Panel Decision for dispute CAC-ADREU-002012

Case number	**CAC-ADREU-002012**
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Domain names	**eito.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**EITO EEIG European Information Technology Observatory, Carola Peter**

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 that the Panel is aware of.

FACTUAL BACKGROUND

EITO EEIG European Information Technology Observatory applied in the Sunrise 1 period and based its application in its trademark “EITO”, registered as Community Trademark no. 00 23 84 675.

On 25 May 2006 EURid rejected the application.

The reasons stated by EURid for rejecting the application were the following:

In an e-mail of 29 May 2006, EURid wrote, that the domain name applied for was “eito.eu” whereas the trademark name the application was based on was “EITO EEIG European Information Technology Observatory” and in that respect the domain name did not correspond with the prior right.

Further when the complainants legal representative addressed EURid for the explanation for the rejection in order to start an ADR-procedure EURid answered in an e-mail of 29 June 2006, stating that there was no proof submitted that the Applicant is the same as the holder of the prior right as the names and the addresses did not match.

The Applicant's name and address were:

Peter Carola
EITO EEIG
Hahnstrasse 70
60528 Frankfurt
Deutschland

The trademark holder's name and address were:

EITO EEIG European Information Technology Observatory
Uhlandstr. 52
D-60314 Frankfurt am Main
DE

On 3 July 2006 the Complainant filed a complaint against EURid ordering that the EURid decision be annulled and the domain name eito.eu be registered in the name of EITO EEIG European Information Technology Observatory.

Below are the parties contentions as recieved by the parties with smaller adjustments and without attachments.

A. COMPLAINANT

EURid incorrectly rejected the application.

1. The domain name applied for was “eito.eu”. The trademark the application was based on is Community trademark No. 00 23 84 675, the word mark “EITO”. Thus, the Applicant did base its application on a trademark identical to the domain name applied for – and fulfilled the requirements of Article 10 of Commission Regulation (EC) 874/2004.

In EURid’s electronical data base system, the category “Prior Right on“ was filled out with: „EITO EEIG European Information Technology Observatory“ instead of simply „EITO“. This was due to the fact that the Applicant erred on how to fill out this category. In order to apply, the Applicant’s registrar sent out a standard form, which the Applicant filled out The Applicant filed out the entry for “prior right” incorrectly. This was due to the fact that in plain German the term “Name” refers to a name of a person or legal entity. In German, a trademark name is simply called “Marke”; the term “Markenname”, the literal translation of “trademark name”, is rather uncommon.

However, from the documentary evidence handed in by the Applicant, it was easily recognizable that this was a misunderstanding and a simple mistake of confusing the categories. It was clear from the copy of the trademark certificate that the domain name application was based on the trademark “EITO” – and that this name was claimed as protected by a prior right.

EURid erred in sanctioning this error by denying the application. Under the Sunrise rules, the Applicant is required to state the complete name for which the prior right is claimed (Sec. 3 (1) (vii) Sunrise rules). However, this seems to be a rather technical provision aiming to help to organize the work of the Validation Agent and the Registry. From a practical point of view, such a requirement was not indispensable: As an application for the Sunrise period could only be based on the complete name for which a prior right exists, it is logical that any applicant bases its applications on the prior right on the name which is contained in the second level of the .eu-domain name applied for. Thus, is was not strictly necessary to insert a slot “prior right on” which applicants had to fill out.

Likewise, also from a legal point of view, such a statement was not necessary. Neither Regulation (EC) 874/2004, nor Regulation (EC) 773/2004 require that the Applicant needs to separately state the name of the prior right claimed. Rather, Article 10 (2) of Regulation (EC) 874/2004 states:

“The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.”

Thus, the relevant name “as written in the documentation” shall be relevant – not the name as written in a data base. In the documentation, the name claimed was “EITO”.

Moreover, article 12 (5) of Regulation 874/2004 does not require that the name is separately stated somewhere in the process. The Article reads: “The request to register a domain name based on a prior right under Article 10 (1) and (2) shall include a reference to the legal basis in national or Community law for the right to the name, as well as other relevant information, such as trademark registration number, information concerning publication in an official journal or government gazette, registration information at professional or business associations and chambers of commerce.”

Likewise, whereas Sec. 3 (1) (vii) of the Sunrise rules requires applicants to provide information as to the name of the prior right in the application, it does not order that a defective statement of the name needs to be sanctioned by rejecting the application. The provision merely says that “the application is only considered complete” if such information is provided; it does not state that any application needs to be rejected if the information filled into this slot differs from the name in the documentary evidence.

A fair view of the materials provided to the Validation Agent made it clear that

a) the Applicant wished to register the domain name eito.eu

b) the Applicant based its application on a trademark consisting of the word “EITO”.

Thus, it was easy to detect that the prior right claimed was for the name “EITO”.

Finally, from a technical point of view, the Applicant did state “the complete name for which a prior right is claimed” – the term “EITO”; it just stated stated more than was required: it inserted the term “EITO” as part of its own company name. To any reviewer of the file, the aim of the Applicant was clear.

According to Article 12 (5) of Regulation 874/2004, a basic principle of the regulation process is fairness. Likewise, the Validation Agents need to exercise their powers in “an objective, transparent and non-discriminatory manner” (Article 13 of Regulation 874/2004). Additionally, the principles of fairness and reasonable interpretation of the communications of an applicant in a application process constitute basic principles of European law and the laws of the EU member states. It is now embedded in Article 41 of the Charter of Fundamental Rights of the European Union.

Thus, EURid needed to adhere to these principles of fairness and validate the file in a manner that takes into account the aim of the Applicant instead of giving regard to a merely formal analysis of the material. Additionally, nothing the Regulations requires to punish an applicant for a rather formal mistake with rejecting its application.

Apparently, this was also the view taken by EURid and the Validation Agent in another case reported in the Decision of 15 June 2006 in case no. 00229, Oomens vs. EURid, where EURid concluded:

“[N]onobstant the errors made by the Applicants in the said EPP fields, the Validation Agent did find that the request did include a reference to the legal basis in national or Community law for the right to the name, and that prior rights exi[s]t for these particular names and has notified to the Registry accordingly.

The Court finally held in this case.

„[T]he Panel mentions that the fact that an applicant may have filled in the “Prior Right on” field in an electronic form with the name of the Applicant organisation and not with the name of the prior right (trademark) would not lead to a conflict with the above mentioned Regulations as in the substantive documentation submitted during the validation process the name of the trademark for which the prior right exists and for which the identical domain name is applied for is mentioned.“

The Court also held in Oomens vs. EURid that the registry “was right to grant” the application even though apparently the name of the applicant organisation and not the name of the prior right (trademark) was inserted in the slot “Prior Right on”.

2. Later, the Registry stated as a second reason that there was no proof submitted that the Applicant is the same as the holder of the prior right as names and addresses did not match. However, the materials provided by the Applicant would have easily allowed the Validation Agent to swiftly verify that the Applicant is indeed the right holder.

The name of the Applicant was reproduced in the electronic system employed by EURid in the abbreviated form “EITO EEIG”. However, this was due to an error that occurred somewhere in the process of data processing. The Applicant itself stated its complete name “EITO EEIG European Information Technology Observatory” in the application process.

When the Applicant contacted the registrar in order to file the application, the Applicant was made to fill out an application form. In this form, the Applicant inserted its name at the appropriate position under No. 1.1 “Name des Antragstellers” [name of the Applicant]. Here, the Applicant inserted: “EITO EEIG European Information Technology Observatory”. Under position no. 5.5 the Applicant had to fill in the name of the right holder: here, it correctly stated: “EITO EEIG European Information Technology Observatory”. However, this information was not filled into EURid’s electronic system. As may be seen from the excerpt of the whois-database, only the abbreviation “EITO EEIG” was inserted into the slot “applicant”.

EITO is the abbreviation for “European Information Technology Observatory”. EEIG is the official abbreviation for “European Economic Interest Grouping“, a legal form established by Council Regulation (EEC) 2137/1985 (cf. Article 5 (1) (a) of this Regulation).

Because EITO is the short form for the long term “European Information Technology Observatory”, in business the Applicant uses both the short version of its name (“EITO EEIG” or in the German version: "EITO EWIV", EWIV being the abbreviation of "Europäische wirtschaftliche Interessenvereinigung") as well as the long form (“EITO EEIG European Information Technology Observatory”).

The doubts the Validation Agent might have had could have easily been solved by following the leads given in the information at hand. The term “EITO EEIG European Information Technology Observatory” was also to be found in the database (even if in the wrong position,

the slot “prior right on”). This was a hint that there is a connection between the two terms, which should have prompted the Validation Agent to look into the matter somewhat further. A short internet research would have prompted the agent to the website of the company “www.eito.com”. There, both the short as well as the long form of the company name are used. Among the information about management (http://www.eito.com/management.html) Ms. Carola Peter is mentioned as the managing director. She is also mentioned in the name section of the electronic system of EURid.

Additional doubts the Validation Agent had were due to the difference in addresses. The trademark certificate handed in as documentary evidence by the Applicant, was the original certificate issued by the Office for Harmonization in the Internal Market (Trade Marks and Designs) – OHIM, another of the European institutions. In a matter of minutes the Validation Agent could have checked the current situation of the trademark “EITO” in the online register of OHIM which is easily accessible. There, he would have seen, that the address was changed to Hahnstr. 70, 60528 Frankfurt – the actual address of the business offices of the Applicant also specified in the domain application as the excerpt from the OHIM online data base which we include here shows.

The original trademark certificate was issued on 5 March 2003 as the documentary evidence showed. It was reasonable that – as the city remained the same – the Applicant just had moved which explained the change of street address. (The change of address was registered by OHIM at the request of the Applicant on 17 November 2004; here, the Applicant made that request by using the short form of its name – nevertheless OHIM registered the change of address.

This Court has held that under the Sunrise Rules, the Validation Agent needs to take advantages of easily accessible information in situations where the circumstances show that uncertainties can be cleared up quickly. In its decision of 29 May 2006 in case no. 00253, Ernst Schoeller GmbH & Co. KG vs. EURid, this Court held:

“When faced with such a situation, the Validation Agent, in terms of section 21 (3) of the Sunshine Rules, had the discretion to “conduct its own investigations into the circumstances of the Application, the Prior Right claimed and the Documentary Evidence produced.” Given the difference of nearly 3 years in date between the Documentary Evidence and the application for domain name registration, it was perfectly possible that some change of address could be the simple reason for the discrepancy. It would have been the work of a few minutes for the Validation Agent to test the issue of identity: the town in both the application and the Documentary Evidence was the same and it was just the street address that was different. A quick Internet search (in seconds through telephone directory, Google etc.) would have consistently thrown up the Applicant’s name as being the Ernst Schoeller Waeschenfabriken GmbH & Co at Sonnenstrasse 100 in Albstadt (a smallish town of 47,000 inhabitants). All it would have taken to ensure that there is no mistake of identity would have been a short e-mail to the Applicant requiring further documentary evidence (such as a certificate of change of address released by the Company Registration authorities in Germany) to prove that despite the different street addresses, the Applicant was one and that same as the holder of the prior right. […]

While the same section 21 (3) of the Sunrise Rules grants the Validation Agent “sole discretion” to carry out such investigations, it is a fundamental principle of justice that, when granted such discretion, the Validation Agent is not exempted from the requirement to act reasonably. Indeed, it may be argued that the extent of the discretion granted to the Validation Agent implies a higher standard of care and reasonableness. In the circumstances of the case, the Validation Agent could have easily cleared up any doubts by seeking and obtaining further proof of identity despite change of address and a slightly abbreviated name.”

While one might argue, that the Sunrise process was installed to yield quick results and did not want to burden the Validation Agent with extended duties to investigate, there is no reason to disregard quick and easily accessible research possibilities. Where the Validation Agent is in a position to investigate circumstances in a quick and easy manner, there is no reason to reject an application just because such investigations were not employed. The principles of fairness and reasonable execution of powers, which we mentioned above, require that such efforts are taken instead of using a formal approach.

This court has repeatedly held that the aim of the Regulations and the Sunrise Period is to safeguard prior rights recognized by Community or national law” (Recital 12 of Regulation 874/2004; Decision of 18 May 2006 in case no. 00181, Pinel vs. EURid). To that end, reasonable effort by the institutions involved in the process may not be left out.

B. RESPONDENT

1. GROUNDS ON WHICH THE RESPONDENT REJECTED THE APPLICATION OF EITO EEIG ON THE DOMAIN NAME EITO

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". Article 20.3. of the Sunrise Rules states that "If, for any reasons other than as are referred to in Section 20(1) and 20(2) hereof, the Documentary Evidence provided does not clearly indicate the name of the Applicant as being the holder of the Prior Right claimed (e.g. because the Applicant has become subject to a name change, a merger, the Prior Right has become subject to a de iure transfer, etc.), 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".

EITO EEIG (hereafter "the Complainant") applied for the domain name EITO on February 2, 2006. The validation agent received the documentary evidence on February 8, 2006, which was before the March 13, 2006 deadline.

The Complainant submitted documentary evidence consisting of a Certificate of Registration of Community Trademark N° 002384675 holding that the trademark "EITO" is registered in the name of "EITO EEIG European Information Technology Observatory" (hereafter "the Trademark Holder".) The name of the Complainant is different from the name of the Trademark Holder. The Complainant however, did not submit documentary evidence substantiating that the Complainant is licensed by the Trademark Holder or that it is the same person as or the legal successor to the Trademark Holder. Based on the documentary evidence, the validation agent concluded from the documentary evidence that the Complainant did not demonstrate that it was the holder or the licensee of a prior right on the name EITO.

Therefore, the Respondent rejected the Complainant's application.

2. COMPLAINANT'S CONTENTIONS

Complainant first argues that the fact that the error in the "Name for which a prior right is claimed" field of the Application form was not a sufficient reason to refuse the application. Secondly, the Complainant argues that it is the same person as the Trademark Holder and that it brought enough evidence to demonstrate it. The Complainant also argues that the Respondent's validation agent should have conducted its own investigations to further investigate the Complainant's application.

3. RESPONSE
3.1 The mistake in the field "Name for which a prior right is claimed" The Complainant agrees that a mistake was made in the filing of the application. The Complainant should have written "EITO" instead of "EITO EEIG European Information Technology Observatory" in the field "Name for which a prior right is claimed".

However, the Respondent did not base its rejection decision on this mistake.

3.2 The burden of proof was with the Complainant to demonstrate that it is the holder or the licensee of a prior right.

Article 10 (1) of the Regulation states that only the holders of prior rights shall be eligible to apply register domain names during the period of phased registration. Pursuant to article 14 of the Regulation, the applicant must submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. Based on this documentary evidence, the validation agent shall examine whether the Complainant has prior rights on the name. It is therefore of crucial importance that the Respondent is provided with all the documentary evidence necessary for it to assess if the Complainant is indeed the holder of a prior right.

The burden of proof was thus on the Complainant to substantiate that it is the holder or the licensee of a prior right (see for example cases 294 (COLT), 551 (VIVENDI), 984 (ISABELLA), 843 (STARFISH)).

3.3 The documentary evidence did not demonstrate that the Complainant was the holder or the licensee of a prior right.

In the case at hand the name of the Complainant is different from the name of the Trademark Holder. This fact is undisputed.

Article 10 of the Regulation clearly states that it is the holder of a prior right that can register a domain name in the first phase of registration.

Section 20 of the Sunrise Rules further regulates the cases where the documentary evidence does not designate the applicant as the holder of the trademark.

The third subsection of section 20 is applicable to name changes. It states very clearly that : "If (...) the Documentary Evidence provided does not clearly indicate the name of the Applicant as being the holder of the Prior Right claimed 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."

In the present case, the documentary evidence did not contain any document explaining the difference between the name of the Complainant ("EITO EEIG ") and the name of the owner or licensee of the trademark relied upon in the application ("EITO EEIG European Information Technology Observatory"). In addition, the addresses of the Complainant and of the Trademark Holder were also different. A different address cannot be the sole reason for rejection of an application. However such a difference only enforce a presumption that one is talking about different entities.

The validation agent and the Respondent were therefore confronted with an application in which the Complainant and the owner of the trademark (a) had different company names, (b) had a different addresses.

The Respondent had thus no right (and a fortiori no obligation) to speculate on the relationship between the Complainant and the Trademark Holder, and therefore correctly rejected the Complainant's application.

In addition, the Respondent wishes to refer the Panel to the following cases:

In case No. 894 (BEEP), the Panel decided that: "Therefore, where the Prior Right claimed is a trademark, the burden of proof regarding ownership and license declaration is placed on the Applicant (Complainant) of the domain name. EURid and the validation agent have to rely upon the documentary evidence submitted by the Applicant and from the submitted evidence in the present case, it was clear that the Applicant of the domain name <beep.eu> was not the same company as the owner of the trademark BEEP. Thus, the Complainant failed to submit the relevant evidence regarding the license declaration within the forty day period set out in Article 14".

In case No. 1242 (APONET), the Panel decided that: "Therefore, in the absence of any document clearly indicating that a) VGDA Gmbh was the short term for Verwaltungsgesellschaft Deutscher Apotheker mbH; b) that VGDA was also an official company name of the Applicant; and c) considering the Complainant’s burden of proof with respect to its prior rights and wording of relevant provisions governing registration of .eu domain names in Sunrise Period, the Panel concludes that the Respondent, without having at its disposal any pertinent document proving that VGDA Gmbh and Verwaltungsgesellschaft Deutscher Apotheker mbH were the same entity, did not err in its decision to reject the Complainant's application. On the contrary, this Panel considers that EURid, in accordance with, Paragraph 3. Section 11 of the Sunrise Rules, correctly considered the Applicant as a different entity from the holder of the Prior Right claimed".

In case No. 551 (VIVENDI), the Panel decided that: "The documentary evidence provided by the Complainant shows that the owner of the trademark, on the basis of which the prior right to the Domain Name was asserted, is the company Vivendi, and not the Complainant (“Vivendi Universal”). The Complainant did not provide any proof within the documentary evidence which would explain that Vivendi Universal is a legal successor (as a result of a merger or otherwise) of the company Vivendi, which was (at the time of filing of the Application) a registered holder of the Trademark. Therefore, a conclusion must be drawn that the Complainant failed to demonstrate its prior right to the Domain Name".

In case No. 1627 (PLANETINTERNET), the Panel decided that: "The validation agent conducted a prima facie review of the submitted document, and in conjunction with point (ii) below, reached the conclusion that as the names did not match, and there was no other documentary evidence to explain such a discrepancy, that the applicant (i.e. the Complainant) had not established its prior right".

In case No. 1625 (TELEDRIVE), the Panel decided that: "Moreover, when examining an application for a domain name, the Registry’s obligation is to examine whether the applicant holds a prior right to the domain name (Article 14 of the Regulation). The right must be verifiable by the presented documentary evidence. This shall demonstrate that the right exists and that the applicant is the holder of this right claimed on the domain name. In the presented case the documentary evidence submitted by the Complainant showed that the IAV GmbH Ingenieurgesellschaft Auto und Verkehr, and not the iav GmbH is the holder of the trade mark TELEDRIVE. Therefore, the documentary evidence in support of the application for the domain name teledrive.eu was incomplete".

Complainant also argues that the Respondent's validation agent should have conduct its own investigations, pursuant to article 21 (3) of the Sunrise Rules.

Respondent would like to stress that section 21.2 of the Sunrise Rules makes it clear that the validation agent is to carry out a prima facie review of the first set of the documentary evidence received from the applicant to establish whether a prior right exists. Section 21.3 of the Sunrise Rules clearly states that the validation agent is under no obligation to conduct its own investigation into the

circumstances of the application. This principle is repeated in various decisions, such as No. 1483 (SUNOCO).

In decision No. 551 (VIVENDI) the panel concluded the following: "Generally, throughout the world, domain names have always been registered on a “first come first serve” principle without having specific regard to rights of owners of the intellectual property. The European Community, regarding legitimate interests of intellectual property rights owners, provided such owners with the opportunity of privileged registration of domain names corresponding to their intellectual property rights during the Sunrise Period. In order to administer such a tremendous task, it was absolutely necessary to establish strict and straightforward rules for demonstrating those intellectual property rights on which the privileged registration of the domain names should be based. These strict rules were, without any doubt, justified and necessary in situations where hundreds of thousands of applications for registration of domain names during the Sunrise Period had to be examined. Nothing in the Sunrise Rules construes the obligation of the validation agent or the Respondent to investigate the circumstances of applications where the prior right was not sufficiently demonstrated, or notify applicants of deficiencies in their application. Quite to the contrary, Section 21 (1) and (2) of the Sunrise Rules expressly stipulate that the validation agent and the Respondent shall not have any such obligations."

3.4 The new documents submitted by the Complainant may not be taken into consideration The Respondent wishes to stress that article 22 (1) b of the Regulation states that a decision taken by the Respondent may only be annulled when it conflicts with the applicable rules and regulations. This verification is the only task for the Panel in these proceedings, which may not in any case serve as a “second chance” or an additional round providing applicants an option to remedy their defective application that was rejected during the Sunrise Period (see cases Nr. 551 (VIVENDI) and Nr. 810 (AHOLD)). In other words, as decided in case Nr. 1194 (INSURESUPERMARKET), "[t]he ADR procedure is not intended to correct domain name applicants’ mistakes".

Indeed, it has been consistently reaffirmed by numerous Panels that only the documents which the Respondent examined at the time of validation of the application may be relied upon by the Panel to evaluate the conformity of the Respondent's decision with the applicable rules and regulations. (see notably cases Nr. 294 (COLT), Nr. 954 (GMP) and Nr. 01549 (EPAGES)).

The Complainant submits new documents in the framework of the present ADR proceedings.

The Respondent wishes to stress that these new documents were not enclosed with the documentary evidence, which means that the Respondent could not use this information in taking its decision. Therefore, it may not be taken into consideration to evaluate whether the Respondent's decision conflicts with the Regulation, which is the only purpose of the present ADR proceedings.

The Respondent wishes to refer the present Panel to the case Nr. 1422 (PORTAS), where the Panel correctly explained that: "This is not a case where the Panel is asked to decide whether a Priority Right exits or not, as suggested by the Complainant. Neither is it a question of whether formalistic rules should win over justice, as the Complainant also suggested. The questions are whether the Validation Agent had a duty to investigate and also whether the Complainant should be given the opportunity to mend its hand, having made an error? The Panel therefore determines that the Respondent was correct in its decision to refuse the Complainant’s application for registration under the Sunrise Rules and the Complaint is denied".

3.5 Conclusion

The Regulation and the Sunrise Rules give all the holders of prior rights the opportunity to demonstrate their prior rights during the phased registration, which is an exception to the basic principle of first-come first-served.

In order to benefit from this opportunity to demonstrate its prior rights, the applicant must comply with the strict procedure laid out by the Regulation for dealing with the thousands of applications received during the phased registration and making sure that these applications are substantiated. The Applicant in the present case did not seize this opportunity, because its application did not correctly fulfil the substantial requirements.

It is therefore untrue that the Applicant who was first in the queue should automatically be granted the domain name if it has prior rights. As the panel clearly summed up in case ADR 1886 (GBG), "According to the Procedure laid out in the Regulation the relevant question is thus not whether the Complainant is the holder of a prior right, but whether the Complainant demonstrated to the validation agent that it is the holder of a prior right. If an applicant fails to submit all documents which show that it is the owner of a prior right the application must be rejected".

As the Panel in case n° 219 (ISL) stated: "One could argue that sympathy is overruled by the applicable Regulations serving among other purposes the (cost-effective) functionality of the phased registration and the principles hereof". In case n° 1627 ("PLANETINTERNET"), the Panel agreed with the Panel in ISL and further explained that "the Regulations and the Sunrise Rules were clearly drafted to ensure a

fair distribution of .eu domain names during the phased period and if an applicant fails to fulfil its primary obligations, then, even where such failure is due to an oversight or genuine mistake, the application must be rejected by the validation agent".

For these reasons, the Complaint's complaint must be rejected.

DISCUSSION AND FINDINGS

The Complainant and Respondent both agrees upon the fact that the Complainant made a mistake in filling out the "Name for which the prior right is claimed"-field.

The field was filled with the text "EITO EEIG European Information Technology Observatory" and in fact the prior right claimed was "EITO" in compliance with the domain name applicated for eito.eu.

In the first explaining e-mail from the Respondent to the Complainant of 29 May 2006 this was the reason for rejection.

Later in the second explaining e-mail from the Respondent to the Complainant of 29 June 2006 the reason was that no proof submitted showed that the Applicant is the same as the holder of the prior right as the names and the addresses did not match.

The Respondent has in such changed its grounds for its decision which ground has been maintained under this ADR-proceeding, thus the first reason for rejection will not be taken further into account in this decision.

The Panel notes that in the Panel's view and in accordance with the cases ADR 229 "CITY, KICKBOXING, CRAWLER, BLUE" and ADR 328 "LAST-MINUTE" such discrepancies is not in direct violation of the Commission Regulation No. 874/2004 (EC) or with the Regulation (EC) No. 733/2002 escpecially provided that the submitted documentary evidence provides for a sufficient and meaningful evidence for the existence of the prior right claimed and the correct ownership og license hereof.

The relevant issue left to discuss is therefore in its essence the following:

Does the fact that the Applicant was filled in as:

EITO EEIG
Hahnstrasse 70
60528 Frankfurt
DE

and the fact the the trademark holder´s name and address were:

EITO EEIG European Information Technology Observatory
Uhlandstr. 52
60314 Frankfurt am Main
DE

Together with the documentation at hand (including the cover sheet) constitute a sufficient reason for the Validation Agent and in that respect later the Respondent to reject the application for the domain name i question?

Further it is relevant to notice that the Applicant by mistake (though) actually in the "Name for which the prior right is claimed"-field on the cover sheet had wrote: "EITO EEIG European Information Technology Observatory".

This is relevant in according to the further below mentioned investigation and the expected extent hereof.

In the Commission Regulation No. 874/2004 (EC) Article 14 “Validation and registration of applications received during phased registration” states: “All claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists.” and “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.” and “The relevant validation agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name. 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.” and “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.”

In accordance herewith Section 13(2) in the Sunrise Rules states regarding registered trademarks that “…Documentary Evidence must clearly evidence that the Applicant is the reported owner of the registered trademark. In case the Applicant is a licensee or transferee of a registered trade mark referred to in Section 13(1) above, Section 20 hereof shall apply.”

These wordings clearly places the burden of proof upon the applicant and being in principle a strict one as also stated in ADR 219 "ISL" and generally accepted through out the ADR-panels.

Section 20(3) in the Sunrise Rules states that “If, for any reasons other than as are referred to in Section 20(1) and 20(2) hereof, the Documentary Evidence provided does not clearly indicate the name of the Applicant as being the holder of the Prior Right claimed (e.g. because the Applicant has become subject to a name change, a merger, the Prior Right has become subject to a de iure transfer, etc.), 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.”

Section 21 “Examination by the Validation Agent” states that 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 and scanned by the Processing Agent (including the Documentary Evidence received electronically, where applicable) and in accordance with the provisions of these Sunrise Rules.”

Further section 21(3) in the Sunrise Rules states: “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.”

The Validation Agent is thus not obliged to conduct any further investigations.

The Panel accepts that "sole discretions" as long as a discretion (whether or not to conduct further investigations) has been made should only carefully be revised and judged upon.

As in such any deviation from this main rule - being the Validation Agent's "sole discretion" - must in this Panels opinion be duly explainable from the following 3 cummulative arguments:

The documentation's discrepancies and mistakes must be:

1) of immaterial nature, hence the prior right must in fact exist and in fact belong to or licensed to the Applicant, and be

2) obvious to a bonus pater examiner, and be

3) easily repaired by the Validation Agent within a few minutes "at hand"-investigations (searching on the Applicants name and address on the Internet, easily free of charge accessable trademark databases etc. - not having to initiate informational contact to the Applicant)

This "test" constitutes what could be called the "minimum of fairness" which the relevant Regulations and Rules should allow in order maintain the strict and formal requirements without taking this to an extent of being unreasonable.

This said it is a sure thing that a lot of the Validation Agents have handled their validation work with the highest degree of a strict approach in accordance with the clear wording of the Regulations and the Rules and perhaps also due to instructions given from their employer and with respect to secure a cost-effective and smooth system. These reasons are fair from that point of view and in such the Validation Agents have been left on "thin ice" due to the lack of guidelines in the Regulations as to how and what the discretion could and should take into account.

The Panel however does not feel that this test opens for a "gate of random decisions" as the mentioned required arguments should be fairly useful and suitable for the most cases in question regarding the applications and the submitted documentation in the Sunrise Periods.

Several cases has dealed with similar issues as this case and here follows a short presentation of some of the decisions as also listed in the ADR 843 "STARFISH":

OSCAR (181) – mistake due to technical matters regarding the length of the applicant’s name, thus the rejection by EURid was annulled.

COLT (294) – mistake in the licensor's name which differed from the name of the right holder's as a result of translation to English, thus the complaint was denied.

DMC (232) – mistake in the name of the applicant's name which differed from the right holder's name as an explainable result of the Austrian Law, hence the law within a member state in the EC, which the Panel found that the Validation Agent should be expected to know (argument 21), thus the rejection by EURid was annulled.

ISABELLA (984) – Applicant's name differed from the right holders name but the addresses where the same and a quick research could state that the company operated and had registered several company names in which the applicant's name seemed to be a confused mix of those. Nevertheless the complaint was denied as there were no technical or obvious mistakes which should have put EURid on notice as to the need to make further enquiries.

BPW (127) – The documentary evidence did not show that the applicant was the owner of the trade mark, thus the complaint was denied.

SCHOELLER (253) – Mistake in the name of the applicant/right holder due to technical matters, mistake in addresses of the applicant/right holder but same city and one simple search would have cleared the mistakes made, thus the rejection by EURid was annulled.

ULTRASUN (541) – Applicant's name differed from the right holders name. The right holder was the applicant's parent company. The complaint was denied.

CAPRI (984) – Applicant's name differed from the right holder's name. The Panel/the Panelist therefore tested that the validation of the application could have been done easily and properly towards correct verification of the data provided by the complainant/the applicant, thus EURid rejection was annulled.

STARFISH (843) - Name of the trademark holder and the licensor was the same but the address differed in the trademark registration and the license agreement which showed two different jurisdictions, thus the majority of the Panel found that it was not easily recognized that the trademakr holder and the licensor was in fact the same legal person.

In the present case the Complainant's name is:

EITO EEIG European Information Technology Observatory

The Applicant was filled in as just:

EITO EEIG

The addresses differed but were still in the same town being Frankfurt, Germany.

The Panel would like to address the term "EEIG" which is the abbreviation for European Economic Interest Grouping (EEIG), a for most relative and rather unknown legal form for a company.

The legal basis for the EEIG is the EC Regulation No. 2137/85, which has been published in the Official Journal of the European Communities L 199, 31st July, 1985. The German legislation adopted the EWIV-Ausführungsgesetz (EEIG Implementation Law) from 14th April, 1988, which was published on 22nd April, 1988 in the Bundesgesetzblatt I (German Official Journal).

According to the German implementation law groupings could be registered in Germany - the country of issue in this case - after the 1st July, 1989.

Statistics shows that in Germany in average 10-20 EEIGs are founded each year since the past 10 years.

According to Article 5 in the EC Regulation No. 2137/85 it is stated:

A contract for the formation of a grouping shall include at least:

(a) the name of the grouping preceded or followed either by the words 'European Economic Interest Grouping' or by the initials 'EEIG', unless those words or initials already form part of the name;

Article 25 further states:

Letters, order forms and similar documents must indicate legibly:

(a) the name of the grouping preceded or followed either by the words 'European Economic Interest Grouping' or by the initials 'EEIG', unless those words or initials already occur in the name;

Hence, EEIG is a legal form for a type of company established and recognized witin the EC.

The term "EEIG" is existing in both the Applicant's filled in name and in the trademark holder's name.

Removed it leaves the two names to be: "EITO" vs. "EITO European Information Technology Observatory".

It is fairly obvious that EITO seems to be the abbreviation of European Information Technology Observatory, which indeed indicates a relevant connection between the Applicant and the Complainant.

The fact that the addresses are both placed in the same city, Frankfurt, Germany gives a reasoned nourish to this presumption.

Taking a glance at the cover sheet submitted together with the documentation (the Panel agrees that documents only submitted under the ADR-proceeding should not be taken into account) the "Name for which the prior right is claimed"-field did in fact - although by mistake - show "EITO European Information Technology Observatory" giving further and stronger evidence for the mistake at hand. EURid did actually see this as this was a part of the first reasoned rejection.

Should the Validation Agent still - despite the said findings - be of the understanding and impression that the discrepansies were due to the possibility of a licensor/licensee relation both based in the same country and city with almost identical company names, then a quick search on the Internet would easily help clear this matter up.

A quick search - a couple of seconds - on the Internet using the well known search engine Google (www.google.com) places the Complainant as the first search result when the search term "EITO EEIG" is used.

In fact the extracted text automatically generated by Google in connection to the found link is:

"European Information Technology Observatory – EITO EEIG. Hahnstrasse 70, 60528 Frankfurt, Germany. Phone +49/69/242416-0, fax +49/69/242416-16, ..."

The prior right claimed in this case and the documentation submitted was a Community Trade Mark (CTM).

A quick search in the easily accessable OHIM database for "EITO" also shows that the registered owner is:

Name: EITO EEIG European Information Technology Observatory
ID No: 124524
Natural or legal person: Legal entity
Address: Hahnstr. 70
Post code: 60528
Town: Frankfurt
Country: GERMANY

Based on the findings in this specific case this Panel - using the above mentioned "3-step-test" - believes that the Validation Agent in these circumstances should have conducted just the simplest investigations which would have easily and quickly revealed the minor mistakes made by the Applicant/Complainant and corrected these.

Therefore the Panel believes that the Complainant has brought sufficient evidence before the Validation Agent to comply with Article 14 of the Regulation No. 874/2004 (EC).

DECISION

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

the EURID's decision be annulled

and

the domain name EITO be transferred to the Complainant

PANELISTS

Name	**Mikkel Gudsøe**

DATE OF PANEL DECISION 2006-10-08

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

EITO EEIG European Information Technology Observatory applied in the Sunrise 1 period and based its application in its trademark “EITO”, registered as Community Trademark no. 00 23 84 675.

On 25 May 2006 EURid rejected the application.

The reasons stated by EURid for rejecting the application were the following:

In an e-mail of 29 May 2006, EURid wrote, that the domain name applied for was “eito.eu” whereas the trademark name the application was based on was “EITO EEIG European Information Technology Observatory” and in that respect the domain name did not correspond with the prior right.

Further when the complainants legal representative addressed EURid for the explanation for the rejection in order to start an ADR-procedure EURid answered in an e-mail of 29 June 2006, stating that there was no proof submitted that the Applicant is the same as the holder of the prior right as the names and the addresses did not match.

The Applicant's name and address were:

Peter Carola
EITO EEIG
Hahnstrasse 70
60528 Frankfurt
Deutschland

The trademark holder's name and address were:

EITO EEIG European Information Technology Observatory
Uhlandstr. 52
D-60314 Frankfurt am Main
DE

In the "Name for which the prior right is claimed"-field on the cover sheet the Applicant/Complainant had wrote: "EITO EEIG European Information Technology Observatory".

On 3 July 2006 the Complainant filed a complaint against EURid ordering that the EURid decision be annulled and the domain name eito.eu be registered in the name of EITO EEIG European Information Technology Observatory.

The Panel introduced a cummulative 3-step-test in order to examine and judge whether or not the discretion by the Validation Agent was duly and fairly made.

The documentation's discrepancies and mistakes must in the Panel's view be:

1) of immaterial nature, hence the prior right must in fact exist and in fact belong to or licensed to the Applicant, and be

2) obvious to a bonus pater examiner, and be

3) easily repaired by the Validation Agent within a few minutes "at hand"-investigations (searching on the Applicants name and address on the Internet, easily free of charge accessable trademark databases etc. - not having to initiate informational contact to the Applicant)

This "test" constitutes what could be called the "minimum of fairness" which the relevant Regulations and Rules should allow in order maintain the strict and formal requirements without taking this to an extent of being unreasonable.

Based on the findings in this specific case this Panel - using the above mentioned "3-step-test" - believes that the Validation Agent in these circumstances should have conducted just the simplest investigations which would have easily and quickly revealed the minor mistakes made by the Applicant/Complainant and corrected these.

Therefore the Panel believes that the Complainant has brought sufficient evidence before the Validation Agent to comply with Article 14 of the Regulation No. 874/2004 (EC).

The Panel therefore ordered:

EURID's decision be annulled

and

the domain name EITO be transferred to the Complainant