Entscheidung der Schiedskommission for dispute CAC-ADREU-002301

Case number	**CAC-ADREU-002301**
Time of filing	**2006-07-17 11:07:27**
Domain names	**whitelight.eu, white-light.eu, lamptronic.eu, eller-technologies.eu, ellertechnologies.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Eller Technologies GmbH, Dipl. Inf. Thomas Möhlmann**

Respondent

Organization / Name	**EURid**

ANDERE RECHTLICHE VERFAHREN

The Panel is not aware of any other legal proceedings relating to the disputed domain names.

SACHLAGE

1. Applications for “white-light.eu” and “whitelight.eu”

1.1 On 16 January 2006 the company White Light GmbH & Co. KG, represented by Mr Torsten Eller, had applied for the domain names “white-light.eu” and “whitelight.eu”. Both domain applications referred to a registered national German trademark as the prior right they were based on.

1.2 The two sets of documentary evidence submitted in support of these applications both consisted of copies of:

- a letter addressed to White Light GmbH & Co. KG from the local company register on certain internal re-organisations of its responsibilities,
- an extract of this company register for White Light GmbH & Co. KG, according to which the company Asia Link Consult GmbH & Co. KG is one of the shareholders with limited liability (“Kommanditist”) of White Light GmbH & Co. KG,
- the certificate of registration for the international trademark registration no. IR 847 111 “White Light” (with design), which shows Asia Link Consult GmbH & Co. KG as trademark owner and mentions a number of European countries (not Germany) where this international trademark is protected; the certificate also indicates that the underlying basic registration for this international trademark is registered in Germany with registration no. 30402738.3; and
- a letter from the German Patent and Trademark Office personally addressed to the applicant’s representative, Mr Torsten Eller, according to which the company DIYsupply GmbH & Co. KG had been recorded in the trademark register as the new owner of the German trademark registration no. 30402738.3; this letter also mentions that (i) Asia Link Consult GmbH & Co. KG was the formerly recorded trademark owner, (ii) the request to record this transfer of ownership from Asia Link Consult GmbH & Co. KG to DIYsupply GmbH & Co. KG had been dated 30 November 2005, and (iii) the request had been processed by the German Patent and Trademark Office on 14 February 2006.

2 Application for “lamptronic.eu”

2.1 Also on 16 January 2006 the company Lamptronic International GmbH & Co. KG, represented by Mr Torsten Eller, had applied for the domain name “lamptronic.eu”. This application as well referred to a registered national German trademark as the prior right it was based on.

2.2 The set of documentary evidence submitted in support of this application consisted of copies of:

- a letter addressed to Lamptronic International GmbH & Co. KG from the local company register on certain internal re-organisations of its responsibilities,
- an extract of this company register for Lamptronic International GmbH & Co. KG, according to which the company Asia Link Consult GmbH & Co. KG is one of the shareholders with limited liability (“Kommanditist”) of Lamptronic International GmbH & Co. KG, and
- the certificate of registration for the national German trademark registration no. DE 30516185 “LAMPTRONIC INTERNATIONAL” (with design), which shows Asia Link Consult GmbH & Co. KG as trademark owner.

3 Applications for “eller-technologies.eu” and “ellertechnologies.eu”

3.1 Also on 16 January 2006 the company Eller Technologies GmbH, represented by Mr Torsten Eller, had applied for the domain names “eller-technologies.eu” and “ellertechnologies.eu”. Both applications referred to a registered national German trademark as the prior right they were based on.

3.2 The two sets of documentary evidence submitted in support of these applications each consisted of copies of:

- a letter addressed to Eller Technologies GmbH from the local company register on certain internal re-organisations of its responsibilities,
- an extract of this company register for Eller Technologies GmbH, according to which Mr Torsten Eller is the (sole) director of Eller Technologies GmbH, and
- the certificate of registration for the national German trademark registration no. DE 30517706 “Eller Technologies” (with design), which shows Mr Torsten Eller as trademark owner.

4 All domain name applications described above were rejected by EURid.

A. BESCHWERDEFÜHRER

5. The Complainant, Eller Technologies GmbH represented by Mr Thomas Möhlmann, contends that the documents submitted in support of the applications described above as well as the additional documents annexed to the Complaint were sufficient proof that the respective applicants own prior rights in the relevant names.

6. In addition to the documents described above (paragraphs 1-3) the Complainant has annexed to the Complaint a copy of the original certificate of registration dated 8 April 2004 for the national German trademark registration no. DE 30402738.3 “White Light” (with design), which shows White Light GmbH as the initial trademark owner.

7. The Complainant requests that EURid’s decisions not to register the disputed domain names be annulled, and, more or less implicitly, that these domain names are granted to the respective applicants.

B. BESCHWERDEGEGNER

8. Respondent contends that the documentary evidence submitted by White Light GmbH & Co. KG in support of its applications for “white-light.eu” and “whitelight.eu” demonstrated that the invoked trademark was registered in the name of Asia Link Consult GmbH & Co. KG and not in the name of this applicant.

9. Respondent further contends that the documentary evidence submitted by Lamptronic International GmbH & Co. KG in support of its applications for “lamptronic.eu” demonstrated that the invoked trademark was registered in the name of Asia Link Consult GmbH & Co. KG as well and not in the name of this applicant. Furthermore, the trademark “LAMPTRONIC INTERNATIONAL” could not serve as a prior right for the domain name “lamptronic.eu” (i.e. without “international”).

10. Respondent finally contends that the documentary evidence submitted by Eller Technologies GmbH in support of its applications for “eller-technologies.eu” and “ellertechnologies.eu” demonstrated that the invoked trademark was registered in the name of Mr Torsten Eller and not in the name of this applicant.

11. The Respondent argues that to substantiate a prior right during the phased registration period for .eu domain names it is not sufficient to merely submit evidence of registered trademarks, but that the applicant must also show that it is the owner or the licensee of the trademark. When there is a difference between the name of the domain name applicant and the name of the (apparent) owner of the prior right, the applicant has to submit documents explaining this difference and why/how the applicant is entitled to rely on the right (apparently) owned by another person.

WÜRDIGUNG UND BEFUNDE

12 Procedural Issues

12.1 A surprising aspect of this ADR proceeding is the fact that for 3 of the 5 disputed domain names the Complainant (Eller Technologies GmbH) is actually not identical to the original domain name applicants (White Light GmbH & Co. KG, Lamptronic International GmbH & Co. KG), but apparently only a member of the same group of companies.

12.2 It is not clear whether a company that is not directly affected by a specific decision of EURid is entitled to dispute this decision by initiating an ADR procedure in its own name. Paragraph B1(c) of the ADR Rules states that “[t]he Complaint may relate to more than one domain name, provided that the Parties and the language of the ADR Proceedings are the same.” In the present ADR proceeding there is formally only one Complainant and one Respondent, so the formal requirement that “the Parties and the language of the ADR Proceedings are the same” is met. It nevertheless appears that such “collection” of several disputes against EURid concerning more than one applicant in a single ADR proceeding could be a tempting approach to reduce the fees due under the fee schedule of the Czech Arbitration Court for .eu related disputes. Had the three different applicants that are subject to this ADR proceeding each initiated there own ADR proceeding the total fees would have amounted to 3 x 1,990 = 5,970 Euro, while the Complainant now only has to pay the significantly lower fee of 2,300 Euro for a single dispute covering 5 domain names.

12.3 The Panel is not convinced that the Complainant who is not directly affected by EURid’s decisions vis-à-vis White Light GmbH & Co. KG and Lamptronic International GmbH & Co. KG should be entitled to dispute these decisions by initiating an ADR procedure in its own name (for a discussion of some related aspects see the Czech Arbitration Court (CAC) decisions no. 1047 – FESTOOL and no. 596 – RESTAURANTS). Given the fact, however, that the Czech Arbitration Court has not raised the issue of a potential avoidance of fees, and also given the result of this dispute based on the arguments discussed below, there is no need to explicitly decide this question.

13 Applications for “white-light.eu” and “whitelight.eu”

13.1 The two sets of documentary evidence submitted in support of these applications demonstrated that either the company Asia Link Consult GmbH & Co. KG (according to the international trademark registration certificate) or the company DIYsupply GmbH & Co. KG (according to the letter from the German Patent and Trademark Office) was the owner of the relevant “White Light” trademark when the domain name applications were made.

13.2 The original certificate of registration dated 8 April 2004 for the national German trademark registration no. DE 30402738.3 “White Light” (with design), which shows White Light GmbH as the initial trademark owner, is not relevant for this decision because it was not presented to the validation agent as part of the original documentary evidence (see, for

example, CAC decision no. 1695 – VANDIJK for a detailed discussion of this aspect), and also because the subsequent letter of the German Patent and Trademark office supersedes this information on the original trademark ownership of White Light GmbH (not to mention the difference between White Light GmbH as former trademark owner and White Light GmbH & Co. KG as domain name applicant).

13.3 The only identifiable link of the German and/or the international trademark registration "White Light" to the applicant White Light GmbH & Co. KG was the information contained in the company register, according to which Asia Link Consult GmbH & Co. KG is one of the shareholders of White Light GmbH & Co. KG. This alone, however, is not sufficient to demonstrate that White Light GmbH & Co. KG actually owns rights in the trademark.

13.4 This view does not contradict the CAC decision no. 232 – DMC, where the domain name applicant ("DMC GmbH") was the "general partner" of the trademark owner ("DMC GmbH & Co. KG"). In that decision DMC GmbH and DMC GmbH & Co. KG have been treated as a single organisation for the purposes of registration of the disputed domain name because, under the applicable Austrian laws, the "general partner" of a limited partnership (KG) handles the entire management of the limited partnership within the scope of the ordinary conduct of business, and is also solely entitled to represent and sign for and on behalf of the limited partnership. In the present case Asia Link Consult GmbH & Co. KG is not the "general partner" of White Light GmbH & Co. KG, but according to the submitted extract from the company register merely a shareholder with limited liability ("Kommanditist"). This relationship is not sufficient to treat the two companies as a single organisation for domain registration purposes (see CAC decision no. 1691 – IASON for similar considerations).

14 Application for "lamptronic.eu"

14.1 The documentary evidence submitted by Lamptronic International GmbH & Co. KG in support of its applications for "lamptronic.eu" demonstrates that the invoked trademark was registered in the name of Asia Link Consult GmbH & Co. KG as well, and not in the name of the domain name applicant. For the reasons just discussed in paragraph 13 above this difference alone justifies EURid's decision not to grant the domain name to the applicant.

14.2 In addition to this, and pursuant to Article 10(2) of Regulation (EC) No. 874/2004 and Section 19(1) of the Sunrise Rules, the trademark "LAMPTRONIC INTERNATIONAL" could only have served as a prior right for the domain names "lamptronic-international.eu" and/or "lamptronicinternational.eu", but not for "lamptronic.eu" (i.e. without "international").

15 Applications for "eller-technologies.eu" and "ellertechnologies.eu"

15.1 The documentary evidence submitted by Eller Technologies GmbH in support of its applications for these domain names demonstrated that the invoked trademark was registered in the name of Mr Torsten Eller and not in the name of Eller Technologies GmbH.

15.2 Even though Mr Torsten Eller name was named in the domain application as Eller Technologies GmbH's representative there is no reasonable doubt that the domain application was made in the name of Eller Technologies GmbH, and not in the name of Mr Eller himself. Section 3(1)(i) of the Sunrise Rules specifies in this regard: "[W]here no name of a company or organisation is specified, the individual requesting registration of the Domain Name is considered the Applicant; if the name of the company or the organisation is specified, then the company or organisation is considered the Applicant". This rule is consistent with Article 3(a) of Regulation (EC) No. 874/2004 (see CAC decision no. 1930 – MODELTRAIN).

15.3 This understanding is confirmed by the fact that Eller Technologies GmbH (represented by Mr Thomas Möhlmann) and not Mr Torsten Eller has initiated this ADR proceeding. Unlike in the CAC decision no. 1047 – FESTOOL Eller Technologies GmbH as the Complainant and original domain name applicant still requests registration of the disputed domain names for itself, and not on behalf of the trademark owner Mr Torsten Eller.

15.4 Mr Eller on the one hand and Eller Technologies GmbH on the other hand are separate legal entities. There is a clear

distinction between a company on the one hand and its director as the company's representative on the other hand (see CAC decision no. 903 – SBK for a similar discussion). It is therefore not possible to assume that Eller Technologies GmbH's application was made on behalf of Mr Eller as trademark owner.

15.5 If Mr Eller has licensed his trademark "Eller Technologies" to Eller Technologies GmbH, the Complainant should have submitted suitable documentation of such license to the validation agent in support of its domain name application. Such documentation, however, was not provided.

ENTSCHEIDUNG

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	**Thomas Schafft**

DATUM DER ENTSCHEIDUNG DER SCHIEDSKOMMISSION 2006-10-19

Summary

EINE ENGLISCHSPRACHIGE KURZFASSUNG DIESER ENTSCHEIDUNG IST ALS ANLAGE 1 BEIGEFÜGT

The Complainant and 2 other companies from the Complainant's group of companies had applied for a total of 5 domain names during the phased registration period. All these applications were rejected by EURid.

The Panel discusses (but does not decide) whether the Complainant was entitled to initiate a single ADR proceeding covering its own rejected applications as well as the 3 other rejected applications of its affiliated companies.

The Complaint is denied because for all disputed domain applications the documentary evidence submitted merely demonstrates that corresponding trademarks exist, but not that the respective domain name applicants have actually rights in these trademarks. The fact that a shareholder of the domain name applicant may have rights in the trademark at issue is not sufficient to grant the corresponding domain name to the applicant.