules states: "If a Respondent submits … solely an administratively deficient Response, the Provider shall notify the Parties of Respondent's default. The Provider shall send to the Panel for its information and to the Complainant the administratively deficient Response .."

Paragraph B3(g) states: "The Respondent can challenge the Provider's notification of the Respondent's default in a written submission to the Provider filed within five (5) days from receiving the notification of Respondent's default … If the Panel confirms that the Response is administratively deficient, the Panel may decide the dispute based upon the Complainant only."

As mentioned above, paragraph B7(d) provides that the Panel has sole discretion to determine the admissibility, relevance, materiality and weight of the evidence.

Paragraph B10(a) states: "In the event that a Party does not comply with any of the time periods established by these ADR Rules …, the Panel shall proceed to a decision on the Complaint and may consider this failure to comply as grounds to accept the claims of the other Party."

Paragraph B10(b) states: "Unless provided differently in these ADR Rules, if a Party does not comply with any provision of, or requirement under, these ADR Rules … the Panel shall draw such inferences therefrom as it deems appropriate."

The Respondent did not challenge the notification of default as it could have done under paragraph B3(g) of the ADR Rules (thereby accepting that it was in default) let alone argue that there were any exceptional circumstances justifying the delay. The Panel considers that the Respondent cannot be permitted to sidestep the ADR Rules by submitting a late Response via a non-standard communication. The Panel will have regard to the Respondent's non-standard communication purely to understand the reasons for the Respondent's decision but will not otherwise place any weight on it. However, the Panel considers that the Complainant must still prove its case to the required degree.

2. Substantive issue

In accordance with Article 22(11) of Regulation 874/2004 ("the Regulation"), the Panel must decide whether the decision of the Respondent conflicts with the Regulation or with Regulation 733/2002.

Recital 12 of the Regulation explains the purpose of the phased registration period as follows: "In order to safeguard prior rights recognised by Community or national law, a procedure for phased registration should be put in place. Phased registration should take place in two phases, with the aim of ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights. The Registry should ensure that validation of the rights is performed by appointed validation agents. On the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name. Allocation of

that name should then take place on a first-come, first-served basis if there are two or more applicants for a domain name, each having a prior right."

Article 10 (1) of the Regulation provides that holders of applicable prior rights were eligible to apply to register domain names during a period of phased registration before general registration of .eu started.

The procedure to be followed for validation and registration of applications received during the phased registration period is described in Article 14 of the Regulation. In particular, Article 14(1) states: "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(4) states: "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…" Article 14(7) states: "The relevant validation agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name…" Article 14(10) states: "The Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in the second, third and fourth paragraphs."

It is worth mentioning briefly the Sunrise Rules although these are only of limited relevance here – see Case 1071 (ESSENCE) and Case 1539 (SETRA). Section 20(3) says that if documentary evidence does not clearly indicate the name of the applicant, the applicant must submit official documents showing that it is the same person as the holder of the prior right. Section 21(2) says that the validation agent shall assess the prior right exclusively on the basis of a prima facie review of the first set of documentary evidence received. Section 21(3) says that the validation agent is permitted in its own discretion, but not obliged, to conduct its own investigations into documentary evidence produced.

Clearly, the Regulation places the burden of demonstrating prior rights on the domain name applicant.

Here the Complainant produced a printout of a trade mark in the name of "Güler Buyuksarac-Esgikan h.o.d.n. European Social Projects Office". The Respondent (acting through its validation agent) must, or at least should, have been aware that "h.o.d.n" was the abbreviation of "doing business under the name" in Dutch and that therefore the legal entity which owned the trade mark was a natural person "Güler Buyuksarac-Esgikan" trading under the name "European Social Projects Office".

Importantly, the address shown in the trade mark printout and domain name application were identical. (It is interesting that in Case 253 (SCHOELLER), the Respondent invoked differences in both name and address in claiming that it could not reasonably conclude that trade mark owner and domain name applicant were the same; clearly it considered that identicality of address was a relevant factor.)

The name "Buyuksarac" appeared in the name field of the domain name application. This was the first part of what should have been clear to the Respondent was the double barrelled surname of an individual shown in the trade mark printout.

The name in the organisation field (and therefore the domain name applicant) was "ESPO". This name was the same as the trade mark and there was no corporate suffix or anything else indicating that it might have been a different legal entity. Taking all the above matters together, it should have been reasonably apparent to the Respondent that "ESPO" in the domain name application was an acronym of the trade mark owner's trading name "European Social Projects Office" and that the domain name applicant and the holder of the prior right were one and the same. While the Complainant did make an error in the domain name application, in the Panel's view it was not a material one.

In light of this conclusion it is unnecessary for the Panel to consider the Complainant's further assertion that the Respondent should have carried out further investigations or sought additional documentary evidence.

The Panel concludes that the Respondent's overly restrictive approach failed to safeguard the Complainant's prior rights in accordance with the Regulation.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

EURID's decision be annulled

PANELISTS

Name	Adam Taylor

DATE OF PANEL DECISION 2006-08-23

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant's trade mark for "ESPO" was in the name "Güler Buyuksarac-Esgikan h.o.d.n. European Social Projects Office". In the domain application, the name and organisation were given as "Buyuksarac" and "ESPO" respectively. The addresses were identical.

The Respondent rejected the domain name application on the grounds that the evidence was insufficient to demonstrate the existence of the prior right.

The Panel considered that, taking all of the relevant matters together, it should have been reasonably apparent to the Respondent that "ESPO" in the domain name application was an acronym of the trade mark owner's trading name "European Social Projects Office" and that the domain name applicant and the holder of the prior right were one and the same.

The Panel concluded that the Respondent's overly restrictive approach failed to safeguard the Complainant's prior rights in accordance with the Regulation.