# Entscheidung der Schiedskommission for dispute CAC-ADREU-001592

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| Case number | **CAC-ADREU-001592** |
| Time of filing | **2006-06-06 10:33:30** |
| Domain names | **hirsch.eu** |

## Case administrator

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| Name | **Josef Herian** |

## Complainant

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| Organization / Name | **HIRSCH Armbänder GmbH, Dr. Katharina Ehrenfried** |

## Respondent

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| Organization / Name | **EURid** |

ANDERE RECHTLICHE VERFAHREN

The Panel is not aware of any other legal proceedings regarding the disputed domain name.

SACHLAGE

The Complainant challenges the rejection of his application for the domain name hirsch.eu.

A. BESCHWERDEFÜHRER

On 07 December 2005 the Complainant filed its application for the domain name hirsch.eu. To support this application it relied on the national (Austrian) trademark No. 85876 HIRSCH (Registration date: 24 June 1977). According to Complainant this trademark is in full force and effective.

Together with its application Complainant transferred a copy of the trademark registration certificate. This certificate was issued on behalf of Hermann Hirsch Leder- und Kunststoffwarenfabrik which was – according to Complainant – the predecessor in title of Complainant. To prove this fact (in a complete chain of evidence) Complainant did also present – together with its application - a set of extracts of the commercial register. Together with the complaint it did submit a confirmation issued by an Austrian Notary Public according to which Complainant is the legal successor of the owner of the trademark.

With its e-mail of 27 April 2006 Respondent did inform Complainant that its application has been rejected. The reason given for this was that the documentary evidence provided by Complainant was insufficient.

According to the opinion of Complainant the Validation Agent has violated the provisions of the Sunrise Rules and has not examined the documentary evidence properly. If the Validation Agent would have reviewed the documentary evidence to its full extent it could not have come to the conclusion that this evidence is insufficient.

According to its further arguments Complainant has also registered the trademark HIRSCH in several other EU Member States (Finland, Sweden, Ireland).

After the rejection of the application on behalf of Complainant Respondent did – even though the time limit for issuing ADR proceedings has not been expired - accept another application for the domain name hirsch.eu on behalf of Vema N.V., based in the Netherlands. Complainant requests that Respondent does not activate the domain name hirsch.eu on behalf of Vema N.V. as long as the present ADR proceedings are still pending.

On the basis of these arguments Complainant requests that the decision of Respondent is to be annulled and that the domain name hirsch.eu is to be attributed to Complainant.

B. BESCHWERDEGEGNER

According to Respondent the Validation Agent concluded from the documentary evidence provided by Complainant that it was not owner of a prior right. This because of the fact that the trademark certificate was issued on behalf of Hermann Hirsch Leder- und Kunststoffwarenfabrik and not on behalf of Complainant and since the Hirsch Armbänder Ges.m.b.H. was split into several companies, one of which is the Complainant. The documentary evidence did not show what assets went to which of these companies.

Respondent agrees that Hermann Hirsch Leder- und Kunststoffwarenfabrik was later incorporated into Hermann Hirsch Gesellschaft m.b.H., which did then change its name to “Hirsch Armbänder Ges.m.b.H.”. In 2000 Hirsch Armbänder Ges.m.b.H. was split up to form – inter alia – Hirsch Armbänder AG, which is the legal predecessor of Complainant.

Respondent does deny that Complainant did prove that it is the owner of the trademark HIRSCH since it has not provide (on the basis of a prima facie review) a sufficient documentary evidence as to this fact. It has especially not delivered any evidence that the trademark was assigned to Hirsch Armbänder AG. According to Respondent the trademark could have been assigned to any of the companies resulting from the demerger of Hirsch Armbänder Ges.m.b.H.

It was – following the further arguments of Respondent – Complainants duty to provide clear evidence that it is the holder of a prior right. If this burden of proof is not fulfilled, the application is to be rejected. The Validation Agent was not obliged to undertake further investigations with regard to the question whether Complainant actually is the owner of the trademark. According to Respondent the relevant question is whether an Applicant does meet the requirements of delivering sufficient documentary evidence and not if it actually is the holder of a prior right.

With regard to some of the documents submitted by Complainant together with the complaint Respondent requests that these documents are to be disregarded since they have not been presented together with the application. Therefore theses documents could not have been considered by the Validation Agent.

Respondent furthermore states that the acceptance of the second application in queue does not affect the status of Complainant’s application, since the registration is based on a first-come-first-served principle.

WÜRDIGUNG UND BEFUNDE

1. On 7 December 2005 Complainant filed its application with regard to the domain name hirsch.eu. This application was based on a prior right, i.e. the national (Austrian) trademark HIRSCH.

2. Both parties agree that Hermann Hirsch Leder- und Kunststoffwarenfabrik was owner of the trademark HIRSCH. This trademark has been entered in the register of the Austrian Patent Office on 24 June 1977.

3. In 1989 the business of Hermann Hirsch Leder- und Kunststoffwarenfabrik was incorporated into Hermann Hirsch Gesellschaft m.b.H., which (in 1995) changed its name to Hirsch Armbänder Ges.m.b.H. in 2000 Hirsch Armbänder Ges.m.b.H. was split up to form Hirsch Armbänder AG, HAT – Skinline AG and Artisanal – Produktions GmbH. In 2003 Hirsch Armbänder AG changed its name to Hirsch Armbänder GmbH (Complainant).

4. The documentary evidence proving these facts has been received by the Validation Agent in due time on 23 December

2005.

5.The application has been rejected according to EURid's e-mail of 27 April 2006.

6. Following the rejection of the application of Complainant the Panel has to consider whether Complainant has proved (by presenting the documentary evidence) that it is the owner of the trademark HIRSCH.

7. Art. 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 rules that the holder of prior rights recognized or established by national and/or Community law is eligible to apply to register a domain name during a period of phased registration (before general registration starts). One of these prior rights is a trademark registered by (inter alia) a trademark office in one of the EU Member States (Section 13 (1) (i) of the Sunrise Rules).

8. Art 12 (3) of Commission Regulation (EC) No 874/2004 of 28 April 2004 provides that the request to register a domain name based on such a prior right shall include a reference to the legal basis in national or Community law for the right to the name.

9. The requirements of the documentary evidence are (inter alia) set in Section 13 (2) i of the Sunrise Rules.

10. This documentary evidence does have to prove that the Applicant is the owner of the prior right (Art 14 (4) of Commission Regulation (EC) No 874/2004 of 28 April 2004), i.e. the registered trademark (Section 13 (2) of the Sunrise Rules).

11. Section 20 of the Sunrise Rules determines additional requirements if the documentary evidence does not clearly prove that an Applicant is owner of a prior right. The Provision of Section 20 (3) of the Sunrise Rules – which is invoked by both parties – rules that the an Applicant does have to submit official documents substantiating that it is (inter alia) legal successor of the person registered as owner of the prior right.

12. The examination of prior rights and the duties of the Validation Agent are set in Section 21 of the Sunrise Rules. This examination is to be conducted on the basis of a prima facie review (Section 21 (2) of the Sunrise Rules), the Validation Agent is permitted but not obliged to conduct its own investigations with regard to the prior right (Section 21 (3) of the Sunrise Rules).

13. Complainant has provided documentary evidence that Hermann Hirsch Leder- und Kunststoffwarenfabrik was owner of the trademark HIRSCH. It has also provided documentary evidence of the following chain of legal succession: Hermann Hirsch Leder- und Kunststoffwarenfabrik was legal predecessor of Hermann Hirsch Gesellschaft m.b.H., who was legal predecessor of Hirsch Armbänder Ges.m.b.H. Because of these facts the Panel comes to the conclusion that Hirsch Armbänder Ges.mb.H. was – at the point of time of its splitting up - to be qualified as owner of the trademark HIRSCH.

14. Complainant has therefore on the one hand provided evidence that Hirsch Armbänder Ges.m.b.H. was the owner of this trademark.

15. It has on the other hand not provided clear evidence as to the question which of three companies into which Hirsch Armbänder Ges.m.b.H. has been split up in 2000 is the successor with regard to the trademark i.e. which of these three companies is allowed to use this trademark now (usually the contract in which this division is stipulated does contain provisions as to the question to which of the companies established in the course of a splitting up an already existing trademark is assigned).

16. Because of these facts the Panel is not able to hold, which of these three new companies is now the owner of the trademark HIRSCH. According to the opinion of the Panel Complainant has not provided sufficient and clear evidence that it actually is the owner of the trademark HIRSCH (Section 20 (3) of the Sunrise Rules). The Validation Agent was not obliged to investigate whether Complainant actually is the owner of that trademark (Section 21 (3) of the Sunrise Rules).

17. The documents presented by Complainant for the first time together with its complaint (especially the certificates of the Finnish, Irish and Swedish Patent-/Trademark Offices) are not to be considered by the Panel since documentary evidence to prove a prior right does have to be presented within the time limit according to Sections 6 (1) (iv) and 8 (5) of the Sunrise Rules. Even if the Panel would have had to consider these documents they do only deliver evidence that the trademark HIRSCH is registered in the mentioned countries on behalf of Hirsch Armbänder Gesellschaft m.b.H./Hermann Hirsch Leder- und Kunststoffwarenfabrik. The documents do not prove that Complainant is the owner of that trademark.

18. The Panel therefore decides that the complaint is to be denied.

ENTSCHEIDUNG

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

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| Name | **Christoph Haidlen** |

DATUM DER ENTSCHEIDUNG DER SCHIEDSKOMMISSION 2006-08-11

## Summary

EINE ENGLISCHSPRACHIGE KURZFASSUNG DIESER ENTSCHEIDUNG IST ALS ANLAGE 1 BEIGEFÜGT

1. On 7 December 2005 Complainant filed its application with regard to the domain name hirsch.eu. This application was based on a prior right, i.e. the national (Austrian) trademark HIRSCH.

2. The trademark was registered on behalf of Hermann Hirsch Leder- und Kunststoffwarenfabrik who was incorporated into Hermann Hirsch Gesellschaft m.b.H., which changed its name to Hirsch Armbänder Ges.m.b.H. which was split up to form the legal predecessor of Complainant and two other companies.

3. Complainant has provided evidence that Hirsch Armbänder Ges.m.b.H. was – at the point of time of its splitting up - owner of the trademark.

4. Complainant has not provided clear evidence which of three companies into which Hirsch Armbänder Ges.m.b.H. has been split up is the successor with regard to the trademark, i.e. which of these three companies is allowed to use the trademark now.

5. Because of these facts Complainant has not provided sufficient evidence that it actually is the owner of the trademark,the Panel is not able to hold, which of the three new companies is the owner of it.

6. The Panel therefore decides that the complaint is to be denied.