Panel Decision for dispute CAC-ADREU-001691

Case number	CAC-ADREU-001691
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Domain names	iason.eu

Case administrator

Name	Eva Zahořová

Complainant

Organization / Name	IASON Labormedizin GesmbH (now IASON GmbH), FN 152046 y

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

To the knowledge of the Panel there are no other legal proceedings that are pending or decided and that relate to the disputed domain name iason.eu.

FACTUAL BACKGROUND

The Complainant is IASON Labormedizin GesmbH (now IASON GmbH), a company registered and based in Austria. The Complainant was at the time of the application (on 7th December 2005) the sole general partner of Iason Labormedizin GesmbH & Co KG which is recorded as the owner of the Austrian registered trademark AM 710/99 for the word IASON.

On 7th December 2005 the Complainant filed for registration of the domain name iason.eu ("the Domain Name"). The Registry rejected the application for registration of the Domain Name because the name of the Domain Name applicant was not identical with the holder of the Austrian Trademark.

Complainant requests the Arbitration Board (Panel) to reverse the decision of the Register denying the application of the Complainant concerning registration of the domain name iason.eu and revise said application to the effect that the Complainant's application concerning registration of the domain name iason.eu be granted.

A. COMPLAINANT

According to Complainant it is an undertaking registered with the Austrian Register of Companies under the number FN 152046 y with its registered office in 8054 Graz, Feldkirchnerstrasse 4, Austria. Since March 14, 1994, the Complainant has been the only personally liable shareholder of IASON Labormedizin Gmbh & Co KG, registered with the Austrian Register of Companies under the number FN 114908 h. A "KG (Kommanditgesellschaft)" is in Austrian law described as follows: ".. in a KG there must be at least one partner with unlimited liability for the partnership's debts (general partner – Komplementär), and at least one partner who is only liable for a specified maximum amount registered in the commercial register (limited partner – Kommanditist). Frequently, the general partner (the Complainant) is a GmbH. This type of a mixed company is referred to as GmbH & Co KG and is often chosen for tax, liability, and management reasons. The company name of a KG must contain the name of at least one general partner and an addition indicating the existence of a partnership. The general partner (here: the Complainant) represents and manages the KG." (Panel´s Decision No. 00232, DMC Design for Media and Communication GmbH – EURid). Therefore, the Complainant and IASON Labormedizin GmbH & Co KG have to be treated as one (as a single organisation) for the purpose of a Domain Name application and prior rights verification (Panel´s Decision No. 00232, DMC Design for Media and Communication GmbH – EURid)

On the basis of a contribution agreement dated December 23, 2005, the assets of IASON Labormedizin Gmbh & Co KG were taken over by the Complainant as universal successor including all and any rights and obligations in accordance with Art. 142, Austrian Commercial

Code, (öHGB) and IASON Labormedizin Gmbh & Co KG was struck off the Austrian Register of Companies. Only the name of the Complainant was changed from IASON Labormedizin GesmbH to IASON GmbH.

Since April 20, 1999, the series of letters 'IASON' has been registered with the Austrian Patent office as a trademark on behalf of IASON Labormedizin Gmbh & Co KG under AM 710/99, registration number 181 701. Additionally, the mark 'IASON' has been protected under the Madrid Agreement Concerning the International Registration of Marks ('the Madrid Agreement', registration number 722035) for Germany, Croatia, Spain, France, Hungary, Italy, the Czech Republic, Slovenia, Switzerland, and the Benelux countries on behalf of IASON Labormedizin Gmbh & Co KG since December 2, 1999. The Complainant, as (former) personally liable shareholder, has at all times been entitled to use the mark 'IASON' as it had been granted the pertinent (licensing) rights by IASON Labormedizin Gmbh & Co KG. In addition to that, the Complainant and IASON Labormedizin GmbH & Co KG have to be treated as one, also in reference to the right to use the trade mark. This is (inter alia) obvious from the fact that the mark 'IASON' is a central component of the Complainant's registered name.

With the transfer of assets in accordance with Art. 142, Austrian Commercial Code, the trademark rights concerning the mark 'IASON' devolved on the Complainant also ex lege.

By virtue of the application dated February 7, 2005, i.e. within the 'Sunrise Period I', the Complainant applied to the Register for the registration of the domain name „iason.eu" through the Registrar info.at Internet GmbH & Co KG. This application was denied by EURid. The Complainant has not been informed of any reasons or given any reference number pertaining to the Register's negative decision. In any case, however, this negative decision violates Community law as all requirement for the registration of the domain name iason.eu according to Regulation (EC) No 733/2002 (Official Journal L 113, April 30, 2002), as well as Regulation (EC) No 874/2004 (Official Journal L 162, April 30, 2004) have been fulfilled, i.e.
- the Complainant is an undertaking with a registered office within the Community in accordance with Art. 4, Para. 2, Regulation (EC) No 733/2002;
- before the taking over its assets in accordance with Art. 142, Austrian Commercial Code, the Complainant, as personally liable shareholder of IASON Labormedizin Gmbh & Co KG, had at all times been entitled to use the mark 'IASON' and was thus a licensee in accordance with Art. 12, Para. 2, Regulation (EC) No 874/2004; since the aforementioned transfer of assets of December 23, 2005, the Complainant itself has been the holder of the trademark;
- the domain name 'iason' to be registered is a protected trademark in accordance with Art. 12, Para. 2, Regulation (EC) No 874/2004

Complainant concludes that the denial of the registration runs contrary to Community law and Complainant requests the Arbitration Board (Panel) to reverse the decision of the Register denying the application of the Complainant concerning registration of the domain name iason.eu and revise said application to the effect that the Complainant's application concerning registration of the domain name iason.eu be granted.

B. RESPONDENT

Respondent mentions the following.

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

Pursuant to article 14 of the Regulation, it is up to the applicant to submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. Based on this documentary evidence, the validation agent shall examine whether the applicant has prior rights on the name.

Article 20.3. of the Sunrise Rules states that "If, for any reasons other than as are referred to in Section 20(1) and 20(2) hereof, the Documentary Evidence provided does not clearly indicate the name of the Applicant as being the holder of the Prior Right claimed (e.g. because the Applicant has become subject to a name change, a merger, the Prior Right has become subject to a de iure transfer, etc.), the Applicant must submit official documents substantiating that it is the same person as or the legal successor to the person indicated in the Documentary Evidence as being the holder of the Prior Right".

Iason Labormedizin GesmbH ("the Complainant") applied for the domain name IASON on 7 December 2005. The validation agent received the documentary evidence on 3 January 2006, which was before the 16 January 2006 deadline.
The Complainant submitted documentary evidence consisting of the Austrian registered trademark IASON (No. 181 701). However, this trademark is not registered in the name of the Complainant, but in the name of "Iason Labormedizin GesmbH & CO KG" (hereafter "the Trademark Holder").

The Complainant did not submit documentary evidence substantiating that the Complainant is licensed by the Trademark Holder or that it is the same person as or the legal successor to the Trademark Holder.

Based on the documentary evidence, the validation agent concluded from the documentary evidence that the Complainant did not demonstrate that it was the holder or the licensee of a prior right on the name IASON.

Therefore, the Respondent rejected the Complainant's application.

DISCUSSION AND FINDINGS

In the opinion of the Panel, the Complainant's argument that the Complainant and the Trademark Holder are to be treated as one is not valid since the two parties are registered with the Austrian Register of Companies separately under two different registration numbers. The fact that the Complainant is the general partner of the Trademark Holder and manages the Trademark Holder does not mean that for the purposes of the .eu domain name application the Complainant as Applicant should be considered as being an identical party to the Trademark Holder as the holder of the Prior Right (the trade mark), which distinction is evidenced by the fact that the Trademark Holder, Iason Labormedizin GesmbH & CO KG (a limited partnership), is the owner of the Prior Right and not the Complainant. Within a group of companies the parties obviously have a choice of whether Iason Labormedizin GesmbH or Iason Labormedizin GesmbH & CO KG apply for the .eu domain name in the same manner as they had a choice at the time the Iason group applied for the Iason trade mark. A choice which turns out to be incorrect cannot be corrected in an ADR proceeding. This is in particular true as, according to Section 4.1 of the Sunrise Rules, the Applicant (= the Complainant) represented and warranted that it is the owner, right-holder or licensee of the Prior Right claimed; such representation and warranty was untrue as the Documentary Evidence submitted by the Complainant showed that the Complainant was not, at the time the .eu domain name was applied for, the registered owner of the Prior Right. It is not up to the Panel to correct in an ADR-Procedure mistakes of an administrative or legal nature made by the Complainant.

Para 2 of Section 13(2) of the Sunrise Rules provides that the Documentary Evidence must clearly evidence that the Applicant is the reported owner of the registered trademark. Para 3 of Section 13(2) of the Sunrise Rules provides that if the Applicant is a licensee of a registered trademark, then Section 20 shall apply. Section 20.1 of the Sunrise Rules provides that if an Applicant has obtained a license for a registered trademark in respect of which it claims a Prior Right, it must enclose with the Documentary Evidence an acknowledgement and declaration form, duly signed by both the licensor of the relevant registered trade mark and the Applicant (as licensee). The Complainant had not filed any documentation or evidence certifying the 'license', 'acknowledgement' or 'declaration' from the Trademark Holder in accordance with Section 20.1 of the Sunrise Rules that it was entitled or authorized by the Trademark Holder to take advantage of the prior rights of the Trademark Holder to register the domain name in its own name.

Section 20.3 of the Sunrise Rules states that if the Documentary Evidence provided does not clearly indicate the name of the Applicant as being the holder of the Prior Right claimed (e.g., because the Applicant has become subject to a name change, a merger, the Prior Right has become subject to a de jure transfer, etc), the Applicant must submit official documents substantiating that it is the same person as or the legal successor to the person indicated in the Documentary Evidence as being the holder of the Prior Right. The Complainant did not provide any such Documentary Evidence and, in any case, while the application for registration of the domain name was filed on 7 December 2005, the merger of the Complainant with the Trademark Holder on 23 December 2005 is a post-application event that the Registry could not take cognizance of under Section 20.3 of the Sunrise Rules if it had been made aware of such merger. Only Prior Rights that exist and are valid on the date of the application, and evidenced as such, can be considered for the purposes of the Domain Name registration under the Sunrise Rules.

Consequently, the Panel is of the opinion that the Respondent's decision does not conflict with Commission Regulation (EC) No 874/2004 of 28 April 2004.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel decides to dismiss the Complaint.

PANELISTS

Name	**Dinant Oosterbaan**

DATE OF PANEL DECISION 2006-08-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

In the opinion of the Panel, the Complainant's argument that the Complainant and the Trademark Holder are to be treated as one is not

valid since the two parties are registered with the Austrian Register of Companies separately under two different registration numbers. The fact that the Complainant is the general partner of the Trademark Holder and manages the Trademark Holder does not mean that for the purposes of the .eu domain name application the Complainant as Applicant should be considered as being an identical party to the Trademark Holder as the holder of the Prior Right (the trade mark), which distinction is evidenced by the fact that the Trademark Holder, Iason Labormedizin GesmbH & CO KG (a limited partnership), is the owner of the Prior Right and not the Complainant. Within a group of companies the parties obviously have a choice of whether Iason Labormedizin GesmbH or Iason Labormedizin GesmbH & CO KG apply for the .eu domain name in the same manner as they had a choice at the time the Iason group applied for the Iason trade mark. A choice which turns out to be incorrect cannot be corrected in an ADR proceeding. This is in particular true as, according to Section 4.1 of the Sunrise Rules, the Applicant (= the Complainant) represented and warranted that it is the owner, right-holder or licensee of the Prior Right claimed; such representation and warranty was untrue as the Documentary Evidence submitted by the Complainant showed that the Complainant was not, at the time the .eu domain name was applied for, the registered owner of the Prior Right. It is not up to the Panel to correct in an ADR-Procedure mistakes of an administrative or legal nature made by the Complainant.

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