Panel Decision for dispute CAC-ADREU-002022

Case number	CAC-ADREU-002022
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Domain names	etas.eu

Case administrator

Name	Kateřina Fáberová

Complainant

Organization / Name	ETAS Entwicklungs- und Applikationswerkzeuge für elektronische Systeme GmbH, Sandra Fischer

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

The Panel is not aware of other legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The complainant is ETAS Entwicklungs- und Applikationswerkzeuge für elektronische Systeme GmbH, Germany.

The request for the registration of the domain name ETAS was filled via the registrar Schlund + Partner AG, Germany.

The complainant applied for the domain name ETAS on December 7, 2005, under the trade name ETAS GmbH.

The validation agent, PriceWaterhouseCoopers, received the documentary evidence on January 16, 2006, during a period (the Sunrise period) of phased registration of domaine names of the .eu Top Level Domain before the general registration of .eu domain starts.

The complainant submitted documentary evidence consisting of an excerpt of the German Patent and Trade Mark Office holding that the trade mark ETAS (No 304 11 797) is registered in the name of complainant.

With decision of May 26, 2006, the Respondent, European Registry for Internet Domains (EURID), denied the request for registration on the ground that no proof of the complainant beeing the holder of the German trade mark ETAS has been submitted.

Against this decision the complainant filed a complaint with the Czech Arbitration Court.

A. COMPLAINANT

The Complainant argues that the name of the holder of ETAS trade mark is identical to the name of the Complainant. The Complainant argues that he is the same entity as the applicant and submits additional documentary evidence.

Moreover, the Complainant also argues that it filled an applicatiion for the domain name ETASGROUP and this application was accepted, whereas an identical situation was at hand.

For these reasons, the Complainant requests that Registry's decision be annulled.

B. RESPONDENT

The Respondet expresses that the applicant has submitted documentary evidence consisting of an excerpt of the German Patent and Trade Mark Office holding that the trade mark ETAS is registered in the name of ETAS Entwicklungs- und Applikationswerkzeuge für

elektronische Systeme GmbH.

The name of the applicant is different from the name of the Complainant. The Complainant however, did not submit documenatry evidence substantiating that the Complainant is licensed by the trade mark holder or that it is the same person as or the legal successor of the applicant.

Based on the documentary evidence, the validation agent concluded that the Complainant did not demonstrate that he was the holder of the licensee of a prior right on the name ETAS. Therefore, the Respondent rejected the Complainant's application.

DISCUSSION AND FINDINGS

In consideration of the factual background and the Parties contentions, the following legal conclusions must be reached:

Applicant has the burden of providing the evidence needed to support the application. In this case it means the evidence that the applicant and the trademark holder is the same person. The burden of proof is putted on the applicant not on the Respondent.

The Registry's obligation is to examine whether the applicant holds a prior right to the domain name. The right muse be verifiable by presented documentary evidence in time.

In the presented case the documentary evidence submitted by the Complainant showed that ETAS Etnwicklungs- und Applikationswerkzeuge für elektronische Systeme GmbH is the holder of trade mark ETAS, not ETAS GmbH.

Therefore the documentary evidence, which was submitted within the phased registration (Sunrise period), was incomplete and did not clearly demonstrate that the Complainant and the applicant were the same person.

The documentary evidence does not clearly indicate the name of the applicant as being the holder of the prior right claimed.

Proving that one is the holder of a trade mark means in this case that the name of the trade mark holder must match with the name of the applicant.

The Complainant failed to clearly, prima facie, demonstrate itself as the holder of ETAS trade mark without any doubt.

The validation agent examines whether the applicant has a prior right exclusively on the basis of a prima facie review of the documentary evidence received in time.

The validation agent or the Respondent is not obliged to engage yourself in a possible speculation or to provide its own enquiry especialiy more in the phased registration.

According to the legal position and duties of the validation agent or the Respondent, the clear identity between the applicant and the trade mark holder must be given in time.

In the phased registration (Sunrise period) there is no reasonable place of a possible speculation about the applicant's identity and the identity of the trade mark holder or about a possible trade mark licence between them or about a possible affiliated company etc.

The new evidence brought in the framework of this proceedings by the Complainant has to be disregarded. The applicant is provided with forty days to demonstrate its prior right (Art. 14 of the Regulation No 874/2004). Once the period is over, the Respondent must asses the prior right on basis of the evidence he received in time.

Only the documentary evidence which the Respondent was able to examine at the time of validation of the application should be considered by the Panel to asses the legal validity of the Respondent's decision.

The Complainant has a sufficient time to submit an accurate application and all relevant documentary evidence without any mismatch in a trade name and a trade mark.

As to as the prior decision by the Respondent in the case of ETASGROUP, this decision may not serve as a precedent because of its error in the validation process. The existence of a decision based on an error, cannot be interpreted to mean that the Respondent would be obliged to repeat such erros.

Regarding to the legal nature of the phased registration, it is appropriete to emphasize the legal principle of concentration of the documentary evidence during a restricted time and the legal principle vigilantibus iura, too.

The application under only a short form of the applicant's trade name which is not prima facie verifible from the documentary evidence is a defect application.

The applicant can use a short form of his trade name in a legal contact only at his own risk, especially during the phased registration of domain names .eu.

The fact of using only a short form of applicant's trade name is not a formal inaccuracy or a formal discrepancy, but a material one in the specific situation of this case when the applicant has submitted the documentary evidence under a different trade name.

Applicant has the burden of providing the evidence needed to support the application. In this case it means the prima facie evidence that the applicant and the trade mark holder is the same person. The burden of proof is putted on the applicant not on the Respondent.

The decision taken by the Respondent, European Registry of Domain Names (EURID), does not conflict with the Comission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implemenation and functions of the .eu Top level Domain and the principles governing registration or with the Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain.

DECISION

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	**Ivo Telec**

DATE OF PANEL DECISION 2006-10-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

1. It must be prima facie verifiable from documentary evidence presented in time that the applicant for a domain name is the holder of the trade mark to the name.

2. Regarding to the legal nature of the phased registration (Sunrise period), it is appropriete to emphasize the legal principle of concentration of the documentary evidence during a restricted time and the legal principle vigilantibus iura, too.

3. The application with only a short form of the applicant's trade name which is not prima facie verifible from the documentary evidence is a defect application. The applicant can use a short form of his trade name in a legal contact only at his own risk, especially during the phased registration of domain names .eu. The fact of using only a short form of applicant's trade name is not a formal inaccuracy or a formal discrepancy, but a material one in the specific situation when the applicant has submitted the documentary evidence under a different trade name.

4. No additional documents should be accepted after the 40 day period for the submission of documentary evidence.