Panel Decision for dispute CAC-ADREU-002702

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Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	ESSILOR INTERNATIONAL, ogerg

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 of the parties provided information about other legal proceedings which relate to the disputed domain name.

FACTUAL BACKGROUND

Essilor International, ogerg (hereafter “the Complainant”) has requested the annulment of the decision made by the Respondent, EURid, regarding the domain name “VARILUX”.

The domain name “VARILUX” was applied for in the name of Essilor International on 7 December 2005, i.e. at the beginning of the phased registration or the so-called Sunrise Period.

The application was based on the following prior right: the French verbal trademark VARILUX, filed on 29 July 1983, registered under the trademark number 158.110 for products or services of class 9 and recently renewed under the number 1247541. The proprietor of the trademark VARILUX is, according to the renewal certificate, Essilor International Compagnie Générale d’Optique Société Anonyme.

Because the documentary evidence stated that the trademark was registered in the name of Essilor International Compagnie Générale d’Optique, whereas the Complainant’s name, as given on the domain name application form, is Essilor International, EURid rejected the Complainant’s application on 28 June 2006.

A. COMPLAINANT

1. The Complainant argues that the letter by the French Trademark Office contained an error. In lieu of « Essilor International Compagnie Générale d’Optique », the letter should have stated that the proprietor of the VARILUX trademark was « Essilor International (Compagnie Générale d'Optique) ».

The Complainant argues that the trademark was originally registered in the name of “Essilor International (Compagnie Générale d'Optique)”, with the French Trademark Office having forgotten to use the (and the) symbols in its letter confirming the renewal of the trademark.

In support of this argument, the Complainant submits in the ADR proceedings a copy of the original certificates from the French Trademark Office for the trademark VARILUX. These certificates show that the mark was initially applied for and registered by « Essilor International (Compagnie Générale d'Optique) » with the (and the) symbols.

The Complainant argues that “Essilor International (Compagnie Générale d'Optique)” and “Essilor International Compagnie Générale d'Optique” are one and the same.

2. The Complainant further argues that EURid rejected its application for the varilux.eu domain name because the documentary evidence submitted was neither a copy of the trademark registration nor an extract of an official database from the Trademark Register.

According to the Complainant, the submitted renewal certificate of the French Trademark Office INPI constituted sufficient evidence of its prior right.

3. For these reasons, the Complainant requests the Panel to annul the Respondent's decision.

B. RESPONDENT

The documentary evidence did not demonstrate that the Complainant was the holder of a prior right.

The Complainant's name is:

ESSILOR INTERNATIONAL

whereas the name of the holder of the prior right, as mentioned in the documentary evidence, is:

ESSILOR INTERNATIONAL COMPAGNIE GENERALE D'OPTIQUE.

The Complainant failed to explain this difference in the names. Without any further explanation in the documentary evidence, the Respondent was in no position to determine whether the Complainant was entitled to rely on the claimed trademark. Therefore, the documentary evidence did not demonstrate that the Complainant was the holder of a prior right.

The Respondent refers to several ADR decisions in which it was held that when the applicant' name in the domain name application differs from the applicant's name in the documentary evidence, the applicant does not meet the burden of proof as set out in the Regulation EC/874/2004 and the Registry must reject the application (cfr. ADR case n° 1886, GBG, ADR case n° 1242, APONET, ADR case n° 294, COLT and ADR case n° 810, AHOLD).

With regard to the Complainant's argument that the French Trademark Office mistakenly failed to include the (and the) symbols in the trademark renewal certificate, the Respondent notes that the mere fact that those symbols were not included does not explain why the name of the Complainant and the name of the holder of the prior right are different as there are still three words missing: Compagnie Générale d'Optique. Such difference is more than trivial.

According to the Respondent, the Respondent and the Validation agent were under no obligation to investigate into the circumstance of the application. Under Article 21 (3) of the Sunrise Rules, the validation agent is permitted in its sole discretion, to conduct its own investigations, but he is not obliged to do so. The Respondent refers to several ADR decisions including ADR case n° 2150, DUTCHORIGINALS and ADR case n° 1695, VANDIJK.

DISCUSSION AND FINDINGS

1. In its complaint, the Complainant writes that it elects to have the decision rendered by a three member Panel, but the Complainant has not checked the appropriate tick box in the Complaint forms and has not paid the fees for a three member Panel. Therefore, this single member Panel will decide the Complaint.

2. Article 10.1 of the Regulation EC/874/2004 provides that the holders of prior rights recognized or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts. Prior rights shall be understood to include registered national trademarks.

Article 14 of the Regulation EC/874/2004 provides that all claims for prior rights must be verifiable by documentary evidence, which demonstrates the right under the law by virtue of which it exists. Article 14 adds 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." The same article also provides that the validation agent shall examine whether the applicant has prior rights on the name.

Article 20 of the .eu Sunrise Rules provides that, if the documentary evidence provided does not clearly indicate the name of the applicant as being the holder of the prior right claimed, 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.

3. The prior right on which the application for the domain name VARILUX.EU is based, is the French registered trademark VARILUX, which is prior right recognized by the Regulation EC/874/2004. The proprietor of this prior right is:

ESSILOR INTERNATIONAL COMPAGNIE GENERALE D'OPTIQUE.

The applicant and the Complainant, however, is ESSILOR INTERNATIONAL, which may or which may not be the same legal entity.

Because the documentary evidence did not allow concluding that the applicant and the holder of the prior right were one and the same, the Respondent EURid rejected the application. This rejection was not based on the issue as to whether the name of the applicant was ESSILOR INTERNATIONAL COMPAGNIE GENERALE D'OPTIQUE (without the (and the) symbols) or

ESSILOR INTERNATIONAL (COMPAGNIE GENERALE D'OPTIQUE) (with the (and the) symbols).

The rejection was based on the difference with the applicant's name, which was merely ESSILOR INTERNATIONAL, without the words COMPAGNIE GENERALE D'OPTIQUE.

Because of this difference, the Respondent could not know whether the applicant and the holder of the prior right were one and the same and the Respondent therefore correctly rejected the application for the VARILUX.EU domain name of the Complainant.

4. The intention behind the Commission Regulation EC/733/2002 on the implementation of the .eu Top Level Domain, the Regulation EC/874/2004 and the Sunrise Rules laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration, as is evident from the recitals of the said regulations, has been to allow holders of legitimate and genuine prior rights to register domain names which correspond to their proprietary rights.

This opportunity to demonstrate their prior rights during the phased registration 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 Complainant in the present case did not seize this opportunity, because its application did not correctly fulfil the substantial requirements. Neither explanation for the difference in the names of the applicant and the holder of the prior right, nor any documentary evidence of the two entities being one and the same was put forward within the allotted time period.

During the Sunrise Period, the principle "first-come, first-served" is more properly described as "first-come-and-substantiate, first-served" (see ADR case n° 119, NAGEL). In other words, during the Sunrise Period, the first applicant in the line does not have an unconditional right to the domain name, but only has an opportunity to clearly demonstrate that it is the holder of a prior right.

As the panel clearly summed up in the ADR case n° 1886 (GBG), "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".

The documentary evidence did not demonstrate that the Complainant was the holder of a prior right.

5. Moreover, the Respondent was under no obligation to investigate the circumstances of the application by the Complainant. Article 21.3. of the Sunrise Rules states that "The Validation Agent is not obliged, but it is permitted in its sole discretion, to conduct its own investigations into the circumstances of the Application, the Prior Right claimed and the Documentary Evidence produced".

Article 21.3 of the Sunrise Rules does not impose any obligation for the Validation Agent to conduct its own investigation: it is a mere possibility that he can use "in its sole discretion". This is supported by the consideration that the Regulation EC/874/2004 places the burden of proof on the applicant to show that it is the holder of a prior right.

In the ADR case n° 2150, DUTCHORIGINALS, where the difference was between "B.V. Meubelfabreik Gebroeders van der Stroom te Culemborg" and "Gebroeders van der Stroom B.V.", the Panel stated that:

"However, there is an even more fundamental objection to the Complainant's contention. That is that the contention precedes on the assumption that EURid or the Validation Agent is somehow obliged to "put some effort in establishing if the applicant of a domain name and the holder of the prior right are one and the same if - as in this case - the identifiers of the applicant and holder of the prior right are not identical". I do not think that this is correct. Nothing in the Regulation requires EURid or the Validation Agent to perform such enquiries and indeed any such requirement to make the applicant's case would be hard to square with the fact that under Article 14 it is the applicant that bears the burden of proof".

The Panel refers in this respect also to the ADR case n° 1695, VANDIJK, with regard to the practical reasons behind the strictly legal reasons.

6. Based on the foregoing, the Panel finds that the decision made by the Respondent to reject the application for the domain name VARILUX was justified and therefore rejects the present Complaint.

The Panel refers to the following cases which support its opinion:

- ADR case n° 1242, APONET, where the applicant incorrectly used a short name (VGDA) instead of its real name (Verwaltungsgesellschaft Deutscher Apotheker). The Panel clearly stated 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";

- ADR case n° 810, AHOLD, where the difference in name was between "Koninklijke Ahold BV" and "Ahold BV" and where the Panel decided :

"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".

- ADR case n° 1625, TELEDRIVE, where the applicant incorrectly used its short name (IAV GmbH) instead of its real name (IAV GmbH Ingenieurgesellschaft Auto und Verkehr) and where the Panel decided:

"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".

- ADR case n° 2211, IMAGE, where the difference in name was between "Image ICT" and "Image Information & Communication Technology" and where the Panel stated :

"In particular, the name and address of the applicant, as appearing in the application form, did not match with the name and address of the holder of the Benelux trademark number 0774050. In this Panel point of view, such formal deficiencies are more than trivial (as contended by the Complainant) and, moreover, this Panel considers that the analysis of the information contained in the Submitted Documentation does not allow per se the clearance of such deficiencies. In particular, such information does not allow the validation agent to conclude that the term "Image ICT" is only the abbreviation of "Image Information & Communication Technology V.O.F." "

7. Finally, because the Complaint is denied for the reasons set out above, the Panel does not have to examine whether the second argument used by the Respondent EURid to reject the application for the domain name was justified. This argument regards the question whether the documentary evidence submitted was valid (according to the Respondent it was not, because it was neither a copy of the trademark registration nor an extract of an official database from the Trademark Register).

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	Tom Joris Jan Heremans

DATE OF PANEL DECISION 2006-11-13

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Essilor International, ogerg (hereafter “the Complainant”) has requested the annulment of the decision made by the Respondent, EURid, regarding the domain name “VARILUX”.

The domain name “VARILUX” was applied for in the name of Essilor International on 7 December 2005. The application was based on the French verbal trademark VARILUX, owned by Essilor International Compagnie Générale d’Optique Société Anonyme.

Because the documentary evidence stated that the trademark was registered in the name of Essilor International Compagnie Générale d’Optique and/or in the name of Essilor International (Compagnie Générale d’Optique), whereas the Complainant’s name, as given on the domain name application form, is Essilor International, EURid correctly rejected the Complainant’s application.

The documentary evidence did indeed not demonstrate that the Complainant was the holder of a prior right. The Complainant failed to explain this difference in the names. Without any further explanation in the documentary evidence, the Respondent was in no position to determine whether the Complainant was entitled to rely on the claimed trademark.

With regard to the Complainant's argument that the French Trademark Office mistakenly failed to include the (and the) symbols in the trademark renewal certificate, the mere fact that those symbols were not included, does not explain why the name of the Complainant and the name of the holder of the prior right are different as there are still three words missing: Compagnie Générale d'Optique. Such difference is more than trivial.

The complaint is denied