Panel Decision for dispute CAC-ADREU-001310

Case number	**CAC-ADREU-001310**
Time of filing	**2006-06-16 09:51:19**
Domain names	**astrodata.eu**

Case administrator

Name	**Eva Zahořová**

Complainant

Organization / Name	**Astrodata AG, Christian Wüthrich**

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 other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

1. The Complainant is ASTRODATA AG, Albisriederstraße 232, CH-8047 Zurich, a private company, organised under the laws of Switzerland.

2. The Complainant is the owner of trade marks for ASTRODATA + Device in Switzerland, Austria, Benelux, Germany, Spain, France, Hungary, Italy and various other countries.

3. The Complainant has, prior to receipt of the domain name application by the Registry, entered into a licence agreement concerning the use of the international trademark No. 507 490 ASTRODATA + Device with Esther Klinghammer, Apostelnstr. 20, 50667 Köln, a natural person resident within the Community as referred to under Article 4(2) (b) (iii) of Regulation (EC) No. 733/2002 of the European Parliament and of the Council of 22 April 2002. In this licence agreement Complainant authorised Esther Klinghammer to apply for the Domain Name <astrodata.eu> during the Phased Registration Period.

4. The licencee, Esther Klinghammer, has applied to register the disputed domain during the first phase of the Phased Registration Period. The application corresponds with the formal and substantial requirement set forth in Sec. 11 ss. of .eu Surise Rules.

5. EURid refused to register the domain name <astrodata.eu> because of an “incorrect transcription of the figurative sign” which was in conflict with Section 19 (2) (a) of the Sunrise-Rules.

A. COMPLAINANT

6. The Complaint contends as follow:

According to Section 19 (2) of the Sunrise Rules, all alphanumeric character have to be included in the domaine name, but it applies only if the trademark contains a character which can be separated from the figurative element of the trademark but does not require that a figurative element which merely creates the figurative impression of a character and cannot be separated from the figurative element to be reproduced in the domain name.

7. The Complainant’s trademark consists of the word element ASTRODATA and a figurative element, which consists of a stylized star consisting of 6 overlapping triangles, but does not contain a separate alphanumeric character. The world element ASTRODATA is identical with the domain name applied for.

8. Therefore a figurative element which cannot be reproduced in a domain name does not have to be transliterated but has to be eliminated from the corresponding domain name.

9. According to the Complainant, it has got a prior right on the name ASTRODATA, and it has properly licensed its prior right to the Applicant in view of the application for the ASTRODATA domain name. Therefore EURid's decision to refuse the registration <astrodata.eu> has to be annulled and the domain name <astrodata.eu> has to be registered in favour of Esther Klinghammer.

B. RESPONDENT

10. The Respondent contends as follow:

Article 10 (2) of the Regulation (EC) N° 874/20004 of 28 April 2004 (hereafter "the Regulation") 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.

11. Section 19 (2) of the Sunrise Rules states that 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 the sign exclusively contains a name or if 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 in which 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".

12. According to the Respondent, the domain name based on this prior right must consists of all alphanumerical elements, disregarding only the device elements.
The figurative trademark submitted as documentary evidence by the Applicant consists of the following elements:
- an alphanumerical character "A" printed in bold,
- a device element (i.e. a star) reproduced in the background of the letter "A", and
- the word "ASTRODATA" printed in bold.

13. Therefore, this trademark is comprised of the following alphanumerical elements: "A ASTRODATA". Consequently, pursuant to section 19 (2) of the Sunrise Rules, this trademark establishes a prior right on the sign A ASTRODATA, but not on the sign ASTRODATA as such.

For all these reasons, the Complaint must be rejected.

DISCUSSION AND FINDINGS

14. In consideration of the Factual Background and the Parties' Contentions stated above, the Panel comes to the following conclusions:

Article 10 (1) of the Regulation states that only holders of prior rights which are 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.

Article 10 (2) of the Regulation 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.

Section 19 (2) of the Sunrise Rules states that 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 the sign exclusively contains a name or if 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 in which 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".

15. However, under Section 26.2 of the Sunrise Rules, it is stated that the "sole object and purpose of an ADR Proceeding against the Registry is to verify whether the relevant decision by the Registry conflicts with the Regulations". In the Definitions of the Sunrise Rules, "Regulations" are defined as "the .eu Regulation and the Public Policy Rules," the former meaning EC Regulation 733/2002 and the latter EC Regulation 874/2004. Article 22.11 of EC Regulation 874/2004 also states that in "the case of a procedure against the Registry, the

ADR panel shall decide whether a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002," and not if it conflicts with any other rule (see Case n° 1047, FESTOOL).

16. Therefore, this Panel is of the view that, while the Sunrise Rules may lay down technical and administrative measures to ensure a proper, fair and technically sound administration of the phased registration period, they may not give additional grounds for the rejection of applications which otherwise comply with the Regulations (see Case n° 1071, ESSENCE). Therefore the Panel has to assess this Case on the basis of the Regulations themselves and, while the Sunrise Rules should not be disregarded when considering the Regulations, the Rules are only persuasive and do not constitute a binding interpretation or amendment of the Regulations.

17. As a consequence, it is the Panel's opinion, nevertheless using Section 19 (2) of the Sunrise Rules in order to interpret Article 10 (2) of the Regulation, that the Complainant's trademark consists of the predominant word element ASTRODATA and a figurative element, which consists of a stylized star consisting of 6 overlapping triangles drawing a kind of "A", but does not contain a separate alphanumeric character from the figurative element. Moreover, 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 appears.

18. As the rationale of EC Regulations 733/2002 and 874/2004 is to safeguard prior rights recognized by Community or national law (see Recital 16 of the former and Recital 12 of the latter), and considering the Complainant's trademarks, ruling that the Respondent's decision is lawful would be contrary to the principles of the Regulations.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the EURID's decision be annulled and that the domain name ASTRODATA be transferred to Esther Klinghammer, Apostelnstr. 20, 50667 Köln (Deutschland).

PANELISTS

Name	**Frédéric Sardain**

DATE OF PANEL DECISION 2006-09-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

EURid refused to register the domain name <astrodata.eu> because of an "incorrect transcription of the figurative sign" which was in conflict with Section 19 (2) (a) of the Sunrise-Rules.

However, the Panel must decide only on the basis of the Regulations themselves and, while the Sunrise Rules should not be disregarded when considering the Regulations, the Sunrise Rules are only persuasive and do not constitute a binding interpretation or amendment of the Regulations.

As a consequence, it is the Panel's opinion, using Section 19 (2) of the Sunrise Rules in order to interpret Article 10 (2) of the Regulation, that the Complainant's trademark consists of the predominant word element ASTRODATA and a figurative element, which consists of a stylized star consisting of 6 overlapping triangles drawing a kind of "A", but does not contain a separate alphanumeric character from the figurative element. Moreover, 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 appears.

The domain name is transferred.