Sentence arbitrale for dispute CAC-ADREU-002782

Case number	CAC-ADREU-002782
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Domain names	desa.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	DESIGN SYSTEMS, William GRUET

Respondent

Organization / Name	EURid

AUTRES PROCÉDURES JURIDIQUES

The Panel is not aware of any other legal proceedings, which are pending or decided and relate to the disputed domain name

SITUATION DE FAIT

On December 4, 2005, Desa applied for the registration of the domain name DESA.EU. The documentary evidence in support of the application was filed within the deadline of Janvier 16, 2006, i.e., on January 12 2006. The Applicant supplied as documentary evidence a form (so-called fiche marque) of the French Trademark Office (INPI) referring to the French trademark registration No. 3143612 granted on June 28, 2002..

Eurid rejected the domain name application on the grounds that the domain name applied for did not consist of the complete name of the earlier right upon which the application was based . The French registration referred to the semi-figurative trademark DESA LOGICIELS, while the requested domain name was DESA.EU. Moreover, the domain name applicant did not coincide with the holder of the earlier right upon which the domain name application was based and the applicant did not supply appropriate evidence that he was the owner or the licensee of such an earlier right.

The Complainant disagrees with Eurid's decision to reject the domain name application for DESA.EU and filed this Complaint. requesting the assignment of the domain name.

A. PARTIE REQUÉRANTE

In the Complainant's view, Eurid's decision to reject the domain name application is incorrect as it is not true that the domain name applied for does not consist of the complete name of the trademark French registration . According to the Complainant, the French registration concerns the trademark DESA, while DESA-Logiciels (likewise DESA-software (English) and DESA-aplicaciones (Spanish)) is only a "derived name". The main name for which the protection was required is DESA.

Therefore, the Complainant requests that Eurid's decision be annulled and that the domain name DESA.EU be assigned to him.

B. PARTIE DÉFENDANTE

The Respondent objects to the Complainant' statements on the following grounds.

DESA (hereinafter "the Applicant") applied for the domain name DESA on 7 December 2005. The processing agent received the documentary evidence on 12 January 2006, which was before the 16 January 2006 deadline. The documentary evidence consisted of a French trademark certificate of the composite trademark No. 779657. The validation agent concluded from its examination of the documentary evidence that the domain name applied for, DESA, did not consist of the complete name of the trademark which was submitted as documentary evidence. Also, the name of the holder of the prior right was different from the name of the Applicant. As no explanation was provided with regard to this difference, the validation agent concluded that the Applicant and the holder of the prior right might be different companies.
Based on these findings, the Respondent rejected the Complainant's application.

The Complainant, which bears a different name than the Applicant, argues that the French trademark grants a prior right on the name DESA. More in particular, the Complainant appears to be arguing that the word DESA is predominant in the composite trademark. The other signs forming part of the trademark are generic and should be disregarded. Therefore, the Complainant requests the Panel to annul the Respondent's decision.

According to the Respondent, it is insufficient to be the holder of a prior right so as to be granted a .eu domain name during the Sunrise Period. The domain name applied for must also consist of the complete name of that prior right. Indeed, article 10 (2) of Commission Regulation (EC) No. 874/2004 of 28 April 2004 (hereinafter the "Regulation") states that a domain name applied for during the Sunrise Period must consist of the complete name of the prior right on which the application is based. Section 19 (2) of the Sunrise Rules further clarifies article 10 (2) of the Regulation, by stating that: a prior right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos, etc.) will only be accepted if (i) the sign exclusively contains a name, or (ii) the word element is predominant, and can be clearly separated or distinguished from the device element, provided that (a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the domain name applied for, in the same order as that in which they appear in the sign, and (b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear.

The relevant question is not what part of the prior right/trademark is distinctive and what part is generic. Such a question would be relevant under trademark law. However, the Respondent has no authority to determine the value of a trademark. Only courts and trademark offices have such authority.

The legal framework for domain names set in place by the Regulation clearly states that the complete name must be applied for, not the distinctive element. The figurative trademark submitted as documentary evidence by the Applicant consists of the following complete name: DESA LOGICIELS This is also confirmed by a statement on the trademark certificate itself, see "Marque: DESA LOGICIELS (semi-figurative)" (in English: "Trademark: DESA LOGICIELS (composite)") As the Applicant applied for the DESA domain name (and not for the DESALOGICIELS or DESA-LOGICIELS domain name), the Respondent had no other option but to reject the Applicant's application for the DESA domain name. The Respondent cites a number of cases in support of its arguments, namely ADR Cases No. 1053 (SANTOS), No. 470 (O2 DEVELOPPEMENT), No. 713 (HUETTINGER), No. 1438 (ELLISON), No. 1728 (ANONSE, OFERTA), No. 1427 (BONOLLO) and No. 1364 (GUTSCHEINBUCH).

Moreover, the documentary evidence did not demonstrate that the Applicant was the holder of a prior right According to the Respondent, there can be no doubt that the name of the Applicant and the name of the holder of the prior right are different. The Applicant's name is DESA whereas the name of the holder of the prior right is, as mentioned in the documentary evidence, DESIGN SYSTEMS.
When it appears from the documentary evidence that the name of the applicant and the name of the owner of the trademark are different, section 20 of the Sunrise Rules clearly explains what documents should be submitted to demonstrate how the applicant is entitled to rely upon the claimed prior right. Section 20 further clarifies article 14 of the Regulation. Section 20 of the Sunrise Rules is intended to cover all situation where the documentary evidence provided does not clearly indicate the name of the applicant as being the holder of the prior right claimed. When the names are different because the applicant is a licensee, article 20 (1) of the Sunrise Rules will apply, when it is a transferee of the prior right, article 20 (2) of the Sunrise

Rules will apply.
For any other situation where the name of the applicant is not the same as the name of the owner of the prior right, section 20 (3) of the Sunrise Rules states that: "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".

The Applicant failed to explain the 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 trademarks. Therefore, the Respondent correctly rejected the Applicant's application, pursuant to the Regulation and the Sunrise Rules, because the Complainant failed to meet its burden of proof. The Respondent makes reference to a number of ADR Cases to support its arguments, as follows: ADR 1242 (APONET), ADR 1625 (TELEDRIVE), ADR 294 (COLT), ADR 810 (AHOLD), ADR 2211 (IMAGE) and ADR 551 (VIVENDI).

The burden of proof was with the Applicant to demonstrate that it is the holder or the licensee of a prior right Article 10 (1) of the Regulation states that only the holders of prior rights shall be eligible to apply to register domain names during the period of phased registration. 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. It is therefore of crucial importance that the Respondent is provided with all the documentary evidence necessary for it to assess if the applicant is indeed the holder of a prior right. The burden of proof was thus on the Applicant to substantiate that it is the holder or the licensee of a prior right (see for example cases 127 (BPW), 219 (ISL), 294 (COLT), 551 (VIVENDI), 984 (ISABELLA), 843 (STARFISH), 1931 (DIEHL, DIEHLCONTROLS)). As the panel clearly summed up in case ADR 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".

For all the aforementioned reasons, the Respondents requests that the Complaint be denied.

DÉBATS ET CONSTATATIONS

The application for the registration of the domain name DESA.EU was rejected because the domain name applied for did not consist of the complete name for which the earlier right existed and because the domain name applicant did not prove that he was the holder of the earlier right upon which the domain name application was based.

1. The identity/dissimilarity between the French trademark registration and the domain name DESA.EU

Article 10 (2) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") states that the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists. Section 19 (2) of the Sunrise Rules states that a prior right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos, etc.) will only be accepted if the sign exclusively contains a name or if the word element is predominant, and can be clearly separated or distinguished from the device element. Pursuant to article 14 of the Regulation, "[a]ll claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists. (…).

In the case at issue, the applicant forwarded to the validation agent the trademark form (fiche marque) of the French Trademark Office (INPI) relating to the French trademark registration No. 3143612 (hereinafter the "INPI Form"). The INPI form makes reference to the semi-figurative trademark DESA LOGICIELS. At the same time, however, the term DESA per se is indicated beside the word "Marque" (trademark) and below the word "Modèle" (Model), under "Déclinaison 1" and "Déclinaison 2" (declension 1 and 2) respectively, two different device trademarks both containing the words DESA LOGICIELS are displayed.

According to Article 7(a) of the ADR Rules, the Panel is not obliged, but is permitted in its sole discretion, to conduct its own investigations on the circumstances of the case. The Panel has therefore decided to investigate deeper as to whether the French trademark registration No. 3143612 could also be considered to cover the word DESA per se in addition to the figurative trademarks DESA LOGICIELS. The Panel has conducted a trademark search on the database available on the French trademark office's website entering the word DESA in class 9. The search did not retrieve any trademark for DESA per se. It only retrieved the DESA LOGICIELS French registration that the applicant used as a prior right to base its application for DESA.EU.

It appears from the above that at least in the French Trademark Office's database there is no trademark registration for DESA per se. The Panel made a second check on a different private database and again no DESA per se trademark was retrieved. The only retrieved hit referred to the French trademark registration No. 3143612 upon which the applicant based its application for the registration of DESA.EU.

Moreover, the Panel has found on the French Trademark Office's database, that the space entitled "Modèle de Marque" in the INPI Form is the space provided to applicants to insert the representation of their trademarks in the relevant application forms. Since the INPI Form that the applicant supplied as documentary evidence to support the registration of DESA.EU depicts the figurative trademark DESA LOGICIELS below the word "Modèle", and since the space below the word "Modèle" in the INPI Form is the space available for the trademark representation, it is clear that the French registration No. 3143612 protects the trademark DESA LOGICIELS and device and not DESA per se.

Therefore, the domain name applicant could not obtain the registration of the domain name DESA.EU based on the French registration No. 3143612 as this would have been in contrast with Article 10 (2) of the Regulation, which provides that the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.

As there is no exact match between the French trademark registration No. 3143612 and the domain name applied for, Eurid was correct in rejecting the application for the domain name DESA.EU.

For the sake of completeness, the Panel wishes to examine also the second ground upon which the application for DESA.EU was rejected.

2. The identity/difference between the holder of the French trademark registration and the domain name applicant.

According to the Respondent and as also demonstrated by the evidence enclosed with the Complaint and Eurid’s reply to the request of verification for the case at issue, the domain name applicant is DESA, while the holder of the French trademark registration used as a basis of the domain name application is Design Systems S.A. No explanation was given to the validation agent of the reasons of this discrepancy.

Pursuant to Article 12(2) of the Regulation, [D]uring the first part of phased registration, only registered national and Community trademarks, geographical indications, and the names and acronyms referred to in Article 10(3), may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in Article 10(1). Pursuant to Article 14 of the Regulation, [E]very applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question. Section 20 of the Sunrise Rules clearly explains what documents should be submitted to demonstrate how the applicant is entitled to rely upon the claimed prior right. Section 20 further clarifies article 14 of the Regulation. Section 20 of the Sunrise Rules is intended to cover all situation where the documentary evidence provided does not clearly indicate the name of the applicant as being the holder of the prior right claimed. When the names are different because the applicant is a licensee or a transferee of the prior right, article 20 (1) and (2) of the Sunrise Rules will apply. For any other situation where the name of the applicant is not the same as the name of the owner of the prior right, section 20 (3) of the Sunrise Rules states that: "[I]f, 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".

It clearly appears from the above that either the domain name applicant and the holder of the earlier right upon which the domain name application is based are the same, or the applicant must demonstrate the reason of the discrepancy by submitting the appropriate documents provided for by the Sunrise Rules according to the circumstances of the case.

As already stated in other ADR decisions, the burden of proof to substantiate that he is the holder or the licensee of the prior right lies on the domain name applicant. As clearly explained in ADR Case No. 1886 (GB G), "[A]ccording 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 applicant failed to prove that it is the holder of the earlier right upon which its domain name application was based. Therefore, Eurid was correct in rejecting the domain name application for DESA.EU also on this ground.

DECISION

For all the aforementioned reasons, in compliance with § B12 (b) et (c) of the Rules, the Panel denies the Complaint.

PANELISTS

Name	**Angelica Lodigiani**

DATE DE LA SENTENCE ARBITRALE 2006-11-09

Summary

LE RÉSUMÉ EN ANGLAIS DE LA SENTENCE ARBITRALE SE TROUVE À L´ANNEXE 1

The domain name applied for is DESA.EU. Eurid rejected the application because the domain name applied for did not consist of the complete name for which the earlier right existed and because the domain name applicant did not prove that he was the holder of the earlier right upon which the domain name application was based.

The Complainant objected to the lack of identity between the earlier right and the domain name applied for and did not supply any argument concerning the lack of identity between the owner of the earlier right and the domain name applicant.

The Panel found that the domain name applied for did not consist of the complete name for which the earlier right existed, that the domain name applicant and the holder of the earlier right were different, and that the domain name applicant did not provide any evidence supporting that he was the holder of the earlier right.

For all these reasons, the Panel denied the Complaint.