Panel Decision for dispute CAC-ADREU-000499

Case number	CAC-ADREU-000499
Time of filing	2006-03-30 15:27:47
Domain names	grunfos.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Grundfos A/S

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 legal proceedings which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant's company name and registered trademark GRUNDFOS is used from 1945 and is well-known all over the world. Member of Grundfos Group, company Grundfos Management A/S, submitted on December 7th, 2005, an application for registration of the domain name GRUNFOS. As evidence of the prior right regarding "GRUNFOS" a legal opinion of an legal expert was submitted stated, that "GRUNFOS" is confusingly similar to the trademark GRUNDFOS. EURid rejected Complainant's application for registration of the disputed domain name stating that the documentary evidence did not sufficiently prove the right claimed.

A. COMPLAINANT

The Grundfos Group, established in 1945, is one of the largest manufacturers of circular pumps in the world producing more than 10 million pumps per year. The Grundfos Group trades under the well-known company name and trademark GRUNDFOS registered worldwide, including in all EU countries, from 1946 (GRUNDFOSS) and 1967 (GRUNDFOS). The Complainant's company name and trademark GRUNDFOS is well-known all over the world. The Grundfos Group operates websites promoting its products and services on inter alia grundfos.com. The website grundfos.com receives approximately 20,000 visitors per month.

During the first phase of the sunrise-period the Complainant submitted an application for registration of the domain name GRUNFOS. As evidence of the Complainant's prior rights regarding "GRUNFOS" a legal opinion of a legal expert was submitted.

Complainant's conviction is that the Complainant solely has prior rights with regard to the designation GRUNFOS. As stated in article 10(1) of Commision Regulation (EC) No 874/2004 of 28 April 2004 (Public Policy Rules): "Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply 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 and community trademarks, geographical indications or designations of origin, and, in so far as they are 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."

Based on the very close visual resemblance between GRUNDFOS and GRUNFOS, the almost complete aural identity between GRUNDFOS and GRUNFOS and taking into account the reputation of the GRUNDFOS trademark it must be considered evident, that the designation GRUNFOS is confusingly similar to GRUNDFOS.

Complainant argues (with reference to the decision of 3 August 2005 in WIPO Arbitration and Mediation Center's case No D2005-0618:

Grundfos v Orion Web regarding domain name grundfospump.com) that any third parties registration and/or use of any designation identical with or similar to GRUNDFOS shall be considered to be contrary to the Complainant's trademark rights regardless of whether such designations are registered and/or used for goods or services similar to those provided by the Complainant or not, as such registration and/or use would clearly take unfair advantage of, or be detrimental to, the distinctive character or the repute of the GRUNDFOS trademark.

The Complainant's trademark rights based on the well-known registered trademark GRUNDFOS thus comprises an exclusive right to use and register not only the designation GRUNDFOS, but also the confusingly similar designation GRUNFOS.

It is thus evident that the Complainant holds "prior rights" with regard to the designation GRUNFOS within the meaning of article 10(1) of the Public Policy Rules and is thus entitled to apply for and have registered the domain name GRUNFOS.EU during the first phase of the sunrise period, cf. paragraph 11(1) of the sunrise-rules.

B. RESPONDENT

Art. 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (Public Policy Rules) 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. According to art. 12.3 of the same regulation 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.

The .eu Registration Policy and the Terms and Conditions, referred to as the Sunrise Rules, that apply for all applications during the phased registration period in accordance with art. 3 (d) of the said Regulation, provide under section 13.2 that it is sufficient to submit as documentary evidence a copy of an official document issued by the competent trademark office indicating that the trademark is registered, such as a certificate of registration. The documentary evidence must clearly evidence that the applicant is the reported owner of the registered trademark.

The Complainant has filed an application for the registration of the domain name GRUNFOS on the ground of a registered trademark and has submitted in due time as documentary evidence an extract from the certificate of the trademark GRUNDFOS under nr 1986 02852 issued by the Danish Patent og Varemaerkestyrelsen, a competent trademark office. However, this document does not evidence that the complainant has a prior right on the name GRUNFOS, the name protected by a trademark being GRUNDFOS. Therefore the Registry has rejected the application.

The Complainant claims that, based on the very close visual resemblance between GRUNDFOS and GRUNFOS and the almost complete aural identity between GRUNDFOS and GRUNFOS it must be considered evident, that the designation GRUNFOS is confusingly similar to GRUNDFOS and that his rights based in the well-known trademark GRUNDFOS comprises an exclusive right to use and register the similar designation GRUNFOS. However, article 10.2 of the Regulation No 874/2004 provides 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 right exists. The complete name for which the prior right exists as written in the documentation is GRUNDFOS and the Registry is not allowed to register another name, how similar this name might be. Moreover, there is no legal basis for the argument that a trademark would give an exclusive right to the use of a similar word.

DISCUSSION AND FINDINGS

According article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (Public Policy Rules), the holders of prior rights and public bodies shall be eligible to apply to register domain names during a period of phased registration. Prior rights shall be understood to include registered national and community trademarks, geographical indications or designations of origin, and, as far as they are 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.

According article 12 (2) of Public Policy Rules, phased registration shall be comprised of two parts. According Section 11 (1) of the .eu Registration Policy and the Terms and Conditions (Sunrise Rules), during the first part only registered national and Community trademarks, geographical indication or designations of origin may be applied for as domain names. During the second part, the names that can be registered in the first part as well as names based on all other prior rights can be applied for as domain names.

The aim of the phased registration (Sunrise period) of the .eu domain names was to ensure, that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights (see Preamble of Public Policy Rules, sec. 12). The aim was not to

claim all similar words which could interfere with holders' "prior rights".

There are no doubts that trademark "GRUNDFOS" is registered well known trademark.

However, the registration of domain name "GRUNFOS" was requested. The application (filled in the first part of the phased registration – Sunrise period) for the registration was based on the fact, that "GRUNFOS" is confusingly similar to the registered trademark "GRUNDFOS". During the first part of the phased registration (started on December 7, 2005) only holders of registered trademarks, geographical indication and designations of origin were entitled to register the appropriate domain name. As the Complainant did not prove that the word "GRUNFOS" is the "registered trademark" nor "geographical indication" nor "designation of origin", the Respondent had to reject the application for registration of the domain name "GRUNFOS" irrespective of the similarity of GRUNFOS and GRUNDFOS designations. The Complainant's trademark rights based on the well-known registered trademark GRUNDFOS comprise an exclusive right to use and register the designation GRUNDFOS and prevent the using and/or registration of the confusingly similar designations by the third parties, but does not constitute the exclusive right to register such similar designation during the first part of the Sunrise period.

Even if the application would be filled in the second part of the phased registration, the application should be rejected. During the second part (started on February 7, 2006) holders of all kind of prior rights according article 10 (1) of the Public Policy Rule were entitled to register the appropriate domain name. However, the Complainant didn't prove that he had any prior right to the word "GRUNFOS":

1. The provided legal opinion states that "GRUNFOS" is confusingly similar to the trademark "GRUNDFOS", but doesn't contain any declaration that the similarity of one word to the registered trademark constitutes a prior right of the holder of such trademark to use the respective word or prevent third parties from using the respective word and that such prior right is protected under the law (as required in section 12 (1) of the Sunrise Rules - … Applicant must submit Documentary Evidence containing an affidavit … declaring that the type of Prior Right claimed by the Applicant is protected under the laws of the relevant member state).

2. The provided WIPO decision (Grundfos v Orion Web) doesn't state that the Complainant has protection for the complete name for which a prior right is claimed, as the judgment refers to domain name containing "GRUNDFOSPUMP" and not "GRUNFOS" (see section 12 (2) of the Sunrise Rules - … arbitration decision … stating that the Applicant has protection for the complete name for which a Prior Right is claimed).

3. There is no evidence, that name "GRUNFOS" is the unregistered trademark (section 15 of the Sunrise Rules), company name, trade name and business identifier (section 16 of the Sunrise Rules), family name (section 17 of the Sunrise Rules) nor distinctive title of protected literary and artistic work (section 18 of the Sunrise Rules) and the Complainant didn't claim a prior right to this name on this basis.

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	**Petr Hostas**

DATE OF PANEL DECISION 2006-05-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The ADR Proceeding related to a Complaint challenging the decision of the Registry to reject the application for the registration of the disputed domain name filled in the first part of the Sunrise period. The Complaint was based on the fact that the disputed domain name was confusingly similar to registered trademark of the Complainant and that the similarity constituted the prior right to the registration of disputed domain name.

The Panel agreed with the decision of the Registry to reject the application of the disputed domain name GRUNFOS. The Complainant's trademark GRUNDFOS is registered well known trademark. However, Complainant did not prove that he had any prior right related to name GRUNFOS. The fact, that name GRUNFOS is confusingly similar to trademark GRUNDFOS, is not relevant and cannot be used as an argument for the registration of domain name GRUNFOS during the first part of the Sunrise period.