Sentence arbitrale for dispute CAC-ADREU-001393

Case number	**CAC-ADREU-001393**
Time of filing	**2006-05-19 12:35:17**
Domain names	**hansa.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**VsI Teleradijo kompanija Hansa, General director Jonas Varnas**

Respondent

Organization / Name	**EURid**

SITUATION DE FAIT

On December 7, 2005 (i.e. the first day of the Sunrise Period) the Complainant filed an application for the domain name <hansa.eu> (“the disputed domain name”). The application was filed under the Sunrise Rules and was based upon 3 earlier trade marks all of them registered in Lithuania – Nos. 26102, 26474 and 50176.

The Complainant was the first person to apply for the disputed domain name <hansa.eu>, but on April 7, 2006 the Respondent, EURid, issued a refusal to register it, on the grounds that the name did not consist of the complete name of any of the prior rights on which the application was founded.

The Complainant is one of a number of television and radio stations in Lithuania, but it claims to be the only one using the name ‘Hansa’.

It maintains that the Decision to refuse its application was wrong and that it should be rejected.

A. PARTIE REQUÉRANTE

The Complainant contends that EURID’s decision on April 7, 2006 not to register the disputed domain name in should be annulled because it conflicts with Article 14 of Commission Regulation No. (EC) 874/2004, and especially the last paragraph thereof which states that the Registry shall register the domain name on a first-come-first-served basis if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in the said Article 14. The Complainant contends that the Registry has acted contrary to these duties, and has infringed Article 14.

The Complainant maintains that it has demonstrated its prior right in the word "Hansa" in accordance with paragraphs 11 and 12 of the .eu Registration Policy (the “Sunrise Rules”) and published in accordance with Article 12.1 of the Public Policy Rules in Regulation (EC) 874/2004. It is the proprietor of three figurative trademarks in which it claims the word HANSA is predominant and can be clearly separated or distinguished from any of the device elements in the marks. It identifies these trade marks as being registered under No. 26102, No. 26474, and No. 50176. It contends that the alphanumeric characters included in these signs are all contained in the domain name in the same order as they appear in the sign, and the

impression of the word is apparent without any possibility of misreading (Section 19.2 of the Sunrise Rules).

In accordance with paragraph 12 of the “Sunrise Rules”, the Complainant also submitted documentary evidence in the form of an Affidavit signed by the competent authority declaring that the type of Prior right claimed by the Complainant is protected by the laws of Lithuania. The name of the public establishment Vsl Teleradijo kompanija Hansa contains the word HANSA, and the trade marks mentioned above are protected by the law of Lithuania. The Complainant maintains that it is important to emphasize that the word HANSA specifies and individualizes its name as a public establishment. There are, it contends, a lot of teleradio companies in Lithuania but there is only one teleradio public establishment with the name of HANSA.

The Complainant contends that the purpose of Regulation(EC) 874/2004 is, inter alia, to grant domain names during the sunrise period on a first-come-first-served basis. EURid must observe these rules, inter alia Article 4 of Regulation No. (EC) 733/2002 which indicates that the Registry shall observe transparent and non discriminatory procedures, and that the Registry shall register the domain names in the .eu TLD through any accredited .eu Registrar requested by any undertaking having his registered office within the Community.

The Complainant contends that EURid's Decision of April 7, 2006 is illegal and baseless which is why it should be annulled, and the Registry obliged to register the domain name “hansa.eu” in the name of the Complainant.

B. PARTIE DÉFENDANTE

EURid’s Response was in two parts:

No complete name
Article 10 (2) of Regulation (EC) 874/2004 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. In that regard, section 19 (2) of the Sunrise Rules, which further clarifies article 10 (2) of the Regulation, states 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 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.”

The trademarks which the Complainant submitted as documentary evidence in support of its domain name application consisted of the following alphanumeric characters:
• registration No. 26102 : THR HANSA (TR stands for "teleradijo", the stylized letter in between the T and the R being an H, the first letter of HANSA)
• registration No. 50176 : HANSAINET
• registration No. 26474 : H RADIJAS HANSA (the stylized letter being an H, the first letter of HANSA)

The Complainant contends that one must distinguish the HANSA element in these marks, which it considers to be the word element, from the THR, INET and H RADIJAS elements, which it considers to be the device elements.

The Respondent, for its part, contends that, when applying section 19 (2) of the Sunrise Rules, one must distinguish the alphanumerical characters from their stylized appearance and that in the present case, the stylized characters clearly depict alphanumerical characters which can be separated from their stylized appearance. Moreover, these alphanumerical characters predominate over their stylized appearance.

In this context, the Respondent referred at length to Case No. 01053 (SANTOS), in which the Panel commented – “The Panel is however conscious that the Complainant’s case is not without merit. The Complainant is clearly known as SANTOS. SANTOS is its company name. It appears to have common law rights in the name SANTOS. It has an Internet presence in its web site established at the <santos.fr> address. Third parties refer to the Complainant’s goods as SANTOS goods. While these do not amount to Prior Rights for the purposes of the first phase of the Sunrise Period, they do indicate that the Complainant has undoubtedly rights in the SANTOS trade mark.”. However both parties in that case appear to have accepted that there were two distinct elements in the mark viz. the device element and the word element SANTOS.

The Panel also stated: “Since the device element in the Prior Right relied upon by the Complainant is a stylised alpha numeric character, the letter “S” applying the methodology laid down in Rule 19.2(i) of the Sunrise Rules or even the methodology laid down in Rule 19.2(ii) that all alphanumeric characters (including hyphens, if any) included in the sign should be contained in the Domain Name applied for, in the same order as that in which they appear in the sign, it was reasonable that the Respondent should have rejected the application in those circumstances.”

In this context, the Respondent also referred to Case No. 00470 which concerned the name O2. In that Decision the mark in issue was also a composite sign, albeit where all the elements appear to have been clearly alphanumeric.

In the present case, all the alphanumerical characters in the Complainant’s 3 trade marks should have been contained in the domain name applied for. If they had been, it would have led to the following result:
• for registration No. 26102 the domain name would have been THRHANSA or THR-HANSA (if the hyphen had been included pursuant to Article 11 of Regulation (EC) 874/2004);
• for registration No. 50176 the domain name would have been HANSAINET; and
• for registration No. 26474 : the domain name would have been HRADIJASHANSA, H-RADIJAS-HANSA, HRADIJAS-HANSA or H-RADIJASHANSA (if the hyphens had been included pursuant to Article 11 of Regulation (EC) 874/2004).

However the disputed domain name which the Complainant applied for is, simply, HANSA. In the Respondent’s opinion, there can be no doubt that it does not consist of the complete name of any of the trademark registrations, as not all of the alphanumerical characters depicted in the trademarks have been included in it.

The Respondent therefore concludes that the Complainant's application was not compliant with article 10 (2) of Regulation (EC) 874/2004, or with section 19 (2) of the Sunrise Rules.

Company Name
A company/trade name may only be used as the basis for a domain name application in the second phase of the Sunrise Period. The Complainant's application was filed on December 7, 2005 which is the starting date for the first phase of the Sunrise Period. During this period only registered trademarks, geographical indications, and the names and acronyms referred to in Article 10 (3) of Regulation (EC) 874/2004 can be accepted as prior rights. A company name is only acceptable as a prior right when the application was filed during the second phase of the Sunrise Period.

Therefore, the Complainant's reference to its company name is not relevant.

For the reasons mentioned above, the Respondent contends that the Complaint must be rejected, and it concluded with the following quote from the Decision in Case No. 00219 which concerned the name ISL: “One could argue that sympathy is overruled by the applicable Regulations serving among other purposes the (cost-effective) functionality of the phased registration and the principles hereof.”

DÉBATS ET CONSTATATIONS

Those Articles and Sections of the Regulation and the Sunrise Rules that are relevant to this case are all referred to and are set out in the Complaint and the Response, but for the sake of completeness, and where relevant to these Findings, they are repeated below.

As the Complainant states, there are two issues to be decided in this Case – whether the 3 trade mark registrations on which the Complainant relies consist of the word HANSA, and whether the Complainant's claim to have rights in the company name HANSA is admissible as a prior right.

Dealing with the second issue first, the Panel was initially in some doubt as to whether the Complainant was actually making the claim to base its domain name application on a company name, or whether it was merely using the Affidavit which it allegedly filed to bolster its claim to have exclusive rights in the name 'Hansa' for the purpose of obtaining the disputed domain name <hansa.eu>. However the Panel has not been provided with a copy of the Affidavit, so this point cannot be decided one way or the other. Nevertheless, as the Respondent points out, under Articles 12 and 10 of Regulation (EC) 874/2004, an application for a domain name based on a company name could only be filed in the second phase of the Sunrise Period which began on February 7, 2006, and the Complainant's application for the disputed domain name <hansa.eu> was filed well prior to that, on December 7, 2005. So, if indeed the Respondent is attempting to argue that its company name should be a sufficient basis for the disputed domain name, then this argument must fail. If on the other hand the Respondent is attempting to say that it has rights in the name 'Hansa' by virtue of its company name and its use thereof then, on the basis of the information supplied to it, the Panel feels that this too is not sustainable, because the Complainant's full name (Vsl Teleradjo Kompanija Hansa) contains a lot more material than simply the word 'Hansa'. Therefore any claim to base the disputed domain name on this name must fall foul of sections 19.1 and 19.2 of the Sunrise Rules as analysed below. If the Complainant had filed significant evidence that it and it alone in Lithuania is referred to as 'Hansa' the result might have been different.

Consequently the Panel has concluded that the Complainant's company name cannot be relied upon as a basis for the disputed domain name.

On the trade mark issue, as neither of the parties filed copies of the 3 trade marks relied upon by the Complainant the Panel, through the medium of a non-standard communication, asked for copies of them and these copies were received on August 4, 2006.

There appears to be no agreement between the parties as to what these 3 trade marks actually consist of. Both agree that they are figurative marks. However, the Complainant describes them simply as 'Hansa' and 'Hansa i-net' and claims that in them "the word HANSA is predominant and can be clearly separated or distinguished from the device element …". The Respondent on the other hand describes them much more comprehensively, thus –

"The trademarks which the Complainant submitted as documentary evidence consisted of the following alphanumeric characters:
• registration n° 26102 : THR HANSA (TR stands for "teleradijo", the stylized letter in between the T and the R being an H, the first letter of HANSA)
• registration n° 50176 : HANSAINET
• registration n° 26474 : H RADIJAS HANSA (the stylized letter being an H, the first letter of HANSA)."

Having now seen copies of the 3 trade marks, the Panel is of the opinion that neither of these descriptions does them full justice, but that the Respondent's is perhaps rather more accurate.

The law is clear. Article 10.2 of Regulation (EC) 874/2004 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 prior right exists." However EURid was clearly aware that not all trade mark registrations consist only of simple words, some will contain both words and other matter. It therefore devised rules for deciding on how to deal with applications for domain names during the first and second phase of the Sunrise Period that were based on prior rights that contained matter in addition to the word of which the domain name application consisted. These rules are set out in Section 19 of the Sunrise Rules. The Respondent quotes Section 19.2 –

"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."

However it does not quote Section 19.1 the last sentence of which is, in the opinion of the Panel, also very relevant –

"As stated in Article 10(2) of the Public Policy Rules, registration of a Domain Name on the basis of a prior right consists in the registration of the complete name for which the prior Right exists, as manifested by the Documentary Evidence. It is not possible for an Applicant to obtain registration of a Domain Name comprising part of the complete name for which the prior Right exists."

The Panel will now apply these Rules to the 3 trade marks in this case.

Firstly, it is clear that trade mark registration No. 26474 cannot possibly be relied upon as the basis for the disputed domain name. Its dominant feature is a square box containing 2 outer dark strips and a central white one all of equal width. Superimposed on this is a large letter 'H' in gothic lettering surrounded by 3 circles. Under this appears the word 'RADIJAS' in white lettering with a black outline and under that, in very slightly larger black lettering, is the word 'Hansa'. As this last word is only a minor part of the whole device, it clearly falls within the embargo contained in Section 19 of the Sunrise Rules, most especially Section 19.2(ii) and the second sentence of Section 19.1. It is clear to the Panel that the word 'Hansa' is only a small part of this trade mark. It is not predominant, and it cannot be either separated or distinguished from the other elements in the mark.

The same almost certainly also applies to trade mark registration No. 26102. This consists of a black square on which are imposed, in a large white outline, the letters 'T' and 'R' over which is printed the same gothic letter 'H' that appears in the mark described above, while under it all, in white lettering, is the word 'Hansa'. Whilst it is probably wrong to describe this mark, as the Respondent does, as consisting of THR HANSA, because the word 'HANSA', being printed in white, does stand out to some extent, it is a familiar concept in trade mark law and practice to say that it is by the word element of a composite mark (i.e. the word 'Hansa') that the public will recognise it. Furthermore, the word 'Hansa' can, as Section 19.2 of the Sunrise Rules has it, be "clearly separated or distinguished from the device element" in the mark. However it is not "predominant" (as Section 19.2(ii) requires) for it is only a small part of the mark and the gothic letter 'H' is also in white as are the outlines of the letters 'T' and 'R'. Furthermore, Section 19.2(ii)(a) contains a proviso to a word element being predominant, namely that "all alphanumeric characters … included in the sign" must also be included in the domain name applied for. In this case the disputed domain name is <hansa.eu> and not <thrhansa.eu>. Consequently, the Panel has concluded that trade mark registration No. 26102 must also be excluded as being a proper basis for the disputed domain name.

The third trade mark registration, No. 50176, is a better candidate, and its claim to be a proper basis for the disputed domain name has more merit, but in the opinion of the Panel it too is insufficient. Unlike the other two trade marks, it does not contain any device element. It is a word mark and consists of the word 'Hansai' in which 'hansa' is printed in mauve and the letter 'i' in orange. This is followed by the word 'net' in script form which is also in mauve, and whose first letter is partly superimposed over the orange letter 'i'. The Complainant describes this mark as "Hansa i-net" but this is wrong for there is no hyphen in the mark and no separation between the final 'a' of 'Hansa' and the letter 'i'. It is true that this letter 'i' is printed in a different colour to 'Hansa' but together they form a single word with all the letters printed in the same size – apart from the initial capital H – and typeface. As with trade mark No. 26102 above, in the opinion of the Panel, this mark satisfies Section 19.2(ii) in that the word 'Hansa' is predominant and can, because of the different colours, be separated from the rest of the mark, but it too fails the test in Section 19.2(ii)(a) in that all of its alphanumeric characters, namely the letters 'i' and the word 'net' are not included in the disputed domain name. Consequently, the Panel has concluded that trade mark

registration No. 50176 must also be excluded as a candidate for being a proper basis for the disputed domain name.

The Panel could have some sympathy with the Complainant if its claim to be the only radio and television station using the name Hansa is correct. However it has no absolute exclusivity to the name 'Hansa' which is an adjective referring to elements from the Hanseatic League that was such a dominant trading force among the cities and states around the Baltic Sea in the Middle Ages. However the law is the law and rules are rules, and the Panel has concluded, on the evidence before it, that the Respondent's decision to refuse to register the disputed domain name <hansa.eu> was correct and does not conflict with Regulation (EC) 874/2004. The Panel also believes that its Decision is in line with those in the previously decided Cases 00470 (O2) and 01053 (SANTOS).

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	**David Tatham**

DATE DE LA SENTENCE ARBITRALE 2006-08-19

Summary

LE RÉSUMÉ EN ANGLAIS DE LA SENTENCE ARBITRALE SE TROUVE À L´ANNEXE 1

In its application for the registration of the domain name <hansa.eu> during the Sunrise Period, the Complainant (Vsl Teletadjo kompanja Hansa) relied upon three trade marks registered in its home state of Lithuania, Nos. 26102, 26474 and 50176. Each of these marks contains the word HANSA but each contains other matter as well. The Complainant also filed an Affidavit from a competent Lithuanian authority as proof that the Complainant is protected under the laws of Lithuania.

The Respondent (EURid) refused the application on the basis that the disputed domain name did not consist of the complete name of any of the trade marks on which the Complainant relied when making the application.

The Complainant filed a Complaint arguing that the refusal is contrary to the EC Regulations regarding .eu domain names and the Sunrise Rules. It maintains that the word HANSA is predominant in its trade marks and can clearly be separated or distinguished from the device elements in them. By its Complaint, the Complainant maintains that the refusal should be annulled and that the domain name should be registered in the name of the Complainant.

The Complaint was timely filed and in order.

EURid filed a Response arguing that since none of the additional alphanumeric matter in the Complainant's three trade marks had been included in the domain name applied for, it does not consist of the complete name of these trade marks. Therefore it does not comply with, in particular, Section 19 of the Sunrise Rules. EURid also pointed out that the additional claim to base the application on the Complainant's company name must fail because such a claim can only be filed during the second phase of the Sunrise Period.

The Panel examined the appearance of the three trade marks and concluded that none of them consisted solely of the word HANSA and that therefore the decision to reject the application was correct. The Panel also found that the claim to base the domain name on a company name had been incorrectly filed. As a result the Complaint was rejected.