Panel Decision for dispute CAC-ADREU-002190

Case number	**CAC-ADREU-002190**
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Domain names	**worlee.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Worlée NaturProdukte GmbH, Karsten Brodersen**

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 which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

On December 07, 2005 Worlée NaturProdukte GmbH filed a Request for the Registration of the domain name “worlee.eu” within the so-called Sunrise Period. On January 05, 2006 the Registry received as documentary evidence for the prior right a copy of an extract from the database of the German Patent and Trademark Office regarding the German trademark No. 824329 on “Worlée”, registered in the name of the Worlée-Chemie G.m.b.H., Hamburg.

With decision from May 24, 2006, the Respondent rejected the request for registration on the grounds that there was a mismatch between the name of the holder of the prior right and of the applicant.

On July 10, 2006 the Worlée NaturProdukte GmbH (hereafter “the Complainant”) filed a Complaint against the Registry. Among other documents the Complainant submitted a license declaration for the trademark “worlée” signed by the trademark holder Worlée-Chemie G.m.b.H., Hamburg as licensor and the Complainant as licensee on June 30, 2006, more than six months after the application.

The receipt of the complaint was acknowledged by the Arbitration Court on July 10, 2006

A. COMPLAINANT

The Complainant as Applicant, Worlée Naturprodukte GmbH, and the trademark owner, Worlée-Chemie G.m.b.H. are affiliated companies. Both belong to the Worlée Group. Worlée Naturprodukte GmbH is entitled to use the trademark "Worlée" as a licensee.

The Complainant contents that the Respondent needed 4,5 month to reach a decision. Had the Registry informed the Complainant about the rejection in due time before the end of the Sunrise Period the Complainant would have been able to file a new Application in the Sunrise Period with sufficient evidence. The inadequately long examination time in the Applicant's case forms a discrimination of the Complainant and is contrary to Article 4 Para. 1 and Para. 2 (a) of the regulation (ec) No. 733/2002.

The Complainant further contents that the Respondent acted contrary to Section 21 (3) of the Sunrise Rules granting the validation agent "sole discretion" to carry out investigations.

The Respondent had all possible means and rights to validate properly the prior rights. Already a look at the Complainant's website (www.worlee.de) would have revealed that both companies Worlée-Chemie G.m.b.H. and Worlée Naturprodukte GmbH belonged to the same company group and that the Complainant was obviously entitled to use the trademark.

As the Complainant claims to have proven his priority rights, he requests to attribute the domain name "worlee.eu" to the Complainant.

B. RESPONDENT

Pursuant to Article 14 of the Regulation, it was up to the Complainant to submit documentary evidence showing that he is the holder of the prior right claimed on the name in question. The Complainant submitted documentary evidence consisting of the German registered trademark "WORLEE" (No. 824329). This trademark was not registered in the name of the Complainant but in the name of "Worlée-Chemie G.m.b.H".

Consequently, the Complainant did not submit documentary evidence substantiating that the Complainant is entitled to a prior right or licensed by the trademark holder respectively. The Complainant should have enclosed in the documentary evidence an acknowledgement and declaration form duly completed and signed by both the licensor of the relevant registered trade mark and the Complainant (as licensee), pursuant to section 20 (1) of the Sunrise Rules.

The Respondent was under no obligation to investigate about the eventuality that the Complainant could be licensed to use the trademark that belongs to another company. 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 and section 21.3 of the Sunrise Rules states that the Validation Agent is under no obligation to conduct its own investigation into the circumstances of the application.

DISCUSSION AND FINDINGS

It is very clear from the wording of Art. 14 of the Regulation that the burden of proof concerning the ownership of prior rights is on the Applicant. Accordingly, every Applicant has to submit documentary evidence showing that he or she is the holder of the prior right claimed on the domain name in question.

This burden of proof is further specified by the Sunrise Rules with respect to each type of prior right. If the prior right is based on a trademark, the applicant must provide documentary evidence according to the requirements set forth in Section 13 (2) (i) or (ii) of the Sunrise Rules: he has to provide a copy of an official document issued by the competent trade mark office or an extract from an official (on-line) database managed by a relevant trade mark office. In the present case, the Complainant submitted a copy of an extract from the database of the German Patent and Trademark Office regarding the German trademark No. 824329 on “Worlée”. This, however, did not serve as a sufficient evidence of the Complainant’s prior right in the trademark since the trademark was registered in the name of a different company, namely the Worlée-Chemie G.m.b.H.

Supposed that due to a licence from the trademark holder the Complainant is generally allowed to use a prior right, the according evidence would have had to be submitted as well. - Section 20 of the Sunrise Rules sets forth additional requirements the applicant must meet in the event that it is not completely clear from the documentary evidence that the applicant is holder of the prior right. Here, this could have been done through the submission of a copy of a licence agreement. The Complainant, however, failed to do so in the application. Accordingly, it was not obvious from the submitted evidentiary documents that the Complainant is the owner of a prior right to the domain name. To that respect, the documentary evidence was incomplete and caused the responsible Validation Agent rightly to reject the application of the Complainant.

Considering the arguments of the Complainant, that the Validation Agent could have easily found out, that there was a license to the prior right and that the trademark holder and the Complainant were affiliated companies, the following question must be raised: To what extent is a Validation Agent obliged to carry out own investigations on the prior right of an Applicant?

To that regard, section 21 (3) of the Sunrise Rule generally states that the Validation Agent is permitted to conduct own investigation into the circumstances of the prior right. Since this provision does not speak of an obligation as such, a next question must be raised: What level of discretion is granted to the Validation Agent?

To keep the examination work at an appropriate level and to respect the rights and expectations of the involved parties the test for this question must be the reasonability. Consequently, it is in all events in line with section 21 (3) to legitimately allow for the correction of immaterial, obvious or typing errors (see ADR no. 328 – lastminute) which can be easily erased by the examination of the submitted documentary evidence. As human errors are inevitable it is on the Validation Agent to examine the general consistency of the documentary evidence and correct the provided facts of the application if possible.

But what about cases where the Validation Agent is not able to identify any discrepancies from the content of the submitted documents? Does he also has the duty to materially, and not just formally examine whether or not the applicant has the claimed prior right? To affirm

this question positively would mean to accept a duty to not only examine the submitted evidentiary document but also to investigate into other sources. The hitherto existing decisions reveal an unfortunate inconsistency in this respect. For instance in the case no. 253 (Schoeller), a difference between the street address of the applicant mentioned in the trademark certificate and in the application was not held to be fatal for the granting of the requested domain name. In case no. 903 (SBK), a discrepancy in relation to the legal form of the applicant in the application and the documentary evidence was considered as an obvious error, amenable for validation.

However, bearing in mind that the examination duty for the Validation Agent should remain an reasonable one, the examination in cases of more substantial discrepancies must be denied. With respect to the amount of applications and the time constraints a proper balance of practice indicates that errors which cannot be solved by the consultation of the documentary evidence provided are for the applicant's account. Where an Applicant claims to have a prior right, it is not too much to demand the presented evidence to be in line with this claim. Apart from that, it still remains on the Applicant to bear the burden of proof. Any attempt to admit exceptions would allow for arbitrary interpretation and undermine the fact that it is not the Registry's task to research evidentiary material on a claimed prior right. It is not its task to investigate the evidence needed for a successful registration. In addition, it must be remembered that the decision on who should be the owner of the domain name ending with the .eu prefix is a decision on ownership rights. Such a decision needs to be taken carefully and in full sureness of the claimed entitlement. If such entitlement is not adequately proven, the decision must be a negative one (see case no. 119 - nagel, no. 219 - isl and case no. 1194 -insuresupermarket).

In addition, it should generally be noted that the ADR proceedings initiated against the Registry shall not in any way serve as a "second chance" providing applicants an option to remedy their imperfect original application (see case no. 551 – vivendi). In light of this, the Panel is not to consider any additional documents now submitted to prove the prior right of the Complainant. It is not the role of the ADR to verify whether the first Applicant in the queue owns the prior right, no matter what documentary evidence was presented (see case no. 431- cashcontrol, case no. 174 –domaine). Accepting anything else would affect the legitimate expectations of the next Applicant in the queue and conflict with the "first-come-first served" principle. The 40-day period for the submission of documentary evidence must considered as sufficient to collect, prepare and submit all necessary documents for the proof of a prior right. According to Section 21 (1) of the Sunrise Rules, the Validation Agent and with this the Respondent are also not obligated to notify the applicant if the requirement to sufficiently establish the prior right to a domain name is not complied with.

Finally, the Complainant's contentions that he was prevented to file a new application within the Sunrise Period because it took the Respondent too long to reach a decision must be rejected. There is no rule for a period within which a decision on an application for a Domain Name has do be achieved.

In the wake of all these considerations, the Panel observes that the decision of the Respondent does neither conflict with the Regulation nor the Sunrise Rules. The documentary evidence provided by the Complainant showed that he is not the owner of the trademark, on the basis of which the prior right to the Domain Name was to be asserted. Moreover, the Complainant did not provide any proof within the documentary evidence which would explain that he is a licensee to the company holding the trademark. Therefore, it must be concluded that the Complainant failed to demonstrate its prior right to the Domain Name in time.

The Registry should not be held responsible for such a failure of the Complainant. It is also not the purpose of the ADR Proceeding to remedy such a omission of the Complainant. Thus, the Registry correctly rejected Complainant's application and its decision conflicts neither with the Sunrise Rules, nor with the Regulation.

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	Lambert Grosskopf

DATE OF PANEL DECISION 2006-10-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

1. The level of examination of the submitted documentary evidence does neither include the Registry's task to research evidentiary material on a claimed prior right nor a task to investigate the evidence needed for a successful registration.

2. In deciding ADR proceedings against the Registry the Panel is not to take additional documents into consideration, which have been submitted by the Complainant after the expiration of the 40-day period for the submission of documentary evidence.

3. There is no rule for a definite period of time within which a decision on an application for a domain name has to be achieved by the Registry.