Panel Decision for dispute CAC-ADREU-002075

Case number	CAC-ADREU-002075
Time of filing	2006-07-03 14:12:13
Domain names	e-motion.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	e-motion Gesellschaft für Antriebstechnik mbh, Peter Mauch

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 any other legal proceedings that are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant applied for the domain name e-motion.eu on the first day of Phase One the Sunrise Period. The Prior Right relied upon was a trademark registered in Germany. The Documentary Evidence was submitted in good time; this included an excerpt from the trademark register from the German Patent and Trademark office for the trademark relied upon. The except certified that the name of the holder was “e-motion Gesellschaft für Antriebstechnik mbH.” Whereas the application for the domain name was in the name of “e-motion GmbH.”

The Validation Agent was of the opinion that the Applicant had not provided sufficient evidence that it was the same legal person as, or successor to, the holder of the trademark. The application was therefore declined. The Complainant commenced this Complaint against that decision.

A. COMPLAINANT

The Complaint is brief and the Panel has allowed a generous margin of interpretation on the arguments submitted in order understand the points of objection.

Firstly, the Complainant suggests there is doubt over the supposed earlier rights of another applicant for the domain name, “E-motion SpA”. In evidence the Complainant said that it had carried out “intensive searches” and was unable to find any “appropriate entry or entries referring to [those earlier rights or the name itself]”.

Secondly, the Complainant contrasted E-motion SpA’s prior rights to its own. It referred again to the supporting documentation it supplied, which comprises the trade mark certificate referred to above and a copy of its entry in the commercial register certifying its incorporation as a company with limited liability.

On the basis of the foregoing, the Complainant alleges that the decision of the Registry is contrary to the European Union regulations because the Domain name is identical to its “trade name”, suggesting (or so it seems) that the Registry’s refusal constitutes a mistake – presumably either in law or fact or both.

B. RESPONDENT

In essence, the Registry relies upon Article 20.3 of the Sunrise Rules for its decision. This provides that "If, for any reasons ..., 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". As the Complainant Applicant did not duly supply that it is the same person or legal successor the validation agent concluded that the Applicant did not demonstrate that it was the holder or the licensee of a prior right on the name "E-MOTION".

The Respondent pointed out that the name of the company applying for the domain name was “e-motion GmbH”, whereas the Documentary Evidence submitted consisted of an extract from the Stuttgart company register for the company "e-motion Gesellschaft für Antriebstechnik mbH", as well as the German registered trademark "e-motion" (No. 39714574.8) that is also registered in the name of "e-motion Gesellschaft für Antriebstechnik mbH".

The Registry maintains that the obligation to prove the entitlement is on the Applicant to discharge through the Documentary Evidence at the time that it is due; this, it adds is a process that must be strictly adhered to since, in the absence of such clear evidence of the entitlement, the Registry has no right (and a fortiori no obligation) to speculate on the relationship between an Applicant and the owner of the trademark.

In support of this position, the Registry cites several Panel decisions in which this position, or something like it, was apparently accepted and endorsed. In any event it adds that the purpose of an Administrative Proceeding is not to correct a defective application, thus precluding giving a Complainant a second change to correct their original application.

Finally, the Registry argues that the Respondent’s points about the merits of E-Motion SpA’s application cannot be considered in this proceeding which is only concerned with the decision the Registry took with regard to the Complainant’s application. But in any event it advises that the application from E-Motion SpA has been rejected.

DISCUSSION AND FINDINGS

The sole object and purpose of an ADR Proceeding against the Registry is to verify whether the relevant decision by the Registry conflicts with the Regulations. The decision in question is the one rejecting the Complainant’s application. In verifying whether the Registry’s decision conflicts with the Regulations it is necessary to examine the reasons for the decision. E-motion SpA’s application is of no relevance, not merely because it was rejected, but also because it was made subsequent to the Complainant’s. (A previous application could be considered if it was accepted and that is the one being complained about.)

The Panel does not have any reasonable doubts that the Complainant genuinely and in good faith submitted the application for the domain name which is the subject of this proceeding. Furthermore the Panel can accept in principle that it is the holder of the Prior Right relied upon. However for some reason unknown to either the Panel or the Registry, the applicant Complainant described itself differently to how it is described in the commercial company register, on the trade mark certificate, and indeed in the manner and style it is described in the Complaint. Although the Complainant did not address this discrepancy, the evidence cannot be in dispute as they are discoverable from the face of the documentation. The key question to be answered is whether the Registry can reject an application because the name of the holder of the Prior Right, as stated in the Documentary Evidence, is different from the name of the applicant.

In the Panel’s opinion, the Panel agrees that burden of proof is on the applicant to demonstrate the entitlement to the reasonable satisfaction of the Validation Agent as specifically set out in the Sunrise Rules. Since proof must be supplied, and more importantly is limited to that which is in documentary form it follows that an inspection of the evidence must show that the applicant and the holder of the trade mark are one and the same or, where they are different, that the applicant supplies evidence that he is entitled to use the trade mark with the written permission of the holder. Where there is no such proof the Registry can reject an application on those grounds. The Panel is not convinced that the Registry has a strict duty to reject applications in such circumstances. It is possible if not probable that that the Registry has during the Sunrise Period exercised a discretion to deal with some minor margin of error on the face of the documentation from one or more applicants. It is better simply to consider it as a duty that the Complainant must discharge. In this regard, the Panel is satisfied that on this occasion the Registry reached an appropriate decision because the discrepancy is too great to be able to conclude that the Complainant has discharged the burden of proof. Thus the Panel concludes that Complaint should be refused.

In so doing the Panel has considered one point not dealt with either party, and this is the possibility that German law allows the Complainant to use its name in shortened (and not just abbreviated) form as used in the application, even though it appears differently in the trade mark certificate. If it does then, the Panel observes, this would be a feature that would distinguish it from the decision cited by the Registry.

Within the European Union, when a company wishes to be incorporated it applies to use a “given name” and on incorporation is required to append a designated extension that indicates its status. Thus the complete legal name of an incorporated company is made up of the

“given name” and the designated extension. In Germany, as in the present case, a company can be incorporated as a “Gesellschaft mit beschränkter Haftung “(company with limited liability). This designated extension must be used along side its “given name” but may be abbreviated to “GmbH”. Thus for example, if the Panel was incorporated in Germany as a company with limited liability, it would postulate that the “given name” of the company is “the Panel” but that it is a company with limited liability as indicated by the designated extension, “GmbH”.

If that is correct, it falls to consider what the given name of the Complainant is: “e-motion GmbH” is used in the application, whereas "e-motion Gesellschaft für Antriebstechnik mbH" is used in the trade mark certificate, the excerpt from the commercial register and for that matter in the Complaint. Obviously the Complainant is incorporated as a “Gesellschaft mit beschränkter Haftung”. However it has additionally inserted the words “für Antriebstechnik” (“for propulsion engineering”). In so far as the Panel knows or can determine, the use of these words is not a mandatory requirement of German company law. However, what the Panel has determined is that a German company may use the word Gesellschaft as part of its “given name” so long as the designated extension “mbH” is retained.

Clearly, if the use of Gesellschaft as part of the given name is permitted then it follows that additional, non-statutory words might be further added in the given name, as is evident in the case of the Complainant. Thus from this examination the Panel concludes that, given the proposition espoused above, the “given name” of the incorporated company is “e-motion Gesellschaft für Antriebstechnik” and it is a company with limited liability because of it uses the extension “mbH”. Having established this as a fact in this proceeding the Panel more easily ascertain that the Complainant did not use its full given name in the application so as to ensure it could properly and adequately demonstrate it was the same person as the holder of the trade mark.

For the sake of completeness, the Panel notes that the application was made during phase one of the Sunrise period, which was limited to certain domain names corresponding to, inter alia, registered Community or national trademarks. Prior Rights consisting of protected company names (which includes companies incorporated in Germany) could only be relied upon during phase two of the Sunrise period and so even if the Panel is wrong in its findings in relation to German law, the Complainant is not entitled to the domain name during phase one on the basis of the protection given to company names.

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	**Joseph DALBY**

DATE OF PANEL DECISION 2006-09-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, an incorporated company, did not use its full legal name in the application for the domain name, but had done so when it obtained the trade mark relied upon.

The burden was on the complainant to show that the applicant and the trade mark holder were one and the same. The required proof was limited to that which can be presented in documentary form at the time of the application or within such time as is permitted. The Panel doubts the Registry is under an strict duty to decline applications in which the proof is marginally inadequate. It is simply better to say that there is a duty that the Complainant applicant must discharge.

In the present case, the Panel determined that, even if the application had been made in good faith, he Registry had reached an appropriate decision not to accept the application. The difference between the name of the applicant and the name of trade mark holder was too different to to say that the duty had been discharged. The Panel reached this conclusion after considering if the discrepancy might have been allowed for under Gerrman law, but determined that it would not.