Panel Decision for dispute CAC-ADREU-003905

Case number	**CAC-ADREU-003905**
Time of filing	**2006-11-30 14:05:52**
Domain names	**entelec.eu, entelec.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**entelec control systems NV, Raets**

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 relating to the disputed domain name.

FACTUAL BACKGROUND

The application for registration of the domain name ENTELEC.eu was filed on 6 April 2006 during the period of phased registration by the applicant ENTELEC NV. The documentary evidence submitted by the Applicant in support of the application consisted of a copy of the statutes of incorporation of ENTELEC CONTROL SYSTEMS as published in the annexes to the Belgian Official Journal. The Registry rejected the application for the domain name ENTELEC.eu on 18 October 2006 on the grounds that the Applicant had failed to show that it was the holder of a prior right to the name ENTELEC.

A. COMPLAINANT

The Complainant, ENTELEC CONTROL SYSTEMS NV, seeks annulment of the disputed Registry decision and attribution of the disputed domain name to the Complainant.

Insofar as relevant, the Complainant attaches the following documentary evidence to the Complaint:

1 A copy of the Legal Act dated 3 September 1992 which established the Complainant company. The document states inter alia that the name of the company is "… Entelec Control Systems, in short Entelec …". (The Panel observes in passing that the electronic record on the online arbitration platform contained an error in that the document at Annex 2 to the Complaint was included twice, both at Annex 1 and Annex 2, while the document which should have been at Annex 1 was omitted, but that the Panel obtained a copy of the correct Annex 1 from the hard-copy file kept by the ADR Center).

2 Revised Statutes of the Complainant dated 14 December 2004, pursuant to which the name of the company is ENTELEC CONTROL SYSTEMS but which no longer refers to a short form of the corporate name.

3 Revised Statutes dated 17 January 2006. These appear to be the statutes of the Complainant current at the date on which the application for the domain name ENTELEC.eu was filed. Again, these statutes state the name of the company to be ENTELEC CONTROL SYSTEMS.

4 A copy extract from the annexes to the Belgian Official Journal dated 24 January 2006, which states that the name of the company is ENTELEC CONTROL SYSTEMS.

5 A Whois register entry showing that ENTELEC CONTROL SYSTEMS is the holder of the domain name ENTELEC.be.

6 An Infobase extract of the company record which shows that the name of the Complainant registered for various purposes is ENTELEC CONTROL SYSTEMS (for certain purposes together with the prefix or suffix NV).

The Complainant submits that it is the same entity as the Applicant and has been trading under the name of ENTELEC CONTROL SYSTEMS, or ENTELEC in short, since its registration in 1992, as provided by the Legal Act dated 3 September 1992 which established the company. The Complainant submits that it uses and is best known by the short name ENTELEC. The Complainant further points out that it is the registered holder of the domain name ENTELEC.be and that it wished to secure the domain ENTELEC.eu. The Complainant believes that it satisfies the requirements for holders of prior rights within the meaning of Article 10 of Regulation (EC) 874/2004 ("the Regulation").

B. RESPONDENT

The Respondent, EURid, seeks rejection of the complaint and submits a detailed response, which may be summarised as follows.

Article 10(1) of the Regulation provides that only holders of certain prior rights shall be eligible to apply to register domain names during the period of phased registration.

Article 10(2) of the Regulation requires that 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.

The validation agent concluded from its examination of the documentary evidence submitted within the applicable time limits in support of the application that the Applicant ENTELEC NV did not demonstrate that it was the holder of a prior right to the name ENTELEC. The Respondent therefore correctly rejected the application.

The Respondent rejects the argument raised by the Complainant that the Registry decision should be annulled because the Complainant is known under the short name ENTELEC. 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 examines whether the applicant has a prior right to the name. The Respondent must therefore be provided within the applicable time limits with all the documentary evidence necessary for it to assess whether the Applicant is indeed the holder of a prior right.

The Regulation and the Sunrise Rules, supported by relevant ADR decisions, provide clearly and with certainty that the burden of proof is upon the Applicant to demonstrate that it is the holder of a prior right. The Respondent asserts that the Complainant failed to satisfy this burden of proof because: (1) the domain name ENTELEC did not consist of the Complainant's full name ENTELEC CONTROL SYSTEMS; (2) the documentary evidence did not establish the protection of a trade name; and (3) the Complainant did not submit documentary evidence explaining the difference between the name of the Applicant ENTELEC NV and the name of the company to which the documentary evidence submitted in support of the application related, namely ENTELEC CONTROL SYSTEMS.

The Respondent elaborates on its submissions as follows. It states by reference to ADR case law that the relevant question is not whether the Complainant is the holder of a prior right, but whether the Complainant demonstrates to the validation agent that it is the holder of a prior right. If the Complainant fails to do so, its application must be rejected.

The Respondent refers to Section 19.1 of the Sunrise Rules in support of its argument, which provides that "[A]s stated in Article 10(2) of the Public Policy Rules, registration of a Domain Name on the basis of a Prior Right consists in [sic] the registration of the complete name for which the Prior Right exists, as manifested by the Documentary Evidence. It is not possible for the Applicant to obtain registration of a Domain Name comprising part of the complete name for which the Prior Right exists."

The Respondent points out that the Complainant submitted documentary evidence substantiating that the company name relied upon as a prior right was ENTELEC CONTROL SYSTEMS; and that, pursuant to Article 10(2) of the Regulation and Section 19.1 of the Sunrise Rules, the company name relied upon by the Complainant could only serve as prior right to the domain name ENTELECCONTROLSYSTEMS.eu, i.e., the complete name for which the prior right exists, but not to the domain name ENTELEC.eu. The Respondent therefore correctly rejected the application.

The Respondent adds that it was not under any obligation to investigate whether the Complainant is also known under the short version of its company name but only to verify whether the domain name applied for consisted of the complete name of the prior right on which the application waas based as written in the documentation which proves that such a right exists.

The Respondent further asserts that the documentary evidence submitted by the Complainant did not establish the protection of a trade name in accordance with Sections 16.5 and/or 12.3 of the Sunrise Rules. Since the documentary evidence received by the validation agent within the applicable deadline consisted of a copy of the statutes of incorporation of the company ENTELEC CONTROL SYSTEMS, there was nothing in the documentary evidence which could have lead the validation agent to consider that the Applicant was the holder of the trade name ENTELEC.

Furthermore, the Respondent points out that, where there is a difference between the name of the applicant and the name of the owner of the prior right, Section 20.3 of the Sunrise Rules requires the applicant to 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 did not submit documentary evidence explaining the difference between the name of the Applicant (ENTELEC NV) and the company mentioned in the documentary evidence (ENTELEC CONTROL SYSTEMS NV). The Respondent was therefore left with legitimate doubts as to whether the Applicant ENTELEC NV was entitled to rely on the company name ENTELEC CONTROL SYSTEMS NV as prior right. This constituted a further valid ground for rejecting the application.

Finally, the Respondent points out that, pursuant to Article 14 of the Regulation, documents which did not form part of the documentary evidence submitted in support of the application within 40 days from the submission of the application for the domain name, may not be taken into account as evidence establishing the existence of the claimed prior right. The new documents which the Complainant attaches to its Complaint could not be taken into account by the validation agent at the time of validation of the application and therefore cannot be accepted as evidence of the existence of a prior right by the Panel.

For these reasons the Respondent asks for the Complaint to be denied.

DISCUSSION AND FINDINGS

The Panel reviewed and considered the parties' submissions, the documentary evidence produced by the parties, and the online record in relation to the present case in detail. Before addressing the merits of the case, the Panel observes that even though the Complainant elected English as the language of the proceedings, it submitted the Annexes to the Complaint in the Flemish language without English translation. Pursuant to paragraph A.3(c) of the ADR Rules, the Panel may disregard documents submitted in languages other than the language of the proceedings. This notwithstanding, and in the interests of justice, the Panel has reviewed the Annexes to the Complaint. The Panel further considered the ADR decisions referred to by the Respondent in its submissions. The Complainant did not cite specific ADR decisions in support of its position but the Panel took the case law in relation to .eu disputes into account generally insofar as relevant.

The Panel considers it somewhat unclear whether the Complainant sought to pursue its application for registration of the domain name ENTELEC.eu based on prior rights to its company name ENTELEC CONTROL SYSTEMS (as the original application suggests) or based on prior rights to the trade name ENTELEC (as the Complaint appears to suggest). The Panel has therefore considered and discusses both alternatives below.

The jurisdiction of the Panel in this matter is set out in Article 22(11) of the Regulation, which requires that "[i]n the case of a procedure against the Registry, the ADR Panel shall decide whether a decision taken by the Registry conflicts with this Regulation or with Regulation EC 733/2002". Likewise, Paragraph B.11(d)(2) of the ADR Rules provides that "[t]he Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Respondent proves in ADR Proceedings where the Respondent is the Registry that the decision taken by the Registry conflicts with European Union Regulations".

Section 26.2 of the Sunrise Rules contains a similar provision. The Panel is not called upon to consider whether the application for the domain name complies with the Sunrise Rules, or, vice versa, whether the decision of the Registry conflicts with the Sunrise Rules, which were promulgated on the basis of Article 12(1) of the Regulation. They are intended to be "a detailed description of all the technical and administrative measures that [the Registry] shall use to ensure a proper, fair, and technically sound administration of the phased registration period". The Panel adopts the observations of the panel in case 1071 (ESSENCE) on the relevance of the Sunrise Rules.

In considering whether the disputed decision of the Respondent conflicts with the European Union Regulations (as defined in the ADR Rules), the key provisions of the Regulation for present purposes are the following:

1 Article 10(1), which provides that only holders of prior rights recognised or established by national and/or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain [sic] starts. Such prior rights may include company names or trade names.

2 Art 10(2), which requires that 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.

3 Article 14, which provides that all claims for prior rights under Articles 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists; and 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. If the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this. The Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in the second, third and fourth paragraphs.

In the present case the Applicant ENTELEC NV submitted documentary evidence in support of its application which substantiated prior rights to the company name ENTELEC CONTROL SYSTEMS but did not refer to the short form name ENTELEC. Since Article 10(2) of the Regulation and Section 19.1 of the Sunrise Rules require the registration of a domain name on the basis of a prior right to consist of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists, and that complete name was ENTELEC CONTROL SYSTEMS, the Respondent correctly rejected the application for the shortened domain name ENTELEC based on the evidence before it at the time of validation of the application. The principle that an applicant may not obtain registration of a domain name comprising part only of the complete company name for which the prior right exists is not only clarified by Section 19.1 of the Sunrise Rules but also supported by case law of the Arbitration Center (see by way of example cases 2471 (TAIYO-YUDEN), 2499 (PSYTECH) 3032 (SEGHORN), and 2093 (MAZUR)). The Panel in MAZUR stated the principle succinctly in a very similar case when it said that “[t]he case law has also well established that not only the main “identifier” of a company’s name forms the basis for registration but the exact characters of the registered prior right”.

The Respondent further rightly points out that there was a material difference between the name of the Applicant and the company name relied upon as constituting a prior right which was not clearly explained through submission of official documents.

It follows from Article 14 of the Regulation that the validation agent examines whether the Applicant has prior rights to the domain name for which it applied based on the documentary evidence before him. It is now established by a continuous line of ADR decisions that the burden of proof was on the Applicant to demonstrate that it was the holder of a prior right (see cases 127 (BPW), 219 (ISL), 294 (COLT), 551 (VIVENDI), 984 (ISABELLA), 843 (STARFISH), 1931 (DIEHL/DIEHL CONTROLS), and 2881 (MR LODGE)). The Panel refers, in particular, to the decision in case 2350 (PUBLICARE), where the applicant “Publicare” relied on a prior right registered in the name of “Publicare Marketing Communication GmbH”; and to case 1625 (TELEDRIVE), where the applicant “IAV GmbH” relied on prior rights owned by IAV GmbH Ingenieurgesellschaft Auto und Verkehr”.

Section 20.3 of the Sunrise Rules further clarifies 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”.

The legal position is accordingly such that a failure by the Applicant to submit official documents pursuant to Section 20.3 of the Sunrise Rules, substantiating that it is the same person as, or the legal successor to, the person named in the documentary evidence as holder of the prior right, or that it is otherwise entitled to rely upon the prior right, amounts to a failure to show that he is the holder of the prior right in accordance with Article 14 of Regulation EC 874/2004 because the claim to the prior right is not verifiable by documentary evidence.

In the present case the name of the Applicant is ENTELEC NV. The documentary evidence submitted by the Applicant in support of its application substantiates prior rights to the name ENTELEC CONTROL SYSTEMS NV. The Applicant did not submit any other documentary evidence clearly explaining the reasons for the difference between the name of the Applicant and the complete name for which the prior right existed which would have enabled the Registry to verify that the Applicant was identical with, or a successor to, the right holder identified in the documentary evidence, or that the Applicant was otherwise entitled to rely on the prior right in support of its application. Accordingly, the documentary evidence did not demonstrate that the Applicant had a prior right to the name ENTELEC as required by Article 14 of Regulation EC 874/2004 (see cases 810 (AHOLD), 1299 (4CE), 1625 (TELEDRIVE), 1627 (PLANETINTERNET), 2350 (PUBLICARE), 2268 (EBSOFT), 1242 (APONET)).

In both cases 2350 (PUBLICARE) and 1625 (TELEDRIVE) the absence of documentary evidence explaining the difference in the names of the applicants and the owners of the prior right resulted in a rejection of the application for registration of the relevant domain name. In both cases the complaints against the disputed decisions of the Registry were rejected in resulting ADR proceedings (see also case 2268 (EBSOFT)). The panel in case 1886 (GBG) summarized the position by stating that “[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." In the present case, the Applicant failed to satisfy the burden of proof because the prior right was not verifiable by the documentary evidence submitted.

In light of the difference between the name of the Applicant and the complete name to which the prior right related, the Respondent could have had legitimate doubts whether the Applicant was the same company as that to which the documentary evidence related (see cases 1299 (4CE) and 2881 (MRLODGE)). The Registry was therefore entitled to decide that the Applicant had failed to demonstrate that it was the holder of a prior right to the name ENTELEC, and to rejected the application for registration of the domain name by the Applicant based on the evidence before it at the time of validation of the application.

Section 21.1 of the Sunrise Rules provides that the validation agent and the Registry are not obliged to notify the applicant if the requirement sufficiently to establish the prior right to a domain name is not complied with (see also case 551 (VIVENDI)).

Furthermore, pursuant to Section 21.3 of the Sunrise Rules, the validation agent was not obliged, but was 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. Neither the Regulation nor Regulation EC 733/2002 requires the validation agent or the Registry to conduct such investigations. Indeed, Article 10(2) of the Regulation provides that "if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this". The Regulation therefore assumes that the validation agent bases its assessment only on the documentary evidence before it. The Panel regards it as a now accepted principle that a decision taken by the validation agent not to conduct its own investigation in accordance with Section 21.3 of the Sunrise Rules into conflict with Regulation EC 733/2002 or the Regulation within the meaning of Article 22(11) of the Regulation.

The Panel agrees with the Respondent that there was no evidence before the validation agent establishing the protection of a trade name in accordance with Section 16.5 and/or Section 12.3 of the Sunrise Rules.

It follows from Article 22(11) of the Regulation which defines the jurisdiction of the Panel, in conjunction with Articles 10(1) and 14 of the Regulation, that the Panel must review the validity of the Registry's disputed decision based on the evidence which was before the validation agent at the time of validation of the application for the domain name ENTELEC.eu (see cases 294 (COLT), 954 (GMP), 1549 (EPAGES), 1674 (EBAGS), 2124 (EXPOSIUM)). The Panel has no authority to validate the Complainant's application retrospectively based on additional documentary evidence which was submitted in the ADR proceedings but which was not submitted to the validation agent within the applicable time limits (see cases 219 (ISL), 294 (COLT), 706 (AUTOWELT), 954 (GMP), 1627 (PLANETINTERNET) and 2881 (MRLODGE)).

The Panel is therefore precluded from reviewing the Registry's decision based on the documentation annexed to the Complaint, which was not before the validation agent at the time of validation of the application. Even if it was open to the Panel to take the new documents into account, the Panel would have concluded that they did not support the application for the domain name ENTELEC.eu during the period of phased registration. The short form company name ENTELEC is mentioned only in the statutes of the Complainant dated 3 September 1992. These statutes were subsequently overtaken by revised statutes which no longer referred to the short form name ENTELEC but state expressly that the name of the Complainant was ENTELEC CONTRL SYSTEMS. The revised statutes were in force at the time of the application for the domain name ENTELEC and the earlier statutes therefore appear to be of historic interest only. Even if the additional documentation had been before the validation agent contemporaneously, there would have been no evidence supporting prior rights to the name ENTELEC as opposed to ENTELEC CONTROL SYSTEMS (see also case 02093 (MAZUR)).

The Panel further observes that it is quite unclear why the application was made in the name of ENTELEC NV and not in the name of ENTELEC CONTROL SYSTEMS NV, which appears at the relevant time to have been the only recognised name of the company based on the documentary evidence annexed to the Complaint and, in particular, on the statutes of the Complainant dated 17 January 2006.

Finally, the fact that the Complainant is the holder of the domain name ENTELEC.be does not assist the Complainant, first, because the registration criteria applied by DNS Belgium may well be different from those applicable to applications for .eu domain names during the period of phased registration; and further because registration of a national domain name is not in itself sufficient evidence of the use of a trade name in accordance with Section 16(5) of the Sunrise Rules (see also case 2093 (MAZUR), where a similar argument was raised and failed).

The Panel concludes that the Respondent's decision to refuse the application for the domain name ENTELEC does not conflict with the Regulation or with Regulation EC 733/2002.

DECISION

For all the foregoing reasons, and in accordance with Paragraph B.12(b) of the ADR Rules, the Panel orders that the Complaint is denied.

PANELISTS

Name	**Klein Solicitors, Gregor Kleinknecht, LLM MCIArb**

DATE OF PANEL DECISION 2007-02-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Applicant filed an application for the domain name ENTELEC. The name of the Applicant is ENTELEC NV. In support of its application, the Applicant submitted documentary evidence establishing prior rights to the name ENTELEC CONTROL SYSTEMS. The Registry rejected the application on the grounds that the Applicant had failed to show that it was the holder of a prior right to the name ENTELEC.

The Complainant, ENTELEC CONTROL SYSTEMS, seeks annulment of the disputed Registry decision and attribution of the domain name in dispute to the Complainant in accordance with Paragraph B.11(c) of the ADR Rules. The Respondent, EURid, asks for the complaint to be rejected.

The Panel orders that the Complaint is denied on the grounds that (1) the domain name ENTELEC does not consist of the Complainant's full company name ENTELEC CONTROL SYSTEMS; (2) the documentary evidence did not establish the protection of a trade name; and (3) the Applicant did not submit documentary evidence explaining the difference between the name of the Applicant ENTELEC NV and the name of the company to which the documentary evidence submitted in support of the application referred, namely ENTELEC CONTROL SYSTEMS NV.

The burden of proof was on the Applicant to demonstrate that it was the holder of a prior right. The Applicant failed to satisfy that burden of proof because the prior right was not verifiable by the documentary evidence submitted to the validation agent within the applicable time limits. The validation agent was not obliged, but was permitted in its sole discretion, to conduct its own investigations into the circumstances of the application.

The Respondent's decision to refuse the application for the domain name ENTELEC therefore did not conflict with Regulation EC 733/2002 or Regulation 784/2004.