Panel Decision for dispute CAC-ADREU-000713

Case number	CAC-ADREU-000713
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Domain names	huettinger.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Michael Reiser

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 pending legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

The Complainant applied for the domain name huettinger.eu on December 7, 2005. The application was based on the German composite trademark n° 39517834 registered on March 29, 1996 by Fritz Huttinger Elektronik GmbH. The trademark was acquired by HUTTINGER GmbH + Co. KG in February 20, 2003 which authorised TRUMPF GmbH + Co. KG to apply for the disputed domain name as licensee.

A. COMPLAINANT

The Complainant contends that the application was based on the German composite trademark "Hüttinger", whereas the word "Hüttinger" is the formative part of the trademark and the word "Hüttinger" is written "Huettinger" as the written form provides no "ü" and therefore "Huettinger" is pronounced in exactly the same way as "Hüttinger".

The Complainant also states that “Alternatively we base the application of the domain "huettinger.eu" also on the company name HÜTTINGER GmbH + Co. KG”.

The Complainant points out that:
- the word element dominates in the picture/text marker "Hüttinger" as it is distinctly separated from the picture element and can therefore be clearly distinguished;
- all characters contained in the word element are contained in the domain name applied for since the alphanumerical character "ü", in conformity with general practice, is rendered as the phonetically identical character "ue";
- the sequence of characters in the word element could not be read in the wrong order. In particular, it is not possible for the stylized "H" in the center of the logo to be misinterpreted as part of the word element since word element and picture element are distinctly and unmistakably separated from each other.

For these reasons, the Complainant considers the decision made by the Respondent to be wrong and requests that the domain "huettinger.eu" be assigned to TRUMPF GmbH + Co. KG.

B. RESPONDENT

The Respondent states that the disputed domain name was applied for on December 7, 2005 during the first phase of the Sunrise. During this period only registered trademarks, geographical indications and the names and acronyms referred to in Article 10 (3) of the Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") will be accepted as prior rights. Hence, the Complainant would have not been entitled to base its application on a company name during the first phase of the sunrise period. The

Respondent further indicates that the Complainant's reference to its company name is therefore not relevant in the present case.
With reference to the rejection of the application, the Respondent highlights the following grounds:
- article 10 (2) of the Regulation stating that a domain name applied for during the Sunrise Period must consist of the complete name of the prior right on which the application is based.
- Article 19 (2) of the Sunrise Rules stating that: “documentary evidence must clearly depict the name for which a prior right is claimed. 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 real possibility of misreading the characters of which the sign consists or the order in which those characters appear”

The Respondent states that the trademark registration submitted by the Complainant as documentary evidence consisted of the following alphanumeric characters: HH HÜTTINGER.

The Respondent contends that when applying section 19 (2) of the Sunrise Rules, one must distinguish the alphanumerical characters from their stylized appearance and in the present trademark registration the stylized characters clearly depict alphanumerical characters, even predominant over their stylized appearance.

In the present case, all alphanumerical characters must also be contained in the domain name applied for leading to the following result: HH-HUETTINGER or HHHUETTINGER with the hyphen that could have been included pursuant to article 11 of the Regulation.

The Respondent highlights that domain name HUETTINGER does not consist of the complete name of the trademark registration, as not all alphanumerical characters depicted in the trademark have been included in the domain name applied for.

The Respondent concludes that the Complaint must be rejected.

DISCUSSION AND FINDINGS

The article 10.1 of the Regulation 874/2004 states that “holders of prior rights recognised 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”

The owner of the trademark, on which the application is based, is HUTTINGER GmbH + Co. KG which has acquired it from Fritz Huttinger Elektronik GmbH. The Complainant, TRUMPF GmbH + Co. KG, is the legitimate licensee of the trademark’s owner.

Therefore, the Panel finds that the Complainant was entitled to apply for a domain name according to the Article 12.2 of the Regulation.

In light of the articles 10.1 and 12.2 of the Regulation, holders of company names shall be eligible to register domain names only during the second sunrise period. Therefore, the Panel finds that the Complainant's reference the company name of the licensor as an alternative basis for the application should be disregarded in the present decision.

Article 10.2 of the Regulation 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 a right exist.” The Complainant, based its domain name application for HUETTINGER on the composite German trademark consisting in the word HUTTINGER and two stylised letters H, one smaller included into the other in contrasting colors.

The Article 11 of the Regulation states that “Without prejudice to the third paragraph of Article 6, if the prior right name contains letters which have additional elements that cannot be reproduced in ASCII code, such as ä, é or ñ, the letters concerned shall be reproduced without these elements (such as a, e, n), or shall be replaced by conventionally accepted spellings (such as ae). In all other respects, the domain name shall be identical to the textual or word elements of the prior right name.”

Therefore, the Panel finds that the verbal portion of the registered trademark was correctly reproduced in HUETTINGER.

The Article 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 real possibility of misreading the characters of which the sign consists or the order in which those characters appear”

In the present case, the Panel finds that the composite mark does not comprise exclusively the name HUETTINGER but also the stylised letters HH. The word element HUETTINGER is not predominant and the letters “HH” contained in the composite trademark must be interpreted, for the purposes of article 19.2 (a) of the Sunrise Rules, as alphanumeric characters.

Therefore the Panel finds that the letters HH should have been included in the domain name application as also decided in the case N. 00470 O2 Developpement v. EURid (O2), case N. 01053 SANTOS Jacques Fouquet v. EURid (SANTOS) and Case N. 01438 Ellison Educational Europe, Ltd. v. EURid (ELLISON).

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	**Luca Barbero**

DATE OF PANEL DECISION 2006-08-29

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, based its domain name application for HUETTINGER on the composite German trademark consisting in the word hüttinger and two stylised letters H, one smaller included into the other in contrasting colours pointing out that it was not possible for the stylized "H" in the center of the logo to be misinterpreted as part of the word element.

The Respondent considered that the Complainant’s application did not consist of the complete name of the prior right on which the application was based as not all alphanumerical characters depicted in the trademark have been included in the domain name applied for, thus rejecting the application.

In light of Article 10.2 of the Regulation and Article 19.2 of the Sunrise Rules states, the Panel found that the composite mark did not comprise exclusively the name HUETTINGER but also the stylised letters HH. The word element HUETTINGER was not predominant and the letters “HH” contained in the composite trademark must be interpreted, for the purposes of article 19.2 (a) of the Sunrise Rules, as alphanumeric characters.

The Panel found that the letters HH should have been included in the domain name application and the Complaint was therefore denied.