# Panel Decision for dispute CAC-ADREU-002002

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| Case number | **CAC-ADREU-002002** |
| Time of filing | **2006-07-10 11:11:58** |
| Domain names | **linear.eu** |

## Case administrator

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| Name | **Eva Zahořová** |

## Complainant

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| Organization / Name | **linear Gesellschaft für konstruktives Design mbH (also known as "linear GmbH")** |

## Respondent

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| Organization / Name | **EURid** |

FACTUAL BACKGROUND

The Complainant is a corporation with limited liability engaged in the development of CAD applications and software for building services, duly incorporated in Germany within the European Community.

The Complainant is the registered owner of German Trademark 2 903 003 “linear®” which was registered on 24th April 1994 and renewed on 1st July 2004 at the German Patent and Trademark Office (Deutsches Patent und Markenamt).

On 7th December 2005, the Complainant applied through the automated application system provided by the Respondent to register the .eu domain name “linear” during Phase I of the phased registration period (Sunrise Period). In the application for the domain name <linear.eu> received by the Respondent from the Complainant, the name of the Complainant was, ostensibly due to the technical limitations of the automated system, abbreviated to "linear Gmbh" rather than the full name "linear Gesellschaft für konstruktives Design mbH" which would have required 49 characters.

Supporting its application under the Sunrise Rules, the Complainant relied on the above-mentioned German Trademark 2 903 003 “linear®” to establish its Prior Right and on 16th December 2005 submitted a copy of the original Trademark certificate in its possession, including the confirmation of the renewal of the German Trademark by the German Patent and Trademark Office, together with the signed application form and a corresponding letter. These documents were received by the Respondent on 22nd December 2005 (within the respective deadline for documents which ended on 16th January 2006).

On 25th May 2006 the Complainant received an email from the Respondent notifying the Complainant of the rejection of the application on the grounds that the evidence provided to the Respondent would not substantiate the Prior Right. In the course of an additional telephone inquiry on 16th June 2006 the Respondent informed the Complainant that there was “no proof” that the Applicant (Complainant) was the holder of the German Trademark owing to the difference between the names and addresses on the Trademark certificate and the corresponding application (form).

The Complainant's ownership of said trade mark registration is not in dispute and the Complainant has submitted documentary evidence of said registration in the form of a copy of the original Trade Mark certificate in its possession. What is disputed is whether the documentary evidence submitted clearly evidences that the Applicant and the Trade Mark owner

are one and the same, since the name in the Application is missing the word “für konstruktives Design” and, in addition, the address in the Application and that in the original Deed on the registration on the trademark registered in 1994 are different.

A. COMPLAINANT

The Complainant maintains that “linear GmbH” is an abbreviation commonly used to indicate its company, and is used in place of the full name (which is 49 characters long) to be able to fit within the limit of 30 characters imposed by the form used in the automated application process. This can be deduced from the letter accompanying the documentation sent to the Validation Agent, which contains both the abbreviated and the full names.

On these grounds, the Complainant considers that, even though its name was given in abbreviated form on the application, it was quite clear that this was the common abbreviation of the longer, full name appearing on the trademark registration certificate. EURid cannot thus conclude that the Applicant is not the owner of the trademark submitted to the Validation Agent as Documentary Evidence of the Prior Right to the “linear.eu” domain name.

The Complainant further maintains that it cannot be deduced from the difference between the address appearing on the trademark registration certificate issued 12 years ago and the address appearing on the current certificate that the owner of the trademark and the Applicant are different persons, as the confirmation of renewal of the trademark was sent in 2004 to the new address, thereby constituting proof of the change of address of the trademark owner.

The Complainant requests the Panel to rule that its Application was in accordance with the .eu Regulations, and that the Respondent’s decision to reject the Application was not in accordance with the .eu Regulations. For these reasons, in accordance with Section B 11 (c) of the ADR Rules, the Complainant requests the annulment of the disputed decision taken by the registry and, in accordance with Section B 11 (c) of the ADR Rules, the Complainant further requests the attribution of the domain name linear.eu to the Complainant.

B. RESPONDENT

The Respondent submits that the documentary evidence in the form of a certificate of trademark registration mentions as owner of the registered trademark the “linear Gesellschaft für konstruktives Design mbH”, established at Monnatstr. 9, 52146 Wurselen, while the name of the applicant for the domain name is “linear GmbH”, established at Kackerstr. 7-11, 52072 Aachen, and that the documentary evidence did not prove that the applicant for registration of the domain name was the reported owner of the registered trademark.

The Respondent further submits that the Validation Agent had no right (and a fortiori no obligation) to speculate on the relationship between the Applicant and the owner of the trademark, nor had any duty to conduct additional investigations into the circumstances of the application, the Prior Right claimed or the documentary evidence produced.

Therefore the Respondent, upon notification of the finding by the Validation Agent that the documentary evidence did not prove that the applicant for the domain name was the holder of the Prior Right to the domain name, rejected the application.

DISCUSSION AND FINDINGS

The Parties do not dispute the fact that the Complainant is indeed the holder of the German trademark “linear®”, or that the current address of the Complainant is different from that appearing on the registration certificate sent with the registration application.

The defence used by the Registry is essentially based on the following points:

a) The name of the Applicant was slightly shorter than the name of the indicated owner of the registered trademark;
b) the address of the applicant for the domain name was different from that of the owner of the trade mark;
c) the Validation Agent was not obliged to conduct its own investigations into the circumstances of the Application, the Prior Right claimed or the Documentary Evidence produced;
d) the Documentary Evidence produced did not allow the Validation Agent or the Registry to reasonably conclude that the

applicant and the trademark owner were one and the same.

This line of reasoning cannot be sustained. The provisions of Section 21 (3) of the “Sunrise Rules”, according to which “The Validation Agent is not obliged, but it is permitted in its sole discretion, to conduct its own investigations into the circumstances of the Application, the Prior Right claimed and the Documentary Evidence produced” cannot be interpreted in the sense of authorising any frustration of the reasoning of Article 1.0 (1.) of Commission Regulation (EC) No 874/2004 of 28th April 2004, which 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 domains starts (ADR 830, adi.eu); nor can it be understood as a rule exempting the Registry or the Validation Agent from the application of due diligence or of the requirement to act reasonably (ADR 253, schoeller.eu).

In this case, the Panelist considers that the documentation produced by the Applicant was of itself sufficient to prove the existence in its favour of the Prior Right required for the registration of .eu domains in the Sunrise Period. Should the Validation Agent have had any remaining doubt s, these could have been dispelled simply by verifying the Applicant's data on the Internet, as the Panelist did on this occasion.

For the purposes of registering the .eu domain, the Applicant in fact sent not only the trademark registration certificate showing its full name and the address of its registered office at the time of the registration, but also the letter from the German Trademark Office dated 1st July 2004, addressed to “linear Gesellschaft für konstruktives Design mbH” at its current address in Aachen, which confirmed the registration of the trademark up until 31 August 2014.

Now, the fact that the German Trademark Office sent the letter confirming the renewal of the trademark to “linear Gesellschaft für konstruktives Design mbH” to its current address in Aachen constitutes proof that, although the electronic form shows the abbreviation “linear GmbH”, the Applicant is actually the legitimate holder of the trademark. Moreover, should this not be the case, it cannot be explained: a) why the renewal letter was sent from the Trademark Office to the Applicant at its current address; b) how the Applicant came into possession of this letter, which is in fact private correspondence.

To this should be added that the documentation attesting to the Prior Right of the Applicant to the linear.eu domain was sent with a letter showing the abbreviated name used on the electronic form (“linear GmbH”) at the top, in the first part of the headed paper, while the stamp that accompanies the signature at the bottom of the letter gives the name of the company in full (“linear Gesellschaft für konstruktives Design mbH”). This too should have led the Validation Agent to conclude that the Applicant and the holder of the trademark were one and the same person (ADR 181, oscar.eu).

None of this was done by the Validation Agent, who also seems not to have examined either the letter from the German Trademark Office or the letter accompanying the documentation sent by the Applicant.

Nor does it appear that the Validation Agent, when faced with documentation sent by an Applicant whose full name consisted of 49 characters, compared to the 30 permitted by the electronic registration form, made any further investigation as to whether the name given on the form was in reality the usual abbreviation of the longer full name of the Applicant; in fact, in such cases the due diligence of the Validation Agent would indeed have required it to carry out further verification (ADR 253, schoeller.eu).

These omissions represent serious negligence on the part of PricewaterhouseCoopers, which was responsible for the validation service, and whose function was not merely to mechanically check that the name and address appearing on an electronic form corresponded with the name and address appearing on a trademark registration certificate, but actually to verify, through a diligent examination of all of the documentation, whether the Applicant did or did not have the right to register the domain in the Sunrise Period (ADR 253, schoeller.eu).

In its judgment, the Panelist held that the Complainant had shown that it was the holder of a Prior Right on the basis of its own registered trademark, and that the Registry's decision to reject its application to grant the “linear.eu” domain name was incorrect, insofar as this was due to serious negligence on the part of the Validation Agent PricewaterhouseCoopers.

In the circumstances the decision of the Respondent should be annulled and the Complainant's requests granted.

DECISION

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

the EURID's decision be annulled

the domain name LINEAR be transferred to the Complainant

## PANELISTS

| Name | **Enzo Fogliani** |
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DATE OF PANEL DECISION 2006-09-21

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant challenged the rejection of its domain name application by the Registry. Although the Complainant was the first applicant for the domain name “linear.eu” and submitted proof of a German trademark registration in good time, the Registry rejected the application.

The name on the application contained fewer words than the name on the trademark registration certificate, while the address on the trademark certificate was not the same as that given on the application. The renewal of the trademark, on the other hand, was sent to the Complainant’s new address by the Patent Office; the letter to the Validation Agent accompanying the documentation contained both the abbreviated and the full names.

The Panelist considers that the items provided by the Complainant to the Validation Agent were sufficient to demonstrate the Prior Right of the Applicant. The Panelist also considers that the Validation Agent was seriously negligent in its actions, insofar as the rejection of the request appears due (a) to a superficial and inadequate examination of the documentation submitted to the Validation Agent by the Applicant and (b) to the lack of even minimal further investigations to clarify any doubts regarding the identity of the Applicant; given the circumstances, due diligence would reasonably require such investigations.

The Panelist therefore annulled the Registry’s decision, as the proof of Prior Right was valid, produced in good time and is sufficient for an applicant to become the holder of a .eu domain name. The Panelist therefore ordered the granting of the domain name linear.eu to the Complainant and the activation of the domain name linear.eu.