Entscheidung der Schiedskommission for dispute CAC-ADREU-001943

Case number	**CAC-ADREU-001943**
Time of filing	**2006-06-22 12:04:54**
Domain names	**metzler.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**B. Metzler seel. Sohn & Co. KGaA, Jocelyne Doucin, Prokuristin**

Respondent

Organization / Name	**EURid**

ANDERE RECHTLICHE VERFAHREN

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name.

SACHLAGE

The B. Metzler sell. Sohn & Co. KGaA (hereafter "the Complainant" or “Applicant”) applied for the domain name “metzler.eu” on December 08, 2005. The validation agent received the documentary evidence on December 22, 2005 within the prescribed deadline.

The documentary evidence demonstrated that the holder of the trademark “Metzler” for which a prior right was claimed was registered in the name of the B.Metzler seel. Sohn & Co. Holding AG. A licence declaration for the trademark “Metzler” for the benefit of the Applicant was submitted. It was signed on December 01, 2005 by the B. Metzler seel. Sohn & Co. Holding AG as Licensor and the B. Metzler sell. Sohn & Co. KGaA as Licensee.

The trademark of the Licensor was initially registered on January 17, 1995 under the registration number 2 094 557. According to German Trademark Law, the registration was valid for a period of 10 years until January 31, 2005. Only on January 19, 2006 an application for a renewal of the trademark was filed by the B.Metzler seels. Sohn & Co. Holding AG. An anew registration of the trademark “Metzler” was afterwards carried out on April 21, 2006 under the registration number 306 03 858.

At the time the Complainant requested the registration of the domain name “metzler” as well as at the time the license declaration was signed the trademark had ceased to exist.
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 on June 01, 2006.

The Complainant now requests the Panel to annul the Registry’s decision and to attribute the domain name “metzler” to the Complainant. An according complaint was submitted to the ADR Center against Respondent’s decision. This as well as the

submitted documents was filed in the German language. In the following communications it was pointed out to the Complainant that according to Rule A 2 (k) of the ADR-Rules the proceedings against EURid as Respondent is to be conducted always in English. The Complainant consequently submitted a complaint in English together with a translation of all relevant documents.

A. BESCHWERDEFÜHRER

The Complainant contends the B. Metzler seel. Sohn & Co. Holding AG is the owner of the trademark “Metzler” and the B. Metzler sell. Sohn & Co. KGaA as Applicant to the domain name is a 100 % subsidiary to the trademark owner. For this reason a license declaration was signed between the B. Metzler seel. Sohn & Co. Holding AG as Licensor and the Complainant as Licensee.

B. BESCHWERDEGEGNER

The Respondent contends that the Complainant did not submit documentary evidence showing that the Complainant is the holder or licensee of a valid prior right. The Complainant merely demonstrated with the submitted documentary evidence that it was the holder of a license to an expired trademark and failed to comply with its burden of proof.

Pursuant to Art 14 of the Regulation, documentary evidence relating to the renewal of the trademark is not to be accepted. Such evidence cannot be considered as having been submitted within the prescribed 40-day deadline. The Respondent contends that the Panel should assess the validity of the Respondent’s decision only by the documentary evidence which the Respondent was able to examine at the time of the validation of the Complainants application.

The Respondent further contends that the new documents provided by the Complainant also fail to demonstrate a valid prior right at the time of the application. The Complainant applied for the domain name on December 08, 2005, but the documents of the complaint show that the trademark has been reregistered on April 21, 2006, more than four months after the application.

WÜRDIGUNG UND BEFUNDE

I.
The application for the domain name “metzler” by the Complainant was made on December 08, 2005 with the documentary evidence being received by the Respondent’s validation agent on December 22, 2005. The Complainant submitted an extract of the certificate of registration of the trademark “Metzler” with the German Patent and Trademark Office and a license declaration for its own benefit. These documents raised two crucial issues to the validation agent:

1. The name on the trademark certificate did not match the applicant’s name.
2. The submitted trademark certificate had expired in January 2005 and no document of a renewal or of an application for renewal was submitted.

ad 1.
The burden of proving that the Applicant is the holder or the licensee of a registered trademark exclusively falls on the Applicant. If an Applicant fails to submit all documents which demonstrate that it is the holder or the licensee of a prior right in due time, the application must be rejected. 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, completed and signed by both the licensor of the relevant registered trade mark and the Applicant.

Here, the Complainant was not the holder of the trademark “Metzler”, but the licensee. With the documentary evidence the Complainant submitted the accordingly required license declaration signed by the B. Metzler seel. Sohn & Co. Holding AG as licensor and the B. Metzler sell. Sohn & Co. KGaA as licensee. The Complainant therefore, duly demonstrated that he was the holder of a license to the trademark.

ad 2.

According to the Sunrise Rules the validation agent examines whether the Applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence received (Section 21.2).

The Complainant requested the registration of the domain name “metzler” for its benefit on December 08, 2005. The trade mark certificate submitted as documentary evidence to the application demonstrated that the retention period for the trademark “Metzler” had obviously expired already in January 2005 according to § 46 of the German Patent Act, i.e. prior to the date of the application and prior to the license declaration assigned to it. At the time of its application, the Complainant was in fact in possession of an invalid license certificate, for the trademark in question.

However, Section 11.3 of the Sunrise Rules provides that the Applicant must be the holder or licensee, of a valid prior right at the date on which the Application is received by the Registry. Validity in this sense means that the prior right must be in full force and effect. Such an effectiveness or validity was duly excluded by the validation agent on the basis of a prima facie review of the documentary evidence at the time of the assessment of the Complainant’s application. There was neither an apparent evidence of a renewal of the trademark registration nor of an application for renewal.

The validation agent was not obliged, to conduct its own investigations into the circumstances of the application and research about a potential extension of the trademark registration (Section 21.3). Any arguments on such an obligation for the validation agent have been repeatedly rejected in various other ADR proceedings (see case no 02190 - worlee).

II.
The Panel agrees with the Respondent that documents which did not form part of the first set of documents submitted to the validation agent should be disregarded when assessing the validity of a decision of the Respondent (see case no.219 - isl, case no.294 - colt, case no.706 - autowelt). Moreover, if the Panel admitted the documents filed by the Complainant, it would put it self into a role of quasi-validation or registration entity. This would go beyond its task and power (see ADR case no. 865 - hi). The ADR procedure is generally not intended to correct a domain name applicants’ mistakes.

Apart from that, even a consideration of documents demonstrating that the trademark registration has been renewed would not restore the Complainant’s right to the domain name “metzler.”. The Complainant applied for the domain name on December 08, 2005, but the documents of the complaint show that the trademark has been reregistered more than four months afterwards on April 21, 2006. Therefore, at no point of time regarding the application for the domain name a valid prior right for the benefit of the Complainant had existed.

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

Name	**Lambert Grosskopf**

DATUM DER ENTSCHEIDUNG DER SCHIEDSKOMMISSION 2006-10-04

Summary

EINE ENGLISCHSPRACHIGE KURZFASSUNG DIESER ENTSCHEIDUNG IST ALS ANLAGE 1 BEIGEFÜGT

1. The burden of proof is on the Applicant to show that he is the holder of a valid prior right or a licensee thereof.

2. Documentary evidence submitted after the 40-days deadline will not be considered by the Panel in a proceeding against EURid as Respondent.