Panel Decision for dispute CAC-ADREU-003738

Case number	**CAC-ADREU-003738**
Time of filing	**2006-11-14 13:58:40**
Domain names	**esser.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Honeywell International Inc., Susan Giniger**

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 involving the disputed domain name.

FACTUAL BACKGROUND

1. Andr. Peter Esser GmbH (hereafter "the Applicant") applied for the domain name ESSER on 23 March 2006.

2. The application was put on the basis that the Applicant had a prior right within the meaning of Article 10 of Commission Regulation No 874/2004 of 28 April 2004 and in particular that the prior right claimed was an 'other' right, that is that it came within the category of rights '…protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works'.

3.On 19 April 2006, which was before the 2 May 2006 deadline, the processing agent received the documentary evidence relied on by the Applicant.

4. The documentary evidence received by the validation agent consisted of:

(a) a letter dated 5 April 2006 and signed by a legal practitioner (Christian Weil, Rechtsanwalt) ; and

(b) supporting documentation, including copies of advertising and promotional materials and invoices on which the name 'ESSER' was mentioned in bold letters and large characters.

5. At the invitation of the Panel, both parties provided English translations of the letter and as there is no material difference between the two, the following is the translation provided by the Complainant.

'Confirmation on trademark rights; rights in titles of works; commercial designation

Dear Mr. Esser, We are glad to confirm that we have applied on November 22, 2005 for a trademark, word: "Esser", and this application has been allocated the file number 305 69 923.7/23. The official fee has been paid and we trust that the sign will be registered soon. In the enclosure hereto we submit the official filing receipt of the GPTO. Furthermore we confirm that the component of your company name "Esser" is used independently as a catch word, so that also for this use there are trademark rights and/or name rights pursuant to S. 12 of the German Civil Code. We confirm that the designation "Esser" is used independently as a commercial designation pursuant to the rules as set out in the German Trademark Act. We attach in the enclosure hereto some advertising material, letterheads and invoices, from which it can be seen that the designation "Esser" is used independently in accordance with S. 5 of the German Trademark Act. To

this end, the commercial designation “Esser” is used independently ever since the foundation of the company in the year 1897, when the company was in sole proprietorship and has only been subsequently transformed into a “GmbH” (a limited liability company). Lastly we confirm that you use the designation “Esser” independently also as a title of works, for example in the internet, for years.

With kind regards (Signature Christian Weil) -Rechtsanwalt- (Attorney at law) Enclosure: - Filing receipt GPTO - Miscellaneous advertising material, invoices.’

6. The validation agent concluded from a prima facie review of the documentation that the Applicant was the holder of a prior right on the name ESSER.

Accordingly, the Respondent (EURid) accepted the Application’s application on 23 October 2006.

7. The Complainant brings these proceedings to obtain annulment of the decision taken by EURid on the ground that the applicant has no valid prior right to the domain name ESSER.EU that qualifies as an ‘other’ right under Article 10 of Commission Regulation No 874/2004 of 28 April 2004.

8. The Panel was appointed on 12 January 2007.

A. COMPLAINANT

The Complainant is Honeywell International Inc of the United States of America.

The Complainant contends that in accepting that the Applicant had established a prior right to the name ESSER, EURid did not follow the .EU sunrise regulations. That is
so, it contends, for the following reasons.

First, the applicant based its application for ESSER.EU on an “other right” within the definition of ‘Prior Rights’ in Article 10 of Commission Regulation No 874/2004 of 28 April 2004.

Accordingly, the sunrise regulations provide that evidence must be submitted that establishes such an “other right” in the Applicant.

Then, by virtue of Section 12(3) of the Sunrise Regulations the Applicant must submit an affidavit signed by a competent authority, legal practitioner or professional representative, ‘declaring that the type of Prior Right claimed by the Applicant is protected under the laws of the relevant member state…’ in this case an ‘other right’.

Next, the affidavit should contain:

“a. references to the relevant legal provisions, scholarly works, and court decisions” to establish the right contended for by the Applicant.

However, it is contended, the documentary evidence submitted contains only references to the provisions of “par. 12 BGB” and a reference to “par. 5 MarkenG” which deal with trademark rights. The Complainant says that this reliance on the trademark law is irrelevant and insufficient, as the application was based on an‘other right’ and not a trademark right.

Moreover, the Applicant could not have succeeded based on an alleged trademark to ESSER, because at the time of filing the application for the domain name, although an application for the trademark had been made, the trademark had not been registered.

Therefore, the applicant could only claim ESSER.EU on the basis of an “other right” (not being a trademark right) as it has done in this application.

Accordingly, the material submitted did not show how an ‘other’ right could be supported by the trademark law and no other law is relied on, leaving the Applicant’s proof deficient.

For those reasons, it is argued, the applicant did not meet the requirements of the relevant provision of the .eu Sunrise regulations. Moreover, under section 12(3) of the Regulations, further information is required which has also not been provided. That is so because this was an application where, within the meaning of Section 12 (3) :

‘the existence of the Prior Right claimed is subject to certain conditions relating to the name being famous, well known, publicly or generally known, have a certain reputation, goodwill or use, or the like…’

That being so, the “other right” claimed must be a right subject to the condition of being in use. Therefore, additional information should have been included in the affidavit to establish that fact. The evidence should have shown:

“that the name for which a Prior Right is claimed meets the conditions provided for in the law (including relevant court decisions, scholarly works and such conditions as may be mentioned in Annex 1 (if any)) of the relevant member state in relation to the type of Prior Right concerned.”

However, the affidavit does not contain this information and is therefore insufficient.

In toto, the material submitted does not contain sufficient information to support the “other right” claimed and, therefore, it does not fulfil the requirements of the .eu Sunrise Regulations.

Accordingly, it is contended, EURid should have dismissed the application as it does not comply with the Sunrise rules and the decision should be annulled.

The Complainant has also submitted a legal opinion on a question raised by the Panel, namely whether the letter of 5 April 2006 constitutes an ‘affidavit’ for the purposes of Section 12 (3) of the Sunset Rules.

The Complainant’s opinion, prepared by Dr Rudolph Bockenholt of the firm Boehmert & Boehmert, can be summarised as follows.

First, in the German text of the Sunrise Rules, the expression that is translated into the English word ‘affidavit’ is ‘Eidesstattliche Versicherung’, a declaration in lieu of an oath, that is, a declaration that may be used in lieu of sworn evidence from witnesses in court proceedings where they would be subject to cross examination.

2.The Eidesstattliche Versicherung is recognised by the German Code of Civil Procedure and the German Criminal Code.

3. Accordingly, European legislators knew that when they called for evidence to be submitted by means of an Eidesstattliche Versicherung they knew they are calling for a declaration that was either sworn or made with an affirmation.

4. According, Dr Bockenholt contends that the letter in question, submitted on behalf of the Applicant, is on its face not an Eidesstattliche Versicherung, nor a document that can be characterised by the English expression ‘affidavit’, for the purposes of Section 12 (3) of the Sunrise Rules, for the Eidesstattliche Versicherung and the affidavit both have the same substantial requirement which is that they must be sworn or affirmed.

B. RESPONDENT

The Respondent is EURid. Its initial submission was as follows.

The Respondent contends that the Applicant submitted documentary and supporting evidence that met the requirements of Section 12(3) of the Sunrise Rules

This evidence established a prior right to the name ‘ESSER’ and the Applicant was the first to establish such a right.

However, after considering the Complainant’s opinion on the question of whether the letter was an ‘affidavit’, the Respondent made a further submission.

In view of the significance of this issue to EURid, it is only fair that EURid’s response to Dr Bockenholt’s opinion should be set out in full. It reads as follows:

‘First of all, the letter meets the requirements of section 12.4 of the Sunrise Rules since it clearly states that signatory qualifies as a legal practitioner.

The letter is signed by "Christan Weil Rechstanwalt". Rechstanwalt is a title that only legal practitioners are authorized to use in Germany.

Furthermore, the letter is printed on the letterhead of the law firm (Hübsch & Weil).

Then, the Respondent will try to address the interrogation of this Panel with regards to the term "affidavit".

The Respondent wishes to refer this Panel to the decision ADR 2796 (EICHHORN) available online at http://adreu.eurid.eu/adr/decisions/decision.php?dispute_id=2796.

This case bears many similarities insofar as both affidavits were in German language, both affidavits claimed prior rights protected in Germany and both affidavits do not contain a formal "sworn statement" from the legal practitioner.

However, there is also one important difference between the present case and case 2796.

In case 2796, the Respondent decided to reject the application because the statement was made by the applicant himself, who was not a legal practitioner.

The affidavit started by a statement from a public notary according to which the applicant visited him and he confirmed the existence of the applicant.

Then the public notary recorded a statement by the applicant himself.

The Respondent rejected the application because there was no legal assessment made by the public notary, who produced no legal reasoning but merely recorded a statement made by a person who is not a legal practitioner.

However, the majority of a three member Panel decided that:

"The only mistake which was made is that the statement was formulated in a way as if it was made by the Complainant whereas it should have been formulated in a way that the document contains the legal considerations of the notary himself. However, the content and the material substance of the document is compatible with Sect. 12 of the Sunrise Rules. Since a German notary is by law not allowed to notarize wrong statements and the Complainant is not a lawyer, it must be presumed that the legal statement in the document was de-signed by the notary, but only by mistake not phrased as his own statement. In this very specific situation, the Panel considers the given formal incorrectness as an obvious mistake which shall not lead to a refusal of the application".

As other Panels have decided already, at least obvious mistakes (ADR 253 – Schoeller, ADR 903 - SBK) should not form the basis of a refusal."

Therefore, the majority of the three-member Panel annulled the Respondent's decision to reject the application, which means that the applicant received the domain name.

In the present case, the Respondent accepted the application because the affidavit is actually written by a legal practitioner who is professionally responsible for the correctness of its legal analysis. Since this legal analysis confirms that the applicant is the holder of the prior right and that this analysis is accompanied by supporting documentation, the validation agent had all the elements it needed to confirm that the applicant is the holder of the prior right, pursuant to article 14 of the Regulation.

Based on these findings, the Respondent correctly accepted the Applicant's application.

The decision in case 2796 teaches at least two elements that may be applied to the present case, namely that:

- A panel may be satisfied with the fact that a German notary is by law not allowed to notarize wrong statements. Applied to this case, this rule means that a Panel may be satisfied with the fact that a Rechstanwalt (legal practitioner) is not allowed to make wrong statements or is subject to professional liability for malpractice by providing a wrong legal opinion.

- A panel may consider a formal incorrectness in an affidavit as an obvious mistake which shall not lead to a refusal of the application. Similarly in the present case, the Panel may consider the lack of the formal mention "I swear it in lieu of an oath" is an obvious mistake which shall not lead to a refusal of the application in the case that the documentary evidence is sufficient for the validation agent to confirm its finding that the claimed prior right is protected.

Finally and for the sake of completeness, the Respondent contends that the purpose of the Sunrise Rules was not to seek the application of the national rules of evidence or civil procedure of the various Member States.

The Sunrise Rules and the Regulation are only concerned about the substantial rules of the Member States that govern the protection of the prior rights. Indeed, the purpose of the Regulation and the Sunrise Rules is to insure that the validation is provided with documents that will allow the validation agent to assess whether the applicant is the holder of a prior right protected under the substantial law of a Member State.

In this case, a legal practitioner operated a legal analysis under German law and subsequently confirmed that the claimed prior right is protected under German law. There was no reason to question the correctness of the statements made by the legal practitioner, especially since those statements were correctly supported by appropriate documentation. In short, the documentary evidence submitted by the applicant meets the requirements of the Regulation and the Sunrise Rules, since it allowed the validation agent to confirm that the claimed prior right is protected under German law.'

DISCUSSION AND FINDINGS

After reading and considering the English translation of the documentary evidence submitted to the validation agent, the Panel raised with the parties by Nonstandard Communication an important threshold question.

That question was whether the major component of the documentary evidence, which was, to use a neutral expression, a letter from a lawyer, could constitute an affidavit for the purposes of Section 12 (3) of the Sunset Rules.

This was an important threshold question because, it seemed to the Panel that if the letter were not an affidavit, the validation agent and subsequently the Respondent made their decision not merely on allegedly inadequate evidence, but on no evidence at all and consequently inconsistently with the regulations. As Section 12(3) clearly requires the Applicant's case to be made out by means of an affidavit, it could not have made out a case within the meaning of Section 12(3) without having submitted an affidavit.

Accordingly, the Panel specifically sought the views of the parties on whether the letter of 5 April 2006 constituted an affidavit or otherwise came within the requirements of Section 12 (3). Both parties have been helpful to the Panel in providing it with their views and expressing them so clearly.

The Respondent has not submitted a legal opinion, but its views have been closely argued and like the Complainant's opinion have been of considerable assistance.

The result, however, is that the Panel is of the opinion that the letter relied on is not an affidavit and that there was consequently no material before the validation agent and the Respondent on which they could have made the decision they did.

The reasons why the Panel has reached this decision are as follows.

First, the Panel has been influenced by the opinion of Dr Bockenholt which is not contradicted by the Respondent on the opinion on the law that it expresses. The Panel accepts the propositions of law contained in the opinion as they appear to have the hallmarks of a correct statement of the German law and because they accord with generally accepted requirements for proper affidavits and similar dispositions.

The opinion makes the valid point, with which EURid agrees, that the starting point must be the requirements of the German law.

That being so, it is instructive to see that in the original German version of the Rules, the required document is described as an Eidesstattliche Versicherung. The Eidesstattliche Versicherung is a declaration in lieu of an oath, meaning that instead of a deponent appearing in Court and swearing or affirming to evidence, he or she may put the proposed evidence into a documentary form and swear or affirm it to be true. If that is done, the document may be accepted by the tribunal or body to which it is submitted, initially as prima facie evidence and subsequently as conclusive evidence.

But as Dr Bockenholt makes plain, the essence of the Eidesstattlichte Versicherung is that it is a declaration and it requires an oath or affirmation as its most essential ingredient and without that ingredient it is not evidence.

As the Eidesstattliche Versicherung is known and has a precise and very significant use, it is not surprising that it is recognised by the German Code of Civil Procedure and that, to deter perjury, it is also recognised by the German Criminal Code.

Accordingly, it must be presumed that the European legislators who drafted the Sunrise Rules knew exactly what they were asking for when they stipulated an Eidesstattlichte Versicherung and, in the English version, an affidavit, as the means to be adopted by applicants in cases such as the present to establish their claims.

Nor is it surprising that they should have done so. They were in effect legislating for a form of summary judgement where one party would have an instant remedy by gaining the domain name in question in preference to all others. It would thus have been surprising if the legislators had opted for anything other than a requirement of evidence that was sworn to or affirmed as being true.

Moreover, the legislators made the requirement mandatory by the time-honoured use of the word 'must' in Section 12(3), making it as plain as could be, that they wanted applicants to comply with these requirements.

On this occasion, the mandatory requirement is for evidence supported by oath or affirmation.

Consequently, the present case is not a borderline one where there is some minor departure from the specified requirements, but rather it is one where the most essential requirements of an Eidesstattlichte Versicherung, or an affidavit, is missing, an element that goes to the substance of the required proof.

It is here that the Panel must respectfully disagree with the two principal points made by the Respondent.

First, the Respondent submits that the omission of the swearing or affirming to the veracity of the contents of the document can be treated as an 'obvious mistake' and overlooked. In this regard, it relies on decision 2796 (EICHHORN) available online at http://adreu.eurid.eu/adr/decisions/decision.php?dispute_id=2796.

It is true that in that case, by a majority decision, but with a powerful dissent, the panel decided that it could in effect overlook what was described as a mistake in the material submitted, which consisted of a statement verifying that the applicant could claim a civil name right under German law.

The mistake was that

'…the statement was formulated in a way as if it was made by the Complainant whereas it should have been formulated in a way that the document contains the legal considerations of the notary himself ',

although both the individual party and the notary signed the document.

But in that case, as the decision shows, the statement was actually headed "Eidesstattliche Versicherung" and the Applicant-deponent declared it 'in lieu of oath', after being informed about the consequences of a wrong affidavit.

So the Rule had in substance been complied with. In the EICHORN case, there was an Eidesstattliche Versicherung, but in the present case there is not, for the essential elements are missing. In the EICHORN case, the requirements of the Rules had been met whereas in the present case they have not. The case is therefore not authority for the proposition that when the Rules call for an affidavit, non-compliance can be overlooked as a mere mistake.

That leads to the second departure that the Panel must, with respect, make from EURid's position. EURid argues that to reject the Applicants letter is to

'seek the application of the national rules of evidence or civil procedure of the various Member States'.

The panel does not accept that argument because the issue under debate is not a rule of evidence or procedure but a matter of substantive law. The issue is not the form that the affidavit should take, for its form and contents will clearly vary from one jurisdiction to another, but the substantive question of whether a mandatory law on proving a prior intellectual property right need be complied with.

The view of the Panel on that matter of substance is not to apply the rules of procedure or evidence of any State, but to implement the collective view of all Member States that where it is specified to be a mandatory requirement, the prior right can be established only by sworn or affirmed evidence.

In the view of the Panel, the letter submitted on behalf of the Applicant was not an affidavit as required by Section 12(3) of the Sunset Rules and neither the letter nor its enclosures were properly before the validation agent or EURid and could not be relied on to obtain the decision that is the subject of the Complaint. Accordingly, pursuant to Section 26(2) of the Sunrise Rules the decision of the Registry conflicted with the Regulations. In particular, it conflicted with Article 14 of the Regulations that requires all claims for prior right to be verifiable by documentary evidence that demonstrates the right under the law by virtue of which it exists, for there was no documentary

evidence that could have been accepted.

In view of the decision taken, it is not necessary to comment on whether, had the letter been an affidavit, it met the additional requirement of Section 12 (4) and verified the competence of the signatory or on the wider question of whether the contents of the document were sufficient evidence to make out the case under Section 12 (3) and establish the prior rights claimed.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that EURid´s decision be annulled.

PANELISTS

Name	**Neil Anthony Brown**

DATE OF PANEL DECISION 2007-02-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Applicant successfully applied for the domain name ESSER, claiming it as an ‘other’ prior right under Article 10 of Commission Regulation No 874/2004.

The documentary evidence relied on by the Applicant consisted of:

(a) a letter dated 5 April 2006 and signed by a legal practitioner; and

(b) supporting documentation, including copies of advertising and promotional materials and invoices on which the name ‘ESSER’ was mentioned in bold letters and large characters.

The letter was not sworn or affirmed.

The validation agent concluded from a prima facie review of the documentation that the Applicant was the holder of a prior right to the name ESSER and EURid therefore accepted the application.

The Complainant brought these proceedings to obtain annulment of the decision taken by EURid on the ground that the applicant had no valid prior right to the domain name ESSER.EU that qualifies as an ‘other’ right under Article 10 of the Regulations.

As a threshold question, the Panel invited the parties to make submissions on whether the letter was an ‘affidavit’ for the purposes of Section 12 (3) of the Sunset Rules. The Complainant submitted that the letter was not an‘affidavit’. The Respondent contended that it was an affidavit.

The Panel decided that the letter was not an affidavit, that the decision should accordingly not have been made on the basis of the documentary material before the validation agent and the Registry and that the decision was therefore contrary to the Regulations and should be annulled.