Panel Decision for dispute CAC-ADREU-002350

Case number	CAC-ADREU-002350
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Domain names	publicare.eu

Case administrator

Name	Eva Zahořová

Complainant

Organization / Name	Publicare Marketing Communcations GmbH, Robert Harnischmacher

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

nihil

FACTUAL BACKGROUND

The application for domain name PUBLICARE was applied on December 7, 2005 at 11:12 :12.772 and arrived in first position in the queue of the applications made for this domain name.

The name of the applicant in the application letter was “PubliCare”.

The Aplicant for the domain name submitted as enclosure to the application excerpts from Germant trademark registration for trademark “publicare” and exceprt from the commercial register of commercial court Frankfurt of Publicare Marketing Communication GmbH.

On June 18, 2006 EURid rejected the registration because according to EURid opinion the application does not constitutes statisfactory evidence of the claimed right.

A. COMPLAINANT

The Complainant Publicare Marketing Communication GmbH, based in Frankfurt am Main, Schweizer Strasse 8, Germany, founded in 1994 and registered in commercial register of the Commercial court in Frankfurt, is owner of Greman trademark “publicare” registered under No. 305 60 520.8.

The Complainant contends that submission of evidence for the prior right of the claimed domain has been made in accordance with the EU Sunrise regulation.

The Complainant further contends, that opposite to the Respondent’s opinion the Complainant/Applicant has submitted documentary evidence which prove his prior right of the applied domain under article 10 (1) and (2) EU Regulation 874/2004, namely by filing an excerpt of prior German trademark registration No. 305 60 520.8 for the word-mark (trademark) “publicare”, which has been registered for the Publicare Marketing Communication GmbH. The Complainant submitted also the notice of registration to the commercial register of commercial court Frankfurt.

The Complainant calls Respondent’s argumentation into questions. Especially the Respondents argumentation, that there is a difference between the company name mentioned in application letter, and the name, mentioned in the trademark certificate, which could lead to the assumption two different legal entities could be involved.

According to the Complainant “this reasoning can not be followed: As the enclosed excerpt from the German trademark register No. 305 60 520.8, shows, the trademark “publicare” has been registered for the Publicare Marketing Communications GmbH, the complainant. The trademark “Publicare” is the short form of the complaining company used in commercial life. Additionally an excerpt from the commercial register entry of the complainant was enclosed to the filed application. As from the excerpt is to be seen, the complainants registered office is totally in accordance with the address named in the application letter and the address named in the above mentioned trademark registration, namely Schweizerstraße 8 in Frankfurt am Main. Form these accordance results without doubt that the complainant is the trademark “publicare” owner and has therefore the prior right for registration of the domain “publicare.eu”.

The Complainant contends, that the Respondent’s decision to reject the application for the domain name PUBLICARE, for reasons that the submitted evidence does not sufficiently prove the claimed rights means violation of the commission regulation (EU) No. 874/2004 of April 28.

Therefore, the Complainant requests the Panel to annul the Respondents decision and to grant the domain name PUBLICARE to the Complainant.

B. RESPONDENT

The Respondent contends that the Applicant “PubliCare” submitted documentary evidence consisting of certificate from the German Trademark Office stating that the trademark "PUBLICARE" is registered in the name of "Publicare Marketing Communication Gmbh" (hereafter "the Complainant".)

The Respondent further contends, that the Applicant did not submit documentary evidence substantiating that the Applicant is licensed by the owner of the trademark or that it is 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 Applicant did not demonstrate that it was the holder or the licensee of a prior right on the name PUBLICARE. Therefore, the Respondent rejected the Applicant's application in conformity with all applicable rules and regulations.

The Respondent argues that the Regulation and the Sunrise Rules clearly and certainly provide that the burden of proof is with the Applicant to demonstrate that it is the holder of a prior right.

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 and Respondent must then give the next applicant in line the opportunity to try to demonstrate its prior rights.

During the Sunrise Rules, the first applicant in the line does not have an unconditional right to the domain name, but only has an opportunity to try to clearly demonstrate that it is the holder of a prior right.

The burden of proof was with the Applicant to demonstrate that it is 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 to 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 on 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.

DISCUSSION AND FINDINGS

The Applicant, named in the application letter as PubliCare (hereafter “the Applicant”) applied for the applied for the domain name PUBLICARE on 7 December 2005. The processing agent received the documentary evidence on 13 January 2006, which was before the 16 January 2006 deadline.
The Applicant submitted documentary evidence consisting of certificate from the German Trademark Office stating that the trademark

"PUBLICARE" is registered by "Publicare Marketing Communication Gmbh".

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 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.

During the Sunrise Rules, the first applicant in the line does not have an unconditional right to the domain name, but only has an opportunity to try to clearly demonstrate that it is the holder of a prior right.

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".

The documentary evidence did not demonstrate, with no doubt, that the Applicant was the holder of a prior right the name of the Applicant is “PubliCare”, as stated on the application letter. The owner of the trademark is "Publicare Marketing Communication Gmbh".

Article 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".

The Complainant does not dispute that the names of the Applicant in the application letter and the name of the owner of the trademark are different. The Complainant contends that the reason why the name of the Applicant ("PubliCare") is not the same as the name of the owner of the trademark ("Publicare Marketing Communication Gmbh") is simply because PubliCare is the short form of the name "Publicare Marketing Communication Gmbh".

The Applicant did not submit any other documentary evidence explaining the difference between the name of the Applicant and name of the trademark holder. Therefore the Respondent could have legitimate doubts if the Applicant and the trademark owner is the same company. "PubliCare" could indeed very well be a different company from "Publicare Marketing Communication Gmbh".

The Complainant contends that excerpt from the commercial registers entry of the complainant was enclosed to the filed application and that the complainants registered office address, the address on the application letter and the trade mark registration is the same and therefore the Applicant prior right was demonstrated.
It is not breach of the Regulation if the validation agent did not conduct own investigations into circumstances of the application, the prior right and the documentary evidence, if there are different names of the Applicant and the trademark holder and it is not supported by any other documentary evidence except of the same address.
Section 21 (3) of the Sunrise Rules confirms that the validation agent was no obliged but only permitted, in its sole discretion, to conduct own investigations into the circumstances of the application, the prior right and the Documentary Evidence submitted.
There was no other evidence substantiate that the Applicant (PubliCare) is the same person, legal successor or is licensed by the owner of the trademark.

Based on the documentary evidence, the validation agent found that the Applicant did not demonstrate that it was the holder or the licensee of a prior right on the name PUBLICARE. Therefore, the Respondent rejected the Applicant's application.

The Panel finds that the Regulation and the Sunrise Rules clearly and certainly provide that the burden of proof to demonstrate that it is the holder of prior right is with the Applicant. 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. It is also basic requirement of any legal action to use the correct and full name of the Applicant as registered in the commercial register.

The Panel finds that the Respondent has no option to investigate or correct the difference between the Applicant name and the name prior right holder during the procedure of registration, because any right given to the Applicant to correct its defective application at this stage of the procedure would be unfair to the other applicants and would clearly be in breach of the Regulation and the Sunrise Rules. (Cases n° 706 (AUTOWELT) and 1710 (PARLOPHONE, EMI, EMIMUSIC, EMIRECORDS, ANGEL, THERAFT)).

When there is a difference between the name of the Applicant, at the application letter, and the name of the owner of the prior right, the Applicant must submit official documents explaining this difference. Whereas the Applicant fails to do so, its application must be rejected and Respondent must then give the next applicant in line the opportunity to try to demonstrate its prior rights.

Taking in consideration all above mentioned the Panel finds that the complaint must be rejected.

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	**Premysl Libal**

DATE OF PANEL DECISION 2006-09-29

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Applicant, named in the application letter as PubliCare (hereafter “the Applicant”) applied for the applied for the domain name PUBLICARE The Applicant submitted documentary evidence consisting of certificate from the German Trademark Office stating that the trademark "PUBLICARE" is registered by "Publicare Marketing Communication Gmbh".
The documentary evidence did not demonstrate, with no doubt, that the Applicant was the holder of a prior right the name of the Applicant is “PubliCare”, as stated on the application letter. The owner of the trademark is "Publicare Marketing Communication Gmbh".
The Complainant does not dispute that the names of the Applicant in the application letter and the name of the owner of the trademark are different. The Complainant contends that the reason why the name of the Applicant ("PubliCare") is not the same as the name of the owner of the trademark ("Publicare Marketing Communication Gmbh") is simply because PubliCare is the short form of the name "Publicare Marketing Communication Gmbh".
The Applicant did not submit any other documentary evidence explaining the difference between the name of the Applicant and name of the trademark holder. Therefore the Respondent could have legitimate doubts if the Applicant and the trademark owner is the same company. "PubliCare" could indeed very well be a different company from "Publicare Marketing Communication Gmbh".
There was no other evidence substantiate that the Applicant (PubliCare) is the same person, legal successor or is licensed by the owner of the trademark.
Based on the documentary evidence, the validation agent found that the Applicant did not demonstrate that it was the holder or the licensee of a prior right on the name PUBLICARE. Therefore, the Respondent rejected the Applicant's application.
The Panel finds that the Regulation and the Sunrise Rules clearly and certainly provide that the burden of proof to demonstrate that it is the holder of prior right is with the Applicant. 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. It is also basic requirement of any legal action to use the correct and full name of the Applicant as registered in the commercial register.
When there is a difference between the name of the Applicant, at the application letter, and the name of the owner of the prior right, the Applicant must submit official documents explaining this difference. Whereas the Applicant fails to do so, its application must be rejected and Respondent must then give the next applicant in line the opportunity to try to demonstrate its prior rights.

Taking in consideration all above mentioned the Panel finds that the complaint must be rejected.