Panel Decision for dispute CAC-ADREU-002368

Case number	**CAC-ADREU-002368**
Time of filing	**2006-07-19 13:40:40**
Domain names	**hofmann.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Snap-on Equipment GmbH, Peter Drust**

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 such proceedings.

FACTUAL BACKGROUND

The Complainant submitted the application for registration (hereinafter the “Application”) of the .eu domain name “hofmann.eu” (hereinafter the “Domain Name”) on 18 January 2006. The Application ranked no. 1 among those filed in Sunrise Period.

The Application was based on the Community trademark “HOFMANN” no. 001158161 (hereinafter the “Trademark”) as the prior right pursuant to of Article 10 (1) of the Commission Regulation No. 874/2004 (hereinafter “Public Policy Rules”):

The deadline for filing the documentary evidence pursuant to Article 14 of Public Policy Rules was 27 February 2006 and the Complainant submitted documentary evidence on 13 February 2006 and thus within the said deadline.

The documentary evidence was not provided to the Panel in the course of these ADR proceedings, however, the Panel relied on the concurrent assertion of both parties that:

(a) The documentary evidence consisted of the registration certificate of the Trademark;

(b) The registration certificate shows that the company “Snap-On Deutschland Holding GmbH” is the owner of the Trademark.

By its decision dated 5 June 2006 (hereinafter the “Decision”) the Respondent rejected the Application because the documentary evidence as provided by the Complainant was considered insufficient to demonstrate the prior right of the Complainant to the Domain Name within the meaning of Article 10 (1) of the Public Policy Rules.

On 14 July 2006 and thus within Sunrise Appeal Period as defined by Sunrise Rules the Complainant has filed the complaint against the Decision (hereinafter the “Complaint”) seeking registration of the Domain Name in the name of the Complainant.

The Respondent submitted its response to the complaint on 15 September 2006 (hereinafter the “Response”) and thus within the deadline as stipulated by Paragraph B3 (a) of the ADR Rules.

A. COMPLAINANT

The Complainant contends the following:

(a) The Complainant is the owner the Trademark.

(b) The documentary evidence contained registration certificate of the Trademark on which the company “Snap-on Deutschland Holding GmbH” with its seat at 40822 Mettmann was shown as the owner of the Trademark.

(c) The Complainant missed to explain that the name and address of the owner of the Trademark changed in 2002 and the Trademark is owned by the Complainant since then.

(d) Notwithstanding that an actual excerpt of the OHIM-database has not been submitted along with the documentary evidence the Domain Name shall be registered for the Complainant as the Complainant is the actual owner of the Trademark.

For all the aforesaid reasons the Domain Name should be registered for the Complainant.

B. RESPONDENT

The Respondent contends the following.

(a) The burden of proof as to demonstration of the prior right is with the Complainant.

(b) When there is a difference between the name of the applicant for a domain name and the owner of the prior right the applicant must submit official documents explaining that difference. If the applicant fails to do so its application has to be rejected and the Respondent must give the next applicant in line the opportunity to try to demonstrate its prior rights.

(c) The Respondent and the validation agent were under no obligation to investigate into the circumstances of the application of the Complainant in order to establish whether the Complainant is the actual owner of the asserted prior right.

(d) Documents submitted by the Complainant for the first time during the present ADR proceedings cannot be taken into consideration.

In the light of the foregoing it must be concluded that the Complainant failed to demonstrate the prior right to the Domain Name and therefore the Complaint should be dismissed.

The Respondent also cites a number of previous decisions in ADR proceedings in support of the aforesaid arguments.

DISCUSSION AND FINDINGS

The Panel concurs with the Respondent.

According to Article 10 of the Public Policy Rules only an applicant who is able to demonstrate a prior right to a domain name is eligible for registration of such domain name in Sunrise Period.

According to Article 14 of the Public Policy Rules every applicant shall submit the documentary evidence that shows he or she is the holder of the prior right claimed on the domain name in question. This requirement is further specified with respect to each type of prior rights by Sunrise Rules. If the prior right is based on a trademark, the applicant must provide the documentary evidence according to the requirements set forth in Section 13 (2) (i) or (ii) of the Sunrise Rules.

Section 20 of the Sunrise Rules sets forth additional requirements the applicant must meet in the event that the documentary evidence (such as trademark registration certificates) shows that the owner of the prior right is different from the applicant. If there has been a name change of the applicant, 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 owner of the prior right (Section 20.3 of the Sunrise Rules). In the case at hand, the recent extract from the OHIM database would most probably be sufficient for this purpose (Section 13 (2) (ii) of the Sunrise Rules), however, no such extract has been submitted by the Complainant as the part of the documentary evidence.

The burden of proof with respect to demonstration of the prior right is undoubtedly with the Complainant. See for example ADR cases no. 127 (BPW), 219 (ISL), 294 (COLT), 551 (Vivendi), 843 (STARFISH), 1931 (DIEHL, DIEHLCONTROLS).

According to Section 21 (1) (ii) of the Sunrise Rules, the validation agent shall verify whether the requirement for the existence of the prior right to the domain name claimed by the applicant is fulfilled. According to Section 21 (2) of the Sunrise Rules the validation agent examines whether the applicant has a prior right to the domain name in question on the basis of prima facie review of the first set of

documentary evidence received. According to Section 21 (1) in fine of the Sunrise Rules, the validation agent and the Respondent are not obliged to notify the applicant if the requirement to sufficiently establish the prior right to a domain name is not complied with.

The documentary evidence provided by the Complainant shows that the owner of the Trademark is the company “Snap-on Deutschland Holding GmbH” and not the Complainant. The Complainant did not provide any document within the documentary evidence which would explain this discrepancy and demonstrate Complainant’s right to the trademarks in question. Therefore a conclusion has to be drawn that the Complainant failed to demonstrate its prior right to the Domain Name. On this issue the Panel concurs with decisions in ADR cases no. 810 (Ahold), 1242 (Aponet), 1299 (4CE), 1625 (Teledrive) and 1627 (Planetinternet).

Documents submitted as annexes to the Complaint cannot be taken into account in these ADR proceedings as such documents did not form part of the documentary evidence submitted to the validation agent within 40 days from the day of submission of the Application in accordance with Article 14 (4) of the Public Policy Rules. Taking such documents into account would in fact turn the ADR proceedings into a “second round” of .eu domain name registrations providing applicants with an option to remedy their imperfect original applications. It would also adversely affect the legitimate expectancy of the next applicant in the queue for registration of the Domain Name and conflict with the first-come-first-served principle, i.e. the principle that, in the course of the phased registration, the first applicant who first demonstrates its prior right in compliance with the requirements of Public Policy Rules and Sunrise Rules should be able to register the domain name. On this issue the Panel concurs with decisions in ADR cases no. 119 (Nagel), 551 (Vivendi), 810 (Ahold), 865 (HI) and 894 (Beep).

Generally, throughout the world, domain names have always been registered on “first come first serve” principle without having specific regard to the rights of the owners of intellectual property. The European Community, having regard to legitimate interests of the intellectual property right owners, provided such owners with the opportunity of privileged registration of domain names corresponding to their intellectual property rights in the Sunrise Period. In order to administer such a tremendous task it was absolutely necessary to establish strict and straightforward rules for demonstrating of the intellectual property rights on which the privileged registration of domain names should be based. These strict rules are without any doubt justified and necessary in situation when hundreds of thousands of applications for registration of the domain names in the Sunrise Period had to be examined. Nothing in these rules construes the obligation of the validation agent or the Respondent to investigate into the circumstances of the applications where the prior right was not sufficiently demonstrated, or notify applicants of deficiencies in their applications. Quite to the contrary, Section 21 (1) and (2) of the Sunrise Rules expressly stipulate that the validation agent and the Respondent shall not have any such obligations. Therefore, it cannot be reasonably anticipated that the validation agent (although it has the permission to do so pursuant to Section 21 (3) of the Sunrise Rules) would investigate into the circumstances of each and every domain name application where the documentary evidence submitted by the applicant does not comply with the requirements set forth by Sunrise Rules. On this issue the Panel concurs with the decisions in ADR case no. 501 (LODE, PROCARE), 551 (Vivendi) and 1443 (Urbis).

In the light of the foregoing it has to be concluded that it is the responsibility of the domain name applicant to provide documentary evidence in a manner that its prior right to the domain name applied for is clearly demonstrated. Should the documentary evidence show that the owner of the asserted prior right is different from the applicant, the documentary evidence must include appropriate documents explaining this difference and demonstrating that the applicant is authorized to register the domain name on the basis of the asserted prior right. If such documents are not provided by the applicant, the validation agent, exercising the prima facie review of the documentary evidence pursuant to Section 21 (2) of the Sunrise Rules may (and most likely will) conclude that the prior right of the applicant to the domain name is not demonstrated and thus reject the domain name application. The documents provided by the applicant for the first time in the course of ADR proceedings cannot be taken into account.

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	**Michal Matejka**

DATE OF PANEL DECISION 2006-09-29

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant applied for a domain name hofmann.eu on the basis of registered trademark, which was, according to the

documentary evidence provided, owned by different entity than the Complainant. Complainant did not provide any of the documents required by Section 20 of the Sunrise Rules that would demonstrate its authorization to register the domain name on the basis of the prior right. With its complaint the Complainant provided documents demonstrating that the difference between the name and address of the trademark owner on the registration certificate submitted as documentary evidence and the Complainant was due to name and address change which occurred in 2002. The documentary evidence however, did not contain any document from which the fact such name and address change could be ascertained.

The Panel held that the Complainant apparently failed to demonstrate the prior right to the claimed domain name in compliance with the requirements of Public Policy Rules and Sunrise Rules as the trademark on the basis of which the prior right has been asserted was, according to the documentary evidence, owned by different entity than the Complainant, and the Complainant failed to explain this difference by provision of the documents required by Section 20 of the Sunrise Rules within the deadline set forth by Article 14 (4) of the Public Policy Rules.

For these reasons the Complaint was dismissed.