Entscheidung der Schiedskommission for dispute CAC-ADREU-001695

Case number	**CAC-ADREU-001695**
Time of filing	**2006-06-19 13:36:44**
Domain names	**vandijk.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Van Dijk Educatie B.V., Saskia Waagmeester**

Respondent

Organization / Name	**EURid**

ANDERE RECHTLICHE VERFAHREN

The Panel is not aware of other legal procedings relating to the disputed domain name.

SACHLAGE

On 7 December 2005 Complainant's registrar filed an application for the domain name <vandijk.eu> in the name of "Van Dijk Studieboeken B.V.".

On 10 January 2006 the registrar electronically submitted documentary evidence in support of this application. The documentary evidence consisted of an extract from the Benelux Trademark Register's online trademark database for the trademark no. 780212 "VAN DIJK". This extract mentioned "Van Dijk Studieboeken B.V." as the (original) trademark owner. At the bottom of this database extract, however, it was also mentioned that a notice indicating the transfer of this trademark from "Van Dijk Studieboeken B.V." to "Van Dijk Educatie B.V." had been filed with the Benelux Trademark Register on 10 November 2005. The street address that was provided for both company names was identical.

On 9 May 2006 EURid informed Complainant that it had rejected Complainant's application because the documentary evidence did not sufficiently prove Complainant's prior right.

A. BESCHWERDEFÜHRER

Complainant contends that the two companies "Van Dijk Studieboeken B.V." and "Van Dijk Educatie B.V." are in fact one and the same legal entity because Complainant had merely changed its corporate name from "Van Dijk Studieboeken B.V." into "Van Dijk Educatie B.V." on 9 June 2005. A Chamber of Commerce extract evidencing this company name change was attached as an Annex to the Complaint. Attached to an additional non-standard communication in this ADR Proceeding Complainant also submitted an updated database extract for the trademark no. 780212 "VAN DIJK", which explicitly indicated "Van Dijk Educatie B.V." as owner of the trademark.

Complainant further contends that Complainant's registrar, based on a wrong interpretation of the database extract that Complainant had provided to this registrar for submission to the validation agent, had changed the applicant's name in the domain application for <vandijk.eu> from "Van Dijk Educatie B.V." to "Van Dijk Studieboeken B.V." without consulting the Complainant.

Complainant argues that, when faced with the present immaterial discrepancy between the name of the applicant (Van Dijk Studieboeken) and the trademark owner indicated in the documentary evidence (Van Dijk Educatie), which have the same distinctive element “Van Dijk” and which both have the same street address, the validation agent should have asked the question whether a mistake had been made. According to the Complainant it is for situations like these that the validation agent, in terms of section 21(3) of the Sunrise Rules, has received the power to conduct its own investigation.

The validation agent, according to Complainant, acted unreasonably by not making any enquiry with the concerned registrar or the Complainant. To support this view Complainant refers to the ADR decision in Case No. 253 (SCHOELLER). Complainant also points out that under the last sentence of Section 21(1) Sunrise Rules the validation agent is not required to draw the applicant's attention to a possible mistake prior to rejecting an application, thereby depriving the applicant of the opportunity to correct any mistakes. This, according to Complainant, contrasts with the widespread practice of national trademark authorities in the European Union and of the OHIM to alert an applicant of a trademark right to any mistakes and omissions in the application, in order to enable the applicant to make the necessary corrections and additions.

Complainant finally contends that EURid's disputed decision not to grant the domain name <vandijk.eu> to the Complainant implies that the domain name might now be awarded to another party, which would cause irreparable harm to Complainant. The fact that the validation agent has had to deal with hundreds of thousands of Sunrise applications and was therefore under time pressure, was, according to Complainant, no justification for the alleged breach of the fundamental principle of justice to act reasonably.

Based on these contentions Complainant requests that the Panel
– orders EURid to suspend any decision regarding the attribution of the domain name <vandijk.eu> until the ADR Proceeding or any subsequent legal proceedings have been completed,
– annuls EURid's decision in which EURid has rejected Complainant's application for registration of the domain name <vandijk.eu>, and
– attributes the domain name <vandijk.eu> to Complainant.

B. BESCHWERDEGEGNER

Respondent contends that Complainant had failed to submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question.

Respondent particularly points to Section 20(2) and Section 20(3) of the Sunrise Rules, according to which the documentary evidence has to “clearly indicate” the name of the applicant as being the holder of the prior right claimed. Respondent contends that the validation agent could not conclude that the applicant Van Dijk Studieboeken B.V. was the holder of a prior right on the name “Van Dijk” because the documentary evidence provided indicated that the trademark at issue had been assigned to a (seemingly) different entity named Van Dijk Educatie B.V. Respondent argues that in these circumstances the validation agent did not act unreasonably in rejecting the application because the documentary evidence submitted did not demonstrate that the applicant was the holder of the claimed prior right.

Respondent further contends that, under the Sunrise Rules, the validation agent was merely permitted but not obliged to conduct its own investigations into the circumstances of Complainant’s application.

Respondent finally contends that a mistake made by the Complainant’s registrar cannot be attributed to EURid or the validation agent.

WÜRDIGUNG UND BEFUNDE

1. Suspension of the domain name

1.1 There is no need for the Panel to order EURid to suspend any decision regarding the attribution of the domain name <vandijk.eu> until this ADR Proceeding has been completed. This effect has automatically been achieved by initiating the ADR Proceeding. The relevant provisions in this regard are Section 9(3)(b) of the .eu Domain Name Registration Terms and

Conditions and the last sentence of Section B(1)(e) of the .eu Alternative Dispute Resolution Rules. The wording of these provisions may seem to apply to registered domain names only, which can no longer be “transferred” etc. after an ADR Proceeding has been initiated. It is the clear aim of these provisions, however, to preserve the current domain status during a pending ADR Proceeding, whatever this domain status may currently be, i.e. whether or not the disputed domain name has already been registered.

It is therefore standard practice that EURid implements and confirms to the ADR provider a lock on any disputed domain names for the duration of the pending ADR Proceeding, whether or not the disputed domain name has already been registered. In the present case EURid has confirmed this lock for <vandijk.eu> in its non-standard communication of 19 June 2006.

1.2 The Panel does not feel competent to order any ongoing suspension regarding the attribution of <vandijk.eu> for the time after this ADR Proceeding has ended. If the parties should continue their dispute in regular court proceedings the competent courts may decide to issue such interim suspension orders to prevent attribution of the domain name <vandijk.eu> to a third party. This Panel does not see a legal basis for itself, however, to order such measures that would reach beyond the scope of this ADR Proceeding.

2. Documents submitted during the ADR Proceeding

2.1 The purpose of this ADR Proceeding is to verify whether EURid’s decision to deny registration of the domain name <vandijk.eu> complies with Regulation (EC) No. 874/2004 (the “Public Policy Rules”) and Regulation (EC) No. 778/2002. The Panel believes that it is not the purpose of this ADR Proceeding to verify whether Complainant actually owns sufficient prior rights in “VAN DIJK” (which, according to the documents submitted during this ADR Proceeding, indeed seems to be the case).

2.2 This understanding of the limited scope of this ADR Proceeding is based on the clear wording of Article 22(1)(b) and the second sub-paragraph of Article 22(11) Public Policy Rules. Previous panel decisions have shared this view (see, for example, Case No. 865 – HI, Case No. 219 – ISL, Case No. 119 – NAGEL, Case No. 894 – BEEP, Case No. 541 – ULTRASUN, Case No. 551 – VIVENDI, Case No. 1483 - SUNOCO, and Case No. 1262 – NATIONALBANK). In particular the Panelist in this last decision (NATIONALBANK) has rightly pointed out that it is not for the Panel to perform the task of the validation agent retrospectively and examine new evidence relating to prior rights. To allow a Panel to do this would in effect be giving an applicant a second bite at the cherry, contrary to Article 14(4) and Article 14(10) of the Public Policy Rules.

2.3 Other Panels have annulled similar decisions by EURid and have attributed the disputed domain names based on documents that had not been submitted to the validation agent before the deadline stipulated by Article 14(4) of the Public Policy Rules but only during the ADR Procedure (see Case No. 431 – CASHCONTROL, Case No. 1047 – FESTOOL). In these decisions it was argued that it would be against the rationale of the phased registration period provided for by the Public Policy Rules if a domain name was not attributed to the holder of a prior right, even if this prior right was only demonstrated during the ADR Proceeding. This Panel is not convinced by this argument because it does not account for the legitimate expectancy of the next applicant(s) in the queue for the domain name in question. The rationale of the phased registration period was not to attribute a specific domain name to the applicant with the “best” corresponding prior right, but merely to provide the owners of prior rights with a mechanism giving them a chance to obtain a head start in the registration process. It is consistent with the rationale of the phased registration period if the first application in the queue only succeeds if this application itself and the corresponding documentary evidence presented to the validation agent satisfy the formal requirements of the Sunrise Rules. The (singular) first-time distribution of domain names to be registered under the .eu Top Level Domain differs significantly from the registration process for national or Community trademarks, which justifies the use of different (and less fault-tolerant) standards for the application process.

2.4 Consequently, the additional documents submitted by the Complainant during the ADR Proceeding are not relevant for deciding this case. The Panel only has to decide whether EURid and the validation agent, based on the documentary evidence originally submitted by the Complainant, should have either directly attributed the domain name <vandijk.eu> to the Complainant (sub 3 below), or should at least have initiated further investigations regarding the ownership of the prior right

claimed (sub 4 below).

3. Attribution of the domain name to the Complainant

The documentary evidence that was originally submitted by the Complainant did not demonstrate that the prior right claimed was registered in the name of the applicant, but rather indicated that it had been transferred away from the applicant to a different legal entity. Based on this documentary evidence the Respondent was right not to attribute the domain name <vandijk.eu> to the Complainant.

4. Respondent's obligation to investigate ownership of the prior right

4.1 The main question of this ADR Proceeding is whether the validation agent was obliged to investigate the ownership of the prior right claimed. Complainant contends that the validation agent, in view of the almost identical company names and the identical street addresses, should have suspected a mere clerical mistake, and should therefore have conducted further investigations as permitted by Section 21(3) of the Sunrise Rules.

4.2 To support this argument Complainant refers on the following quote from the Panel decision in Case No. 253 (SCHOELLER):

"While the same section 21(3) of the Sunrise Rules grants the Validation Agent 'sole discretion' to carry out such investigations, it is a fundamental principle of justice that, when granted such discretion, the Validation Agent is not exempted from the requirement to act reasonably. Indeed, it may be argued that the extent of the discretion granted to the Validation Agent implies a higher standard of care and reasonableness. In the circumstances of the case, the Validation Agent could have easily cleared up any doubts by seeking and obtaining further proof of identity despite change of address and a slightly abbreviated name. It would be unreasonable for the Validation Agent not to have expended the minimum of effort required to clear any small doubt. For it is clearly the intention of the .eu Sunrise Rules that the role of the Validation Agent should go far beyond that of a mere clerical function, otherwise it would not have endowed this office with such wide and important investigative powers. Just because there was not an immediate and perfect match between the Documentary Evidence and the street address in the domain name application is not sufficient excuse to reject the application for a domain name out of hand. Even the most humble of clerks would have had the common sense to check out the small discrepancy in a suitable manner but there is no evidence to suggest that the Validation Agent applied the diligence of the humble clerk or the reasonable man."

(More or less identical arguments are put forward in the decisions of Case No. 174 – DOMAINE, Case No. 985 – GEDORE, and Case No. 1467 – TELEVORK).

4.3 This Panel agrees that EURid and the validation agent must not act unreasonable in reaching their decision, and that applications for domain names must indeed not be rejected without due diligence being applied. This general consideration, however, does not provide guidance on the precise level of diligence that has to be expected from the validation agent.

4.4 The present case appears to fall squarely into the circumstances addressed in Section 20(3) of the Sunrise Rules, according to which it was the applicant's obligation to submit official documents clarifying the ownership of the claimed prior right. In this Panel's view the validation agent and EURid did not act unreasonable by following the strict guidelines specified in Section 20(3) of the Sunrise Rules without conducting further investigations under Section 21(3) of the Sunrise Rules.

4.4.1 Unlike in the SCHOELLER case cited above and the similar Case No. 181 (OSCAR), the present case is not based on a mere technical flaw of the concerned registrar's IT system, but was apparently rather caused by human error. Also unlike the SCHOELLER and OSCAR case, the applicant's company name in this case was not merely longer or shorter than the name of the trademark owner specified in the documentary evidence. Because of the different words "Studieboeken" and "Educatie" it was not possible to regard one of these company names as the abbreviation of the other. It is actually quite common that the names of different legal entities have the same distinctive element (in this case "Van Dijk") and/or the same street address.

Even if such companies belong to the same group of companies they (usually) are nevertheless separate legal entities. It is just as well possible that such companies may have belonged to the same group of companies in the past, but now, despite their identical distinctive element in their company name, have entirely different owners (the German brands “AEG”, “Agfa” or “Grundig” are examples for such developments). Given this range of possible explanations for the different company names “Van Dijk Studieboeken” and “Van Dijk Educatie” it was actually not clear that the difference between the application and the documentary evidence was caused by a mere clerical mistake.

4.4.3 The Panel also notes that in the time span between 7 December 2005 (when the application for <vandijk.eu> was filed) and 10 January 2006 (when the documentary evidence was submitted) Complainant could well have verified the precise contact details that its registrar had used for the online application, and could have amended its documentary evidence accordingly to demonstrate that the two companies Van Dijk Studieboeken B.V. and Van Dijk Educatie B.V. are in fact one and the same legal entity. Other applicants for .eu domain names have invested the effort (and the costs) to diligently comply with the requirements of the Sunrise Rules, while the Complainant has not. If the validation agent would have been obliged (and not merely entitled) to investigate further in cases like the present one, this would have increased the already substantial verification costs (both in time and in money) for the phased registration period, which would have benefited a few (like the Complainant) to the disadvantage of most other applicants who have submitted their applications and documentary evidence in full compliance with the Sunrise Rules.

4.5 Based on these considerations it was an acceptable decision that the validation agent did not spend additional effort on the Complainant’s domain application.

5. Responsibility for registrar’s mistake

As to the supposed mistake by the Complainant's registrar to change the applicant’s name in the domain application without consulting Complainant, Section 5(3) of the Sunrise Rules makes it clear that EURid and the validation agent are not parties to the agreement between an applicant and its registrar, and that EURid does not incur any liability under this agreement. The Panel agrees with previous panel decisions that a default by the applicant’s registrar should be taken up as between the applicant and the registrar, and is not a reason for overturning EURid's decision (see Case No. 393 – 4M and Case No. 984 – ISABELLA).

ENTSCHEIDUNG

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the .eu Alternative Dispute Resolution Rules, the Panel orders that the Complaint is denied.

PANELISTS

Name	**Thomas Schafft**

DATUM DER ENTSCHEIDUNG DER SCHIEDSKOMMISSION 2006-09-04

Summary

EINE ENGLISCHSPRACHIGE KURZFASSUNG DIESER ENTSCHEIDUNG IST ALS ANLAGE 1 BEIGEFÜGT

The Panel refused to issue an order suspending any decision regarding the attribution of the disputed domain until (i) the ADR Procedure or (ii) any subsequent legal proceedings have been completed.

The Panel further held that it is not the purpose of the ADR Proceeding to verify whether Complainant actually owns sufficient prior rights regarding the domain name, but merely to verify compliance of EURid’s decision not to register the disputed domain name based on the documentary evidence that Complainant had originally submitted.

The Panel finally decided that EURid did not act unreasonably in rejecting the application for <vandijk.eu> in the name of “Van Dijk Studieboeken B.V.” as the documentary evidence showed that the owner of the relevant trademark was not this company but “Van Dijk Educatie B.V.”. The validation agent was also not obliged to investigate the relationship between these two

companies, even though the documentary evidence showed that they had the same street addresses.

ble-responsive">

Name	Darius Sauliunas

Date of Panel Decision
2006-10-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The complainant is Polish company Ericpol Telecom sp. z o.o. It has registered trademarks ERICPOL TELECOM and ET ERICPOL TELECOM since 2000. The initial Sunrise registration of domain name <ericpol.eu> failed because the wording of the trademarks was not identical to the domain name. On the very first minutes of the second trial complainant was left without it's desired domain name as the first to file was the respondent Zheng Qingying from London.

The e-mail communication revealed that respondent claimed EUR 30.000 for this domain name. This fact was not contested by the respondent. The complainant started the ADR procedure in English but later has been informed about the deficiencies of the complaint. As the respondent has changed the language of the domain name registration agreement from English to Lithuanian, the complainant was required to file the complaint in Lithuanian. This was done and Respondent was required to present its response. No response in any language was presented by the deadline.

The Panel accepted all arguments presented by the complainant in Lithuanian and has rejected some English statements of the respondent because they were not presented in Lithuanian and have not been in due form as required according to the ADR Rules.

The complainant showed that it had prior rights to the trade marks ERICPOL TELECOM and ET ERICPOL TELECOM. The Panel was satisfied with the argument that domain name <ericpol.eu> is confusingly similar to the trademark ERICPOL TELECOM, as the first element, namely the word Ericpol, which is identical to the domain name, is the dominant and distinctive element of Complainant's trademark and company name.

The respondent does not have any rights or legitimate interests in the domain name. The name and surname of the respondent cannot be anyhow linked to the domain name. The respondent has not presented data which would show that he or she has any legitimate interest to the domain name.

The Panel confirmed that the domain name has been registered and is used in bad faith in the meaning of Article 21(1) (b) of the Regulation. The circumstances of this case indicate that the domain name was registered primarily for the purpose of selling the domain name to the holder of a name in respect of which a right is recognised or established by national and/or Community law. The holder of such name is the complainant. A pattern of such conduct by the registrant was clearly demonstrated from the e-mail communication between complainant and respondent where the latter has required EUR 30.000 for the domain name and was continuously concentrated on this deal only.

The facts of the case clearly show that the respondent is a cybersquatter. The search on Google has revealed that the holder of the e-mail address domain.com@gmail.com has cybersquatted several more domain names and several European companies are facing problems of the same kind as the ones in the present case. These facts were not contested by the respondent.

It is important to note that the respondent has showed his or her bad faith conduct by abusing ADR proceeding as well. This was done by changing the language of the registration agreement in order to change the language of the

proceeding immediately after the complaint was presented. This of course has caused additional expenses to the complainant and shall be regarded as the conduct which aimed at the highest price possible for the domain name. No evidence was presented that Respondent can actually speak Lithuanian. The respondent has selected Lithuanian language which is the oldest and the most difficult language from the group of Indo-European languages in Europe and in the world. Therefore language selection has caused the maximum possible translation expenses for the complainant. Such conduct is obvious abuse of ADR proceeding and clearly reflects the bad faith of the respondent.

Based upon the said arguments the Panel has decided to transfer the domain name to the complainant.