# Panel Decision for dispute CAC-ADREU-001542

| | |
|---|---|
| Case number | CAC-ADREU-001542 |
| Time of filing | 2006-05-31 12:54:38 |
| Domain names | megaman.eu |

## Case administrator

| | |
|---|---|
| Name | Josef Herian |

## Complainant

| | |
|---|---|
| Organization / Name | IDV Import- und Direkt-Vertriebsgesellschaft mbH, Michael Wiesner |

## 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 any other pending or decided legal proceedings relating to the disputed domain names.

FACTUAL BACKGROUND

All capitalized terms not defined herein are used by reference to the various regulations and rules identified in this decision.

This complaint arises out of the interpretation and application of Commission Regulation (EC) No 874/2004 of 28 April 2004 (“Regulation”), European Parliament and Council Regulation (EC) No 733/2002 of April 22, 2002 (“EU Regulation”) and the .eu Domain Name Terms and Conditions and phased registration rules for domain name applications made during the phased registration period (“the Sunrise Rules” and the “Conditions”).

1.The Domain name application proceeding

IDV Import-und direkt- Vertriebsgesellschaft mbH (hereafter "the Complainant" or “Applicant”) applied for the domain name MEGAMAN.EU on 3 January 2006.
The validation agent received the Documentary Evidence on 3 February 2006, before the 12 February 2006 deadline.
The Documentary Evidence demonstrates that the holder of the Community trademark for which the Prior Right was claimed was registered to “Werner Th. Wiesner”, not the Complainant.
Therefore, the Registry (hereafter “the Respondent”) concluded that the Documentary Evidence did not establish that the Complainant was the holder of a Prior Right and rejected the Complainant’s application.

The Complainant requests that the Panel annul the Registry’s decision and to attribute the domain name MEGAMAN.EU to it.

2.The ADR proceeding

On May 24, 2006, Complainant submitted a Complaint to the ADR Center against Respondent’s decision. This was filed in the German language.

A number of documents were subsequently filed. All in the German language.

On August 23, 2006, Respondent submitted a Response to the ADR Center. This was filed in the English language.

On September 12, 2006, the Panel ordered on the basis of the ADR Rules, Rule A(3) (d) and B(8) that if a party wishes to rely on the

Complaint , or any other document, to demonstrate whether or not there is a conflict between the disputed decisions of the Registry and Regulation 733/2002, that Party should submit the Complaint in English and a statement indicating which documents are relevant and provide a translation of such documents or summary in English by Monday September 18, 2006

No translation has been submitted.

A. COMPLAINANT

In its Complaint filed on May 24, 2006 in German language, the Complainants asserts the following.

Sehr geehrte Damen und Herren, die Registrierungstelle EURid hat unseren Antrag auf Zuteilung der Domain megaman.eu abgelehnt, obwohl wir glaubhaft versichert haben, dass wir rechtmäßiger Nutzer der Marken: MEGAMAN sind.

Wir hatten dem Antrag den Nachweis der EU-Marke 000580647 MEGAMAN (Klasse: 7) beigefügt, die Erlaubnis des Inhabers Herrn Werner Th. Wiesner, Birkenweiherstr. 2, 63505 Langenselbold lag und liegt uns vor.
Von Seiten der EURid und PWC gab es keine Hinweise, dass eine Lizenzerklärung beizufügen wäre. Diese Lizenzerklärung kommt es jetzt im ADR-Verfahren ins Spiel!

Außerdem wurden wir vom Inhaber, der Fa. Neonlite Electronic & Lighting (HK) Ltd, Hong Kong, der Marken 004830717 & 002689677: MEGAMAN (Klassen 9 & 11) beauftragt, die Domain auf uns eintragen zu lassen. Dieser Beschwerde haben wir nun den Nachweis und die Lizenzerklärung dieser beiden eingetragenenen EU-Marken beigefügt.

Wir beantragen die Aufhebung der Entscheidung von EURid vom 17.04.2006.

In Erwartung einer positiven Antwort verbleiben wir mit freundlichen Grüßen
IDV GmbH
Michael Wiesner

B. RESPONDENT

The Respondent responded on August 23, 2006.
This is below.

1. GROUNDS ON WHICH THE REGISTRY REJECTED THE APPLICATION FOR THE DOMAIN NAME MEGAMAN BY IDV IMPORT-UND DIREKT- VERTRIEBSGESELLSCHAFT MBH
Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") states that only holders of prior rights which are recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts. Pursuant to article 14 of the Regulation, the applicant must submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. Based on this documentary evidence, the validation agent shall examine whether the applicant has prior rights on the name.
Article 20 (1) of the Sunrise Rules states that "If an Applicant has obtained a licence for a registered trade mark referred to in Section 13(1)(i) above in respect of which it claims a Prior Right, it must enclose with the Documentary Evidence an acknowledgement and declaration form, a template of which is contained in Annex 2 hereto, duly completed and signed by both the licensor of the relevant registered trade mark and the Applicant (as licensee)".

IDV Import-und direkt- Vertriebsgesellschaft mbH (hereafter "the Complainant") applied for the domain name MEGAMAN on 3 January 2006. The validation agent received the documentary evidence on 3 February 2006, which is before the 12 February 2006 deadline. The documentary evidence demonstrated that the holder of the Community trademark for which the prior right was claimed was registered to "Werner Th. Wiesner", not the Complainant. The Complainant did not submit the required acknowledgement and declaration form duly completed and signed by "Werner Th. Wiesner" and the Complainant. Therefore, the Registry concluded that the documentary evidence did not establish that the Complainant was the holder of a prior right and rejected the Complainant's application.

2. COMPLAINANT'S CONTENTIONS
The Complainant agrees that it did not submit the required acknowledgement and declaration form duly completed and signed. However, the Complainant contends that it was not aware that such a form was required. The Complainant also submits new documents consisting of a proof of the Community trademark MEGAMAN, registered in the name of NEONLITE ELECTRONIC & LIGHTING, and a License Declaration form signed by this Company and the Complainant. The Complainant requests the Panel to annul the Registry's decision and to attribute the domain name MEGAMAN to it.

3. RESPONSE

3.1 The new documents submitted by the Complainant may not be taken into consideration The Respondent wishes to stress that, pursuant to article 22 (1) b of the Regulation, a decision taken by the Respondent may only be annulled when it conflicts with the Regulation. This verification is the only task for the Panel in these proceedings, which may not in any case serve as a “second chance” or an additional round providing applicants an option to remedy their imperfect original application that was rejected during the Sunrise Period (see cases Nr. 551 (VIVENDI) and Nr. 810 (AHOLD)). In other words, as decided in case Nr. 1194 (INSURESUPERMARKET), "[t]he ADR procedure is not intended to correct domain name applicants’ mistakes". Thus, only the documentary evidence which the Respondent was able to examine at the time of validation of the application should be considered by the Panel to assess the validity of the Respondent's decision (see notably cases Nr. 294 (COLT), Nr. 954 (GMP), Nr. 01549 (EPAGES) and Nr. 1674 (EBAGS)).
The Complainant submits new documents consisting of a proof of the Community trademark MEGAMAN, registered in the name of NEONLITE ELECTRONIC & LIGHTING, and the License Declaration form signed by this Company and the Complainant. These documents are submitted for the first time during the present ADR proceedings and were not enclosed with the documentary evidence. This means that the Respondent could not use this information for taking its decision. Therefore, these documents should not be taken into consideration to evaluate whether the Respondent's decision conflicts with the Regulation, which is the only purpose of the present ADR proceedings.

3.2 The burden of proof is with the applicant to demonstrate that it is the holder or the licensee of a prior right

Article 10 (1) of the Regulation states that only the holders of prior rights shall be eligible to apply to register domain names during the period of phased registration. Article 14 of the Regulation states that "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". It is therefore of crucial importance that the Respondent is provided with all the documentary evidence necessary for it to assess if the applicant is indeed the holder of a prior right. The burden of proof is thus on the Applicant to demonstrate that it is the holder or the licensee of a registered trademark. If an applicant fails to submit all documents which demonstrate that it is the holder or licensee of a prior right, the application must be rejected.
Section 11 (3) of the Sunrise Rules states that "The Applicant must be the holder (or licensee, where applicable) of the Prior Right claimed no later than the date on which the Application is received by the Registry, on which date the Prior Right must be valid, which means that it must be in full force and effect". Section 20 (3) of the Sunrise Rules provides that if an Applicant has obtained a licence for a registered trade mark in respect of which it claims a Prior Right, it must enclose with the Documentary Evidence an acknowledgement and declaration form, a template of which is contained in Annex 2 hereto, duly completed and signed by both the licensor of the relevant registered trade mark and the Applicant (as licensee). The documentary evidence demonstrated that the holder of the Community trademark for which the prior right is claimed was registered to "Werner Th. Wiesner", not the Complainant. However, the Complainant failed to submit the required acknowledgement and declaration form duly completed and signed by "Werner Th. Wiesner" and the Complainant. Therefore, the Applicant failed to establish that it was the holder or licensee of the claimed prior rights and the Respondent had no choice but to reject the application.
In the case No. 810 (AHOLD), the Panel also had to evaluate the conformity of Respondent's decision to reject an application due to differences between the name of the Applicant and the name of the holder of the prior right. The Panel stated that : "As confirmed by sec. 20 of SR, it is important to make sure that the applicant is the same holder of the prior rights, to avoid any domain name registration deprived of legitimation on the applicant’s side. As a result, when faced before a difference between the applicant name and the prior right holder name, correctly detected by the Validation Agent, the Registry may not accept the corresponding domain name application being the application incomplete under sec. 3 (1) SR".
Similarly, in the case No. 551 (VIVENDI), the Panel decided that "The documentary evidence provided by the Complainant shows that the owner of the trademark, on the basis of which the prior right to the Domain Name was asserted, is the company Vivendi, and not the Complainant (“Vivendi Universal”). The Complainant did not provide any proof within the documentary evidence which would explain that Vivendi Universal is a legal successor (as a result of a merger or otherwise) of the company Vivendi, which was (at the time of filing of the Application) a registered holder of the Trademark. Therefore, a conclusion must be drawn that the Complainant failed to demonstrate its prior right to the Domain Name".

3.3 The Complainant had to comply with the Sunrise Rules

For the sake of completeness, the Respondent would like to address the Complainant's contentions that the Complainant was not aware that it had to comply with the Sunrise Rules, and more in particular section 20.
The Respondent would first like to note that section 20 of the Sunrise Rules further clarifies article 14 (10) of the Regulation, which states that "the Respondent 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." Section 20 of the Sunrise Rules does nothing but exemplifying what documents should be submitted for an applicant to prove that it has a prior right. Clearly it is not too much for an applicant who is not mentioned as the actual holder of the prior right which was submitted as documentary evidence to explain his relationship with aforementioned holder? In addition, the Sunrise Rules have been published on the Registry's website pursuant to article 12 of the Regulation. Moreover, the Respondent would like to remind the Complainant that it signed

a cover letter (in German) which the Complainant submitted with its application. This cover letter clearly states that (English translation): "The Rules, including the special terms that relate to the phased registration period, apply and have been read and approved without reservation by the Applicant. The Applicant has understood that any breach of the Rules can invalidate the application for the domain name or result in the cancellation of the Registration itself". (emphasis added) This statement is included in the cover letter pursuant to article 3 (d) of the Regulation which states that the request for domain name registration shall include an undertaking from the requesting party that it shall abide by all terms and conditions for registration, including the policy on the extra-judicial settlement of conflicts. The Complainant is duly bound by the Sunrise Rules. Its argument that it ignored that such rules existed cannot be accepted.
The Respondent refers the Panel to a non-exhaustive list of cases where the Panel decided that the Respondent's decision was correct to reject an application for non-compliance with the Sunrise Rules: cases 119 (NAGEL), 404 (ODYSSEY), 954 (GMP), 1710 (PARLOPHONE, EMI, EMIMUSIC, EMIRECORDS, ANGEL, THERAFT).

4. CONCLUSION
The Regulation and the Sunrise Rules give the holders of prior rights the opportunity to demonstrate their prior rights during the phased registration, which is an exception to the basic principle of first-come first-served. In order to benefit from this opportunity to demonstrate its prior rights, the applicant must comply with the strict procedure laid out by the Regulation for dealing with the thousands of applications received during the phased registration and making sure that these applications are substantiated.
The Complainant in the present case did not seize this opportunity, because its application did not correctly fulfil the substantial requirements. As the Panel in case n° 219 (ISL) stated: "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".
For these reasons, the Complaint must be rejected.

DISCUSSION AND FINDINGS

1. Documents presented to the Panel

Under Section 16(3) of the Domain Names Registration Terms and Conditions, the language of any and all proceedings against Respondent shall be English. Since these ADR Proceedings are in English all documents should be submitted in the English language. The second sentence of Paragraph A3(c) of the ADR Rules states that the Panel may disregard documents submitted in languages other than the language of the ADR Proceeding without requesting their translation, leaving the admission of the document to the discretion of the Panel.

The Panel notes that the Complaint was filed in the German language. The Panel also notes that under Rules B(7)(b)-(c), the Panel shall ensures that the Parties are treated fairly and with equality and that the ADR Proceeding takes place with due expedition.

On the basis of the above considerations and of the ADR Rules, Rule A(3)(d) and B(8) the Panel stated via a non standard communication dated September 12, 2006 that: (1) if either Party wishes to rely on the Complaint, or any other document, to demonstrate whether or not there is a conflict between the disputed decisions of the Registry and Regulation 733/2002, that Party should submit the Complaint in English and a statement indicating which documents are relevant and provide a translation of such document or summary in English by Monday September 18, 2006.

The Complainant did not respond to the non standard communication dated September 12, 2006. As a result, the Panel can only deduce that Complainant is happy with the idea that the Panel shall not take the Complaint into consideration in making its decision.

As a result, the Panel has decided not to take the content of the Complaint into consideration. Nor will it take into account documents that are not translated into English.

The Panel is of the view that it can decide based solely on the Respondent’s response which is in the English language and clearly states the reasons for Respondent’s decision.

2. Burden of proof that the Applicant is the holder of a Prior Right or a licensee thereof

The Regulation, the Sunrise Rules and the Conditions govern all .eu domain name applications made during the phased registration period. The main obligations of Respondent regarding registrations of .eu domain names during the phased registration are set out in Article 14 of the Regulation.
Article 14 obliges the Registry to register .eu domain names on a first come first served basis, if it finds that the Applicant has demonstrated a Prior Right in accordance with that Article.
There are thus two conditions: to be the first and to own a prior right.

The first application received gets a chance to demonstrate its prior right. If it succeeds in doing so within the defined framework, it will obtain registration. If it fails, the second application received will then get a chance to demonstrate its prior right, and so on.

Pursuant to Article 14 of the Regulation, the onus of proving the Prior Right is on Applicant. See Cases 00119 and 00232. Applicant must also be the holder of the prior right. Article 14(4) states that "applicant shall submit documentary evidence that shows that he or she is the holder of the prior right…".

Article 12(2) of the Regulation provides that "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…".

Section 20 (3) of the Sunrise Rules provides that if an Applicant has obtained a license for a registered trade mark in respect of which it claims a Prior Right, it must enclose with the Documentary Evidence an acknowledgement and declaration form, duly completed and signed by both the licensor of the relevant registered trade mark and the Applicant (as licensee).

The burden proving that it is the holder or the licensee of a registered trademark thus falls on the Applicant. If an applicant fails to submit in due time all documents which demonstrate that it is the holder or the licensee of a prior right, the application must be rejected and the next applicant in line may obtain the domain name. It would not be fair on those in the queue if Respondent accepted Documentary Evidence long after the deadline to submit such evidence has expired.

Applicant has demonstrated that a trademark existed for the name MEGAMAN and that such trademark was registered in the name of a third party ("Holder").
However, the Applicant has failed to show that a licensee-licensor existed between it and such Holder.

3. Ignorance of the Rules

In its response, the Respondent summarizes the Complainant's position. The Complainant admits that it failed to provide proof that it was a licensee of the holder of the Prior Right. The reason given for such failure is that Complainant was not familiar with the rules that required Complainant to demonstrate its licensee-licensor relationship with a holder of a Prior Right if is was not itself the holder of such right. Further, it claims that it was not aware of the existence of a specific form to be used for purposes of showing such relationship, the License Declaration form.

Article 12(2) of the Regulation provides that "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…".

Article 14 (10) of the Regulation states that "the Respondent 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." Section 20 (3) of the Sunrise Rules provides that if an Applicant has obtained a license for a registered trade mark in respect of which it claims a Prior Right, it must enclose with the Documentary Evidence an acknowledgement and declaration form, duly completed and signed by both the licensor of the relevant registered trade mark and the Applicant (as licensee).

Applicant knew how to apply for the Domain Name and signed the relevant documents that refer to the Regulation and the Sunrise Rules and Conditions which it accepted when it applied for Domain Name. Further, Applicant knew that demonstration of a Prior Right was required. It provided evidence to that effect. It failed to show that it was a licensee of such right. As a result, Applicant cannot claim not to be aware of the rules.

Further, beyond the letter of the law, it is only logical that the Applicant demonstrates not only the existence of the Prior Right but also that it is the holder or the licensee of such Prior Right. Respondent cannot guess the existence of a licensee-licensor relationship.

As a result the Panel cannot annul the Respondent's decisions as this decision was made in full compliance with the Regulation and derived rules.

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 | **Jean Albert** |

DATE OF PANEL DECISION 2006-09-23

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

In a dispute in which the language of the proceedings is English, the Panel will not take into account a Complaint filed in another language especially when the Complainant has been given a chance by the Panel to correct this and has refused to do so.

The burden proving that it is the holder or the licensee of a registered trademark falls on the Applicant.

If an Applicant fails to submit in due time all documents which demonstrate that it is the holder or the licensee of a Prior Right, the application must be rejected so that the next applicant in line may obtain the domain name.

The Applicant assertion that it did not know the rules is not a valid excuse.

The Compliant is denied.