

Panel Decision for dispute CAC-ADREU-000340

Case number **CAC-ADREU-000340**

Time of filing **2006-03-23 10:51:58**

Domain names **pompadour.eu**

Case administrator

Name **Josef Herian**

Complainant

Organization / Name **Christian Ludwig Maag KG**

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

No legal proceedings have been issued or terminated in connection with the disputed domain name.

FACTUAL BACKGROUND

The Complainant challenges the rejection of his application for the domain name pompadour.eu.

A. COMPLAINANT

The Complainant filed his application for the domain name pompadour.eu on 07 December 2005. This application was properly received by EURID. The documentary evidence was received by EURID on 12 December 2005. On 13 February 2006 the Processing Agent issued the rejection of the application. The grounds on which the rejection was based on was that the documentary evidence did not prove the prior rights claimed by the Complainant. The rejection did not include any details or further reasons.

The Complainant does request the annulment of the disputed decision taken by the registry and the attribution of the domain name pompadour.eu to him. According to Complainant the rejection of the application for this domain name must be annulled as his prior rights are fully existent and have been proven through the appropriate documentary evidence.

The Complainant submits that he is the owner of the German trademark 699225 (word mark) "Pompadour" which has been registered with priority from 24 July 1956 at the German Patent and Trademark Office. It exclusively consists of the word "Pompadour".

The trademark certificate dated 2 July 2003 which was also transmitted by Complainant shows – according to his opinion - the official proof of the transfer of the trademark to him. The former owner of the trademark is referred to in the upper right corner as "POMPADOUR Lizenz-Verwaltungs-GmbH", a company that was in charge of licensing the trademark "Pompadour". The line "Umgeschrieben auf: Chr. Ludwig Maag KG, Albstadt, DE" states to whom the mark has been transferred, which is the Complainant who is therefore the current owner of the trademark.

Therefore the Complainant has – according to his opinion - presented all relevant information to the Registry.

The Complainant does also requests the domain name pompadour.eu to be attributed to him since he was the first applicant for this domain name and does also satisfy all registration criteria.

B. RESPONDENT

According to Respondent the Complainant did not prove that the trademark is still valid. Respondent confirms that Complainant has properly filed an application for the registration of the domain name pompadour.eu on the ground of a registered trademark and has submitted in due time as documentary evidence an extract from the certificate of the trademark POMPADOUR under nr. 699225 issued by the German Patent Office (Deutsches Patentamt), a competent trademark office.

Respondent does deny that the submitted documentary evidence does confirm that after the date of the transfer of the trademark to Complainant (2

July 2003) the validity of the trademark was still established.

Therefore the Respondent, upon notification of the finding by the validation agent that the documentary evidence does not substantiate a prior right on the domain name, has rejected the application.

DISCUSSION AND FINDINGS

1. Both parties agree as to the fact that Complainant has filed the necessary documents in due time.
2. Both parties agree that the German Patent Office which issued the certificate under the nr. 699225 in 1956 and the letter dated 2 July 2003 is a competent trademark office.
3. The Complainant has also filed – together with this certificate – a letter from his Patent Attorneys and a confirmation from the German Patent and Trademark Office according to which the trademark nr. 699225 has been transferred from Pompadour Lizenz-Verwaltungs GmbH to the Complainant. This confirmation of the German Patent and Trademark Office dates 2 July 2003.
4. The documents filed by Complainant – neither the initial certificate from the German Patent Office, nor its confirmation (issued under its current name “German Patent and Trademark Office”) dated 2 July 2003 - do not mention the term for which the registration of the trademark is valid.
5. According to § 47 of the German Law of Trademarks a registration protects the owner of the trademark for ten years measured from the date of application, extensions of this term of protection are possible.
6. Following the rejection of the application the Panel has to consider whether (a) the Complainant has proved that he is the owner of the trademark and whether (b) Complainant has been able to prove a prior right as to the domain name Pompadour.
7. First of all the Panel considers the claimed transfer of the trademark to the Complainant. According to the certificate of the German Patent Office the trademark Pompadour was registered there on 21 January 1957 (with priority from 24 July 1956) under the nr. 699225. With its confirmation dated 02 July 2003 the German Patent and Trademark Office (which is the present name of the German Patent Office) holds that a transfer of the trademark has been registered there. This confirmation does (inter alia) refer to the trademark nr. 699225, which is the number under which the trademark Pompadour was registered on 21 January 1957.

This confirmation furthermore shows that the former owner of the trademark was the Pompadour Lizenz-Verwaltungs GmbH and that the trademark has been transferred to Complainant (in German: “Umgeschrieben auf ...”). It also holds that this transfer is to be published in the official journal concerning trademarks on 1 August 2003.
The confirmation dated 2 July 2003 is – according to the letter of the Patent Attorneys of Complainant dated 7 July 2003 the official notification of the German Patent and Trademark Office according to which the trademark Pompadour has been transferred to Complainant.
8. Taking into consideration all of these facts the Panel comes to the conclusion that the trademark has been properly transferred to Complainant in July 2003. Since Complainant did clearly prove that the trademark has been transferred to him, he did also not have to submit the acknowledgement and declaration form mentioned in Section 20.2 of the Sunrise Rules.
9. The second basis because of which the application of Complainant has been rejected was that he did – according to the Response to Complaint filed on behalf of EURID - not prove that the validity of the trademark was not expired after the date of the confirmation of the German Patent and Trademark Office (2 July 2003). According to this argument, Respondent would have requested a confirmation showing that the registration of the trademark is still valid.
10. The Panel agrees that none of the documentary evidence filed on behalf of Complainant does refer to a period of protection as to the trademark. The most recent confirmation stating that Complainant is the owner of the trademark dates 2 July 2003. There is no confirmation after this date within the documentary evidence delivered on 7 December 2005.
11. According to Art. 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 holders of prior rights recognized or established by national and/or Community law are eligible to apply to register domain names during a period of phased registration before general registration of .eu domains starts. One of these prior rights mentioned in Art. 10 (1) of this regulation is a registered national trademark.
Section 13 (1) of the Sunrise Rules confirms that the trademark does have – to be a basis for such a prior right – to be registered by (inter alia) a trademark office in one of the member states.
12. Art 12 (3) of Commission Regulation (EC) No 874/2004 of 28 April 2004 provides that the request to register a domain name based on such a prior right shall include a reference to the legal basis in national or Community law for the right to the name. The regulation specifies that such an application does also have to contain information such as the trademark registration number, information concerning publication in an official journal or government gazette etc.

13. According to Section 13 (2) i of the Sunrise Rules it is sufficient to submit a copy of an official document issued by the competent office indicating that the trademark is registered. This official document could be a certificate of registration, a renewal certificate, an official extract from the register, a declaration by the trademark office, or a publication of the fact of registration in an official journal, etc.

14. Complainant did provide as documentary evidence a copy of the certificate of registration which mentions the trademark registration number. Also the confirmation of the German Patent and Trademark Office dated 2 July 2003 refers to this number.

This confirmation does also refer to the fact that the transfer of the trademark to Complainant (and with this the legal validity of the trademark) will be published in the official journal concerning trademarks on 1 August 2003. The letter of the Patent Attorneys of Complainant dated 7 July 2003 confirms that all Pompadour-trademarks have been transferred to Complainant.

15. According to the opinion of the Panel this documentary evidence does comply with the requirements mentioned in Section 13 (2) i of the Sunrise Rules as to the documents which have to be submitted to prove a prior right. Complainant was therefore able to prove that he is the owner of the trademark.

16. The Panel cannot follow the opinion of Respondent that Complainant would have had to provide documents, proving that the trademark was not expired, i.e. an extension notice issued by the German Patent and Trademark Office.

17. Neither the Commission Regulation (EC) No 874/2004 of 28 April 2004 nor the Sunrise Rules determine that an applicant does have to submit such a document. If the presentation of such a document would be a peremptory condition for the proof of a prior right the Regulation or the Sunrise Rules would provided this fact expressly.

The regulation mentions the documentary evidence which has to be submitted in Section 13 (2) of the Sunrise Rules, Complainant did provide this evidence. He did also sign the official form sheet on 8 December 2005 and with doing so has confirmed that he is the owner of the prior right (the trademark) and that the trademark is still valid

18. The Panel therefore decides that EURID's decision is to be annulled.

19. Complainant does also request the attribution of the domain name.

20. According to the information at whois.eu (and according to Annex C1 of the Complaint), Complainant was the first applicant as to this domain name, and therefore the next applicant in queue mentioned in Paragraph B11 (c) of the ARD Rules.

21. Complainant does, as to Paragraph B11 (c) of the ADR Rules, satisfy all registration criteria set out in the European Union Regulations. He has provided the necessary documentary evidence and has proved his prior right on the basis of his trademark.

22. The Panel does therefore order the attribution of the domain name pompadour.eu to Complainant in accordance with Paragraph B11 (c) of the ADR Rules.

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 POMPADOUR be attributed to the Complainant.

PANELISTS

Name	Christoph Haidlen
------	--------------------------

DATE OF PANEL DECISION 2006-05-29

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

1. The Panel comes to the conclusion that the trademark has been properly transferred to Complainant.

2. According to Section 13 (2) i of the Sunrise Rules it is sufficient to submit a copy of an official document issued by the competent office indicating that the trademark is registered.

3. Neither the Commission Regulation (EC) No 874/2004 of 28 April 2004 nor the Sunrise Rules determine that an applicant does also have to submit a document proving that the trademark was not expired at the time he filed his application for registration of a domain name.

4. The Panel therefore decides that EURiD's decision is to be annulled.

5. The Panel does also order the attribution of the domain name pompadour to Complainant.
