Panel Decision for dispute CAC-ADREU-001774

Case number	**CAC-ADREU-001774**
Time of filing	**2006-07-04 14:31:45**
Domain names	**psp.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Peters, Schönberger & Partner GbR**

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

None the Panel is aware

FACTUAL BACKGROUND

Factual background
On December 13, 2005, complainant filed an application of the domain name “psp.eu”, on the basis of prior right consisting in the German registered trademark n° 30054209 for the word “PSP”, valid until July 20, 2010, as from documentary evidence submitted to respondent on January 22, 2006.

On May 26, 2006, respondent notified by email to complainant stating that its application was rejected on the basis of insufficient substantiation of prior rights arising from documentary evidence submitted.

After an informal enquiry with respondent conducted by telephone on May 31, 2006 by complainant’s representatives, it was apparently told to an employee of the applicant that the application was rejected due to a “lack of identity between applicant and prior right holder”. On June 9, 2006 respondent notified by email the complainant, confirming the rejection of the application on the basis of a slight difference between the applicant’s name designated in the application form (i.e. “PSP Peters, Schönberger Partner GbR”), and the name of the holder of the trademark resulting from the trademark certificate (i.e. “Peters, Schönberger & Partner GbR”).

On June 30, 2006 12:33:22 complainant filed by email to CAC a complaint against Eurid. Hardcopy of the complaint was filed on the July 21, 2006. The complainant elected that the dispute shall be decided by a three-member Panel. The complainant ask the Panel to annul respondent decision, arguing that the slight difference cited by respondent was an obvious immaterial error, which in any case would have led respondent to the rejection of domain name application. Furthermore, complainant contends how it is not rationale that respondent may benefice of the human faultness by declining its decisions, while the applicant would be absolutely prevented in using the same benefice.

On July 21, 2006 CAC notified parties, after successful review of formal requirements compliance, the commencement of the ADR proceeding.
After reception of respondent’s response on September 8, 2006, CAC notified the appointment of the three-member panel on September 13, 2006. Projected decision date was October 9, 2006.

On September 15, 2006 by way of a non standard communication, complainant submitted additional grounds.

On September 25, 2006 a member of the Panel commission filed a non-standard communication arising some independence and

impartiality issue. On September 26, 2006 CAC notified the appointment of a new member of the Panel commission and the postponement of the decision date until the October 26, 2006.

A. COMPLAINANT

It is complainant's submission that respondent's decision to reject the domain name psp.eu is contrary to .eu regulations, as from the documentary evidence duly provided it is clear that:
a) applicant is the owner of the prior right;
b) applicant and p.r.owner are the same person.
The presence of the acronym of the applicant ("psp") in the "applicant name" field does not infringe the identicality rule, as it is a clear immaterial error not affecting the substantial identity between the two entities.

Complainant explains that after informal enquiry with respondent representatives in order to understand the basis for the rejection on the application (notified by email the 26 May 2006), they were told that the rejection was based on the lack of identity between applicant and holder of prior rights.
Notwithstanding the above mentioned decision, respondent filed on the 9 June 2006, after the aforementioned telephone conversation with complainant's representatives, a new email saying that the rejection should be not revoked on the basis of the lack of documentation justifying the difference between the name of the applicant and the holder of the prior rights.

It is complainant's submission that the presence of the "PSP" element (which is the acronym of the names of complainant's law firm members) is not a deviating name as assumed by respondent, but simply an additive to the correct name, traditionally used in combination with those letters.

This may be confirmed by short ways, including complainant's website address (www.pspmuc.de); the email address used (name)@pspmuc.de; brochures, letter heads and other documents for external use; where "psp" abbreviation is always associated to complainant's full name.

Finally, complainant contends that it seems irreconcilable with the principle of "First Come First Served" that months later Eurid adduced new reasons to uphold its declining decision. This would lead to deny an applicant the right to be awarded with the domain name applied for, even on the basis of slight errors in the relevant application, while Eurid would be left free to rectify its previous decisions.

In any case, complainant argues, may not be taken into account respondent's concerns in avoiding legal difficulties should the respondent accept complainant's application not being 100% correct, as two other firms are enlisted for the same domain name.

B. RESPONDENT

With regard to Complainant's arguments, the Respondent argues that, according to Article 10 of the EC Regulation 874/2004, the holder of a prior right recognized or established by national or community laws is entitled to apply for the corresponding domain name during the phased registration procedure. Furthermore, the Respondent states that, according to article 14 of EC Regulation 874/2004, it shall register the domain name if it finds that the Applicant demonstrated a valid prior right. The Respondent stresses that the Complainant submitted documentary evidence consisting of a certificate stating that the prior right is registered in the name of a company (Peters, Schönberger & Partner GbR) which, in the Respondent's view, has a different denomination with respect to the Applicant's one (PSP Peters, Shoenberger Partner GbR). In addition the Respondent underlines that the request was rejected due to the fact that Complainant did not submit, within the forty (40) calendar days following receipt of the Application by the Registrar, documentary evidence proving that Peters, Shönberger & Partner GbR and PSP Peters, Schönberger Partner GbR are the same legal entity. In consideration of the above, the Respondent requested the rejection of the Complaint.

DISCUSSION AND FINDINGS

Complainant is the German law firm Peters, Schönberger & Partner GbR.
Complainant filed complaint against respondent claiming that rejection of the contested domain names (psp.eu) is in conflict with .eu Regulations, including art. 10 paras. 1 and 2 (priority of the recognised prior right owner in the phased registration) as well as art. 14 of PPR (validation and registration of application).

The Panel here recalls art. 22.11 PPR, proving that the scope of ADR proceedings against the registry is to verify the compliance of registry's decision with the EU Regulation 733/02 or 874/04 (PPRs).

As the present case deals with validation of the documentary evidence in the sunrise period domain name applications, the Panel recalls art. 12 (1) third par. PPR "The Registry shall publish on its website two months before the beginning of the phased registration a detailed

description of all the technical and administrative measures that it shall use to ensure a proper, fair and technically sound administration of the phased registration period."

These rules (Sunrise Rules) are applicable to: v) the Validation Agents, when examining Documentary Evidence; (vi) the Registry, when deciding whether or not to register a Domain Name, and, what is important in this case to vii) Panellist(s) deciding on a Complaint against a decision of the Registry to register or not to register a Domain Name (vide Sunrise Rules, Object and Scope).

Respondent justify the rejection of the psp.eu domain name on the basis of the difference between the name of the applicant "PSP Peters, Schönberger & Partner GbR" and the name of the owner of the prior right, "Peters, Schönberger & Partner GbR".

As the documentary evidence submitted was not explaining this "difference" between the denominations, as provided by art. 20.3 of the Sunrise Rules, the validation agent found that applicant was not the holder of prior rights and consequently the respondent rejected the domain name application.

1. Refusal of the Domain Name

The Panel will focus its attention on the compliance of respondent's operations to the .eu regulations.

Respondent's main argument relies upon the fact that complainant failed to submit official documents substantiating that it is the same person as or the legal successor to the person indicated in the Documentary Evidence as being the holder of the prior right, pursuant to sec. 20.3 of Sunrise Rules.

It is therefore of the most importance to ascertain if sec. 20.3 is applicable in this case.
The Panel finds that the scope of provisions under sec. 20(1), (2) and (3) Sunrise Rules is to allow trademark subcontractors to apply for their exclusive rights. All the cited cases (license agreement; trademark transfer agreement; merger; name change; de iure transfer) make reference to contractual documentary evidences, which shall be provided to substantiate applicant/subcontractor legitimation in the phased registration process. Obviously, when none of the aforementioned agreement have been put in place (as in the present case, where applicant and prior right holder are substantially the same), it does not make sense to request that the applicant shall submit any of those documentary evidence.

The difference in the name of applicant and prior right holder is not the consequence of the applicant negligence in providing proper documentation, or a tentative to invert the burden of proof set for by art. 14 PPR; but of a simple immaterial/formal error consisting in the inclusion of the applicant's acronym in the application form.

This results clearly from the documentary evidence, and may be easily controlled: the signatory of the application is reported in complainant's web site as a partner of the law firm; a simple google search entering prior right name gives a number of results where the acronyme is used; and in the complainant's website PSP acronym is already used.

It is important to point out that under art. 13 PPR Validation Agent shall be reputable bodies with appropriate expertise. This is particularly important in evaluating applicant's prior right under the relevant national law. The Validation Agents should have be aware that German law does not require a civil law association to use a single name in the course of trade. In any case, from the perspective of German law there is not the slightest doubt that the Peters, Schönberger & Partner GbR and PSP Peters, Schönberger & Partner GbR are the same legal entities.

The panel is aware that under sec. 21.3 Sunrise Rules validation agent may discretionally decide to conduct its own investigation into the circumstances of the application. Anyway, it is the Panel's opinion that the validation agent should have been able to recognize and confirm whether or not the difference in the name of the applicant and the name of the holder of prior rights may be justified in consideration of the local legal system, i.e. Germany, (see also ADR 232 DMC).

The panel also believes that that rejection made by Respondent of the Complainant's application implies that the initial discrepancy between the name of the Applicant and the name of the prior right's owner could have not been rectified by the validation agent. In the panel's view this approach is excessively formalistic and in contrast with the spirit of both the Sunrise Rules and the PPR.

Furthermore, it is questionable that respondent notified, after its first notification of May 26, 2006, a specification of the rejection decision on June 9, 2006.

This is because validation of documentary evidence have to be conducted on a prima (not secunda) facie basis, on the first set of

documents provided. The re-exam of the evidence submitted, in any case, confirms that validation agent was able to take initiatives to conduct additional investigations. In the present case the Panel believes that said investigations were not addressed to correct immaterial error but to reject the domain name application.

2. Transfer of Domain name to applicant

Under art. 22.11 PPR, the Panel may decide in appropriate case, after the annulment the registry decision, that the disputed domain name shall be transferred to the applicant.
The present case seems to be one of those appropriate cases, as from the ascertainment of the documentary evidence submitted by the applicant pursuant to art. 14 (4) of PPR., it is clear that the slight difference between the applicant name and the trademark holder was simply due to an immaterial error, and not to the circumstances set for by sec. 20 (3) of Sunrise Rules (i.e.: name change; merger; de iure transfer….). Therefore, it is possible to conclude that, in consideration of the Documentary evidence timely filed by the Applicant/Complainant, the registration criteria set out in European Union Regulations are fully satisfied.

The panel whishes to stress that It should have taken few minutes to the register to verify that applicant and trademark owner was one and the same, for instance:
- by visiting the website corresponding to the email address used for the notification of rejection decisions, where the “PSP” acronym is used together with the full names of applicant’s members;
- by conducting a simple google search typing the keywords “Peters, Schönberger & Partner GbR”, which would have resulted in a list of links to the applicant’s website, all included with the “PSP” acronym.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the (i) EURID's decision be annulled and (ii) the domain name PSP be transferred to the Complainant

PANELISTS

Name	**Torsten Bettinger**

DATE OF PANEL DECISION 2006-10-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

PSP Peters, Schönberger Partner GbR applied for the disputed domain name, stating as its prior right a national trademark registered in Germany. However, the Complainant submitted as documentary evidence a trademark certificate in which the owner of the trademark was indicated as Peters, Shönberger & Partner GbR (which according to the German legal system is a different manner to indicate the applicant’s name).

The Registry has rejected the Complainant’s application for registration of the domain name on the grounds that the application submitted was insufficient in order to prove the ownership on a valid prior right on the Applicant side.

In the case at hand, the Panel had to consider whether the Validation Agent had the opportunity to remedy the discrepancy between the application’s wording and the documentary evidence.

It is the Panel’s opinion that the decision taken by the Registry conflicts with the relevant EC-Regulations, since, as stated in previous cases, the validation agent must be able to recognize when the difference in the name of the applicant and the name of the holder of prior rights are justified in consideration of the local legal system

In addition, the Panel believes that the formalism showed by the Validation Agent is in obvious contradiction with the spirit of the rules regulating the so called sunrise period . Actually, said rules seem to be aimed to protect owners of prior rights and to safeguard those rights during the registration process, upon the condition that the first come, first served rule has been respected.

In the case at hand, both the Registry and the Validation Agent had before them all necessary documentary evidence for assigning the domain name to the Applicant, first in the queue for the domain name PSP.

Therefore, the Panel annulled EURid’s decision and ordered the transfer of the contested domain name to the Complainant.