Panel Decision for dispute CAC-ADREU-001364

Case number	CAC-ADREU-001364
Time of filing	2006-06-19 12:19:37
Domain names	gutscheinbuch.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Kuffer Marketing GmbH

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

FACTUAL BACKGROUND

1. The domain name application proceeding.
The Complainant, the Dutch company Kuffer Marketing GmbH applied, on December 7, 2005, for the registration of the domain name “gutscheinbuch.eu”, i.e. during the Sunrise period. On January 4, 2006, the documentary evidence was received, i.e. before the January 16, 2006 deadline. The Complainant submitted with its application two trademark certificates of the German (composite) trademarks n° 305 26 050 and 302 05 860. The Registry concluded from its examination of the documentary evidence that the Complainant did not have a prior right on the name GUTSCHEINBUCH, because of an error in the transcription of the composite trademarks. Consequently, the Registry rejected the application for the domain name “gutscheinbuch.eu”.

2. The ADR proceeding.
On May 12, 2006, Kuffer Marketing GmbH submitted a Complaint which was received in hardcopy on July 17, 2006 by the Czech Arbitration Court. The ADR proceedings formally started on July 17, 2006. On September 7, 2006, EURid sent its response to the Complaint.

A. COMPLAINANT

2. The Complainant argues that the German (composite) trademarks n° 305 26 050 and 302 05 860 grants it a prior right on the name GUTSCHEINBUCH.

2.1 “german trademark No. 302 05 860 - composition of designs and letters - is likely a umbrella trade mark for publication of abaout 230 books every year since 2002.The letters "gutscheinbuch" are to be added only by the name of a city or region:These added letters are not distinctive,elswhere the wording "gutscheinbuch" is distinctive as well. "gutscheinbuch" has acquired protection as title of work (sect. 5 al.3 German Trade Mark Act) since 2001,and also prominence as title "gutscheinbuch.de" since 2001 and "gutschein-buch.at" by intensive use of these domains for all publications above.Prominence as title by intensively using the domains is confirmed by earlier german jurisdiction (OLG Frankfurt " warez.de")”.

2.2 For the reasons mentioned above, the Complainant requests the annulment of Respondent’s decision and the registration of the domain name “gutscheinbuch.eu”.

B. RESPONDENT

3.The Respondent argues that:

3.1. Article 10 (2) of the Regulation states 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. Section 19 (2) of the Sunrise Rules further clarifies article 10 (2) of the Regulation for figurative or composite signs (such as the composite trademark in casu): "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 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". Pursuant to this section 19 (2) of the Sunrise Rules, the Registry must separate the alphanumerical elements from the device elements. The domain name based on this prior right must consist of all alphanumerical elements, disregarding only the device elements.

3.2 Trademark n° 305 26 050 which the Applicant submitted as documentary evidence consists at least of the following elements:
(1) A device element (the cover of a book with a picture) ;
(2) The word "www.Gutscheinbuch.de" ;
(3) The words "Eine Schiemmerreise mit dem Gutscheinbuch" This trademark is therefore comprised at least of the following alphanumerical elements: " WWW.GUTSCHEINBUCH.DE EINE SCHIEMMERREISE MIT DEM GUTSCHEINBUCH".

3.3 Trademark n°302 05 860 which the Applicant submitted as documentary evidence consists at least of the following elements: (3) A device element (the cover of a book with a picture) (4) The word "www.Gutscheinbuch.de" (5) The words "Gutscheinbuch Regensburg und Umgebung" This trademark is therefore comprised at least of the following alphanumerical elements: " WWW.GUTSCHEINBUCH.DE GUTSCHEINBUCH REGENSBURG UND UMGEBUNG".

3.4 Consequently, pursuant to section 19 (2) of the Sunrise Rules, this trademark could not establish a prior right on the name GUTSCHEINBUCH alone. As the Applicant applied for the domain name GUTSCHEINBUCH, but did not substantiate a prior right on the name GUTSCHEINBUCH alone, the Registry had no other option than to reject the Applicant's application.

3.5 For the reasons mentioned above, the complaint must be denied.

DISCUSSION AND FINDINGS

Article 10.1 Paragraph 2 of Regulation (EC) 874/2004 provides that "'Prior rights' shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in 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".

Article 12.2 of Regulation (EC) 874/2004 paragraph 3 states that " […] During the first part of phased registration, only registered national and Community trademarks, geographical indications, and the names and acronyms referred to in Article 10(3), may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in Article 10(1)".
Article 12.2 of Regulation (EC) 874/2004 paragraph 4 states that "During the second period of phased registration, 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 by holders of prior rights on those names".
Article 14 of Regulation (EC) 874/2004 paragraph 1states that "all claims for prior rights under Article 10 (1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists".
The Complainant sent as documentary evidence two German trademark certificates during the fourty days deadline.The Complainant refers in its complaint to a protection on "gutscheinbuch" as title of work under German law and, according to German case law, as domain names, to justifiy its prior rights on "gutscheinbuch".
These rights now claimed by the Complainant could not have been invocked at the time of the domain name application since this application was submitted during the first Sunrise period that was not opened to holders of such rights.
These rights have not been examined during the validation process and can not be taken into consideration by the Panel.
Regarding the Complainant's trademark rights, the Panel refers to Article 10.2 of the Regulation, which 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".
The two composite trademarks consist of the cover of a book with a picture and other words than "gutscheinbuch".The Compainant alleges that the other words contained in the trademarks are not distinctive but it does not belong to the Panel to appreciate the scope of the Complainant's prior rights (case n° 01427, Bonollo).
The Respondent's decision to refuse to register the disputed domain name "gutscheinbuch.eu" was consequently correct and does not

conflict with EC Regulations.

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	Marie Emmanuelle Haas

DATE OF PANEL DECISION 2006-09-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed an application for the domain name “gutscheinbuch.eu” on the basis of two German composite trademarks including the term “gutscheinbuch” among other words and a device element.
The Respondent rejected the Complainant’s application on the ground that there was an error of transcription between the trademarks and the domain name applied for.
The Complainant refers in its complaint to a protection on “gutscheinbuch” as title of work under German law and, according to German case law, as domain names, to justifiy its prior rights on “gutscheinbuch”.
These allegations can not be taken into consideration by the Panel as, on the one hand, these categories of prior rights were not admitted during the first Sunrise period and, on the other hand, the examination of the composite trademarks by the Panel reveals that the domain name applied for by the Complainant does not correspond to the complete name on which he requests prior rights, in contradiction with Article 12.2 paragraph 4 and Article 10.2 and of Regulation (EC) 874/2004.
The Complaint is therefore denied.