Sentence arbitrale for dispute CAC-ADREU-001438

Case number	**CAC-ADREU-001438**
Time of filing	**2006-05-24 11:53:38**
Domain names	**ellison.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Ellison Educational Europe, Ltd., Ms. Kimberly Fogarty, Esq.**

Respondent

Organization / Name	**EURid**

SITUATION DE FAIT

Glusburn Holdings applied for the domain name ELLISON on 2 February 2006 and the application was accepted on 10 April 2006.

The documentary evidence submitted by Glusburn Holdings included an extract for a community trade mark, but did not include the full information concerning the mark, in particular the information to the effect that the word mark was for “E ELLISON” not for “ELLISON”. The mark consists of the word “ELLISON” preceded by a drawing which is a highly stylized rendition of the letter “E” surrounded by a metal fastener.

The Complainant applied for the disputed domain name on 4 February 2006 and is next in queue.

The Complainant submitted its Complaint, directed against the Registry’s decision to accept Glusburn Holding’s application, on 19 May 2006.

A. PARTIE REQUÉRANTE

Ellison Educational Europe, a limited company incorporated under the laws of Ireland on 10 November 2004 (“Ellison Europe”) forms part of the Ellison group of companies which, since the 1970’s, has designed, manufactured and sold popular die-cutting and embossing systems used by schools and handcrafters. Ellison Europe is the distributor for Ellison products in Europe and a licensee of the Ellison trademarks in Europe.

Ellison Educational Equipment Inc, is the registered owner of national trade mark registrations for the ELLISON mark in 22 countries worldwide, including several European countries. Ellison Educational Equipment Inc. also owns a Community Trade Mark the mark “ELLISON”.

Ellison Europe submitted it application for the domain name on 4 February 2006, claiming its prior rights to receive the domain registration based upon its registered national trademark in the United Kingdom. Ellison Europe submitted documentary evidence of same on 9 March 2006. EURid received Complainant’s documentary evidence on 14 March 2006.

But for the mistakes made by two .eu domain name registrars Ellison Europe engaged to file its application with EURid, Ellison Europe would have been the very first applicant in the queue to file for the Ellison.eu domain name [Complainant submits further detail regarding the alleged mistakes, but these are not reproduced here, for the reasons mentioned in the Discussion below.]

The party whose <ellison.eu> application EURID accepted is Glusburn Holdings, a limited company incorporated under the laws of Great Britain (UK) which, with the group of companies it holds, is engaged in the manufacture and distribution of circlips, retaining rings, and various other manufacturing components ("Glusburn"). Glusburn filed its Application claiming prior rights in the ELLISON mark based upon a registered community trademark.

While Glusburn does own registered community and other international trademarks for "E ELLISON," it does not own a EU community or national trademark for "ELLISON".

Thus EURid's decision to accept Glusburn's application is in conflict with European Union Regulations, because Glusburn does not have adequate prior rights.

The prior right claimed to support the Glusburn application is Community trade mark registration number 003017803 "E ELLISON". This prior right is not sufficient to support an application for the domain name <ellison.eu> for the following reasons:

- contrary to Article 10(2) of the (EC) NO 874/2004 (the "European Regulation"), the domain name applied for, <ellison.eu> does not consist of the complete name for which the prior right exists, i.e., "E ELLISON";

- contrary to Section 19(a) of the Sunrise Rules, the letter "E" comprised in the prior right had been omitted entirely from the domain name applied for and accordingly all alpha-numeric characters comprised in the prior right were not contained in the domain name applied for.

The fact that the prior right relied upon by the Glusburn application should be read as "E ELLISON" and not just "ELLISON" plus device, is apparent from a prima facia examination of the mark and further from the clear intention of Glusburn to obtain registered rights in the mark "E ELLISON" as distinct from "ELLISON". This intention is evident not only from the details of CTM registration 003017803 upon which Glusburn made its prior right claim, but also the details of UK trade mark registration "E ELLISON".

Complainant concludes that EURid should exercise its discretion in favour of according the said Complainant First Come First Serve Prior Rights Applicant Status and attribute the domain name ELLISON to Complainant.

Procedural Point

On 14 May 2006, Complainant pointed out that Respondent's request for an extension of time to respond to the Complaint was three days late and, furthermore, did not provide any evidence of the "exceptional circumstances" required under A.2.i of the ADR Rules in order to grant an extension.

Thus Complainant requested that Provider deny Respondent's request for an extension of time in which to respond to the Complaint.

B. PARTIE DÉFENDANTE

Glusburn Holdings Ltd. (hereafter "the Applicant") applied for the domain name ELLISON on February 2, 2006. As the validation agent concluded that the Applicant had proved that the prior right which it held corresponded to the complete name of the domain name, the Respondent accepted the application.

Under 10.2 of the Regulation and 19.2 of the Sunrise Rules, the domain name applied for must consist of the complete name

of that prior right.

In case n° 1053 (SANTOS), the Panel stated:
“In reaching this decision the Panel is conscious that the present case has certain similarities with the proceedings in O2 DEVELOPPEMENT v. EURid (Case 00470, 2006-07-05) where it would appear from the decision that the mark in issue was also composite sign, albeit where the all elements appear to have been clearly alphanumeric. In the present case both parties seem to have accepted that there were two distinct elements in the mark viz. the device element and the word element SANTOS. Nonetheless the device element is an alphanumeric character for the purposes of Section 19 of the Sunrise Rules."

Although in the case at hand the E is intrinsically linked to what appears to be a metal ring, which is the product for which the trademark is registered, it can be interpreted as an alphanumerical character.

With regard to the Complainant's request to have the domain names transferred, the Respondent would like to refer the Panel to 11(c) of the ADR Rules. Two conditions need to be met before the Panel may order the transfer of a domain name:
• the Complainant must be the next applicant in the queue for the domain name concerned;
• the Respondent must decide that the Complainant satisfies all registration criteria set out in the Regulation.

As the Respondent has not yet decided whether the Complainant satisfies all conditions, its transfer request should be rejected. The validation agent must validate the Complainant's application via the normal procedure.

DÉBATS ET CONSTATATIONS

Procedural Points

Pursuant to 26.1 of the Sunrise Rules, an ADR proceeding against the Registry may be initiated within 40 days of a decision by the Registry. In the present case the contested decision was made on 10 April 2006 and the Complaint was submitted on 19 May 2006. The Complaint was therefore submitted within the deadline and is admissible.

While the Response was filed late, in the present case the content of the Response supports the substance of the Complaint. Notwithstanding the fact that there is a special onus on the Respondent, as the Registry, to adhere to the time limits set in the procedural rules, and the request by the Complainant not to admit the Response, the Panel has exercised its discretion, under B.2.i of the ADR Rules, to admit the Response.

Complainant alleges that, but for mistakes made by two registrars, it would have been the first applicant for the disputed domain name. Such allegations are outside the scope of the present procedure, which can be founded only on the relevant provisions of the European Regulation and the Sunrise Rules. Therefore, the Panel will not consider this matter.

Substantive Issues

The present case is very similar to case no. EU 01053 (SANTOS) and the present decision is consistent with, and indeed largely copied from, the decision in that case.

Article 10.1 of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter 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:

” 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 a right exists.”

The detail of the methodology to be applied by EURid during the Sunrise Period is set out in the Sunrise Rules. Section 19.2

states:

”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.”

In the present case, the name to which the Prior Right is claimed is the sign registered as Community Trade Mark 003017803. The sign is both figurative inasmuch as it contains a device or logo element and is composite inasmuch as it consists of both the figurative element and the word ELLISON.

The Complainant argues that Rule 19.2.ii applies and that there is a predominant word element being the word ELLISON and a figurative element being a stylised letter “E”.

Complainant therefore concludes that not all alphanumeric characters included in the sign are contained in the domain name granted to Glusburn Holdings, which violates 19.2 of the Sunrise Rules and 10.2 of the Regulation.

Respondent states: “Although in the case at hand the E is intrinsically linked to what appears to be a metal ring, which is the product for which the trademark is registered, it can be interpreted as an alphanumerical character.”

The Panel agrees with Respondent: it is a matter of interpretation. Given the material submitted by Glusburn Holdings to support its application, the Panel finds no fault the Registrar’s prima facie decision that Glusburn had prior rights in the mark ELLISON.

However, in accordance with the ADR Rules, the Complainant has the right to request this Panel to examine the matter in more depth, considering additional information submitted by the Complainant, in particular the full text of Glusburn Holdings’ Community Trade Mark.

That information shows that the word mark is “E ELLISON”. In that light, the Panel concludes that the stylized “E” in the figurative mark must indeed be interpreted, for the purposes of the Regulation and the Sunrise Rules, as an alphanumeric character.

Therefore Glusburn Holdings would be entitled, under the Sunrise Rules, to the domain name “E ELLISON” but is not entitled to the domain name “ELLISON”.

Thus the present registration must be annulled.

Article B.11 of the ADR Rules states that the main remedy available pursuant to an ADR Proceeding against EURid shall be the annulment of the disputed decision taken by EURid. Transfer and attribution will only be granted by the Panel if the

Complainant is the next applicant in the queue for the domain name concerned and subject to the decision by EURid that the Complainant satisfies all registration criteria in the Regulation.

Since EURid has not yet examined the Complainant's application, it has not yet decided that the Complainant satisfies all registration criteria. Therefore, the transfer and attribution cannot be granted directly by this Panel.

Section 27.1 of the Sunrise Rules states that if the ADR Proceeding concerns a decision by the Registry to register a Domain Name and the Panel concludes that that decision conflicts with the Regulations, then, upon communication of the decision by the Provider, the Registry will decide whether or not to register the Domain Name in the name of the next Applicant in the queue for the Domain Name concerned, in accordance with the procedure set out in these Sunrise Rules.

Thus, it is clear that EURid must examine the next application in the queue, which is from the Complainant, and decide whether it satisfies all registration criteria set out in the Regulation.

DECISION

For the reasons set forth above, in accordance with B.11.c of the ADR Rules, the Panel annuls EURid's decision to accept Glusburn Holdings' application for the domain name ELLISON and it orders EURid to cancel the present registration. Further, in accordance with 27.1 of the Sunrise Rules, it orders EURid to examine the next application in the queue (which is from the Complainant) and to accept the Complainant's application if it satisfies all registration criteria set out in the Regulation.

PANELISTS

Name	**Richard Hill**

DATE DE LA SENTENCE ARBITRALE 2006-08-13

Summary

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

Complainant challenges the registration of the domain name ELLISON on the ground that the registrant has prior rights for the mark "E ELLISON", but not for the mark "ELLISON". The registrant's mark consists of the word ELLISON preceded by a highly stylized letter E surrounded by a drawing of a metal retaining clip.

When accepting the application, EURid considered that the highly stylized rendering of the letter E in the registrant's trademark was not an alphanumeric character in the sense of 19.2 of the Sunrise Rules.

But EURid's prima facie evaluation was based on information supplied by the registrant.

On the basis of a more in-depth examination, and taking into account additional information supplied by Complainant, the Panel concludes that the stylized E is indeed an alphanumeric character in the sense of 19.2 of the Sunrise Rules.

Therefore the Panel agrees with Complaint's request that EURid's decision be annulled and that the present registration be cancelled; further the Panel decides that EURid should examine the next application in the queue (which is from the Complainant) and accept the Complainant's application if it satisfies all registration criteria set out in the Regulation.