Panel Decision for dispute CAC-ADREU-002225

Case number	**CAC-ADREU-002225**
Time of filing	**2006-07-17 11:15:08**
Domain names	**verdi.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**ver.di e.V. Bundesverwaltung**

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 regarding the disputed domain name.

FACTUAL BACKGROUND

1. The Complainant ver.di e.V. is a leading trade union in Germany which represents about 2.7 million employees in the service industry. ver.di.e.V. is subdivided into about 107 districts. The corresponding German trademark Registration No. 399 17 689.6 “VERDI” is recorded in the name of ver.di e.V.
2. The disputed domain name is verdi.eu.
3. The Complainant submitted an application to the Registry for verdi.eu on the basis of the afore-said German trademark registration.
4. The Registry has refused the domain application arguing that the submitted documents do not support the claimed right due to a difference in the name of the holder of the Prior Right and the name of the Applicant. The difference consists of an addition of the word "Bundesverwaltung" to the name of the Applicant.

A. COMPLAINANT

1. It is the Complainant’s opinion that the Registry’s decision, not to award the domain name verdi.eu during Sunrise I, complies neither with EU Regulation No. 733/2002 and the Commission Regulations No. 874/2004 nor with the so-called “Sunrise Rules”.
2. According to Art. 10 (1) Regulation No. 874/2004, the holders of prior national rights are eligible to apply for registration of domain names during so-called Sunrise I.
3. In the case to decide, the distinctive element ver.di of the domain applicant (Complainant) corresponds with the distinctive element ver.di of the trademark owner.
4. Moreover, the legal form e.V. of the applicant (Complainant) and the trademark owner is the same. Any additions to the name ver.di e.V. are without any legal meaning.
5. Indeed, the additional term “Bundesverwaltung” [Engl.: national headquarters] appearing in the Complainants name does not identify a further legal person other than a mere administrative department of the ver.di e.V. which is responsible for all nationwide matters. As the language of the domain application proceeding is German, this must have been evident for the Examiner who cannot understand the German word “Bundesverwaltung” in any other way than the aforementioned "National Headquarters".
6. Therefore, although the additional term “Bundesverwaltung“ [engl.: National Headquarters] was added to the applicant’s (Complainant’s) name for mere administrative purposes, namely to identify a particular department at ver.di e.V., the applicant (Complainant) is identical to the trademark owner.
7. As the applicant (Complainant) and the trademark owner are one and the same person, the decision of the Registry conflicts with the relevant Regulations and the "Sunrise Rules". As a result, the domain verdi.eu must be awarded to the Complainant.

B. RESPONDENT

1. GROUNDS ON WHICH THE RESPONDENT REJECTED THE APPLICATION BY VER.DI E.V. BUNDESVERWALTUNG FOR THE DOMAIN NAME VERDI.
Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") states that only holders of prior rights which are recognised or established by national or Community law shall be eligible to apply for registration of domain names during a period of phased registration before general registration of .eu domain starts. Article 14 of the Regulation states that "...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. (…) If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this.(…) The Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in the second, third and fourth paragraphs". 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 (e.g. 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". Ver.di e.V. Bundesverwaltung (hereafter "the Complainant") applied for the domain name VERDI on 7 December 2005 and on 30 January 2006 but failed to submit documentary evidence for those applications, which lead to the expiration of the application. The disputed application was filed on 2 February 2006. The processing agent received the documentary evidence on 6 February 2006, which was before March 14 2006. The Complainant submitted documentary evidence consisting of a certificate of registration stating that the German trademark "VERDI" is registered in the name of "Verdi e.V.". The Complainant did not submit documentary evidence substantiating that the Complainant was licensed by the owner of the trademark, or that it was the same person as, or the legal successor to, the owner of the trademark. Based on the documentary evidence, the validation agent found that the Complainant did not demonstrate that it was the holder or the licensee of a prior right to the name VERDI. Therefore, the Respondent rejected the Complainant's application.
2. The Regulation and the Sunrise Rules clearly and certainly make clear that the burden of proof is on the Complainant to demonstrate that it was the holder of a prior right. The WHOIS record clearly shows that the Complainant's name is "ver.di e.V. Bundesverwaltung" but that the owner of the trademark is "Verdi e.V.". When there is a difference between the name of the applicant and the name of the owner of the prior right, the applicant must submit official documents explaining this difference. If the applicant fails to do so, its application must be rejected. During the Sunrise Rules, the first applicant in line does not have an unconditional right to the domain name but only has an opportunity to submit documentary evidence within 40 days clearly demonstrating that it is the holder of a prior right.
2.1 The burden of proof was on the Complainant to demonstrate that it was the holder or the licensee of a prior right. Article 10 (1) of the Regulation states that only the holders of prior rights shall be eligible to apply to register domain names during the period of phased registration. Pursuant to article 14 of the Regulation, the applicant must submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. Based on this documentary evidence, the validation agent shall examine whether the applicant has prior rights to the name. It is therefore of crucial importance that the Respondent is provided with all the documentary evidence necessary for it to assess if the applicant is indeed the holder of a prior right. The burden of proof was thus on the Complainant to substantiate that it was the holder or the licensee of a prior right (see, for example, cases 127 (BPW), 219 (ISL), 294 (COLT), 551 (VIVENDI), 984 (ISABELLA), 843 (STARFISH), 1931 (DIEHL, DIEHLCONTROLS)). As the panel clearly summarized in case ADR 1886 (GBG), "According to the Procedure laid out in the Regulation, the relevant question is thus not whether the Complainant is the holder of a 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 the owner of a prior right the application must be rejected".
2.2 The documentary evidence did not demonstrate that the Complainant was the holder of a prior right The Complainant's name is "ver.di e.V. Bundesverwaltung". The documentary evidence demonstrates that the owner of the trademark is "Verdi e.V.". The Complainant does not dispute that the name of the Complainant and the name of the owner of the trademark are different, but the Complainant argues that the Complainant's name is simply the name of an "administrative department" of the company mentioned as the owner of the trademark ("Verdi e.V.").

In the present case, the documentary evidence submitted by the Complainant did not clearly indicate the name of the Complainant ("ver.di e.V. Bundesverwaltung") as being the holder of the prior right claimed ("Verdi e.V ").
The Complainant failed to explain this difference in the names of the Complainant and the owner of the trademark.
Therefore, the Respondent correctly rejected the Complainant's application, pursuant to the Regulation and the Sunrise Rules, because the Complainant failed to meet its burden of proof.
The Respondent clearly disagrees with the Complainant's contention that section 20 of the Sunrise rules applies in other situations, but not to the present situation because "the owner of the prior right and the domain applicant is one and the same person having the same name".
Section 20 of the Sunrise Rules applies when " the Documentary Evidence provided does not clearly indicate the name of the Applicant as being the holder of the Prior Right claimed".
In the present case, the names were, as already explained, different.

DISCUSSION AND FINDINGS

The panel agrees with Eurid in regard to the principles referred to by Eurid and, most importantly, the burden of proof. Important herewith is however that the Validation Process is performed and executed properly and not only mechanically so. In some cases the correct situation may be obvious regardless of imperfections in an application. There must always be room for application of common sense. The panel wants to underline that this must not be understood as a deviation from the principles referred to by Eurid.

In the present case, the Applicant has added the word "Bundesverwaltung" after the name of the Applicant by writing ver.di e.V Bundesverwaltung. The correct formal name is ver.di e.V, where e.V stands for "eingetragener Verein" - in English "Registered Society". The addition of the word Bundesverwaltung does not change the correct formal name of the Applicant but merely indicates "National Headquarters" or "Federal Division".
This should have been obvious, especially to a German speaking validation agent. In consequence the application should not have been denied on the grounds referred to.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the EURID's decision be annulled

the domain name VERDI be transferred to the Complainant

PANELISTS

Name	**Raoul Smitt**

DATE OF PANEL DECISION 2006-10-24

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Applicant has sufficiently proved its identity and that it is the holder of the Prior Right. The validation process must be stringent but not to the extent of being mechanical only.

Accordingly, Eurid's decision shall therefore be annulled and the domain name VERDI shall be transferred to the Complainant.