Panel Decision for dispute CAC-ADREU-001260

Case number	CAC-ADREU-001260
Time of filing	2006-05-11 13:25:07
Domain names	guj.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Gruner + Jahr AG & Co KG, Achim Diekmann

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 or decided legal proceedings which may affect the disputed domain name.

FACTUAL BACKGROUND

On 29 March 2006 the Registry refused registration of the Complainant's domain name application for GUJ.eu, filed on 7 December 2005 during the first sunrise period.
The Applicant/Complainant has a registered German trademark for G+J under the Reg. No. 2084936.
The Complainant had technical problems in filing its Complaint and the Registry granted a few more days also for the amendment of some defaults made by the Complainant.
Finally, the Complaint was properly filed and notified to the respondent (Eurid) on 29 May 2006.
The Respondent then had thirty days to file its response, but it did not meet this deadline and filed its response on 19 July 2006, after the thirty-day term established by the ADR rules.

A. COMPLAINANT

The Complainant is the owner of the registered German trademark No. 2084936 for a trademark G+J. On this prior right, the Complainant filed its .eu domain name application for GUJ.
The Complainant believes that the Registry decision to reject its application is in violation of the European Union Regulations – in particular, art. 11 of reg. 874/2004 – because, in its opinion, the special character + is one of those comprised in the list of art. 11 Reg. 874/2004, and therefore, according to this provision, it could be rewritten as it did. In its reasoning, + means AND (UND in German) and UND in German can be abbreviated by U. Therefore, the proposed translation of G+J is GUJ.
To support its view, the Complainant has filed two excerpts taken from German dictionaries (i.e. Duden, a reference book for German spelling, and WORTSCHATZ LEXIKON). In these documents it is stated that U. is the abbreviation of UND.
The Complainant's arguments are also supported by documents concerning the Complainant's use of GUJ, which could be seen on the Corporate website of the applicant/Complainant, and by the fact that they have other GUJ domain names: namely www.guj.de, www.guj.com and www.guj.pl.

B. RESPONDENT

The Respondent did not file its response within the deadline. Therefore, its arguments, filed after the thirty day term, have not been taken into consideration.

DISCUSSION AND FINDINGS

The failure by Eurid to respond timely is not taken as grounds to accept the Complainant's claims and arguments.

In order to examine whether or not the Registry acted contrary to its duties it is necessary to take into consideration two provisions (or parts of them) relating to the sunrise period:
Art. 19.2 of the .eu registration Policy, published in accordance with art. 21.1 of the Public Policy Rules, reads as follows “a prior right …. will only be accepted if (i) the sign exclusively contains a name or (ii) the word element is predominant… provided (a) omissis (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”.
Art. 11, par. 1, of Reg. 874/2004 reads as follows: “as far as the registration of complete names is concerned, where such names comprise a space between the textual or word elements, identicality shall be deemed to exist between such complete names and the same names written with a hyphen between the word elements or combined in one word in the domain applied for”.
And art. 11, par. 2, of Reg. 874/2004 reads “where the name for which prior rights are claimed contains special characters, spaces or punctuations, these shall be eliminated entirely from the corresponding domain name, replaced with hyphens or, if possible, rewritten”.
+ is one of those characters.
From the above-mentioned laws it seems very clear that there must be “identicality” between trademarks and requested domain names.
The said provisions are guidelines to follow in order to achieve that aim: identity between prior rights and a domain name.
Art. 11 offers a choice of three solutions in order to convert a trademark which has special characters or punctuations as indicated in the same provision. + is one of those. In these cases, the special characters or punctuations have to be (i) eliminated entirely from the corresponding domain name, (ii) replaced with hyphens, or, if possible, (iii) rewritten.
The best decision has to be taken in order to maintain the identity rule between a trademark and domain name, taking into consideration that, if possible, the domain name should be rewritten in order to meet the identity rule.
As stated in a previous decision of this Panel (LIVE case No. 00265) identity means
“The quality or condition of being exactly the same; identicalness, oneness, sameness, selfsameness. Therefore, the ‘exact sameness of the things compared’ needs to be stressed”.
The registered trademark No. 2084936 could have been translated as GPLUSJ, because + (in any language) immediately means PLUS and only indirectly may stand for AND (or UND). In the Complainant’s view, + is equal to UND. But the Applicant did not choose to translate + with UND, but made another free interpretive step: UND and U are the same because the latter is always taken as UND. Therefore, G+J is equal to GUJ.
I do not agree with this argument. I believe that in this case, too, the concept of identity has to be construed strictly, but, at the same time, it should not take into account minimal or insignificant changes which are not noticeable.
In the documents filed by the Complainant itself, it is self-evident that U. may stand for UND, but the same cannot be said in relation to a mere U without a dot. Furthermore, as regards the domain name GUJ, nobody would take the middle U as short for UND: they would take GUJ as an invented word or a name, but never as a G UND (u.) J.
The only case in which U, in the middle of an acronym, is taken as UND is KUK – Kaiserlich Und Königlich (meaning Imperial and Royal), and this is known from history books and long-standing traditional heritage. Of course, this is an exception that confirms the rule.
The reasoning and logical steps taken by the Complainant to justify its Complaint and its eligibility to the disputed domain name are both contested and cannot be accepted. The special character + means PLUS (also in German) and thus cannot be rewritten under art. 11 of reg. 874/2004 as AND. Furthermore, even the second step cannot be accepted: if u. (with a dot) may – in special circumstances – stand for und, a U without a dot put in the middle of a name or a word will never be taken as the abbreviation of und. Therefore, the identicality principle is not met by the Applicant and the Registry’s decision has to be held.
The Complainant has also filed documentary evidence showing that GUJ has been used in its website and in different domain names owned by it. However, these documents and rights cannot support an application filed in the first sunrise period, which is only open to registered trademark owners. They could, though, support an application made in the second sunrise period.

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	**Massimo Cimoli**

DATE OF PANEL DECISION 2006-08-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Applicant/Complainant filed an application for GUJ in the first sunrise period on the basis of the Registered German trademark G+J No. 2084936, claiming that under art. 11 of reg. 874/2004 the special character + could have been rewritten as GUJ: U. is, in fact, the

abbreviation of the German word UND (i.e. AND).
The Panel does not agree with this interpretation of the identicality principle. Two reasons are given:
1) The special character + means PLUS and does not mean AND (or UND), at least literally. It may be taken as AND in its lato sensu meaning, but the symbol stands for PLUS.
2) As shown in the Complainant's evidence, UND in German can be abbreviated as u. (with a dot after the vowel). Thus, U without a dot does not have the same meaning. If you put just a U in the middle of a name or acronym or a word, this letter will never be taken as the abbreviation of UND.
The use claimed by the Complainant could have been a valid prior right in the second sunrise period. In the Applicant/Complainant's application, filed on 7 December 2005, the only grounds claimed for obtaining a .eu domain name were those based on a registered trademark (or a geographical indication, which, however, was not applicable in the present case) and not on the use of the trademark itself.