Panel Decision for dispute CAC-ADREU-000470

Case number	CAC-ADREU-000470
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Domain names	o2.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	O2 DEVELOPPEMENT

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

At the best knowledge of the Panel: None

FACTUAL BACKGROUND

Complainant filed an application for the domain name "O2" on December 7, 2005. The application was founded on the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter: "Sunrise Rules"). The applicant transmitted all the required documents in due course and well before the deadline set for January 16, 2006.

Complainant based its application on Sections 4.1., 11.1. and 13.2. of the Sunrise Rules, whereby it is requested that (i) the applicant is the owner of the Prior Right claimed, (ii) the domain name corresponds to a registered national or Community trade mark, in this case a French trademark (hereinafter: "French Trademark"); and (iii) the Documentary Evidence clearly evidence the prior two requirements.

Complainant submitted the following Documentary Evidence: (i) a "demande d'inscription au registre national" (free translation: "request for registration in the national trademark registry") to prove the Prior Right; (ii) the agreement between the Complainant and the original French Trademark owner confirming the transfer of the French Trademark to Complainant; and (iii) a declaration by the French Trademark Office (hereinafter: "INPI") that the transfer of the French Trademark has been registered in the French trademark registry.

The French Trademark consists of a composite sign including words and devices, namely the stylized characters "02" printed on a blue background and accompanied, on the right side, by the stylized words (slogan) "l'oxygène de votre quotidien".

Respondent rejected the application.

Complainant does not agree and requests to be reinstated in his rights and, more exactly, that the domain name "O2" would be attributed to him.

A. COMPLAINANT

As to Complainant the Documentary Evidence shows that the French Trademark is registered. This would result from the ticked box on the left hand-side of the designation of the concerned registration, bearing in mind that the document has been checked and approved by the INPI.

Moreover, Complainant contends that the Documentary Evidence shows that the French Trademark has been transferred back in 2004 from the original applicant to the Complainant. Accordingly, the French Trademark should be considered as a Prior Right as defined under the Sunrise Rules.

Complainant invokes in this respect Section 19.2. of the Sunrise Rules. The characters "O2" should be considered as the predominant element of the French Trademark and can be clearly separated from the device element. As a result the application of the domain name "O2" should be accepted.

B. RESPONDENT

Respondent based its rejection of the application on the following legal grounds:

- Article 10.1. of Commission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration (hereinafter: "Regulation 874/2004") provides that holders of prior rights recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts, and that prior rights shall be understood to include, inter alia, registered national and community trademarks.

- Article 12.3. of the Regulation 874/2004 provides that the request to register a domain name based on a prior right shall include a reference to the legal basis in national or Community law for the right to the name, such as a trademark, as well as other relevant information, such as trademark registration number.

- Article 14 of the Regulation 874/2004 provides that an 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.

- Article 10.2 of the Regulation 874/2004 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.

According to Respondent, Complainant applied for the domain name "O2" on December 7, 2005. The Documentary Evidence was received on January 5, 2006, which is before the deadline of January 16, 2006.

Respondent contends that Complainant does not have a prior right on the characters "O2", Respondent rejected the application for the domain name "O2".

According to Respondent, Complainant's registered trademark is a device mark. In this respect, Article 10.2. of the Regulation 874/2004 states that the domain name must be the complete name of the prior right.

Complainant's registered trademark is, however, a stylized slogan which reads as follows: "O2, l'oxygène de votre quotidien".

Therefore, Respondent contends that Complainant only has a prior right on the complete slogan, and not on the element "O2".

Respondent concludes that the complaint must be dismissed.

DISCUSSION AND FINDINGS

Article 22 of the Regulation 874/2004 provides that in case of a procedure against the Registry (i.e. Respondent), the ADR panel shall decide whether a decision taken by the Registry conflicts with this Regulation or with the European Parliament and the Council Regulation (EC) No. 733/2002 of 22 April 2002 on the implementation of the .eu Top Level Domain.

It results from the Case File that there is no discussion between Complainant and Respondent regarding the Documentary Evidence and their submission in due time.

It also results from the Case File that the domain name application and the Complaint is solely based on the French Trademark, to be considered as the Prior Right upon which the "O2" domain name application has been based.

Article 10.1. of the Regulation 874/2004 provides that "(h)olders of prior rights recognized or established by national (…) law (…) shall be eligible to register domain names during a period of phased registration before general registration of .eu domain starts.

'Prior rights' shall be understood to include, inter alia, registered national (…) trademarks."

Article 10.2. of the Regulation 874/2004 is worded as follows: "(t)he 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 such a right exists."

These conditions are confirmed by the Sunrise Rules. Moreover, Section 19.2. of the Sunrise Rules states: "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 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 Prior Right to the domain name "O2", namely the French Trademark, consists of a composite sign including words and devices, and more specifically the stylized characters "02" printed on a blue background and accompanied, on the right side, by the stylized words (slogan) "l'oxygène de votre quotidien".

The domain name "O2" could therefore not be considered as a name included a composite sign that exclusively contains the domain name.

Alternatively, it has to be examined whether the characters "O2" could be considered as the "word element" that is predominant and that can be clearly separated or distinguished from the device element. It appears from the Case File that Respondent does not contest Complainant's allegation that the characters "O2" are to be considered as a "word element" that is predominant and that can be clearly separated from the device element.

However, provided the wording of Section 19.2. of the Sunrise Rules, Complainant can not be followed in his argumentation that, in case the domain name applied for (in the present case: "O2") consists of a word element that is predominant and that can be clearly separated from the device element, the application should and would (automatically) result in the registration of the domain name.

Indeed, Section 19.2. provides two other conditions which, both, have to be fulfilled in order to register a domain name under the Sunrise Rules. One of these conditions is that 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 they appear in the sign.

The Panel finds that all alphanumeric characters of the composite sign invoked by Complainant (i.e. the French Trademark), are not contained in the domain name "O2". Indeed, the words (slogan) "l'oxygène de votre quotidien" are part of the composite sign, namely the French Trademark, but do not appear in the domain name Complainant applied for.

Accordingly, the decision taken by Respondent to reject the "O2" domain name application does not conflict with the Regulation 874/2004.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint is denied

PANELISTS

Name	Gunther Meyer

DATE OF PANEL DECISION 2006-06-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contends that the decision of the Respondent (i.e. the Registry) to reject the application for the domain name "02" is in conflict with the EC Regulations on .eu domain names.

The Complainant is owner of a national (i.e. French) trade mark consisting of a composite sign including words and devices, namely the stylized characters "02" printed on a blue background and accompanied, on the right side, by the stylized words (slogan) "l'oxygène de votre quotidien".

The Complainant sought the annulment of the Respondent's decision and the attribution of the domain name.

The Panel finds that the Documentary Evidence provided by the Complainant proved sufficiently his Prior Right and that its was submitted in due time. The Panel also finds that, notwithstanding the fact that the characters "O2" are considered by parties as the predominant element of the composite sign, the application does not respect the conditions set fourth is Section 19.2. of the Sunrise Rules because not all alphanumeric characters of the composite sign, and more exactly the words (slogan) "l'oxygène de votre quotidien" are contained in the domain name "O2" the Complainant applied for.

The Panel decided that the Respondent's decision to reject the "O2" domain name application by the Complainant, does not conflict with the Regulation 874/2004. Therefore, the complaint is denied.