

Panel Decision for dispute CAC-ADREU-001427

Case number **CAC-ADREU-001427**

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Domain names **bonollo.eu**

Case administrator

Name **Tereza Bartošková**

Complainant

Organization / Name **Distillerie Bonollo S.p.A., Distillerie Bonollo S.p.A.**

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

There are no other legal proceedings of which the panel is aware that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

On December 7, 2005, the Complainant filed a request for registration of the domain name <bonollo.eu> in the name of "Distellerie Bonollo Spa".

On January 4, 2006, the Respondent received documentary evidence consisting of a trademark certificate of the European (composite) trademark No 002109155.

The Respondent rejected the request for registration on the grounds that the Complainant did not have a prior right to the name BONOLLO due to an error in the transcription of the composite trademark.

The Complainant filed a Complaint against the Respondent which was received by the Czech Arbitration Court ("CAC") on May 29, 2006. CAC notified the Complainant on June 19, 2006 that the hardcopy of the Complaint was not submitted on the prescribed form and did not identify the Registrar. The Complainant submitted an amended Complaint which was received by CAC on June 27, 2006. After the compliance review, CAC declared that the formal date of the commencement of the ADR proceeding was June 29, 2006.

The Respondent submitted a Response which was received by CAC on August 18, 2006.

On August 25, 2006 CAC appointed David Štros, Enrique Batalla and Johan Sjöbeck as panellists.

A. COMPLAINANT

The Complainant requests that the Registry's decision to deny Complainant the domain name <bonollo.eu> according to the Commission Regulation No. 874/2004 Article 10(2) shall be annulled.

The Complainant applied for the domain name <bonollo.eu> during the phased registration period. The application was based on the Community trademark No 2109155 "BONOLLO DISTILLERIE BONOLLO S.p.A & device", which enjoys priority as of February 28, 2001 and on the international trademark No 571586 "BONOLLO DISTELLERIE BONOLLO S.p.A. CASA FONDATA NEL 1918 & device", which enjoys priority as of January 23, 1991.

On April 10, 2006 and April 12, 2006, The Complainant received notifications from EURid stating that the domain name application had been refused. The refusal was substantiated by the fact that according to the Commission Regulation No 874/2004 Article 10(2) 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 right exists. According to the Respondent, the requested domain name does not correspond with the complete name of the trademark.

The Complainant argues that according to Section 19(2) of the Sunrise Rules "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 the word element is

predominant, and can be clearly separated or distinguished from the device element". According to the Section 19(4) of the Sunrise Rules for trade names, company names and business identifiers, the company type (such as but not limited to, SA, GmbH, Ltd. Or LLP) may be omitted from the complete name for which the Prior Right exists.

The Prior Right of the Complainant was based on the Community trademark No 2109155 that consists of a graphic element, an individual word element "BONOLLO" and of the trade name "DISTILLERIE BONOLLO S.p.A.". The Prior Right was also based on the international trademark No 571586 that consist of a graphic element, an individual word element "BONOLLO", the trade name "DISTILLERIE BONOLLO S.p.A." and the words "CASA FONDATA NEL 1918".

It is the opinion of the Complainant that the word "BONOLLO" is the dominant element of both the trademarks and can clearly be separated and distinguished from the device and other verbal elements. The word element "BONOLLO" is even included twice in the trademarks, once as an individual denomination and once as part of the trade name of the Complainant. The element "BONOLLO" is written in larger letters than the other word elements.

The word element "S.p.A." must be omitted from the complete name as it represents company type in accordance with Section 19(4) of the Sunrise Rules.

The word element "DISTILLERIE" means "distillery" in English and has a descriptive meaning which is clear not only to Italians but also to the average European consumer. Due to this and due to the fact that this word refers to the place where the goods are manufactured, it is devoid of any distinctive character.

The word elements "CASA FONDATA NEL 1918" are also of a mere descriptive and informative character which can be translated to "an enterprise founded in 1918".

In addition to the above, the Complainant argues that the registration of domain names under Regulation No 733/2002 and No 874/2004 pursues two principal objectives. One is to make the registration of EU domain names readily available to all legitimately interested parties within the Community. The other is to prevent registration of domain names in abusive manner or bad faith. Also the objective of the Sunrise Rules must be to enable all legitimate parties from within the Community to obtain in a readily available, efficient and accessible manner the registration of their distinctive denominations, in which they hold Prior Rights, as domain names, while preventing abusive and speculative registrations. The refusal of the domain name application for <bonollo.eu> clearly does not pursue any of those objectives.

The Complainant is an owner of two registered trademarks in sense of Art. 13(1)(i) of the Sunrise Rules, which consist of the sole distinctive element "BONOLLO". All the other elements contained in those trademarks are either graphic elements or elements which have no distinctive value whatsoever.

The Complainant alleges that indistinctive elements of composite signs registered as trademarks may be registered as a part of the trademark as a whole, but there is no obligation to include them into the registration. Such an obligation would be contrary to the purpose of the system of registration of .eu domain names and to the Sunrise Rules, which is to offer an efficient and accessible method of registration of domain names which enables the public to easily identify the business of the holder of the domain name in the internal market. This purpose would not be properly served if the businesses were obliged to register as the domain name the complete wording of their trademarks, including all indistinctive and descriptive elements.

In addition to the above, the Complainant argues that general principles of interpretation of the scope of trademark protection is applicable to registration of domain names during the phased registration period.

The Sunrise Rules section 19(2) enables to obtain registration of a domain name based on rights in figurative or composite signs. Such signs may include words, devices, pictures, logos etc. Such prior rights shall be accepted if the signs exclusively contain a name or if the word element is predominant and can clearly be separated or distinguished from the device element.

The word "BONOLLO" is the only name contained in the Complainant's two trademarks since all the other verbal elements of the trademark are of a descriptive and generic nature, namely a descriptive denomination of a branch of business, of legal form and of the year when the business was established.

The Complainant requests that EURid's decision is annulled and that the domain name <bonollo.eu> is granted to the Complainant.

B. RESPONDENT

The Respondent contends as follows:

Article 10(1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 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 the general registration

of .eu domain names starts.

Article 10(2) of Commission Regulation (EC) No 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.

Section 19(2) of the Sunrise Rules states that a prior right claimed to a name included in figurative or composite signs will only be accepted if the sign exclusively contains a name or if the word element is predominant and can clearly be 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 of misreading the characters of which the sign consists or in the order in which those characters appear”.

The Complainant applied for the domain name <bonollo.eu> and submitted with its application a trademark certificate of the European (composite) trademark No 002109155. The Registry concluded from its examination of the documentary evidence that the Complainant did not have a prior right to the name BONOLLO due to an error in the transcription of the composite trademark and rejected the application for the domain name <bonollo.eu>.

The trademark which the Complainant submitted as documentary evidence consists of the following elements:

- 1) A device element (a shield in which is placed a bunch of grapes),
- 2) The word “BONOLLO”, and
- 3) The words “DISTILLERIE BONOLLO S.p.A”.

The trademark certificate itself mentions in its description “The trade mark consist of the word BONOLLO above which is placed the drawing of a shield with a helmet and fluttering ribbon, and inside which is placed a bunch of grapes; below are written the words DISTILLERIE BONOLLO S.p.A.; the second letter O of the word BONOLLO is written in larger letters”.

The trademark is therefore comprised of the following alphanumerical elements: “BONOLLO DISTILLERIE BONOLLO SPA”. Consequently, pursuant to section 19(2) of the Sunrise Rules, this trademark establishes a prior right to the sign “BONOLLODISTILLERIEBONOLLOSPA”, but not to the sign “BONOLLO” alone. In support of the above, the Respondent refers to the similar case No. 470 (O2).

Furthermore, the Respondent claims that the Complainant’s contentions that only the distinctive elements of composite signs must be included in the domain name is wrong and that the Regulation article 10(2) and section 19(2) of the Sunrise Rules clearly state 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 and that all alphanumeric characters (including hyphens if any) included in the sign must be contained in the domain name applied for. Neither the validation agent, nor the Registry was allowed to engage in appreciation of the distinctive character of the various elements of composite trademarks.

The panel should reject the Complaint.

DISCUSSION AND FINDINGS

Article 22 of the Commission Regulation (EC) No 874/2004 of 28 April 2004 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 of 22 April 2002 on the implementation of the .eu Top level Domain.

The Complainant’s application for the domain name <bonollo.eu> was rejected by the Respondent with reference to article 10(2) of Regulation (EC) No 733/2002 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”.

Section 19(1) of the Sunrise Rules states that “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 consists, 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”.

Moreover, Section 19(2) of the Sunrise Rules 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 trademark upon which the domain name application was based consists of a composite sign including words and devices. More specifically, the trademark consists of 1) a graphic device element, 2) the word “BONOLLO” where the fourth letter “O” is enlarged and the words “DISTILLERIE BONOLLO S.p.A”. Thus, it is clear that the Complainant’s trademark can not be considered a sign that exclusively contains a name, as described in Section 19(2)(i).

The question therefore arises, whether the word “BONOLLO” can be considered the predominant word element which can clearly be separated of distinguished from the device element as described in Section 19(2)(ii). In addition to the condition above, Section 19(2) provides two additional conditions that must be fulfilled in order to register a domain name under the Sunrise Rules. One of these conditions is that 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.

The words “Bonollo” and “Distillerie Bonollo S.p.A.” are part of the composite trademark but are not all contained in the domain name <bonollo.eu> that the Complainant applied for during the phased registration period. According to Section 19(4) of the Sunrise Rules, the company type may be omitted from the complete name for which the prior right exists. Thus, the company type “S.p.A.” could be excluded from the composite trademark.

However, even if the company type “S.p.A.” is omitted from the complete name of the prior right, the words “Distillerie Bonollo” remain in the composite sign but are not contained in the domain name applied for.

It has been argued by the Complainant that only distinctive elements of a composite sign must be included in the domain name. This is contrary to the wording in Section 19(2) of the Sunrise Rules and Article 10(2) of Regulation (EC) No 733/2002. If there would be exceptions in favour of the Applicant, allowing words of a descriptive and/or informative character to be excluded from a composite trademark on a subjective basis, it would affect the legitimate expectancy of the next Applicant in the queue for the domain name in question and conflict with the first come first served principle set out in Article 14 of the Commission Regulation (EC) No 874/2004.

Having all of the above in mind, the Panel finds that not all alphanumeric characters of the composite sign are contained in the domain name applied for and that the decision taken by the Respondent to reject the Complainants domain name application does not conflict with the Commission Regulation (EC) No 874/2004.

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 Stros
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DATE OF PANEL DECISION 2006-09-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant’s application for the domain name <bonollo.eu> was rejected by the Respondent with reference to article 10(2) of Regulation (EC) No 733/2002 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 Complainant is the owner of a European composite trademark consisting of words and devices. The Complainant alleges that indistinctive elements of composite signs registered as trademarks may be registered as a part of the trademark as a whole, but there is no obligation to include them into the registration. The Complainant requests that the Respondent’s decision to reject the application of the domain name is annulled.

The panel finds that not all alphanumeric characters of the composite sign are contained in the domain name applied for and that the decision taken by the Respondent to reject the Complainant’s domain name application does not conflict with the Commission Regulation (EC) No 874/2004. Therefore, the Complaint is denied.