Panel Decision for dispute CAC-ADREU-002621

Case number	**CAC-ADREU-002621**
Time of filing	**2006-08-04 14:45:22**
Domain names	**motorland.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**HBO SystemCenter GmbH & Co KG, Michael Hahnemann**

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 called “HBO SystemCenter GmbH & Co KG”.

This is the name of Complainant since March 2006.

Before that date, the name of the Complainant was “H.B.O. Einkauf und Marketing GmbH & Co”

Previously, the name of the Complainant was still different: “H.B.O. Einkauf-GmbH & Co KG”.

The Complainant is the owner of a community trademark “Motorland” registered since 1998. At the time of the registration, the name of the company was the third one mentioned here above: “H.B.O. Einkauf-GmbH & Co KG”.

In July 2006, due to the change of its name, the Complainant filed an application with the OHIM to have the database updated. It has been done in July 2006.

The application for motorland.eu was made in the name of:

H.B.O. Einkauf und Marketing GmbH & Co
Industriestr. 8
26160 Bad Zwischenahn
Germany

It has been received on 07/12/2005 11:34:40.467, i.e. during the Sunrise 1 period and it is based on the motorland trademark, and ranked # 1 by the Registry’s system.

The Documentary Evidence has been provided in time; it comprises the following documents:

- the standard cover letter

- a copy of the certificate of registration for the CTM 000167585 MOTORLAND, in the name of “H.B.O. Einkauf-GmbH & Co KG”,

Dietrichsweg, 64, 26127 Oldenbourg, Germany.

A. COMPLAINANT

Complainant changed its arguments during the ADR. This is not detrimental to the Complainant's situation since it explains that it is due to the fact that (1) the rejection letter sent by Eurid is not motivated and it was therefore difficult for the Complainant to understand the origin of the problem, and (2) the Complainant has no copy of its application and documentary evidence and is therefore unsure about the information that was provided to the Registry.

In its complaint, the Complainant assumes that comparing the information in the OHIM database and the information in the whois.eu database, "the reason for the rejection seems to be the following: While the company trade name correspond in both documents the addresses do not. The address in the OHIM database in Annex 4 is an outdated address ("Dietrichsweg 64, 26127 Oldenburg") while the address submitted to EURID and shown in the whois.eu database in Annex 3 is the accurate one ("Industriestraße 8, 26160 Bad Zwischenahn")."

If this was the reason for refusal of its application, Complainant contends that "The inaccuracy of the address is a minor mistake which does not constitute a material inaccuracy according to Commission Regulation (EC) No. 874/2004 – see e.g. cases 00396 (CAPRI), 01077 (EURACTIV), 01047 (FESTOOL). Under the said regulation the Respondent was therefore not allowed to reject the application of the Complainant".

In the course of the ADR, after disclosure of the documentary evidence by the Registry, it appears that not only the addresses were different, but also the names : while the application is made by H.B.O. Einkauf und Marketing GmbH & Co, it appears from the documentary evidence that the trademark holder is "H.B.O. Einkauf-GmbH & Co KG".

The Complainant issued a non standard communication to explain that, in its view, "While it is obvious that the names are not identical it is also obvious on the basis of a prima facie review that there is a link between the two and that there must be a simple explanation for the difference. If EURID - through its Validation Agent - had crosschecked the applicants name with the OHIM online-database - just by simply typing the trade mark number - it would have become clear within thirty seconds that the applicant is the owner of the trade mark "MOTORLAND". The Validation Agent would have got the result as shown in Annex 4 which shows "H.B.O. Einkauf und Marketing GmbH & Co" as the owner of the trade mark as it is mentioned on the cover sheet of the documentary evidence".

In the same communication, the Complainant also states that "The five minutes the undersigned representative spent with the EURID agent on the phone-hotline to find out why the application was rejected was about ten times more time consuming for EURID than a quick OHIM database research would have been. Therefore the Validation Agent took an inefficient decision, which means that he used his discretion unreasonably and therefore in a discriminatory way".

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 the 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 was in the name of a different company than the name mentioned in the application for the domain name.

Respondent stress that it is obvious that the names were different, 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 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

Although the Panel shares Respondent’s view concerning the burden of the proof which is clearly on the Applicant’s side, as well as the fact that the ADR is not a second chance to correct deficiencies in the initial application, the Panel can’t support the view of the Respondent when it describes a system where, due to a strict application of the burden of the proof and a weak application of the other provisions of the Regulations, the assessment duty of the Registry is an empty shell that would justify a fully automated and clerical system.

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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 is of the opinion that current legal rules governing the registration process of EU domain names contain sound provisions, which create a balanced situation between the obligations of the applicant and those of the Registry.

Reference is made, on the one side and among others, to the burden of the proof which is clearly on the Applicant’s side, as well as to the fact that the ADR is not a second chance to correct deficiencies in the initial application.

Reference is made, on the other side and 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.

But the Panel also appreciates the respective legal provisions cited above which put the Respondent under a 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.

Without prejudice to the obligations of the applicant, it is clear in the Panel view that these obligations to examine and assess are clearly in conflict with the absolute idea of an uncompromised automated process or a disproportionate formalistic approach.

Also, the Regulation created a thorough legal scheme for ADR. Where would be the sense of this if the Panel was only supposed to verify that a clerical system based on a strict formalistic approach was applied? There was no need for hiring dozens of prominent lawyers and university teachers for such verification, or to develop a comprehensive set of procedure rules. On the contrary, as ruled in CRUX, the Panel received the power, under the ADR, to 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.

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Bearing this in mind, it is time to come back to the facts of the case, in order to examine if, based on the documentary evidence provided to the verification agent, the Registry correctly assessed the situation.

As a matter of fact, the Applicant did not exactly match the prior right holder.

Contrary to what Complainant stated in its complaint, not only the addresses were different, but also the names of the companies.

Is this 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 and to close the case?

In the Panel view, the answer is yes.

Facts are as such:

- The name of the Applicant and the name of the CTM holder are similar but still quite different: "H.B.O. Einkauf und Marketing GmbH & Co" on the one side, and "H.B.O. Einkauf-GmbH & Co KG";

- This difference in the names is even more confusing since the addresses of both companies are very different: not only the streets but also the town are different;

- The domain name doesn't reproduce the trademark. In fact, the trademark has nothing to do with the names of the companies. Of course, this is very frequent and not problematic at all, but the least that can be said is that it is not easy for a verification agent to draw a line that could link together two different names, two different addresses, and a trademark that is completely different (compare, on this issue, with the situation in GEHL (ADR 2385)) ;

The Panel is not convinced by the argument of the Complainant stating that the verification agent was supposed to check online in the OHIM database in order to correct the applicant's deficiencies. Pursuant to the burden of the proof principle, it was to the applicant to prepare its case carefully, to detect the names and addresses problem, to draw the Registry/verification agent's attention on this issue and to provide reliable information for those differences. When it comes to the protection of the Complainant's right, the latter can't expect the Registry to be more careful than it was itself.

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	**Paul Van Den Bulck**

DATE OF PANEL DECISION 2006-11-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Although the Panel shares Respondent's view concerning the burden of the proof which is clearly on the Applicant's side, as well as the fact that the ADR is not a second chance to correct deficiencies in the initial application, the Panel can't support the view of the Respondent when it describes a system where, due to a strict application of the burden of the proof and a weak application of the other provisions of the Regulations, the assessment duty of the Registry is an empty shell that would justify a fully automated and clerical system.

Bearing this in mind, the Panel underlines that as a matter of fact, the Applicant did not exactly match the prior right holder. Contrary to what Complainant stated in its complaint, not only the addresses were different, but also the names of the companies.

Is this 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 and to close the case? In the Panel view, after assessing all the relevant facts of the case, the answer is yes.