Panel Decision for dispute CAC-ADREU-002268

Case number	**CAC-ADREU-002268**
Time of filing	**2006-07-21 13:02:17**
Domain names	**ebsoft.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**ebsoft GmbH, Helmut Sigler**

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 legal proceedings which are pending or have been decided and which relate to the disputed Domain Name.

FACTUAL BACKGROUND

The Complainant, ebsoft GmbH applied for the registration of the domain name “ebsoft” via Registrar Schlund Technologies on 9/12 2005. A certificate of German trade mark ebsoft No. 398 06 264 which showed that the trademark is registered in the name EB-Soft Gesellschaft für elektronische Beschriftungs-Software mbH of was submitted on 10/12 2005 as the documentary evidence. Based on that, the Registrar found that the Complainant did not prove that is was the owner or licensee of prior right “ebsoft” and the Respondent with decision of 26.5.2006 rejected the application.
The Complainant filed a Complaint against EURid in accordance with the .eu Alternative Dispute Resolution Rules (the “ADR Rules”) and the formal date of the commencement of the ADR Proceeding was 08/08 2006. The Respondent filed its Response on 29/09 2006 and subsequently the case was transferred to a Panel on 5.10.2006.

A. COMPLAINANT

The Complainant contends that the decision of the Respondent that the German and Eu trade mark “ebsoft” cannot be attributed to the complainant from the reason that the Complainant is ebsoft GmbH Kerner str. 62, D-74076 Heilbronn, while the holder of trade marks is EB-Soft Gesellschaft für elektronische Beschriftungs-Software mbH, Kernerstr. 62, D-74076 is not correct. In fact, EB-Soft Gesellschaft für elektronische Beschriftungs-Software mbH and ebsoft GmbH are the same entity. The same is proven by the notarial deed of the notary public (2 UR 263/2006 dated 19 June 2006), which is enclosed as documentary evidence. Further on, the certificate of the German registration No. 398 06 264 and Communitary trade mark registration were attached hereto as well.

B. RESPONDENT

With response dated 26.9.2006 the Respondent requests the Complaint to be rejected. The Respondent contends that the Regulation and Sunrise Rules provide that the burden of proof was with the Complainant to demonstrate that it is the holder of a prior right. Where there is a difference between the name of the applicant and name of the owner of the prior right, the applicant must submit official documents explaining the difference. During the Sunrise Period, the first applicant in line does not have unconditional right to a domain name, but only has an opportunity to submit documentary evidence within 40 days to demonstrate, that it is the holder of a prior right. The Respondent refers to Art. 10 (1) of the Regulation as well as to the case law in order to demonstrate that the burden of proof was on the applicant to substantiate that it is the holder or the licensee of a prior right. Further on, the Respondent contends that the documentary evidence did not demonstrate that the applicant was the holder of a prior right and has not complied with requirements of Section 20, especially Section 20 (3) of the Sunrise Rules. According to Respondent’s opinion, the Respondent and the validation agent were under no obligation to investigate into the circumstance of the application because section 21.3. of the Sunrise rules must be interpreted in a way that no obligation is imposed on the validation agent to conduct it own investigation. In addition thereto the

Respondent referred to existing case law. Finally, the Respondent contends that the information submitted for the first time during the present ADR proceedings may not be taken into consideration, whereby the Respondent refers to the wording of Art. 14 and 22 (1) b of the Regulation and existing case law. The Respondent therefore concludes that from the above mentioned reasons, the Complaint must be rejected.

DISCUSSION AND FINDINGS

1. The Complainant under company name ebsoft GmbH filed application for the registration of the domain name “ebsoft” on 9.12.2005. The Complainant submitted the documentary evidence consisting of a certificate of the registration of German national trade mark “ebsoft” No. 398 06 264 in the name of EB-Soft Gesellschaft für elektronische Beschriftungs-Software mbH. Due to the fact that the Complainant did not substantiate that the holder of prior right is the same person or licensee of the Applicant (=Complainant), the Respondent rejected the application. Complainant in its Complaint argues that it is the same person with the holder of prior trademark rights and provides new documentary evidences to this respect, i.e. notarial deed of the notary public (2 UR 263/2006 dated 19 June 2006), and certificates of the German and Communitary trade mark “ebsoft”. It is to be noted that likewise the power for representation as well as the confirmation of the notary public (when citing the companies register extract) refer to EB-soft Gesellschaft für elektronische Beschriftungs-Software mbH.
The relevant legislation is as follows: Article 10 (1) of Commission Regulation (EC) No. 874/2004 of 28 April 2004 (hereafter “the Regulation”) regulates that only holder of prior rights which are recognized or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts (i.e. Sunrise period).
In accordance with article 14 of the Regulation “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”.
In accordance with Section 21 (2) of the Sunrise Rules ..” the validation agent will examine whether the application has a prior right to the name exclusively on the basis of prima facie review of the first set of Ducumentary Evidence received”.
In accordance with section 20 (3) of the Sunrise Rules.. “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, 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”.
The Validation agent must therefore examine whether the applicant (= Claimant) for a registration of a domain name as filed during Sunrise period is a holder of a prior right (Art.14 of the Regulation).
The wording of the above referenced provisions imposes the burden of proof of the ownership of the prior right clearly on the applicant. This is stated in the above referenced Article 14 of the Regulation. Such documentary evidence must be received within the 40 day period following the submission of the application.
The documentary evidence which was submitted by the applicant (=Complainant) did not prove that the Complainant is the holder of the prior right as the certificate of German trade mark No. 39806264 showed a different company name. The company name on the application for registration of a domain “ebsoft” was ebsoft GmbH, whereby on the certificate of the trademark No. 398 06 264 which should serve as a proof of a prior right was as owner the company EB-Soft Gesellschaft für elektronische Beschriftungs-Software mbH, which was a different company name. It has to be noted that the company name both as applied for in the application for registration of a domain name “ebsoft” as well as inserted in the trade mark certificate show substantial differences consisting of a different number of words of the company as well as different type of letters (capitals vs. small letters).
From the above mentioned reasons, the Panel saw no reason why to investigate if the Complainant was allowed under the German law to use a shortened name as official name in the application.
The Complainant did not submit official documents proving that the applicant is the same person or the legal successor to the person indicated in the documentary evidence as being the holder of the prior right. Therefore Registrar’s obligation to examine if the applicant for the domain name is the same entity as the holder of a prior right was not verifiable by the presented documentary evidence.
Art. 21 (3) of the Sunrise Rules authorizes the validation agent to correct certain immaterial and obvious errors. This was not the case as the name of the applicant and of the holder of prior trade mark rights is substantially different. Therefore validation agent was under no obligation to conduct further investigation.
It is furthermore on obvious that additional documentation (as filed within the ADR proceeding) was filed after expiration of the 40-days period for submission of the documentary evidence and as a consequence thereof cannot be accepted.
Based on the above mentioned facts, the documentary evidence submitted together with the application for the domain name “ebsobt” was not sufficient to prove at that time that the applicant and the holder of the prior right is the same person. Therefore, the Respondent proceeded correctly when it rejected the application.

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	**Otakar Svorcik**

DATE OF PANEL DECISION 2006-10-12

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Decision of the Respondent on the rejection of the applications for the registration of a domain “ebsoft” is correct.
The Complainant, ebsoft GmbH has not submitted sufficient documentary with the application evidence to prove that the Respondent and the holder of the prior right, EB-Soft Gesellschaft für elektronische Beschriftungs-Software mbH,, is the same person at the time.
The burden of proof of the ownership of the prior right is imposed on the Complainant and such prior right must be proven from the submitted documentary evidence. In absence of such documentary evidence, the application must be rejected.
Such procedure of the Respondent is based on Art. 10 (1) and 14 of Commission Regulation (EC) No. 874/2004, as well as Section 20 (3) and 21 (2) of the Sunrise Rules.