Panel Decision for dispute CAC-ADREU-002385

Case number	**CAC-ADREU-002385**
Time of filing	**2006-07-28 11:19:38**
Domain names	**gehl.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Gehl Europe GmbH, Mr. Allan Lackas**

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

None

FACTUAL BACKGROUND

The Complainant is a German company registered on the Amtsgericht Rheine commercial register on 2nd February 1973 under the name “Gehl GmbH”.

On 4th March 1999, an American company (“Gehl Company”) purchased the Complainant.

In July 2003, the Complainant changed its name from “Gehl Gmbh” to “Gehl Europe Gmbh”.

“Gehl Company” is the proprietor of CTM Registration No. 208900 GEHL.

Complainant has been trading by reference to the trade mark GEHL under licence from “Gehl Company”.

On 13th December 2005 at 15:19:30, an application for the domain name GEHL.EU was made under the .eu Sunrise Rule.

Complainant explains that the application was made by its ISP and that it is believed that the Complainant’s name was rendered in the application in the form of its previous name (“Gehl GmbH”) and not in the form of its new name since July 2003 (“Gehl Europe GmbH”).

The Documentary Evidence provided in time comprises notably:

- a Copy of the CTM Registration No. 208900 GEHL

- the standard “Declaration for a Registered Trade Mark (.eu Phased Registration)” executed by “Gehl Company” in favor of “Gehl Europe GmbH”.

A. COMPLAINANT

Complainant contends that although the application is formally made in the in the form of Applicant’s previous name, the Validation Agent was nevertheless in possession of all the information and documents necessary to accept the Application, including the name and address of the Applicant rendered in its present name because that name appeared in the Licence Declaration.

In the Complainant’s view, the correct approach should not be to take a disproportionately formalistic approach but to take into account

all the information provided during the application process.

The Complainant contends that the Verification Agent and the Respondent had enough information to have raised the question in their mind as to whether the Licensee and Applicant were one and the same or so closely related so as to be treated as one and the same or that there was an obvious error in either the Application or the Licence Declaration.

It is further submitted by the Complainant that it is clear on the face of the documentation submitted in support of the Application that the intention of the right holder, Gehl Company, was that its subsidiary would hold the domain name GEHL.EU.

B. RESPONDENT

Respondent contends that the documentary evidence did not demonstrate that the Applicant was the holder or the licensee of a prior right, although the burden of proof is with the Applicant.

Respondent refers notably to case 1886 (GBG) in which the Panel stated that: "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".

Respondent insists on the fact that the Complainant does not deny that the documentary evidence only demonstrated prior rights in the heads of Gehl Company (which owns the GEHL trademark), and Gehl Europe Gmbh, but not in the head of Gehl Gmbh which doesn't exist anymore since the change of its name in 2003.

Respondent stress that it is obvious that the name of the Applicant Gehl Gmbh is different from the above names, and recalls that article 20 (3) of the Sunrise Rules clearly provides that in such case 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 or licensee of the prior right.

The Respondent contends that it had thus no right (and a fortiori no obligation) to speculate on the relationship between the Applicant and the owner/licensee of the trademark, and therefore correctly rejected the Applicant's application. Respondent refers notably to cases 810 (AHOLD), 894 (BEEP), 1242 (APONET), 551 (VIVENDI), 1627 (PLANETINTERNET), 1625 (TELEDRIVE).

Eventually, Respondent requests the Panel to disregard all additional documents provided in the course of the ADR, because pursuant to the Regulation article 14 of the Regulation, the Respondent may only accept, as documentary evidence, documents that are received by the validation agent within 40 days from the submission of the application for the domain name. Respondent explains that:

- This is the consequence of the fact that the Appeal under the ADR rules may not in any case serve as a "second chance" or an additional round providing applicants an option to remedy their imperfect original application that was rejected during the Sunrise Period (see cases 551 (VIVENDI) and 810 (AHOLD)).

- Any right given to the Complainant to correct the Applicant's 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.

DISCUSSION AND FINDINGS

Respondent is right to insist on the fact that the Complainant doesn't deny its "mistake". As a matter of fact, the name of the Applicant ("Gehl Gmbh") did not exactly match the name of the trademark holder / licensee.

Is this sole fact sufficient for the validation agent (and Respondent) to conclude that the Applicant did not demonstrate that it was the holder of the claimed prior rights?

As ruled in case 642 (CRUX), the issue is whether the acquisition of rights (based even on prior rights) in the European Union will depend on the question of whether the applicant has filled in correctly a form, or whether such acquisition will depend on sound and thorough assessment of the filings of the applicants, based on communication with the applicants.

The Panel shall not use any automated processes and the Panel is of the opinion that current legal rules governing the registration

process of EU domain names contain sound provisions, which could have been used by the Respondent during the registration process.

Reference is made, among others, to Recital 12 of the Regulation 874/2004, under which the aim of the registration process is to ensure that holders of prior rights have appropriate opportunities to register names on which they hold prior rights. It further follows from this recital that validation agents should assess rights claimed for a particular name properly. Reference is further made to Article 14 of the Regulation No 874/2004, under which the validation agent should examine the application.

Under Sunrise Rules, Article 21.3, the validation agent may, at his own discretion, conduct investigation into the circumstances of the respective application.

The Panel appreciates the high number of application received and processed by the Respondent, and the Panel also understands the tendency of the Respondent to apply automated processes or to adopt a formalistic approach to cope with all these applications.

The respective legal provisions cited above put the Respondent under clear legal obligation to examine the application (Art. 14 of the Regulation 874/2004) and to assess the respective right of the applicant (recital 12 of the Regulation 874/2004.

In the opinion of the Panel, these obligations to examine and assess are clearly in conflict with the absolute idea of an uncompromised automated process or a disproportionate formalistic approach.

The Panel should, under the ADR, however provide the necessary corrections to procedures and decisions of the Respondent, where the facts of the case allows so, and where such procedure is admissible under the ADR Rules and the respective legal provisions governing the registration process.

Facts are as such:

- The name of the Applicant and the name of the Complainant / Licensee are differentiated only by a geographical indication “Europe”;

- The name of the Community Trade Mark Registration Holder and the name of the Applicant are differentiated only by the terms, “Company”/“GmbH”;

- The domain name GEHL.EU reproduces without any subtraction or addition the distinctive part of the Complainant’s old and new names and the whole of the trade mark right holder’s name;

- The distinctive part of the right holder’s name and the Applicant’s name are identical, and refers directly to the trademark;

- The address of the Applicant and the address of the Licensee are identical.

In the Panel view, it was within the powers and possibilities of the Respondent to ask the Complainant for explanation of the names used in the application form and the Respondent could have proceeded in compliance with the above mentioned legal provisions.

The Respondent decided, within his discretionary power, not to do so during the registration proceeding.

Taking into consideration all the relevant facts of the case the Panel decides to provide for the necessary correction of the procedure of the Respondent.

Eventually, the Panel wishes to underlines that it fully supports Respondent’s view that the latter had no right to “speculate” on an Applicant’s right. This being said, there is far from speculation to assessment of a concrete case and, as case may be, reasonable use of the enquiry rights provided for in the Regulation.

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 GEHL be transferred to the Complainant

PANELISTS

Name	**Paul Van Den Bulck**

DATE OF PANEL DECISION 2006-10-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant doesn't deny its "mistake". As a matter of fact, the name of the Applicant ("Gehl Europe GmbH") did not exactly match the name of the trademark holder / licensee.

Is this sole fact sufficient for the validation agent (and Respondent) to conclude that the Applicant did not demonstrate that it was the holder of the claimed prior rights?

The Panel appreciates the high number of application received and processed by the Respondent, and the Panel also understands the tendency of the Respondent to apply automated processes or to adopt a formalistic approach to cope with all these applications.

The respective legal provisions put the Respondent under clear legal obligation to examine the application (Art. 14 of the Regulation 874/2004) and to assess the respective right of the applicant (recital 12 of the Regulation 874/2004). See also Article 21.3 of the Sunrise Rules.

Based on the facts of the case, in the Panel view, it was within the powers and possibilities of the Respondent to ask the Complainant for explanation of the names used in the application form and the Respondent could have proceeded in compliance with the above mentioned legal provisions.

The Respondent decided, within his discretionary power, not to do so during the registration proceeding. Taking into consideration all the relevant facts of the case the Panel decides to provide for the necessary correction of the procedure of the Respondent.

The Panel fully supports Respondent's view that the latter had no right to "speculate" on an Applicant's right. This being said, there is far from speculation to assessment of a concrete case and, as case may be, reasonable use of the enquiry rights provided for in the Regulation.