Panel Decision for dispute CAC-ADREU-002094

Case number	**CAC-ADREU-002094**
Time of filing	**2006-07-10 13:05:12**
Domain names	**deborah.eu, bio-etyc.eu, rougebaiser.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**DEBORAH GROUP B.V.**

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 of which the Panel is aware

FACTUAL BACKGROUND

1. The Complainant is Deborah Group B.V., a company registered in the Netherlands. It applied for each of the domain names deborah.eu, bio-etyc.eu and rougebaiser.eu ("the Domain Names") on 24 February 2006. It provided documentary evidence in support of those applications by 27 February 2006 and 1 March 2006, within the Phased Registration Period.
2. The documentary evidence submitted by the Complainant in support of the applications consisted in each case of a trademark (DEBORAH, BIO-ETYC or ROUGE BAISER) registered in the name of Deborah Cosmetics B.V. EURid, the Respondent, rejected each application on 22 or 23 May 2006, on the basis that the Applicant was not the owner of the trademark relied upon in support of the application.
3. The Complaint seeking the annulment of EURid's decisions was filed on 30 June 2006. Following the correction of a couple of technical deficiencies, the formal date of commencement of the ADR proceedings was 25 August 2006. The Respondent responded on 11 October 2006.
4. On 11 October 2006 Robert Elliott was appointed panelist in the matter ("the Panel"), having filed the necessary Statement of Acceptance and Declaration of Impartiality and Independence

A. COMPLAINANT

5. The Complaint attaches more extensive evidence of trademark registrations for DEBORAH, BIO-ETYC, and ROUGE BAISER than was provided in support of the original applications. Such evidence includes extensive registration of the trademark DEBORAH in accordance with the Madrid Agreement and Protocol in many members of European Union, as well as national registrations, similar evidence in respect of the BIO-ETYC trademark, and evidence of the registration of ROUGE BAISER as a trademark in Benelux.
6. The Complainant points out that certain of the registrations are held in the name of Deborah Group B.V. (the Complainant). Although the trademark certificates which were filed in support of the applications showed the owner of such trademarks as being Deborah Cosmetics B.V., the Complainant says that this is in fact the same company, which changed its name on 9 October 2002 from Deborah Cosmetics B.V. to Deborah Group B.V. (and provides evidence of that change of name).
7. The Respondent's decisions are therefore challenged on the following grounds:-
i) the Complainant itself is the registered holder of the trademark rights in Europe, which have not been taken into account by the Respondent;
ii) the Complainant a "company of substance with an important turnover" slightly changed its name in 2002, but is strictly the same entity as that appearing on the trademark registration certificates.
8. The Complainant contends that the purpose of the applicable Rules (and in particular Article 10(1) of Commission Regulation number 874/2004 ("the Regulation")), "is to grant priority and favour of registration/obtention of domain names by the legitimate owner of the

relevant trademarks", which would be achieved, by upholding the Complaint, and avoiding its rejection for strictly formal reasons.
9. The Complainant also refers to a fourth application which it made at the same time as the three applications which were rejected, for the domain name debby.eu, which succeeded. The evidence provided with the Complaint shows that the evidence of prior rights submitted in support of that application was the same as that in respect of three rejected applications, namely evidence of a trademark "debby" in the name of Deborah Cosmetics B.V. (not in the name of Deborah Group B.V.). The Complainant does not, however, specifically address what could be the legal consequences of the Respondent's apparently inconsistent approach.

B. RESPONDENT

10. The Respondent, EURid, contends that the burden of proof is on the Applicant to demonstrate that it is the holder or the licensee of a prior right, under Article 10(1) of the Regulation. The Respondent refers to Article 14 of the Regulation, under which the Applicant must submit documentary evidence showing that he or she is the holder of the prior right claimed for the name in question, and based on this documentary evidence, the Validation Agent examines whether the Applicant has prior rights on the name. It is therefore for the Applicant to provide the Respondent with all the documentary evidence necessary. The Respondent refers to a number of previous ADR decisions finding that the burden of proof is on the Applicant, including case ADR 1886 (GBG), from which the Respondent quotes the following summary:-
"According to the Procedure laid out in the Regulation the relevant question is thus not whether the Complainant is the holder of the 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 owner of a prior right the application must be rejected."
11. The Respondent contends that the documentary evidence did not demonstrate that the Applicant was the holder of the prior rights. The Applicant's name is different from the name of the holder of the trademarks for which evidence was provided with the applications. Although the Complainant says that this difference is due to a name change (and that the companies are one and the same) Section 14 of the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period ("the Sunrise Rules") clearly explains (by way of clarification of Article 14 of the Regulation) what documents should be submitted to demonstrate how the Applicant is entitled to rely upon a claim to prior right. Section 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 (eg 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".
12. The Respondent points out that the Complainant failed to explain the difference in names referred to. Therefore, without any further explanation, the Respondent was in no position to determine whether the Complainant was entitled to rely on the claimed trademarks.
13. The Respondent relies upon a series of previously decided ADR decisions in support of this contention, including cases 1242 APONET, 1625 TELEDRIVE, 294 COLT, 810 AHOLD and 557 VIVENDI.
14. The Respondent also contends that it was under no obligation to investigate into the circumstances of the applications and points in particular to Section 21(3) of the Sunrise Rules which states that the "Validation Agent is not obliged, but is permitted in its sole discretion, to conduct its own investigation of the Application, the Prior Right claimed and the Documentary Evidence produced". The Respondent contends that Section 21(3) does not impose any obligation upon it to conduct its own investigations. The Respondent again cites a list of previously decided ADR decisions confirming that there is no such obligation: for example, cases such as 127 BPW, 954 GMP, 541 ULTRASUN, and 2150 DUTCHORIGINALS, which the Respondent says are to be preferred to cases such as 253 SCHOELLER in which it was held that the Respondent should have carried out further investigations, even in the case of inadequate documentation.
15. The Respondent also contends that documents submitted for the first time during the present ADR proceedings may not be taken into consideration, and therefore that the evidence of trademark registrations in the name of Deborah Group B.V. supplied for the first time with the Complaint (and not with the applications) should be disregarded. The Respondent contends that only the documentary evidence which it was able to examine at the time of validation of the applications should be considered, in order to avoid the proceedings acting as a "second chance" for Applicants to remedy their imperfect original applications
16. The Respondent again refers to a number of previously decided ADR proceedings, in support of its contentions including 294 COLT, 954 GMP and 1549 EPAGES.
17. The Respondent concludes by saying that its decision was clearly justified on the basis of the material available before the Validation Agent, the obligation was on the Applicant to ensure that its documentation was in order, it did not do so, and to permit the Complainant to correct its defective applications at this stage would be not only unfair to other potential Applicants, but also clearly in breach of the Regulation and the Sunrise Rules.

DISCUSSION AND FINDINGS

18. As the Respondent has pointed out in its Response, the majority of the issues which arise in this Complaint have already been considered on a number of occasions by Panelists in other ADR cases.
19. In this case, the facts are clear and not disputed. The evidence filed by the Complainant in support of its original applications for

each of the three Domain Names established Prior Rights, but in the name of a company called Deborah Cosmetics B.V. That company changed its name in October 2002 to Deborah Group B.V., the Complainant. The company name Deborah Group B.V. appears on records which could have been provided in support of the original applications as being the holder of relevant rights, but the evidence was not provided until the Complaint was filed. Therefore, the Validation Agent in respect of each of the Domain Names had before it evidence which did not, on its face, support the entitlement of the Complainant to the Domain Names. The name "Deborah Cosmetics B.V." is clearly different from "Deborah Group B.V.". Although it appears that the addresses in question are the same, there is nothing else to suggest to the Validation Agent that the companies are anything other than separate corporate entities. The differences between the names are not insignificant. They are not mere typographical errors.

20. An application on the basis of a claimed Prior Right under Article 10(1) of the Regulation must be verifiable, according to Article 14 of the Regulation, by documentary evidence which demonstrates the right under the law by virtue of which it exists. Under Article 12(1) of the Regulation the Respondent was to publish on its website two months before the beginning of the Phased Registration Period a detailed description of the technical and administrative measures that it shall use to ensure proper, fair and technically sound administration of the Phased Registration Period. Pursuant to that requirement, the Respondent published the Sunrise Rules. Section 20(3) of the Sunrise Rules provides that, where it is not a case of an Applicant being a licensee or transferee, and "the Documentary Evidence provided does not clearly indicate the name of the Applicant as being the holder of the Prior Right claimed (eg 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".

21. Although the task of the Panel is to decide whether the Respondent's decision conflicts with the Regulation or with Regulation (EC) number 733/2002, and not specifically the Sunrise Rules, the Panel considers that the Regulation itself puts the onus upon the Applicant to demonstrate that it is the holder of the Prior Rights relied upon, and that the technical and administrative measures established in the Sunrise Rules do not in this respect contradict the Regulation itself, but clarify what is required.

22. The Panel therefore agrees with the Respondent that the burden of proof was on the Applicant to demonstrate that it is the holder or the licensee of a Prior Right, and that the Documentary Evidence provided the Respondent did not demonstrate in accordance with the Regulation or the Sunrise Rules that the Applicant was the holder of the Prior Rights in respect of any of the Domain Names.

23. The Panel further agrees with the Respondent's contention that neither it nor the Validation Agent were under any obligation to investigate into the circumstances of the applications. The onus is upon the Applicant to submit Documentary Evidence that he or she is the holder of the Prior Right claimed. Although there is the possibility for the Validation Agent in accordance with Section 21(3) of the Sunrise Rules to conduct its own investigations, as many previous panelists have pointed out in other ADR cases, there is no obligation upon the Validation Agent to do so. Requiring the Validation Agent to perform such enquiries would not only have been administratively unworkable for the Validation Agent, but would be in conflict with the wording of Article 14 of the Regulation itself, which puts the burden of proof on the Applicant. Therefore, although the Panel is conscious that in cases such as 253 SCHOELLER some other Panelists have held that the Validation Agent should in some circumstances have conducted further enquiries, the Panel is firmly of the view that the approach taken by what appears to be the majority of panelists in cases such as 2150 DUTCHORIGINALS (and which are reviewed by the Panel in that decision), namely to hold that there is no obligation upon the Respondent to conduct such further enquiries, is the correct one.

24. As already indicated, the company names in question in this case are noticeably different from each other. Under the circumstances, the Panel concludes that the Respondent was under no obligation to investigate the reasons for that disparity.

25. The Panel also agrees with the Respondent that, for the reasons previously rehearsed in many other ADR proceedings, documents submitted for the first time during the present ADR proceedings may not be taken into consideration in deciding this Complaint. This is particularly so given the wording of Article 14 of the Regulation itself which provides that the Respondent may only accept, as Documentary Evidence, documents that are received by the Validation Agent within 40 days from the submission of the application for the Domain Name.

26. Therefore, although the Complainant in this case has (as in many other previously decided cases) now produced evidence which if it had been produced at the time of its applications would have demonstrated its entitlement to the Prior Rights claimed, it should not be taken into account for the purposes of assessing whether the Respondent's decisions to reject the applications was in accordance with the Regulation. Although the Complainant refers to the supposed purpose of the applicable Rules being "to grant priority and favour of registration/obtention of domain names by the legitimate owner of the relevant trademarks", there are potentially many relevant interests involved. Whilst the Complainant may not feel that it is "fair" to it to have been denied its applications on the basis of what the Complainant describes as "strictly formal reasons", the Panel does not see how the Respondent could have been expected to perform its task of validating the very many applications received during the Phased Registration Period, without establishing proper ground rules which, in this case, the Complainant has failed to follow.

27. In the circumstances, the Panel concludes that the difference between the Complainant's name itself, and that shown on the trademarks provided in support of the applications, was such that the Respondent was legitimately entitled to reject the Complainant's applications, and the Complaint should therefore be denied.

28. There is one other point raised in the Complaint, which requires to be dealt with. This is the apparent inconsistency between the Respondent's approach in respect of the domain name debby.eu, and the Domain Names at issue in this Complaint. Essentially the same

evidence was supplied in support of each of the four applications: one succeeded and three failed. The Respondent does not address this in its Response, and the Complainant does not elaborate on what consequences are said to follow from that apparent inconsistency of approach. It seems to the Panel that, if it had been asserted, an argument along the lines of failure of legitimate expectations would not have succeeded – all four applications were submitted at the same time, and there was no prior suggestion to the Complainant that evidence showing that a registration in the name of Deborah Cosmetics B.V. would have been acceptable for the purposes of an application by Deborah Group B.V. (indeed, the Sunrise Rules suggest the contrary) Although it is clearly unfortunate that the Validation Agent has reached apparently different conclusions in respect of what are apparently identical factual circumstances, it does not seem to the Panel that this is in any way a ground for disputing the correctness of the decisions in respect of the Domain Names, in accordance with the Regulation, which is the question before the Panel in this case.

DECISION

For all the foregoing reasons, in accordance with Paragraph B12 (b) of the ADR Rules, the Panel orders that the Complaint is Denied

PANELISTS

Name	**Robert Elliott**

DATE OF PANEL DECISION 2006-10-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant challenged EURid's decisions to refuse to register the disputed domain names deborah.eu, bio-etyc.eu and rougebaiser.eu. EURid refused to register the disputed domain names, on the basis that the evidence received by EURid was insufficient to demonstrate the existence of longstanding rights, and in particular that the evidence submitted showed registered trade marks in the name of Deborah Cosmetics B.V., rather than the Complainant's name Deborah Group B.V. Although the Complainant provided evidence in support of its Complaint to show, firstly, that it and Deborah Cosmetics B.V. were one and the same (following a name change in October 2002), and secondly, that there were trademark registrations which could have been provided in support of the applications which were in its own name, the Panel concluded:-

a) the onus was on the Complainant, as Applicant, to demonstrate that it was the holder or the licensee of the Prior Rights;

b) the documentary evidence provided with the applications did not demonstrate it was the holder of such Prior Rights (because of the difference in the company names);

c) neither the Respondent nor the Validation Agent was under any obligation to investigate into the difference between the names provided;

d) documents and evidence submitted for the first time during the ADR proceedings may not be taken into consideration in determining the correctness of EURid's decisions to refuse the applications.

Therefore, EURid was correct in its decision to refuse registration in each of the cases in question, and the Complaint was denied