# Panel Decision for dispute CAC-ADREU-002148

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| Case number | **CAC-ADREU-002148** |
| Time of filing | **2006-08-14 12:19:16** |
| Domain names | **bahn.eu** |

## Case administrator

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| Name | **Kateřina Fáberová** |

## Complainant

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| Organization / Name | **Deutsche Bahn AG, Dr. Dirk Middelschulte** |

## Respondent

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| 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

N/A

FACTUAL BACKGROUND

The Complainant is the company Deutsche Bahn AG, Germany which was applying for a domain name “bahn.eu”. This application was rejected because the Complainant did not prove its priority right in Germany when identifying in its application as Prior Right Country “Germany”.

The main arguments of the validation agent were that the application was incomplete because the Complainant/the Applicant did not provide the Respondent with the right country in which the prior right was claimed.

The Complainant asked for i) the abrogation (annulment) of the decision of the Registry and ii) the allocation (registration) of the domain “bahn.eu” to the Complainant.

A. COMPLAINANT

The Complainant has asked for the abrogation (annulment) of the decision of the Registry and at the same time the allocation (registration) of the domain “bahn.eu” to the Complainant.

The Complainant has argued as follows.

The rejection of the application during the Sunrise Registration Period violates Article 10 para 1 and 2 of the Regulation (EC) No. 874/2004, since the Complainant holds several national rights in and to the term “bahn”. These prior rights are German national trademark “bahn” (registration No. 30423199.1/05) and also French national trademark “bahn” (registration No. 043294708).

The Complainant further argued according to Article 10 para 1 that he has other rights recognized as priority rights according to Regulation (EC) No. 874/2004. These rights being mainly well known term “bahn” (in German language “railways”), but also emerge from the domain name “bahn.de” which leads to the website of the most heavily used online travel service in Germany. The Complainant further argued that there is protection of the term “bahn” under Section 5 and 15 of the German Trademark Act and Section 12 of the Civil Law Act (Bürgerliches Gesetzbuch) in Germany.

The Complainant also specifically referred to Article 10 of the Regulation (EC) No. 874/2004 which according to him grants him the right for the domain name.

B. RESPONDENT

The Respondent initially in its Response to the Complain argued namely that Section 3 (1) of the Sunrise Rules states that an application will only be considered complete when the Applicant provides the Respondent with the country in which the prior right is claimed. The Complainant applied for the domain name “bahn” on December 7, 2005. The Complainant claimed the prior right in the form of a German trademark – the name “bahn”. The documentary evidence received by the validation agent did not establish that the Complainant was the holder of a German trademark – the name “bahn”, but only documents proving that the Complainant was the holder of a French trademark – the name “bahn” were provided.

The Respondent confirmed the above when providing later the Panel/the Panelist with Non-standard Communication (November 7, 2006) in which it is clearly stated that “for the sake of completeness the Respondent discloses the documentary evidence received by the Validation Agent on January 13, 2006”.

The validation agent received the documentary evidence on January 13, 2006 which was before the January 16, 2006 deadline for its submission.

The Respondent further argued that pursuant to Article 14 of the Regulation (EC) No. 874/2004 “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”.

Since the documentary evidence submitted received by the validation agent did not substantiate that the Complainant was the holder of the German registered trademark on the name “bahn” (the prior right claimed by the Complainant), but only that the Complainant was the holder of a French trademark (which the Complainant did not claim as a prior right), the Respondent correctly rejected the Complainant’s application.

The Respondent further argued that some of the evidence, namely the evidence concerning Germany and German trademarks, was delivered only in the ADR proceedings and not on time when the application was reviewed.

The Respondent also referred to other cases in which the similar decisions (according to the Respondent) have been discussed and made.

The Respondent terminated its arguments with the statement that for all the above reasons the Complaint must be rejected.

## DISCUSSION AND FINDINGS

1. All procedure requirements for .eu dispute resolution (ADR) were met.

2. The main question for the decision is whether the Complainant applied properly and completely when making the application and especially whether non-substantial procedure mistake can influence the domain name registration.

The issue really is whether the formalistic approach overrules the general principle of fairness and justice; in other words, whether the correct or non-correct filing of an application is a decisive element in granting the rights.

3. The Panel/the Panelist fully understands arguments of the parties. It is without any doubt that the Complainant shall be responsible for proper application and at the same time the Respondent is obliged to respect all applicable rules in its decision.

The Panel/the Panelist also respects the arguments of the Respondent that the validation agent is obliged to strictly follow the rules and in thousands of applications it is not possible to do a deep investigation and assessment of all documentary evidence or even have very long lasting and administratively very demanding proceedings.

4. The Panel/the Panelist strongly believe that one of the aims of .eu ADR disputes is to review and verify and in some cases correct the mistakes of the registry which were done also thanks to the administrative proceedings which is really not perfect as no single proceedings can be.

5. The Commission Regulation (EC) No. 874/2004 clearly states in its Recitals para (12) that one of the aims is ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights.

The application shall contain the country in which the prior right claimed is protected with the aim to validate the prior right. In this case when the identified country was Germany but the proof of the prior right was the certificate of the French trademark, it is a minor mistake which should not lead to the rejection of the application.

6. Also Section 21 of the Sunrise Rules shall be taken into consideration. In its para 1 is clearly stated that the validation agent appointed by the registry shall verify whether the requirement for the existence of a prior right to the name claimed by the Applicant in the application is fulfilled. In para 2 it is clearly stated 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. It also has to be stressed that the validation agent is not obliged but it is permitted in its sole discretion to conduct its own investigations into the circumstances of the application, the prior right claimed and the documentary evidence produced (para 3).

As the Respondent correctly pointed out in its Non-standard Communication from November 7, 2006 the Complainant delivered to the validation agent on January 13, 2006 the documents which clearly confirms that the Complainant is a owner of the trademark in the European Union – i.e. registered national trademark under national law in the EU members state in accordance with Article 10 para 1 of the Regulation (EC) No. 874/2004. The only issue which was important for the decision was that in the column “Prior Right Country” was filled in “Germany” and not “France”. If there is such a minor discrepancy than the validation agent should use its discretion under Sunrise Rules and conduct its investigation further.

The Panel/the Panelist is of the opinion that the validation agent would have a right and possibility to clarify this issue in the application with the aim to make a proper registration. The Panel/the Panelist is of the opinion that the Respondent should have proceed with an appropriate due diligence to clarify these issues.

7. The Panel/the Panelist therefore came to the following conclusions:

a) The Panel/the Panelist is of the opinion that the justice shall always rule over the formalistic approach and technical means of communication.

b) The Panel/the Panelist is of the opinion that one of the role of ADR is to verify the application procedure and correct any unfair mistakes which may happen by non-perfect technical means or speed-up proceedings in communication.

c) It was proven that the Complainant applied in the Sunrise Period for domain name “bahn.eu”. It was proven that documentary evidence on prior rights was received on time. The only issue was that the Application stated that the prior right country is Germany even the documentary evidence attached was evidence confirming that the Complainant holds a national trademark in France.

d) It is beyond any doubts that in the application the documents confirming prior right were provided. The only mistake was that the prior right country mentioned was Germany instead of France.

Article 10 of the Regulation (EC) No. 874/2004 clearly states that the prior rights shall be understood “registered national trademarks … as far as they are protected under national law in the EU member state …”.

e) The Sunrise Rules have only a meaning to specify exactly what has to be provided to facilitate the registration. It has not to be understood that non-fulfillment or (minor) mistake in fulfillment of one of the column in an application shall lead automatically to the rejection of the application.

The Complainant properly applied for the disputed domain name based on prior right which was the registered national trademark. The Complainant properly provided the documents confirming that it is an owner of a prior right in the member state in the European Union.

The only mistake of the Complainant was the wrong name of the prior right country.

f) It is without any doubt that the requirement under Article 10 of the Regulation (EC) No. 874/2004 for prior rights was met and therefore it is justified to register the domain name “bahn” in favour of the Complainant.

g) It was proven by the Complainant and from public sources that the Complainant satisfied the general criteria for registration set out in § 4 (2) (b) of Regulation (EC) No. 733/2002.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 of the ADR Rules and B11 of the ADR Rules, the Panel/the Panelist orders that

i) the EURID’s decision is annulled; and

ii) the domain name “bahn.eu” shall be registered in the name of the Complainant, i.e. Deutsche Bahn AG (Potsdamer Platz 2, Berlin, Germany).

## PANELISTS

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| Name | **Vit Horacek** |

DATE OF PANEL DECISION 2006-11-15

## Summary


ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, the company Deutsche Bahn AG, Germany was applying for a domain name “bahn.eu”. This application was rejected because the Complainant did not prove its priority right in Germany when identifying in its application as Prior Right County “France” instead of “Germany”. The main argument of the validation agent was therefore that the application was incomplete because the Complainant/the Applicant did not provide the Respondent with the right country in which the prior right was claimed.

The Complainant asked for i) the annulment of the decision of the Registry and ii) the registration of the domain “bahn.eu” to the Complainant.

The main question for the decision was whether the Complainant applied properly and completely when making the application and especially whether non-substantial procedure mistake (in the name of the prior right country) can influence the domain name registration.

Even there was a mistake in the application when identifying the prior right country, the Complainant/the Applicant provided the validation agent on time with the documentary evidence confirming that the Complainant/the Applicant was an owner of the trademark in the European Union – i.e. registered national trademark under national law in the EU members state in accordance with Article 10 para 1 of the Regulation (EC) No. 874/2004. The Complainant/the Applicant therefore provided the validation agent with the proof that it has prior rights according to the Regulation (EC) No. 874/2004.

The Panel/the Panelist was of the opinion that the justice shall always rule over the formalistic approach and technical means of communication and/or minor mistakes which can be easily corrected by the proper approach and clarification of the issue by the validation agent.

The Panel/the Panelist finally decided to annual the EURid’s decision and ruled that the domain name “bahn.eu” shall be registered in favour of the Complainant.