Panel Decision for dispute CAC-ADREU-002470

Case number	**CAC-ADREU-002470**
Time of filing	**2006-08-04 14:17:40**
Domain names	**transform.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**TRANSFORM a.s. Lazne Bohdanec, Raban**

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

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FACTUAL BACKGROUND

The Complainant is a legal entity (joint – stock company) with its registered office in Lázně Bohdaneč, Na Lužici 659, district Pardubice, PSČ 533 41, Czech Republic, incorporated in the Commercial Register, Section B, inlay 191 at the Regional Court in Hradec Králové. The subject of its business activity is undertaking in the area of the waste disposal, purchase of goods for purpose of sale, manufacture of products made from plastic, completion of manufacturing equipment for recycling plastic waste and accommodation services.

The main subject of the business activity of the Complainant is the transformation of waste plastic material into new useful products and materials.The Complainant is inter alia a holder of a trademark “transform” for this purpose, which was internationally registered with the Czech Patent and Trademark Office under the Number 225656 on 21 July 2000, with priority of the filing date, i.e. of 13 May 1999.
This trademark is a “prior right” pursuant to the Art. 10. Section 1 of the Regulation (EC) No. 874/2004. Pursuant to Section 2 letter a) of the Trademark Act No. 441/2003 Coll. (formerly Act No. 137/1995 Coll.), which says, that “On the territory of the Czech Republic the trademarks registered in the register of the trademarks with the Czech Patent and Trademark Office enjoy protection”, it is also a right established by the national law of a Member State of the Community.

Invoking the trademark “transform”, which is registered with the Czech Patent and Trademark Office, the Complainant filed by means of the Registrar INTERNET CZ, a.s. on 12 January 2006 at 10:40:30 an application for the registration of the domain name “transform.eu” with the Respondent during the first stage of the sunrise period. The Complainant holds rank 1 on the waiting list of the Respondent.

In the course of transferring data a typing error in the name of the Applicant occurred and the name TRANFORM a.s. instead of the right name TRANSFORM a.s. was inserted into the database under the information concerning him. Other data were not changed. It was not possible to figure out this error from the attached correspondence, consequently it was not possible to advise the Complainant of it. Conversely, the Respondent could have realised it from the address, from which the correspondence was sent, including hardcopy materials and from the address of the Applicant, on which he sent his correspondence. On 14 July 2006 the Complainant was notified by the Respondent that his Application had been disqualified on the ground of that “documentary evidence we had received, does not sufficiently prove the ownership following which the domain name is applied for”.

A. COMPLAINANT

The holder of the trademark “transform” and the Applicant was the Company “TRANSFORM a.s.” as results from the documents set out under the No. 1,2 a 3. The identity of the Applicant results also from the identity of the registered office (Lázně Bohdaneč), address (533

41 Lázně Bohdaneč, Na Lužici 659, Czech Republic) and the contact person (Jan Mec). No legal entity or no natural runs a business under the name TRANFORM in the Czech Republic (it can be verified on the portal of the Ministry of Justice of the Czech Republic www.justice.cz). Following the above mentioned the Complainant believes that the Respondent has breached the provision of Art. 10 Subsection 1, and Art. 14 Subsection 10 of the Regulation (EC) No. 874/2004 as the Complainant holds a "prior right" as defined under Art. 10 Subsection 1 of the Regulation (EC) No. 874/2004 and despite that his Application has not been complied with even if he had applied for the registration of this domain name on time and as the first.

Complainant additionally states that he Response that was published on page ADR.eu not until 2 October 2006, whereas the Complaint was published already 24 July 2006, was made evidently late and contrary to provision of B3a ADR Rules. Therefore, Panel should proceed in terms of B3g (last sentence) and decide the dispute entirely on the basis of Complaint.

The Response of the Respondent insists only on one argument that is based on fact, that on the first line of letter to PricewaterhouseCoopers of 20 January 2006 (Documentary evidence TRANSFORM), submitted to him as evidence, a nonexistent "subject" TRANFORM a.s. was stated by mistake as the applicant. But exactly from this document it is clear that the applicant that made the application is the same person as the Complainant TRANSFORM a.s. LÁZNĚ BOHDANEČ because it was him who really made this written submission as results from the signature and identification of the signing person. The validation agent didn't have to make any other investigation in order to find out who the correct applicant is because in case of any doubts, who's making any written submission, every world law system concludes that the person that is signed under this written submission is the same one that made it. The fact, that the applicant is a subject competent to use the trademark in question, was also supported by fact that the applicant attached a print of this trademark (identical stamp) that's written „Transform a.s. Lázně Bohdaneč" to the signature. Identity of both subjects (real applicant and holder of the trademark) was unambiguously proved.
We assume that conclusions cannot be drawn only from typing error done in some line of the application if the correct data is unambiguously clear from its end.

In many other ADR.eu proceedings the decision like this was taken, such as OSCAR – 00181, DMC 00396, CITY, KICKBOXING, CRAWLER, BLUE 00229.

Complainant assume that the provision of Article 10 Section 1 and Article 14 Section 10 of the Regulation 874/2004 was breached because the Complainant owned a prior right as defined under Article 10 Section 1 of the Regulation 874/2004 however, his application was rejected even he applied for registration of this domain name in time and as the first one. The appropriate provisions order that domain name should be registered to the applicant – hence to the real applicant that made the application and signed it, not to the nonexistent organisation that was stated in form by mistake. The real applicant was stated in the application in the right form and his identity was recognisable for the Registry.

Complaiant request that the decision of the Respondent, of which he was notified on 14 January 2006, be revoked following the evident mistake (typing error) and the domain name "transform.eu" be registered in favour of the Complainant, i.e. TRANSFORM a.s. Lázně Bohdaneč

B. RESPONDENT

TRANFORM A.S. (hereafter "the Applicant") applied for the domain name TRANSFORM on 12 January 2006. The validation agent received the documentary evidence on 26 January 2006, which was before the 21 February 2006 deadline.
The documentary evidence submitted by the Complainant consisted of a trademark certificate demonstrating that the Czech trademark TRANSFORM had been registered by the company TRANSFORM A.S. LAZNE BOHDANEC.
As the Applicant TRANFORM A.S. did not submit documentary evidence substantiating that it is the same entity or legal successor of TRANSFORM A.S. LAZNE BOHDANEC, the validation agent concluded that the Applicant did not demonstrate that it was the holder or the licensee of a prior right on the name TRANSFORM. The Respondent agreed with the validation agent and rejected the Complainant's application.
The domain name application was made in the name of the Applicant, TRANFORM A.S., and not in the name of the Complainant, TRANSFORM A.S. LAZNE BOHDANEC, RABAN. It must therefore be examined whether the Respondent was right to consider that the Applicant did not have any prior rights in the TRANSFORM name.
The burden of proof is with the Applicant to demonstrate that it is the holder or the licensee of a prior right
It is obvious that the names of the Applicant and the owner of the trademark are different.
- the Applicant's name is TRANFORM A.S.;
- the name of the trademark owner is TRANSFORM A.S. LAZNE BOHDANEC.
In the present case, the documentary evidence did not contain any document explaining the difference between the names of the Applicant and the owner of the trademark relied upon in the application.
Insofar relevant, it is not true that the difference between both names is solely due to a minor spelling mistake:

- only two out of four parts of the name of the trademark owner is reflected in the name of the Applicant (TRANFORM A.S. v. TRANSFORM A.S. LAZNE BOHDANEC);
- moreover, the corresponding parts are spelled differently: TRANFORM v. TRANSFORM.
The validation agent and the Respondent were therefore confronted with an application in which the Applicant and the owner of the trademark had substantially differing company names. The Respondent had thus no right (and a fortiori no obligation) to speculate on the relationship between the Applicant and the owner of the trademark, and therefore correctly rejected the Applicant's application.
The Regulation and the Sunrise Rules give the holders of prior rights the opportunity to demonstrate their prior rights during the phased registration, which is an exception to the basic principle of first-come first-served.
In order to benefit from this opportunity to demonstrate its prior rights, the applicant must comply with the strict procedure laid out by the Regulation for dealing with the thousands of applications received during the phased registration and making sure that these applications are substantiated. The Respondent falos the Panel attention to the following ADR decisions which support his opinion: GBG 1886, AHOLD 810, BEEP 894, APONET 1242, VIVENDI 551, PLANETINTERNET 1627, TELEDRIVE 1625
The Applicant in the present case did not seize this opportunity, because its application did not correctly fulfil the substantial requirements.
For these reasons, the Complaint must be rejected.

DISCUSSION AND FINDINGS

I. Late response
Under Paragraph B 2(a) of the ADR Rules, the Czech Arbitration Court shall forward the Complaint, if administratively compliant, to the Respondent in the manner prescribed by Paragraph A2 (a).

Paragraph A 2(a) states that it is the responsibility of the Czech Arbitration Court to employ reasonably available means so as notify the Respondent (i.e., serve actual notice).

Paragraph A 2 (b) provides for which ways the Czech Arbitration Court shall discharge its obligation to achieve actual notice to the Respondent:

A 2 (b) (i) by sending the Complaint, or a notice with information on how to access the Complaint (e.g. for the purposes of an on-line platform operated by the Czech Arbitration Court), to the Respondent employing the means stipulated in (c), below, to the Registry’s seat (hereinafter referred to as EURid);

A 2 (b) (ii) in case the Respondent does not confirm receiving the electronic communication made pursuant to (i) above within five (5) days from sending the communication, then it is to forward the Complaint by registered postal or courier service, postage pre-paid, and return receipt requested.

Paragraph A 2 (e) then provides: Except as otherwise provided in these ADR Rules, all communication provided for under the ADR Rules shall be deemed to have been received, in accordance with this provision:

A 2 (e) (3) if by registered postal or courier service, on the date marked on the receipt, or, if it is not possible to deliver the communication in this way, on the expiry of twelve (12) days from the hand over of the communication to a postal or courier service provider.

The Respondent is obliged, under the Paragraph B 3 (a), to submit the Response within thirty (30) working days of the date of delivery of the Complaint, in accordance with Paragraph A 2 (b).

As flows from the above-stated provisions, if the Respondent failed to confirm the electronic communication made pursuant to A 2 (b) (i) within five (5) days, the Czech Arbitration Court forwards the Complaint by registered postal or courier service. Provided the delivery is not possible to prove according to the date marked on the receipt (and this is quite frequently the case because the receipt is not returned to the Czech Arbitration Court at all), then the effective date of delivery for the Complaint to the Respondent is the twelfth (12th) day from the hand over of the communication (containing the Complaint) to the postal or courier service provider. The Period for submitting the Response then starts on the thirteenth day from the hand over the communication, and the total term for submitting the Response is seventeen (17) (5 + 12) days, at best, plus thirty (30) working days.

As to EURid, EURid communicates with the Czech Arbitration Court during ADR Proceedings electronically, via the on-line platform. In order to clarify the time periods for multiple Responses from EURid, the Czech Arbitration Court and EURid agreed on the following understanding of the time periods as applicable to EURid: if EURid is a Respondent, the period of thirty (30) working days for submitting the Response begins after the term of five (5) days from the date of notification of the commencement of the respective ADR

Proceeding in which EURid can access the Complaint on the on-line platform, as any other Respondent. Nevertheless, the additional period of 12 days for the assumption of delivery to EURid does not apply even if EURid does not access the Complaint on the on-line platform. This is because EURid is always aware of every Complaint because it is requested by the Czech Arbitration Court to verify the information contained in every Complaint.
As a general rule, if the termination of a term falls on a holiday, then the term does not end before the end of the next working day following the holiday.

Therefore, with respect to the case No. 2470, the period of thirty (30) working days, within which EURid is obliged to submit its Response, started on 22nd August 2006 and ended on 2nd October 2006 (there was no holiday in this time in Belgium). The electronic version of the Response was delivered on the on-line platform on 2nd October 2006; therefore, EURid is not delinquent with respect to the submitting its Response to case No 2470.

II. Rejection of the Application
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 recognised 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.

Pursuant to article 14 of the Regulation, the applicant must 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.

Article 20.3. of the Sunrise Rules states that in case the documentary evidence provided does not clearly indicate the name of the applicant as being the holder or the licensee of the prior right claimed, the applicant must submit documents substantiating that it is the same person as or the legal successor to the person or company indicated in the documentary evidence.

Article 10 (1) of the Regulation states that only the holders of prior rights shall be eligible to register domain names during the period of phased registration.

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".

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:
"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".

- In case „OSCAR“ – 00181 in which the applicant also stated an incomplete identification of his company Panel decided in favour of the applicant with the following reasoning:
„ Contrary to the Respondent’s submission, the Complainant’s argument that the identity of the addresses in the application and in the documentary evidence and the similarity in the names of the applicant nad of the trademark owner make the name recognisable is very relevant.
These facts that demonstrate that the Complainant was the applicant during the phased registration period and that the Complainant is the owner of the Prior Right on which the application is based. The intended purpose of the phased registration period as set out in Recital 12 of said Regulation 874/2004 was „to safeguard prior rights recognised by Community or national law“.

- In case „DMC“ – 00232 in which the applicant incorrectly filled in his own identification in the stated line the Panel decided that the rejected application should be revoked

- In case „CAPRI“ – 00396, in which contrary to the foregoing cases, both the whole identification of the right name of the applicant

(holder of the trademark) and address of the applicant were incorrectly filled in. The Panelists come to the basic conclusion that the technical error cannot be reason for rejecting to provide protection to prior rights:
„ The Panel/the Panelist therefore came to the following conlusion:
- The Panel/ the Panelist is of the opinion that the justice shall always rule over the formalistic approach and technical means of communication.
- The complainant has finally proven that he is and was before filing the .eu domain name application an owner of the relevant Community trademark CAPRI, No. 000276113, he therefore properly claimed his prior right for the relevant .eu domain name.
- it has to be stated that the complainant has made many mistakes in its application which were very confusing and could have let the registry to believe that the complainant has not proven its right.
- The registry had, however, all possible means and rights to validate properly the prior rights. The registry is not only allowed but even obliged to obey all respective relevant regulations and obligations from these regulations to provide fair and complete validation process. The registry could have done the same validation process s the Panel/the Panelist did which would allow the registry to review more deeply the application and easily remove all relevant discrepancies in the .eu domain name application.
- There are many technical issues which do not give the applicants appropriate possibilities and space to fill fully and withnout any mistakes the applications. The technique can not be an obstacle to register properly the .eu domain name and grant the priority rights.“

-In case „CITY, KICKBOXING, CRAWLER, BLUE“ – 00229 in which the applicant by mistake filled in incorrectly not only the identification of its company but also the identification of the trademark:
„The fact an applicant may have filled in the „Prior right on“ field in an electronic form with the name of the applicant organisation and not with the name of the prior right (trademark) would not lead to a conflict with the above mentioned Regulations. Infact in the substantive documentation submitted during the validation process the name of trademark for which the prior right exists and for which the identical domain name is applied for is mentioned.“

-In case GBG 01886 the Panel decided:
"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".

- In case AHOLD. 000810 , the Panel decided that :
"As confirmed by sec. 20 of SR, it is important to make sure that the applicant is the same holder of the prior rights, to avoid any domain name registration deprived of legitimation on the applicant’s side. As a result, when faced before a difference between the applicant name and the prior right holder name, correctly detected by the Validation Agent, the Registry may not accept the corresponding domain name application".

- In case BEEP 00 894 the Panel decided that:
"Therefore, where the Prior Right claimed is a trademark, the burden of proof regarding ownership and license declaration is placed on the Applicant (Complainant) of the domain name. EURid and the validation agent have to rely upon the documentary evidence submitted by the Applicant and from the submitted evidence in the present case, it was clear that the Applicant of the domain name <beep.eu> was not the same company as the owner of the trademark BEEP. Thus, the Complainant failed to submit the relevant evidence regarding the license declaration within the forty day period set out in Article 14".

- In case APONET 0 1242, the Panel decided that:
"Therefore, in the absence of any document clearly indicating that a) VGDA Gmbh was the short term for Verwaltungsgesellschaft Deutscher Apotheker mbH; b) that VGDA was also an official company name of the Applicant; and c) considering the Complainant’s burden of proof with respect to its prior rights and wording of relevant provisions governing registration of .eu domain names in Sunrise Period, the Panel concludes that the Respondent, without having at its disposal any pertinent document proving that VGDA Gmbh and Verwaltungsgesellschaft Deutscher Apotheker mbH were the same entity, did not err in its decision to reject the Complainant's application. On the contrary, this Panel considers that EURid, in accordance with, Paragraph 3. Section 11 of the Sunrise Rules, correctly considered the Applicant as a different entity from the holder of the Prior Right claimed".

- In case VIVENDI 551 , the Panel decided that:
"The documentary evidence provided by the Complainant shows that the owner of the trademark, on the basis of which the prior right to the Domain Name was asserted, is the company Vivendi, and not the Complainant (“Vivendi Universal”). The Complainant did not provide any proof within the documentary evidence which would explain that Vivendi Universal is a legal successor (as a result of a merger or otherwise) of the company Vivendi, which was (at the time of filing of the Application) a registered holder of the Trademark. Therefore, a conclusion must be drawn that the Complainant failed to demonstrate its prior right to the Domain Name".

- In case PLANETINTERNET 01627 , the Panel decided that:
"The validation agent conducted a prima facie review of the submitted document, and in conjunction with point (ii) below, reached the conclusion that as the names did not match, and there was no other documentary evidence to explain such a discrepancy, that the applicant (i.e. the Complainant) had not established its prior right".

- In case TELEDRIVE 0162), the Panel decided that:
"Moreover, when examining an application for a domain name, the Registry's obligation is to examine whether the applicant holds a prior right to the domain name (Article 14 of the Regulation). The right must be verifiable by the presented documentary evidence. This shall demonstrate that the right exists and that the applicant is the holder of this right claimed on the domain name. In the presented case the documentary evidence submitted by the Complainant showed that the IAV GmbH Ingenieurgesellschaft Auto und Verkehr, and not the iav GmbH is the holder of the trade mark TELEDRIVE. Therefore, the documentary evidence in support of the application for the domain name teledrive.eu was incomplete".

In this case the Complainant used the argumentation that technical and formal aspects should not prevail and overrule the justice, while the Respondent strictly insisted on fulfiling the rules formally stating, that i fany information in the systém is stated incorrectly, the evidence is incomplete and therefore enough reason to reject the application.

The Panel had taken into consideration all rules and relevant ADR decisions and came to the conclusion that the intention of Rules and prefferred intrpretation should be teleological or purposive interpretation and not formal interpretation. The panel came to the conclusion that:

- it was clear from the application who is the Applicant and that the wrongly typed name is a merely technical error. All other information was correct and identified the Applicant without any doubt and without any need of a complicated verification by the Respondent .The Respondent is not only allowed but even obliged to obey all respective relevant regulations and obligations from these regulations to provide fair and complete validation process.
- it is regrettable that the complainant has made a mistake in its application which might be confusing and could have let the Respondent to believe that the complainant has not proven its right.
- - there are many technical issues which do not give the applicants appropriate possibilities and space to fill fully and withnout any mistakes the applications. The technique can not be an obstacle to register properly the .eu domain name and grant the priority rights.
- The law and the justice shall always rule over the formalistic approach and technical means of communication.

In the circumstances this Panel is satisfied that on the particular facts of this case, a teleological or purposive interpretation of the legislation would classify the problem met by the Complainant in this case as being technical and not legal. The Complainant complied with both the Regulation and the Sunrise Rules .

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 TRANSFORM be transferred to the Complainant

PANELISTS

Name	Martin Maisner

DATE OF PANEL DECISION 2006-11-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Complainant applied for the registration of the domain name.eu, to the name, where he had "prior right" as suggested by the Rules.
In the course of transferring data a typing error in the name of the Applicant occurred and the name TRANFORM a.s. instead of the right name TRANSFORM a.s. was inserted into the database under the information concerning him. Other data were not changed.
Complainant was notified by the Respondent that his Application had been disqualified on the ground of that "documentary evidence we had received, does not sufficiently prove the ownership following which the domain name is applied for".

In the circumstances this Panel is satisfied that on the particular facts of this case, a teleological or purposive interpretation of the legislation would classify the problem met by the Complainant in this case as being technical and not legal. The Complainant complied with both the Regulation and the Sunrise Rules .
The decision of the Respondent was therefore anulled and the domain name transferred to the Complainant