Panel Decision for dispute CAC-ADREU-000903

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Case administrator

Name	Josef Herian

Complainant

Organization / Name	Siemens-Betriebskrankenkasse Koerperschaft des oeffentlichen Rechts

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 other legal proceedings concerning the disputed domain name are currently pending.

FACTUAL BACKGROUND

The Siemens-Betriebskrankenkasse Koerperschaft des oeffentlichen Rechts, an entity duly incorporated under the Laws of the Federal Republic of Germany. Its place of incorporation and principal place of business is Munich, Germany. The Complainant is a health insurance and carries the full name “Siemens Betriebskrankenkasse” and is commonly known under the acronym SBK.

The application for the domain name has been initiated by Siemens-Betriebskrankenkasse through its Chairman, Dr. Hans Unterhuber.

Mr. Unterhuber application was the first in the queue, but the Registry concluded that the documentary evidence did not show that Dr. Hans Unterhuber was the holder of a prior right in the name SBK (the prior right was in the name of Siemens-Betriebskrankenkasse Koerperschaft des oeffentlichen Rechts).

The domain name was subsequently allocated the next applicant in the queue, which the Complainant believes it has been done without due regard to the existence of a prior right in the name of the applicant.

This dispute concerns the Respondent's decision to reject Complainant's application as well as its decision to allocate the domain name to the next applicant in the queue.

A. COMPLAINANT

The Complainant carries the full name “Siemens Betriebskrankenkasse” and is commonly known under the acronym SBK. This Acronym is commonly used and therefore generally known as “SBK” in accordance with Art. 10 (3) of the EU Regulation 874/2004.

The Complainant is also holder of the German word-/picture mark “SBK” which has been registered for the Complainant under the registration no. 30229122 with priority from 12 June 2002. The main and predominant element of this mark is the term “SBK”.

The application for the domain name has been initiated by Siemens-Betriebskrankenkasse through its Chairman [Dr. Hans Unterhuber].

The electronic forms for filing an application for a domain name at EURid requires first and last name of a natural person acting on behalf of an Organization.

The Applicant SBK Advies & Training The SBK Advies & Training has also applied for the domain name sbk.eu. This third party is owner

of the Benelux trademarks “SBK Advies & Training” with the registration no. 641720 and 723218 both of which are word-/picture marks. These trademarks consist of the wording “SBK”, but also both include the terms “Advies & Training” and a variety of picture elements. This third party is also not even the owner of the domain name sbk.nl.

On 17 March 2006 12:18 the Processing Agent issued the Rejection of the Application. EURid sent out an E-Mail to the Complainant. The Rejection was not issued by any other means of communication. The grounds on which the Rejection was based on was that the Domain name was to be attributed to the third party applicant who applied for the same domain name. The Rejection did not include any details or further reasons. The rejection concerns the registration of a domain name within the first sunrise phase. This rejection is the disputed decision of the registry according to the ADR Rules Section B 1 (b) (8).

The Complaint is based on the following grounds: A. Annulment of the Rejection The Attribution of the Domain Name sbk.eu must be annulled as the prior rights claimed by the third party Applicant are nonexistent and cannot have been proven through the appropriate Documentary Evidence by the third party applicant.

1. No Prior Rights. Under Article 14 and 10 (1) and (2) of Commission Regulation No. 874/2004 the applicant must clearly show evidence of the prior right that he claims for the domain name application. In this case the applicant, SBK Advies & Training, has based the domain name application upon a national Benelux mark. This means that the applicant was obliged to present a national Benelux mark to the Registry that meets the criteria of Article 10 and Article 14 of Commission Regulation No. 874/2004. In this specific case the applicant based its application on a Benelux mark that has been registered at the Benelux Trade Mark Office under the Registration Numbers 723218 and 641720. It has to be pointed out that these marks are no word marks (verbal marks) but simply figurative marks as shown in Annex C3.

The conditions laid down according to Section 19 of the Sunrise rules have not been fulfilled by the applicant and the Registry’s decision therefore constitutes a breach of Article 14 of Commission Regulation No. 874/2004 of 28 April 2004, Article 10 (1) and (2) of Commission Regulation No. 874/2004 and Section 19 of the Sunrise Rules.

Both trademarks on the other hand have been registered for the commercial partnership “SBK Advies en Training B.V.”. The different spelling of the owner of the trademark and the applicant for the domain name and the missing reference to the legal entity “B.V.” clearly show that it is not the Applicant for the domain name who is the owner of the trademarks. Therefore, the Applicant is not able to prove that he is the owner of the trademarks presented to the processing agent. The attribution of the domain name to the third party applicant is a clear breach of the Art. 10 (1) of the EU Regulation 874/2004, as the Applicant is not the owner of the presented trademarks and also has not presented a Licence Declaration for a Registered Trade Mark to the processing agent.

B. RESPONDENT

Respondent allegations

The Complaint is directed against two decisions made by the Registry with regard to the sbk.eu domain name.

The Registry first rejected the application of the first applicant in the queue and then accepted the application by the second applicant in the queue.

Dr. Hans Unterhuber applied for the domain name SBK on December 7, 2005 and was the first in the queue. SBK Advies & Training (hereafter "the Applicant") applied for the domain name SBK on December 7, 2005.

As the Registry concluded that the documentary evidence did not show that Dr. Hans Unterhuber was the holder of a prior right in the name SBK, it rejected Dr. Hans Unterhuber's application for the SBK domain name. It appears that Dr. Hans Unterhuber is one of the Complainant's employees.

As the Registry concluded that the documentary evidence showed that the Applicant was the holder of a registered trademark at the time of validation, the Applicant's application for the domain name SBK was accepted.

2. COMPLAINANT'S CONTENTIONS With regard to the Registry's decision on Dr. Hans Unterhuber's application, the Complainant argues that this application was made by the holder of a valid German trademark consisting of the sign SBK. The Complainant argues that the Registry should not have rejected this application and requests the Panel to annul the Registry's decision on this matter. With regard to the Registry's decision on the Applicant's application, the Complainant argues that the Applicant submitted a device mark which reads "SBK Advies & training".

3. RESPONSE
3.1 The Registry's decision with regard to Dr. Hans Unterhuber's application Section 26 of the Sunrise Rules clearly states that ADR proceedings against a decision by the Registry must be initiated 40 calendar days following that decision. The ADR Rules states that the Sunrise Appeal Period is the 40 day period during which a Complaint against the Registry's decision to register (or reject) a domain name within the sunrise period can be filed as specified in the Sunrise Rules. The whois for the SBK domain name states that the deadline for ADR proceedings against the Registry's decision to reject Dr. Hans Unterhuber's application was March 8, 2006. The present Complaint however was submitted on April 21, 2006, which is more than one month after the deadline. Therefore, the Complainant's complaint on this matter must be rejected.

3.2 The Registry's decision with regard to the Applicant's application (a) Complete name of the trademark In its Complaint, the Complainant refers to two Benelux device marks which were registered by the Applicant and which consist of the slogan "SBK Advies & training" and states that these must have been the trademarks which the Applicant submitted as documentary evidence. However, the documentary evidence to the Applicant's application did not contain these trademarks. The Applicant submitted another Benelux trademark which consisted only of the sign SBK. As the domain name SBK corresponds to the complete name of this Benelux trademark, the Registry's decision is in line with article 10 (2) of the Regulation.

(b) Name of the applicant The English translation of the Dutch word "en" is "and", which is also the meaning of the ampersand sign. It is common in the Dutch language to transcribe an ampersand in "en". As "SBK advies & training" is identical to "SBK advies en training", the Complainant's argument that the Applicant of the domain name (SBK advise & training) is a different entity from the owner of the SBK trademark (SBK advies en training) cannot be accepted. Moreover, the Complainant itself states in its Complaint that This third party [SBK advies & training] is the owner of the Benelux trademarks "SBK advies & training" whereas these trademarks also mention "SBK advies en training" as the owner. The Complainant itself seems to agree that it is the same company. For the reasons mentioned above, the Complaint must be rejected.

DISCUSSION AND FINDINGS

1. Procedural issue

First of all, the Panel must define the proper scope of the present dispute.

As stated in the parties' contentions, there is a decision from the Registry rejecting the Complainant's application for the domain name <sbk.eu> ("decision of rejection"). Also, there is a decision allocating the domain name to the next applicant in the queue ("allocating decision").

It is not clear from the parties' contentions whether the Complaint is directed against both the "decision of rejection" and the "allocating decision", or only to the latter.

The Complaint only includes incidental references to the inappropriateness of the "decision of rejection" without clearly putting forward any arguments to challenge it.

The Respondent, in turn, considers that the Complaint is also directed against the "decision of rejection", but argues that the deadline to challenge such decision lapsed and therefore, cannot be appealed. This Panel notes however, that according to the information provided by the Complainant (not contested by the Respondent), the "decision of rejection" is dated 17 March 2006. It should also be noted that the Respondent, at the request of the Czech Arbitration Court, stated in the Eurid Verification that the date of commencement of the Sunrise Appeal Period with respect to the Complainant and the disputed domain name is 18 March 2006.

The Complaint was filed on 21 April 2006 and is therefore within the 40-calendar day deadline provided for in Section 26 of the .eu Sunrise Rules.

In order to avoid any potential doubt, and absent procedurally any obstacles, this Panel understands that the Complainant also intended to challenge the "decision of rejection" and will, therefore, review it along with the "allocating decision".

2. Discussion and Findings

A. The "decision of rejection"

Article 10.1 of the Regulation 874/2004 states that “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.”

It follows from that Article that only the "holder" of a prior trademark right is eligible to file an application for a domain name in the Sunrise period.

The Complainant filed an application for the disputed domain name through its Chairman, Dr. Hans Unterhuber. However, the holder of the prior right submitted is not Dr. Unterhuber, but his company Siemens-Betriebskrankenkasse Koerperschaft des oeffentlichen Rechts.

Therefore, Dr. Unterhuber was not eligible to file an application for the domain name <sbk.eu> during the Sunrise period, but only his company.

This argument is further supported by the Complainant itself when contesting the "allocating decision" based on the difference between the domain name applicant ("SBK Advies & Training") and the holder of the trademark submitted ("SBK Advies en Training B.V."). Accordingly, this Panel confirms the Registry’s "decision of rejection" and denies the Complaint regarding that decision.

B. The "allocating decision"

The Complainant's main arguments to challenge the "allocating decision" are as follows:

(i) that the marks submitted by the next applicant in the queue cannot serve a basis for the application of the disputed domain name due to the lack of correspondence between the domain name and the marks; and

(ii) that there are a number of differences between the domain name applicant ("SBK Advies & Training") and the holder of the trademark submitted ("SBK Advies en Training B.V.").

Regarding the first argument, the Respondent contends that the applicant which was allocated the disputed domain name had submitted a Benelux trademark identical to the domain name. At the request of this Panel, the Respondent forwarded a copy of Benelux trademark No.0776762 for the word-mark SBK.

The Panel is satisfied that the mentioned Benelux trademark completely corresponds to the disputed domain name and rejects the Complainant’s argument on this point.

As for the second argument i.e. the difference between the domain name applicant ("SBK Advies & Training") and the holder of the trademark submitted ("SBK Advies en Training B.V."), the Panel notes that such differences are the substitution of the Dutch word "en" (in English, "and") for the "&" (ampersand) symbol and the absence in the domain name application of the form of incorporation of the applicant ("B.V.")

This Panel considers these differences immaterial since there is sufficient documentary evidence in the case record to establish that the domain name applicant and the trademark holder are one and the same. Those differences become even more irrelevant based on the fact that the next applicant in the queue (after Dr. Unterhuber and “SBK Advies & Training”) is "SBK Advies & Training B.V.", with identical contact details as the second applicant and which, in the event the Complaint was awarded, would be allocated the disputed domain name.

However, this Panel does not consider necessary that the disputed domain name is allocated to the next applicant in the queue since the arguments put forward by the Complainant are not sufficient to annul the Registry’s “allocating decision”. Thus, the Panel rejects the Complaint and confirms the “allocating decision”.

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	José Checa

DATE OF PANEL DECISION 2006-07-12

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant (a company incorporated in Germany) filed an application for the domain name <sbk.eu> in the name of its Chairman. However, the holder of the prior right on which the application was based was the company, and not its Chairman. The Registry rejected such application and allocated the domain name to the next applicant in the queue.

Besides the decision of the Registry rejecting its application, the Complainant also challenges the decision of the Registry allocating the domain name to the next applicant in the queue based on the arguments that the domain name does not correspond to the prior right submitted as the basis for the application and that the next applicant in the queue does not correspond to the holder of the prior right.

The Panel rejects the arguments put forward by the Complainant and denies the Complaint.