Arbitrage-beslissing for dispute CAC-ADREU-001669

Case number	CAC-ADREU-001669
Time of filing	2006-06-07 12:33:43
Domain names	hds.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	HACHETTE DISTRIBUTION SERVICES

Respondent

Organization / Name	EURid

ANDERE JURIDISCHE PROCEDURES

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FEITELIJKE SITUATIE

Complainant filed the application for the domain name hds.eu and was received by Arbitration Court 7 June 2006, Respondent have been notified. A domain name application hds.eu was filed on December 7, 2005 in the name of the firm Tegometall Ladenbau GmbH, seated at Bleicherstr. 14, 78467 Konstanz, Baden-Württemberg, Germany. The granted domain name was granted to the above mentioned firm in Complainant's opinion in contrary to the valid legislation and rules since it does not have the required priority right. The registration of the domain hds.eu by the Respondent is subject to dispute.

A. KLAGER

Complainant is of the opinion that the domain name hds.eu must be transferred to the Complainant, because it is the next applicant in the queue for the domain name concerned and it satisfy all registration criteria for the domain name hds.eu. According to the Complainant it appears that the applicant of the domain name hds.eu, Tegometall Ladenbau GmbH, Germany does not own any Trademark Registrations "HDS". This is supported by the documentation (the Community Trademark Office and World International Property Organization (WIPO) searches).
The only trademark revealed by Complainant's search was the trademark "HDS" Community Trademark Registration N° 2475937 filed in the name of the Swiss firm Tegometall (International)AG.

Complainant quoted .eu Sunrise Rules as well as the Article 4 of the EC Regulation 733/2002 to support its opinion that the domain name registration in the name of the German firm Tegometall Ladenbau GmbH is not in accordance with registration criteria of the ".eu Sunrise Rules", and should be rejected as well as the owner of the above mentioned Trademark Registrations, Tegometall (International) AG, is a Swiss firm and therefore is not eligible to register a domain name in the .eu TLD.

B. VERWEERDER

The Respondent describes firstly in its response the grounds on which was the application of Tegometall Ladenbau GmbH,

Germany accepted. Tegometall Ladenbau GmbH, Germany applied for the domain name hds.eu on December 7, 2005. The documentary evidence was received by the processing agent on January 14, 2006, which is before the January 16, 2006 deadline.
As the validation agent concluded that the documentary evidence consisted of a valid Community trademark for the HDS sign, registered by Tegometall (International) AS, Switzerland and a licence declaration regarding this Community trademark duly signed by Tegometall (International) AS, Switzerland and Tegometall Ladenbau GmbH, Germany, the Respondent has accepted the application for the hds.eu domain name.

According to the Respondent Tegometall Ladenbau GmbH, Germany was the holder of a prior right.
Pursuant to article 12 (2) of the EC Regulation 874/2004 licensees of trademark owner may also apply for the corresponding domain name. The documentary evidence submitted by the Tegometall Ladenbau GmbH, Germany clearly shows that the Tegometall (International) AS Switzerland is the holder of a valid Community trademark consisting of the sign HDS and the Tegometall (International) AS, Switzerland (Licensor) has licensed this trademark to Tegometall Ladenbau GmbH, Germany (Licensee).

The licence states that "Licensor authorises Licensee to apply during the Phased Registration Period for the Domain Name (HDS)".
As Tegometall Ladenbau GmbH, Germany has been licensed to use a valid Community trademark to apply for the HDS domain name, the Respondent's decision to accept the Tegometall Ladenbau GmbH, Germany application is in line with the EC Regulation 874/2004. To support its decision the Respondent draws to panel’s attention cases No. 495 (STEMCELL) and No. 1012 (50PLUS).

BEHANDELING EN VASTSTELLING

The complaint of the Complainant as well as the Respondent’s response was duly reviewed.

Pursuant to Article 14 (4) of the EC Regulation 874/2004, the Registry shall register the domain name on the first-come-first-serve basis if it finds that the applicant has demonstrated a prior right.

Pursuant to Article 12 (2) of the EC Regulation 874/2004 licensees of trademark owner may also apply for the corresponding domain name.

Pursuant to .eu Sunrise Rules Section 11(1) as rightly argued Complainant: „ During the first phase of the Phased Registration Period, only Domain Names that correspond to registered Community or national trade marks [...] may be applied for by the holder and/or licensee (where applicable) of the Prior Right concerned [...]“

Tegometall Ladenbau GmbH has its registered offices in Germany and therefore it is an eligible entity pursuant to Article 4 (2) b of the EC Regulation 733/2002.

In my opinion, the content of the complaint shows that the Complainant was not aware of the fact that the applicant has been duly licensed to use the valid Community trademark. This fact is, however the key element of the dispute resolution.

Section 20 (1) of the .eu Sunrise Rules, states that when an applicant has obtained a licence for a registered trade mark in respect of which it claims a prior right, it must enclose with the documentary evidence an acknowledgement and declaration form duly completed and signed by both the licensor of the relevant registered trade mark and the applicant.

After review of the documentary evidence it is clear that the requirement of the Section 20 (1) of the .eu Sunrise Rules have been met by Tegometall Ladenbau GmbH, Germany.

Summarizing the above stated, also bearing in mind the decisions in cases No.00495 (STEMCELL) and No.01012 (50PLUS), I did not find the contested decision to accept the application of Tegometall Ladenbau GmbH, Germany made by the Respondent in conflict with any of the European Union Regulations.

BESLISSING

For all the foregoing reasons, in accordance with Paragraphs B12 (b) of the Rules, the Panel orders that

the Complaint is Denied

PANELISTS

Name	**Tomáš Borec**

DATUM ARBITRAGE-BESLISSING 2006-08-31

Summary

SAMENVATTING ARBITRAGE-BESLISSING IN DE ENGELSE TAAL VORMT DE BIJLAGE 1

The Complainant claimed that the current registration of the domain name hds.eu must be rejected and the domain name must be transferred to the Complainant on the grounds that the Respondent breached the rules on priority rights because of missing trademark ownership.

The Panel reviewed the arguments of Complainant as well as Respondent and found no breach of any of the European Union Regulations on the side of Respondent. The registration of the domain name hds.eu in favour of Tegometall Ladenbau GmbH, Germany have been made in compliance with the Article 12(2) of EC Regulation 874/2004 as well as stated and requested by Section 11(1) and 20(1) of .eu Sunrise Rules, since the applicant Tegometall Ladenbau GmbH, Germany demonstrated a right which is prior to his domain name application, inter alia, with the proper documentary evidence - Licence agreement allowing it to use the Community trademark HDS for the domain name purposes.

The Respondent correctly accepted the application of Tegometall Ladenbau GmbH, Germany in compliance with the Article 12(2) of Regulation No 874/2004 as well as Article 4 (2) b of the EC Regulation 733/2002 as well as Sections 11(1) and 20(1) of .eu Sunrise Rules. The Panel denied the complaint.