Panel Decision for dispute CAC-ADREU-002953

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Case administrator

Name	Josef Herian

Complainant

Organization / Name	ATLANTIC Société Française de Développement Thermique, Pierre-Louis FRANCOIS

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

The Panel is not aware of any other legal proceedings, which are pending or decided in connection with the disputed domain name.

FACTUAL BACKGROUND

ATLANTIC Société Française de Développement Thermique (hereafter The Complainant) challenges the rejection of its application for the domain name pacific.eu (hereafter the Domain Name) issued by the Registry EURid (Hereafter the Respondent).

A. COMPLAINANT

Pursuant to article 4 (2) of EC Regulation n°733/2002 and article 2 of EC Regulation 874/2004, the Complainant claims that it is eligible to register domain names under the top level domain ".eu" since it has its registered office located in France, ie within the Community.

The domain name application for pacific.eu is based on the French Trademark PACIFIC, n°96636471, whose owner is ATLANTIC Société Française de Développement Thermique and who is also the Applicant for the Domain Name in issue.

In accordance with article 3.1 (vii) of the Sunrise Rules the Domain Name subject to the application during the first phase of the Sunrise Period is the complete name for which the prior right exists.

As requested in the Sunrise Rules article 11.1 and 13.2 (ii) the prior right supporting the application of the Domain Name is a trademark registered by the French Trademark Office. The trademark was valid at the time the application for the Domain Name in issue was filed.

The Complainant provided a set of documentary evidence to the Validation Agent on time, consisting of:
- a copy of the French trademark registration certificate PACIFIC n° 96636471. This registration was made in the name of the company PACIFIC S.A., as stated on this certificate. This trademark was registered on July 24th, 1996;
- a copy of the ownership transfer of the said trademark from PACIFIC S.A. in favour of PACIFIC;
- a copy of the ownership transfer of the said trademark from PACIFIC to ATLANTIC Société Française de Développement Thermique.

The application was made in the name of ATLANTIQUE Société Française de Développement Thermique instead of ATLANTIC Société Française de Développement Thermique.

The Complainant claims that this clerical error cannot itself justify a rejection of the application, taking into account the fact that there is no difference in French between ATLANTIQUE and ATLANTIC, which are phonetically identical.

Moreover the Complainant states that the name of the Applicant, which contains too many characters, was cut in two parts in the

application, and reported on the first line of the Applicant address.

According to the Complainant this is the reason why the application was rejected.

However the Complainant asserts that having a too long name should not be prejudicial for the Applicant. Indeed, although a part of the applicant name was reported in the first line of the address, the Applicant name was complete in the application.

The Complainant reminds also that it filed several applications for other domain names during the Sunrise Period, which included similar clerical errors, and all of which have been accepted by the Registry.

Therefore the Complainant claims that the Registry should harmonize its decisions.

According to the Complainant, since the case relies on technical instead of legal issues, the identity of the Applicant and the Complainant being indisputable and the complete name of the trademark holder being in the application, it should not be an obstacle to the registration of the Domain Name and consequently, the Complainant requests that the decision of the Registry be annulled and the Domain Name be registered in the name of the Complainant.

B. RESPONDENT

The Respondent argues that the Regulation and the Sunrise Rules clearly and certainly provide that the burden of proof is with the Applicant to demonstrate that it is the holder of the prior right claimed in its application.

When there is a difference between the name of the Applicant and the name of the owner, the Applicant must submit official documents explaining this difference.

If the Applicant fails to do so, its application must be rejected.

According to the Respondent, the documentary evidence provided in support to its application does not clearly establish that the Applicant is the holder of a prior right.

The Applicant's name is "ATLANTIQUE SOCIETE FRANCAISE". The certificate of trademark registration submitted with the documentary evidence states that the owner of the trademark is "PACIFIC S.A.".

When the name of the applicant and the name of the holder of the prior right differ, Section 20 of the Sunrise Rules clearly lists the necessary documents that the applicant needs to provide in order to demonstrate how it is entitled to rely upon the claimed prior right.

In the present case, the documentary evidence submitted by the Applicant did not indicate the name of the Applicant ("ATLANTIQUE SOCIETE FRANCAISE "), as being the holder of the prior right claimed ("PACIFIC S.A.").

The Respondent insists on the fact that the Applicant documented the alleged transfers of ownership only by two applications asking the French Trademark Office (INPI) to change the owner of the trademark in the trademark register, whose documents are signed by a trademark agent.

No other documents were produced to establish that the trademark had actually been transferred or that the trademark register had been updated. In particular, the Applicant did not provide an acknowledgement and declaration form duly completed and signed by both the transferor of the relevant Prior Right and the Applicant (as transferee).

Neither did the Applicant provide an updated abstract from the French trademark register.

The Applicant failed to submit any document that would clearly demonstrate that it was the transferee of the French trademark and therefore, the Respondent correctly rejected the Applicant's application.

Furthermore, it must also be noted that the name of the Applicant "ATLANTIQUE SOCIETE FRANCAISE" is also different from the name of the person that is alleged to be a transferee of the trademark. This difference in the names, is, by itself also a sufficient ground for rejection of the application, as decided in numerous previous ADR cases.

The Respondent and the Validation agent were under no obligation to investigate into the circumstance of the application according to the provisions of sections 21.2 and 21.3 of the Sunrise Rules.

The Respondent also reminds that the ADR proceeding may not be used to remedy the Applicant's incomplete application. It relies on ADR decisions where Panels decided that the ADR cannot serve as a "second chance" or an additional round providing applicants an option to remedy their imperfect original and rejected application.

Any right given to the Applicant to correct its defective Application at this stage would be unfair to the other applicants and would be clearly in breach of the Regulations and the Sunrise Rules.

In the present case, the Respondent reminds that other legitimate applicants with presumably valid prior rights are standing in the queue.

As a consequence the Respondent requests the Panel to confirm that its decision to reject the application in dispute does not conflict the Regulations and to reject the Complaint.

DISCUSSION AND FINDINGS

The Panel refers to article 10 (1) and 14 of the EC Regulation 874/2004 and also to sections 20.2 and 21.2 of the Sunrise Rules.

Having consideration to all documents provided by the Parties supporting their contentions, which the Panel has carefully reviewed, the main questions set out by the facts in the present case are:
1. Are the documents provided with the documentary evidence sufficient to demonstrate that the Applicant holds a prior right on the French registered trademark PACIFIC;
2. Does the split name of the Applicant in various fields of the application in itself justify the rejection of the application by the Respondent;
3. Is the mistake in the name of the Applicant in the application sufficient to justify in itself the rejection of the application by the Respondent.

1. Did the documents attached to the documentary evidence allow the Applicant/Complainant to demonstrate its prior rights on the trademark in the sense of article 14 of EC Regulation 874/2004.

The documentary evidence provided by the Applicant/Complainant consists of a certificate of registration of the French Trademark PACIFIC, n° 96636471 in the name of PACIFIC S.A.

Therefore the Applicant attached also two official forms of transfer of ownership of the said trademark, one between PACIFIC S.A. and PACIFIC (société anonyme), the other dated on the same day between PACIFIC (société anonyme) and the Complainant.

The Respondent contests the assertion that these documents demonstrate that the Complainant is the holder of a prior right on the trademark PACIFIC, since the aforesaid forms are only applications to the French INPI, signed by a trademark agent.

However the Panel disagrees with the Respondent on this point since the forms attached to the documentary evidence are not mere applications filed to request the assignment of ownership of the trademark PACIFIC before the French INPI (and particularly its department called "Registre National des Marques" (National Trademark Register) where any agreement to license or transfer a trademark right should be registered).

In France the official certificate delivered by INPI to establish a licence or transfer of a trademark consists of sending back the application form submitted by the applicant with an official stamp and registration number.

In the present case, the Panel indeed notices that the forms provided in the documentary evidence bear various mentions on the top left of the documents which confirm that the applicant is the official and legal owner of the trademark PACIFIC:
- official stamp from the French INPI,
- inscription numbers (n°314798 and n°314799)
- date and place of the inscription at INPI (12 january 2001)
- barcodes identifying the operation.

The Panel also refers to the provisions of section 20.2 of the Sunrise Rules which state that "If the Applicant is the transferee of a prior right and the documentary evidence submitted does not clearly indicate that the prior right has been transferred to the applicant, it shall submit an acknowledgement and declaration form (...)".

It is the Panel opinion that the Applicant alleging a prior right on a transferred trademark has to submit an acknowledgement and

declaration form set out in section 20.2 of the Sunrise Rules, only if the documentary evidence does not by itself demonstrate that the applicant holds rights on said trademark.

The Panel refers to previous ADR decisions in similar cases (for instance ADR340 POMPADOUR).

In the present case, since the Complainant did clearly prove that the trademark PACIFIC has been transferred to its profit, the Panel considers that the Complainant did not have to submit the acknowledgement and declaration form mentioned in section 20.2 of the Sunrise Rules.

Within the scope of the provisions set out in section 21.2 of the Sunrise Rules, the Validation Agent should have been able to determine "on the basis of a prima facie review of the first set of documentary evidence" that the applicant holds a prior right on the trademark PACIFIC.

2. Name of the Applicant split in the Application

The Complainant admits that the Applicant's name was cut in two parts in the Application. "ATLANTIQUE Société Française" appears in the field "Applicant's name" and the end of the name was filled in the address line of the application.

But the Complainant claims that its name has too many characters and could not be reproduced in its entirety in the dedicated field of the application.

The Complainant alleges this a technical problem that cannot justify by itself the rejection of the application. The Respondent did not specifically reply on this point.

With reference to previous ADR cases in similar circumstances, and especially ADR181 (OSCAR) the Panel points out the limitations in the automated application system provided by the registrar (the registry ?).

Therefore the Complainant was not able to fill in properly the field reserved to applicant's name .

However the complete name of the Applicant appears in the cover letter submitted with the documentary evidence, both on the top left of the letter and the various fields reproducing the data submitted in the online application.

The Panel agrees with the opinion of the Panel in ADR181 (OSCAR) which states " (...) 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 insofar as it was possible so to do. (...)"

As a consequence the Panel considers that it would be contrary to the purpose of the EU Public Policy Rules and unfair to the Applicant to reject an application for technical reasons.

3. Typing Mistake in the name of the Applicant

The Complainant lastly admits that the Applicant's name ATLANTIC Société Française de Développement Thermique is different from ATLANTIQUE Société Française de Développement Thermique, as it was typed in the application.

The Respondent claims that it justifies by itself the rejection of the application.

The Complainant alleges that ATLANTIC and ATLANTIQUE are very similar, and sound the same even if he assumes there was a typing mistake in the application.

It is indisputable that the Applicant (or rather its registrar) made a typing mistake in the name field of the application.

It should be pointed out that the word ATLANTIQUE is the French litteral translation of ATLANTIC, which would explain the registrar mistake insofar as the Applicant is a French company.

The Panel insists on the fact that on the one hand this was a mere typing mistake in the Applicant name, instead of a complete different name or an incomplete name as in previous ADR cases, and on the other hand this was the sole error in the application since the Panel considers the split name of the Applicant was due to technical reasons.

It results from a short review of the documentary evidence that the Applicant name is ATLANTIC instead of ATLANTIQUE. It did not require many investigations to the Panel to come to this conclusion.

The Panel refers also to relevant previous cases in similar circumstances, and especially ADR396 (CAPRI) and ADR2470 (TRANSFORM).

In those cases, the Panels ruled that "the justice shall always rule over the formalistic approach and technical means" (CAPRI) and "the intention of Rules and preferred interpretation should be teleological or purposive interpretation and not formal interpretation." (TRANSFORM).

Having consideration to these elements, the Panel is satisfied that the Complainant met the requirements of the Policy and the Rules, and consequently the Panel comes to the conclusion that the decision made by the Registry to reject the application conflicts the EC Regulations.

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 PACIFIC be transferred to the Complainant

PANELISTS

Name	**Alexandre Nappey**

DATE OF PANEL DECISION 2006-12-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant ATLANTIC Société Française de développement thermique has filed an application for the domain name PACIFIC.EU during the first phase of the Sunrise Period.
The application was made in the name of "ATLANTIQUE Société Française", the applicant being unable to include all characters of its name due to technical limitations in the automated system.
The documentary evidence was submitted on time and consisted of a French Trademark in the name of a different company and official forms of transfer of ownership of said trademark.
The Registry rejected the application.
First it results from a review of the documentary evidence, that the forms of transfer of ownership submitted by the applicant are not only mere applications to the INPI but official registrations of the assignment of the trademark to the complainant.
Then the Panel considers the fact that the name of the applicant was cut in two parts in the application is a technical and not a legal problem. It cannot by itself justify a rejection of the application.
At last the typing mistake in the applicant name ATLANTIQUE instead of ATLANTIC should not per se conduct to a rejection of the application since it is clear from the application and the documentary evidence who the applicant is.
In this case the Panel is in favour of a more purposive interpretation of the Rules.
Therefore the decision of the Registry is found contrary to the Regulations and annulled.
The domain name is transferred to the Complainant.