Panel Decision for dispute CAC-ADREU-002007

Case number	**CAC-ADREU-002007**
Time of filing	**2006-06-30 13:49:16**
Domain names	**easydrain.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Easy Sanitairy Solutions B.V., Bouman**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

The Complainant, the Dutch company ESS B.V applied for the registration of the domain name “easydrain.eu”, on January 24 2006 during the sunrise period I, based on its prior Benelux trademark registration n° 0760931 “EASYDRAIN” registered in the name of EASY SANITAIRY SOLUTIONS B.V.
On February 13, 2006 the Validation agent received the documentary evidence.
The Complainant submitted documentary evidence consisting of an excerpt of the Benelux Trademark Office database stating that the trademark "EASYDRAIN" is registered in the name of "EASY Sanitory Solutions B.V."
Since the name of the Applicant for the domain name was different from the name of the EASYDRAIN trademark holder. The Respondent rejected the application for the domain name “easydrain.eu” considering that the Applicant did not demonstrate that it was the holder or the licensee of a prior right on the name EASYDRAIN.
On June 27, 2006 the Complainant filed its complaint and requested the panel to cancel the decision of the Respondent and to grant the domain name “easydrain.eu” to the Complainant.
On September 13, 2006, the Respondent filed its response requested the panel to reject the complaint.

A. COMPLAINANT

In support of its position Complainant contend as follows :
1. ESS B.V., the applicant for the domain name, and Easy Sanitairy Solutions B.V., the owner of the earlier trademark, are one and the same company.
2. Easy Sanitairy Solutions uses ESS, a common and obvious abbreviation, as a tradename.
3. The tradename ESS has been registered at the Dutch Chambers of Commerce.
4. The Sunrise Rules give provisions for cases in which the applicant for the domain name is not the legal owner of the earlier trademark.
5. The Sunrise Rules give provisions for cases in which there has been a statutory alteration of the details of the owner of the earlier right.
6. The Sunrise Rules give no provisions for cases in which the applicant of the domain name is the same legal person as the owner of the trademark registration, and there has been no statutory alteration of the name of the owner of the earlier trademark.

7. Paragraph 21 (3) provides a general norm of carefulness to be used in, i.a., situations that are still uncertain under the current rules and regulations.
8. The Validator should have applied the norm of carefulness in this matter because it is obvious that there is a strong relation between the applicant of the domain name and the owner of the trademark. Further investigation would have easily brought up that in fact, the applicant and the owner are one and the same legal person.
9. The applicant cannot be held responsible for the current state of his application because there are no clear rules set out in the Sunrise rules for this matter.

B. RESPONDENT

The Respondent refers to Article 10 (1) and 14 of the EC Regulation 874/2004 of 28 April 2004 and to Article 20.3 of the Sunrise Rules.
The Respondent argues that the Regulation and the Sunrise Rules clearly and certainly provide that the burden of proof is with the Applicant to demonstrate that it is the holder of a prior right. When there is a difference between the name of the Applicant and the name of the holder of the prior right, the Applicant should submit official documents explaining this difference.
In the present case, the documentary evidence did not demonstrate that the Applicant was the owner of a prior right since the Applicant's name is " ESS B.V." and the name of the owner of the trademark is "EASY Sanitory Solutions B.V.".
The Applicant must 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, but in the present case it failed to do so.
The Respondent and the Validation agent were under no obligation to investigate into the circumstance of the application. It is a mere possibility that the Respondent can use "in its sole discretion".
The Registry/validation agent cannot be expected and/or forced to speculate whether the Applicant is a holder of the prior right claimed, and therefore correctly rejected the Applicant's application. (see case 1443 (URBIS)).
Documents submitted for the first time during the present ADR proceedings may not be taken into consideration. In the present case, the new documents attached to the complaint were received by the validation agent after the 40 days period from the submission of the application for the domain name (Article 14 of the Regulation), which means that the Respondent could not use this information in taking its decision.

DISCUSSION AND FINDINGS

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".
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.(…) If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this.(…) The Registry 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 21.2. of the Sunrise Rules states that "[t]he 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 and scanned by the Processing Agent (including the Documentary Evidence received electronically, where applicable) and in accordance with the provisions of these Sunrise Rules".
Section 21.3. of the Sunrise Rules states that "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".

In the present case, the Complainant filed its application under the acronym ESS whereas the trademark registration has been made under the full name of the Complainant ie : EASY SANITAIRY SOLUTIONS B.V.
The Complainant failed to provide the Registry with relevant documents demonstrating a link between the applicant and the owner of the trademark within the 40 days period laid down in Article 14 of the Regulation.
Article Section 10 (1) Sunrise Rules provides that the validation agent validates whether the Documentary Evidence

substantiates the prior claimed by the applicant and Section 11 (3) Sunrise Rules provides that the applicant must be the holder of the prior right.
According to Section 21.3. of the Sunrise Rules, “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".
Knowing the huge number of .eu applications, it is difficult to require from the validation agent to conduct further investigations when the documents provided are not sufficient enough to establish that the applicant and the owner of the prior right are the same person.
However, the decision rendered by the Respondent has to comply with the Regulations, particularly with Regulation (EC) No 733/2002 and 874/2004 which state that “In order to safeguard prior rights recognised by Community or national law, a procedure for phased registration should be put in place. Phased registration should take place in two phases, with the aim of ensuring that holders of prior rights have appropriate opportunities to register names on which they hold prior rights. (Regulation No 874/2004 (12).
If one can understand that the validation agent is not obliged to conduct its own investigations when the Applicant fails to demonstrate that he is the owner of prior rights, the application cannot be rejected when this proof can be easily deduced from the document submitted.
It was clear from the submitted documentary evidence (trademark certificate) that ESS B.V was the acronym of EASY SANITAIRY SOLUTIONS B.V. The Respondent did not need to get further documents to conclude that the Applicant and the owner of the prior right were the same entity.
This is the reason why the panel considers that the link between ESS B.V and EASY SANITAIRY SOLUTIONS B.V. is obvious, therefore there was sufficient evidence to justify the registration of the domain name in the name of the Complainant.

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 and the domain name “easydrain.eu” be registered in the name of the Complainant.

PANELISTS

Name	**Isabelle Leroux**

DATE OF PANEL DECISION 2006-10-11

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant’s application was rejected on the ground that the submitted documentary evidence was not sufficient to prove that the applicant and the owner of the trademark were the same entity.
The application was filed by the complainant under its acronym which is also its tradename whereas the trademark was registered under the full company name of the complainant. The relevant document establishing the link between the acronym and the full name of the complainant was only submitted during the course of the ADR proceedings. The Panel ruled that the relationship between the complainant and the owner of the trademark was enough clear and no further documents were needed to establish that the complainant is the owner of a prior right.
Therefore, the EURid’s decision has to be annulled and the domain name “easydrain.eu” to be registered in the name of the Complainant.