Panel Decision for dispute CAC-ADREU-001878

Case number	CAC-ADREU-001878
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Domain names	rosbacher.eu, bizzl.eu, hassia-sprudel.eu, hassia-gruppe.eu, elisabethen.eu

Case administrator

Name	Eva Zahořová

Complainant

Organization / Name	Hassia Mineralquellen GmbH & Co. KG, Johannes Schneider

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

The Panel is not aware of any other legal proceedings.

FACTUAL BACKGROUND

Within the Phased Registration Period (“Sunrise Period”), the Complainant applied for the registration of five domain names in the .eu space namely, “rosbacher.eu”, “bizzl.eu”, “hassia-sprudel.eu”, “hassia-gruppe.eu” and “elisabethen.eu”. Together with the necessary application forms, the Complainant submitted a copy of the extracts of the German Patent and Trade Mark Office and a copy of the form “Registering a Transfer of Right in the Trade Mark” as a documentary evidence that the Complainant is the trade mark proprietor in the words “rosbacher”, “bissl”, hassia-sprudel”, “hassiagruppe” and “elisabethenquelle”. Therefore, the Complainant alleges that they should have been entitled to register the domain names during the Sunrise period.

The Complaint was filed on 23rd June, 2006 in English, which is the official language of the proceedings, along with the relevant annexes, which were both in German and English. On 30th June 2006, according to paragraph B1 (d) of the .eu Dispute Resolution Rules (the ADR Rules), the Czech Arbitration Court acknowledged receipt of the Complaint.

The Respondent filed his response on 12th September 2006 and the Czech Arbitration Court acknowledged receipt of the Response on the same day. On 12th September 2006, the Provider appointed the selected Panellist and on the same day the Provider received his Statement of Acceptance and Declaration of Impartiality and Independence.

A. COMPLAINANT

The Complainant argues that the Respondent’s decision not to allow the registration of the domain names “rosbacher.eu”, “bizzl.eu”, “Hassia-sprudel.eu”, “Hassia-gruppe.eu” and “elisabethen.eu” is not in accordance with Article 14 of the Commission Regulation (EC) No. 874/2004 of 28th April 2004 and Chapter V (Validation of Prior Rights), section 13.2 (ii) of the Sunrise Rules. According to the complainant, the documents submitted for the registration of the abovementioned .eu domain names fulfil all the requirements and thus, the Complainant is entitled to the registration of these domain names.

a) The domain name “rosbacher”

In order for the Complainant to verify that they are entitled to the .eu domain name “rosbacher” as the owner of the identical trademark, the Complainant submitted an extract from the online database of the German Patent and Trademark Office for which a copy of the extract was attached as Annex III.

Because this extract showed and still does the VMH Vereinte Mineral und Heilquellen GmbH & Co. KG as the owner of the trade mark

and thus not the complainant, the latter also submitted a copy of the form “Registering a Transfer of Rights in the Trademark”(Annex IV). With this form, the Complainant informed the German Patent and Trade Mark Office that it is the legal successor of VMH and therefore the owner of the trade mark.

Even though the German Patent and Trade Mark office had not registered the change in ownership until the time of applying for the registration of the .eu domain name, both copies together show that the Complainant is the owner of the trade mark “rosbacher” and therefore entitled to the domain “rosbacher.eu”.

For clarification purposes, the Complainant states the following:

In November 2001, a company named Urquelle Mineralbrunnen GmbH bought VMH and with the acquisition of the entire company, the trade marks - including the contested “rosbacher” trade mark - have been transferred to Urquelle. To evidence this transfer, the Complainant encloses a copy of the relevant part of the Deed of Sale duly signed by Urquelle and VMH. (Annex V – translated into English)

According to the extract of the business register (Annex VI), in December 2001, Urquelle changed its name to Rosbacher Brunnen GmbH. Finally, in September 2003, Rosbacher merged with Hassia & Luisen Mineralquellen Bad Vilber GmbH & Co. KG.

The Hassia & Luisen Mineralbrunnen Bad Vilbel GmbH & Co. KG has then changed its company name twice: first to Hassia Mineralquellen Bad Vilbel GmbH & Co. KG and then to the complainant’s current name Hassia Mineralquellen GmbH & Co. KG. To prove these changes, the Complainant encloses an extract of the relevant page of the German business register as Annex VII.

Therefore, the Complainant argues that they are the successor of VMH, the prior owner of the trade mark “Rosbacher” and in addition they are entitled to the .eu domain name “rosbacher.eu”.

b) “bizzl.eu”

The Complainant contends that in a similar fashion to the abovementioned, the same applies to the trade mark ‘bizzl”. The Complainant submitted an extract from the online database of the German Patent and Trade Mark Office, which proved that Bad Vilbeler Urquelle Mineralbrunnen GmbH & Co. KG is the owner of the trade mark (Annex VIII).

Similar to the abovementioned case, because the extract did not show the Complainant as the owner of the trade mark, the Complainant submitted a copy of the form “Registering a Transfer of Rights in the Trade Mark”, with which the Complainant informed the German Patent and Trade Mark Office that they are the assignee of the company as well as the owner of the trade mark (Annex IX).

Consequently, the complainant, under its former company name Hassia & Luisen Minerquellen Bad Vilbel GmbH & Co., acquired Bad Vilbeler Urquelle by acquiring all limited partners’ capital contributions. (Annex X)

Therefore, the Complainant alleges that they are the successor of Bad Vilbeler Urquelle Mineralbrunnen GmbH & Co. KG, hence, the owner of the trade mark “Bizzl” and, additionally, entitled to register “bizzl.eu”.

Finally, in both cases, a copy of the WHOIS database shows that the documents have been received within the deadline.

Based on all the above, the Complainant argues that he is entitled to the register the domain names, since they are the proprietors of the trade marks. Therefore, the Complainant believes that the Registry’s decisions of 16th May 2006 are not in conformity with Article 14 of the Commission Regulation (EC) No. 874/2004 and Chapter V (Validation of Prior Rights), section 13.2 (ii) of the Sunrise Rules so that the identified decisions have to be annulled.

Moreover, the Complainant contends that, according to B11 (C) of the ADR Rules, because they are the sole Complainants for registration of these .eu domain names and fulfil the requirements of Article 4 Para. 2 (b) (i) of the Community Regulation EC No. 733/2002, i.e. being an undertaking which has its registered office within the Community, both names have to be attributed to them.

c) “hassia-sprudel.eu”

To prove the ownership of the prior trade mark rights in the word “Hassia-Sprudel”, the Complainant submitted together with the relevant

application forms an extract from the online database of the German Patent and Trade Marks Office for the trade mark “Hassia-Sprudel”, which clearly shows that the Complainant is the owner of the trade mark.

However, according to the complainant, with email as of 25th May 2006, the Registrar rejected the registration of this domain name due to the fact that the documents submitted were not sufficient to prove the claimed rights.

The Complainant challenges this decision, arguing that it is not in compliance with Article 14 of the Commission Regulation No. 874/2004 and Chapter V (Validation of Prior Rights), section 13.2 (ii) of the Sunrise Rules.

d) “hassia-gruppe.eu”

Regarding the application for registration of the domain name “hassia-gruppe.eu”, the Complainant submitted together with the relevant application forms an extract from the online database of the German Patent and Trade Mark Office for the trade mark “HassiaGruppe”, which clearly show that the Complainant is the owner of the trade mark rights in this word.

However, the Complainant argues that with emails as of 8th June 2006, the Registry rejected the registration of this domain name due to the fact that the documents the Complainant submitted were not sufficient to prove the claimed rights (Annex XVII).

The Complainant contends that the extract, which is attached as an Annex (XVIII) clearly shows that the Complainant is the owner of the trade mark “HassiaGruppe”. Moreover, a copy from the relevant WHOIS database shows that the documents were received within the deadline (Annex XIX).

Furthermore, the Complainant also argues that they applied for the registration of the .eu domain name “hassia-gruppe.eu”, which the Registry accepted (Annex XX).

Therefore, the Complainant argues that the Registry’s decision of not registering the abovementioned domain name because the submitted evidence was not sufficient to prove the rights, is not in accordance with Article 14 of the Commission Regulation No. 874/2004 and especially not with Chapter V (Validation of Prior Rights), section 13.2 (ii) of the Sunrise Rules so that the identified decision has to be annulled.

e) “elisabethen.eu”

To register the domain name “elisabethen.eu”, the Complainant submitted together with the relevant application forms an extract from the online database of the German Patent and Trade Mark Office for the trade mark “Elisabethenquelle”, which clearly shows that the Complainant is the owner of the trade mark rights in this word.

However, according to the complainant, with email as of 18th June 2006, the Registrar rejected the registration of this domain name due to the fact that the documents submitted were insufficient to prove the claimed trade mark rights. (Annex XXI)

The Complainant further contends that when it comes to “elisabethen.eu”, the Complainant clarifies that they are the proprietors of “Elisabethenquelle”. The mere fact that the trade mark right is not identical with the domain name applied for is not sufficient to reject the registration. The trade mark “Elisabethenquelle” is characterised by the element of “elisabethen”. The element “quelle” is merely a descriptive term for the source where the goods – i.e. mineral waters – come from. In addition, the mark “Elisabethenquelle” is confusingly similar to “elisabethen” so that the Complainant also is entitled to the domain name “elisabethen.eu” based on its trade mark “Elisabethenquelle” to foreclose the possibility that an unauthorised person claims any rights in this name with respect to the complainant’s goods.

Moreover, the Complainant stresses out that they are also the owners of the trade mark “Elisabethen”. In order to prove this they provide an extract from the online database of the German Patent and Trade Mark Office (Annex XXIII).

For all the abovementioned reasons, the Complainant seeks the remedies of annulment of the disputed decisions taken by the Registry, and the attribution of the domain name to the complainant, according to the ADR Rules, Paragraph B1(b)(11), B11(c).

B. RESPONDENT

The Respondent in his response provided the grounds on which they rejected the application by Hassia Mineralquellen GmbH for the domain names Rosbacher, Bizzl, Hassia-Gruppe Hassia Sprudel and elisabethen.

1. The application for the domain name Rosbacher.

According to the Respondent, the Complainant submitted documentary evidence of a certificate of registration for the German trade mark Rosbacher registered in the name of “VHM Mineral und Heilquellen GmbH & Co. KG.

The Complainant also submitted a document requesting the German Patent and Trade Mark office to transfer the trade mark to “Hassia Mineralquellen GmbH & Co. KG”. This document is dated 20th February 2006 and is signed only by “Hassia Mineralquellen GmbH & Co. KG”. Based on the documentary evidence, the validation agent concluded that the Complainant did not demonstrate that it was the holder or the licensee of a prior right on the name Rosbacher.

2. The application for the domain name Bizzl.

The Complainant submitted documentary evidence consisting of a certificate of registration for the German trade mark Bizzl registered in the name of “Bad Vilber Urquelle Mineralbrunnen GmbH & Co. KG”

The Complainant also submitted a document requesting the German Patent and Trade Mark office to transfer the trade mark Bizzl to “Hassia Mineralquellen GmbH & Co. KG. This document is dated 20th February 2006 and is signed only by “Hassia Mineralquellen GmbH & Co. KG. Based on the documentary evidence, the validation agent concluded that the Complainant did not demonstrate that it was the holder or the licensee of a prior right on the name Bizzl. Therefore, the Respondent rejected the Complainant’s application.

3. The application for the domain name Hassia-Sprudel.

The Complainant submitted documentary evidence consisting of a certificate of registration for the German trade mark Hassia-Sprudel registered in the name of “Bad Vilber Urquelle Mineralbrunnen GmbH & Co. KG”

The device trade mark is comprised of graphical elements and many alphanumerical characters. Based on the documentary evidence, the validation agent concluded that the Complainant did not demonstrate that it was the holder or the licensee of a prior right on the name Hassia-Sprudel only. Therefore, the Respondent rejected the Complainant’s application.

4. The application for the domain name Hassia-Gruppe

The Complainant submitted documentary evidence consisting of a certificate of registration for the German trade mark Hassia-Gruppe registered in the name of “Bad Vilber Urquelle Mineralbrunnen GmbH & Co. KG”
The devised trade mark is only comprised of the alphanumeric characters HassiaGruppe. Based on the documentary evidence, the validation agent concluded that the Complainant did not demonstrate that it was the holder or the licensee of a prior right on the name Hassia-Gruppe. Therefore, the Respondent rejected the Complainant’s application.

5. The application for the domain name Elisabethen.

The Complainant submitted documentary evidence consisting of a certificate of registration for the German trade mark Elisabethenquelle registered in the name of “Bad Vilber Urquelle Mineralbrunnen GmbH & Co. KG”.

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

According to the Respondent, the burden of proof was with the Complainant to demonstrate that it was the holder of a prior right for the domain names Rosbacher and Bizzl on the date of the application.

The burden of proof was on the Complainant to substantiate that it is the holder or the licensee of a prior right on the date no later than the date of the application and this burden is a high one.

It is therefore of crucial importance that the Respondent is provided with all the documentary evidence necessary for it to assess whether the Complainant is indeed the holder or the licensee of a prior right on the date of the application.

The Respondent argues that pursuant to section 20.2 of the Sunrise Rules, if the documentary evidence does not clearly indicate the

name of the Complainant as being the holder of the prior right claimed, the Complainant must submit an acknowledgement and declaration from duly completed and signed by both the transferor of the relevant prior right and the Complainant (as transferee). [The Respondent cites case ADR 1886 (GBG)]. In the present case, the name of the Complainant is “Hassia Mineralquellen GmbH”. The name of the trade mark holder is “VHM Mineral und Heilquellen GmbH & Co. KG” for the trade mark ‘Rosbacher’ and “Bad Vilber UrQuelle Mineralbrunnen GmbH & Co. KG” for the trade mark ‘Bizzl’. Despite these different names, the Complainant did not submit the acknowledgement and declaration from duly completed and signed by both the transferor of the relevant prior right and the Complainant (as transferee), pursuant to section 20.2 of the Sunrise Rules.

Nevertheless, the Complainant argues that the Complainant submitted two forms requesting the German Patent and Trade Mark office to transfer the trade marks ‘Rosbacher’ and ‘Bizzl’ to “Hassia Mineralquellen GmbH & Co. KG”.

Therefore, the Respondent is of the following opinion:

First, since the two forms were not duly signed by both parties but only by the alleged transferee “Hassia Mineralquellen GmbH & Co. KG”, those documents could not be used to establish anything with regard to the transferors.

Second, the form submitted were both dated 20th February 2006. As a result, the forms could not establish that “Hassia Mineralquellen GmbH & Co. KG” was the holder of the trade marks on 24th January 2006 (which is the date of the application), pursuant to article 10 (1) of the Regulation and section 11.3 of the Sunrise Rules.

Finally, the Respondent also notes that the name of the Complainant is “Hassia Minerquellen GmbH” and not “Hassia Mineralquellen GmbH & Co. KG”, which means that the Complainant is a different legal entity from “Hassia Minerquellen GmbH & Co. KG”. The Respondent refers the Panel to the decision ADR 1691 (IASON): “Within a group of companies the parties obviously have a choice of whether Lason Labormedizin GesmbH or Lason Labormedizin GesmbH & Co. KG apply for the .eu domain name in the same manner as they had a choice at the time the Lason group applied for the Lason trade mark. A choice which turns out to be incorrect cannot be corrected in an ADR proceeding”. The Respondent further notes that this argument is equally applicable to the applications for the domain names ‘Hassia-Sprudel’, ‘Hassia-Gruppe’ and ‘Elisabethen’.

Therefore, according to Respondent, the documentary evidence submitted by the Complainant did not clearly demonstrate that the Complainant was the holder of the claimed prior rights. The Respondent had thus no choice but to reject the Complainant’s application. For these reason, the Complaint regarding the domain names ‘Rosbacher’ and ‘Bizzl’ must be rejected.

Further, the Respondent contends that the domain names ‘Hassia-Sprudel’, ‘Hassia-Gruppe’ and ‘Elisabethen’ did not consist of the complete name of the prior right on which the application is based.

Article 10(2) of the Regulation 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. This means, pursuant to section 19(2) of the Sunrise Rules that all alphanumeric characters (including hyphens, if any) included in the trade mark must be contained in the domain name applied for.

In other words, no alphanumeric character of the trade mark relied upon as a prior right may be deleted from or added to the alphanumeric characters of the domain name applied for.

1. Regarding the application for the domain name ‘Hassia-Sprudel’, the Respondent contends that the device trade mark relied upon is comprised of graphical elements and many alphanumerical characters: Hassia, Sprudel, Naturlisches Mineralwasser, and many other characters. This means that the trade marks submitted by the Complainant could not serve as a prior right on the name ‘Hassia-Sprudel’ alone. To support this argument, the Respondent further quotes the very similar ADR decision 470 (O2).

2. Regarding the application for the domain name ‘Hassia-Gruppe’, the Respondent contends that the trade mark ‘HassiaGruppe’ (without any hyphen) submitted by the Complainant did not correspond to the domain name applies for Hassia-Gruppe (with a hyphen). The Complainant is not free to delete or add a hyphen from the name of the trade mark relied upon. This clearly means that the trade mark HassiaGruppe submitted by the Complainant could not establish a prior right on the name ‘Hassia-Gruppe’ with an added hyphen. To further strengthen this argument, the Respondent refers the Panel to decision ADR 1262 (NationalBank).

Finally, the Respondent asserts that the Complainant’s argument that the Respondent already accepted the Complainant’s registration for the domain name ‘HassiaGruppe’ based on the trade mark ‘HassiaGruppe’ does not help the Complainant. To the contrary, it clearly shows that the trade mark ‘HassiaGruppe’ could only serve as a prior right for the domain name ‘HassiaGruppe’, pursuant to article 10 (2) of the Regulation and section 19 (2) of the Sunrise Rules.

3. Regarding the application for the domain name 'Elisabethen', the Complainant agrees that the trade mark submitted with the documentary evidence 'Elisabethenquelle' is not identical to the domain name applied for. However, the Complainant contends that this mere fact was not sufficient to reject the application since the element "Quelle" is merely descriptive to the goods.

The Regulation does not provide that only the distinctive elements of a trade mark must be included in the domain name. to the contrary, the Regulation and 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 (article 10(2) of the Regulation) and that all alphanumeric characters (including hyphens, if any) included in the sign must be contained in the domain name applied for (section 19(2) of the Sunrise Rules).

The difference between distinctive and non-distinctive elements may be of great importance in trade mark law, but this difference is not applicable in the determination of the prior rights under the Regulation and the Sunrise Rules. Therefore, the Respondent was not allowed to engage into the appreciation of the distinctive character of the various elements of the trade mark. The Respondent was only instructed to verify that all alphanumeric characters included in the trade mark are contained in the domain name applied for. The Respondent was therefore correct to reject the application, because the Complainant applied for the domain name 'Elisabethen' without demonstrating a prior right on the name 'Elisabethen' alone.

According to the Respondent elements that were not part of the documentary evidence should not be taken into consideration to evaluate the Respondent's decision Article 22(1) b of the Regulation, which states that a decision taken by the Respondent may only be annulled when it conflicts with the Regulation. This verification is the only task for the Panel in these proceedings, which may not in any case serve as a "second chance" or an additional round providing Complainants an option to remedy their imperfect original application that was rejected during the Sunrise Period.

Therefore, only the documentary evidence which the Respondent was able to examine at the time of validation of the application should be considered by the Panel to assess the validity of the Respondent's decision. The Respondent requests the panel not to take into account any new evidence to evaluate whether the Respondent's decision conflicted with the Regulation, which is the only purpose of the present ADR proceedings.

For all the abovementioned reasons, the Respondent requests the panel to reject the Complaint.

DISCUSSION AND FINDINGS

The Complainant's application is made pursuant to article 22 (1) (b) of EC Regulation 874/2004, which provides that an ADR procedure may be initiated by any party where a decision taken by the Registry conflicts with EC Regulation 733/2002. Pursuant to article 22 (11) of EC Regulation 874/2004, the sole purpose of these proceedings is accordingly to determine whether the decision taken by the Respondent was in accordance with EC Regulation 874/2004 and EC Regulation 733/2002.

The Complainant seeks to annul the decision taken by the Respondent (EURid) to reject registration for the following domain names: 'rosbacher.eu', 'bizzl.eu', 'hassia-sprudel.eu', 'hassia-gruppe.eu' and 'elisabethen.eu'.

First of all, the Panel would like to clarify that a lot of the issues appearing in the specific dispute fall outside the jurisdiction of the ADR Panel as well as the disputes that the .eu Alternative Dispute Resolution Process is meant to solve. Therefore, the Panel has decided to not deal with those issues.

1. 'rosbacher.eu' and 'bizzl.eu'

To verify that the Complainant is entitled to 'rosbacher.eu' and 'bizzl.eu' as the owner of the identical trade marks, the Complainant submitted two extracts from the online database of the German Patent and Trade Mark Office regarding the trade marks 'rosbacher' and 'bizzl'. Because these extracts do not show the Complainant as the owner of the trade marks, the Complainant also submitted a copy of the form "Registering a Transfer of Rights in the Trade Mark". With this form, the Complainant informed the German Patent and Trade Mark Office that they are the (legal) successor and therefore the owners of the trade marks.

The Respondent argued that the burden of proof lies with the Complainant to demonstrate that they are the holder of a prior right for the domain names 'rosbacher.eu' and 'bizzl.eu'. The Respondent states that in the present case the name of the Complainant is 'Hassia Mineralquellen GmbH'. However, the name of the trade mark holder is "VHM Mineral und Heilquellen GmbH & Co. KG' for the trade mark 'rosbacher' and 'Bad Vilber UrQuelle Mineralbrunnen GmbH & Co. KG' for the trade mark 'bizzl'. Despite the different names, the Complainant failed to submit the acknowledgement and declaration from duly completed and signed by both the transferor of the relevant prior right and the Complainant pursuant to section 20.2 of the Sunrise Rules. Therefore, the Respondent decided not to take

these documents into consideration; they also state that the forms were submitted at a date after the application for the domain names were made; finally, the Respondent asserts that the difference in names indicates that the Complainant and the Complainant are a different legal entity.

Nevertheless, on 30th June 2006, the Complainant filed a non standard communication document. In the annexes attached the Complainant proved that the German Patent and Trade Mark Office recorded the change of ownership regarding the trade marks 'rosbacher' and 'bizzl'.

The Panel is of the opinion that an ADR mechanism is in place in order to give the parties the chance to rectify any errors or omissions that have taken place in the past. Similarly, the mechanism is there to try and ensure that any possible cases of cybersquatting can be avoided. It is obvious that when the Complainant submitted the application for 'rosbacher.eu' and 'bizzl.eu' domain names, the information presented to the Registrar was incomplete. Due to this fact, the Registrar was correct at the time to reject the registration of the two domain names. However, the annexes attached to the non-standard communication clearly show that the German Patent and Trade Mark Office has successfully recorded the new owner of the trade marks 'rosbacher' and 'bizzl', who according to their database is Hassia Mineralquellen GmbH & Co. KG, who is the Complainant. Based on the new documents submitted before the Panel, the Panel decides that the two domain names should be attributed to the Complainant.

2. 'hassia-sprudel.eu'

To evidence ownership of the prior trade mark rights in the word 'Hassia-Sprudel', the Complainant submitted together with the relevant application forms an extract from the online database of the German Patent and Trade Mark Office for the trade mark 'Hassia-Sprudel', which clearly shows the Complainant as the owner of the trade mark.

The Respondent, on the other hand, contends that the device trade mark relied upon is comprised of graphic elements and many alphanumerical characters: Hassia, Sprudel, Naturlisches Mineralwasser, and many other characters. This means that the trade mark submitted by the Complainant could not serve as a prior right on the name 'Hassia-Sprudel' alone.

For this specific domain name the Panel took the initiative and made some further investigations. Specifically, the Panel searched the database of the German Patent and Trade Mark Office and is concerned about the ownership of the trade mark. Contrary to the former two domain names, in this case the result of the search showed that 'Hassia and Luisinen Mineralquellen Bad Vilbel GmbH. & Co.' is the owner, an entity which is not the same as the Complainant. The Panel considers that the Complainant failed to carry the burden of proof and prove ownership of both the trade mark and the domain name. At the same time, the Panel does not agree with the contention of the Respondent. The nature of the Domain Name Addressing System is such that it is highly difficult to create a domain name that includes all the features and representations of a trade mark. Trade mark owners have the tendency to register the main part of their trade marks as domain names, without including graphical and any other alphanumerical elements. However, based on concerns about ownership of the trade mark and questioning why the German Patent and Trade Mark Office has not recorded the change of ownership of the trade mark (even though the transfer of rights was made on the 26th March 2004), the Panel is of the opinion that the Complainant has not managed to prove prior rights on the trade mark and, therefore, the Complainant should not be entitled to register the domain name 'hassia-sprudel.eu'.

3. 'hassia-gruppe.eu'

Regarding the application for registration of the 'hassia-gruppe.eu' domain name, the Complainant submitted together with the relevant application forms an extract from the online database of the German Patent and Trade Mark Office for the trade mark 'HassiaGruppe', which clearly show that the Complainant is the owner of the trade mark rights in this word.

On the other hand, the Respondent contends that the trade mark HassiaGruppe (without any hyphen) submitted by the Complainant did not correspond to the domain name for Hassia-Gruppe (with a hyphen). The Complainant is not free to delete or add a hyphen from the name of the trade mark relied upon. This clearly means that the trade mark HassiaGruppe submitted by the Complainant could not establish a prior right on the name Hassia-Gruppe with an added hyphen.

The Panel will agree with the Respondent on that issue. Even though article 11 of the Commission Regulation EC No. 874/2004 refers to the cases whereby there is a space between the textual or word elements and how such elements should be represented in a domain name, a wide interpretation leads to the conclusion that the rationale behind this article is to ensure that trade mark owners choose a domain name that represents their trade marks as similarly as possible. In this case, the Complainant had the option, since its application took place during the Sunrise Period, to choose to register the domain name 'hassiagruppe.eu' (with no hyphen), which would represent their trade mark. Since the Complainant chose not to register such a version of a domain name, the Panel will agree with the

Register and concludes that the Complainant should not be entitled to register the domain name ‘hassia-gruppe.eu’.

4. ‘elisabethen.eu’

To register the domain name ‘elisabethen.eu’, the Complainant submitted together with the relevant application forms an extract from the online database of the German Patent and Trade Mark Office for the trade mark ‘Elisabethenquelle’, which clearly shows that the Complainant is the owner of the trade mark rights in this word. The Complainant also enclosed a relevant extract (Annex XXII), which showed that the Complainant is the owner of the trade mark ‘Elisabethenquelle’. According to the Complainant, the mere fact that the trade mark right is not identical with the domain name applied for is not sufficient to reject the registration. The trade mark ‘Elisabethenquelle’ is characterised by the element ‘elisabethen’. The element ‘quelle’ is merely a descriptive for the source where the goods – i.e. mineral waters – come from. Additionally, the mark ‘Elisabethenquelle’ is confusingly similar to ‘elisabethen’ so that the Complainant also is entitled to the domain name ‘elisabethen.eu’ based on its trade mark ‘Elisabethenquelle’ to foreclose the possibility that an unauthorised person claims any rights in this name with respect to Complainant’s goods.
The Respondent questions the possibility for the Complainant to register the domain name ‘elisabethen.eu’ even though their trade mark is ‘Elisabethenquelle’. According to the Respondent the difference between distinctive and non-distinctive elements may be of great importance in trade mark law, but this difference is not applicable in the determination of the prior rights under the Regulation and the Sunrise Rules. Therefore, the Respondent was not allowed to engage into the appreciation of the distinctive character of the various elements of the trade mark. The Respondent was only instructed to verify that all alphanumeric character included in the trade mark are contained in the domain name applied for. The Respondent, therefore, submits that it was correct to reject the application, because the Complainant applied for the domain name ‘elisabethen’ without demonstrating a prior right on the name ‘elisabethen’ alone.

The Panel will agree with the Respondent and once again will question why the Complainant did not register their trade mark as a domain name, namely ‘elisabethenquelle.eu’. The central rationale behind the Sunrise Period was to provide the opportunity to holders of trade marks to register their trade marks as domain names in order to avoid future cases of cybersquatting. If the Complainant were to have applied for the domain name ‘elisabethenquelle.eu’ and had managed to show that they were in possession of prior trade mark rights, I see no reason why the application for that particular domain name would be rejected. Moreover, the argument of the Complainant that he applied to register ‘elisabethen.eu’ in order to prohibit any possibility that an unauthorised person could claim any right in this name with respect to complainant’s goods, though it makes good sense, at the same time it loses its logic, since the Panel considers that the Complainant should have first and foremost secure his rights on the domain name ‘elisabethenquelle.eu’, which is the same as his trade mark; then, the Complainant could have moved to register any similar names as domain names. For the abovementioned reasons the Panel concludes that the Complainant should not be entitled to register the domain name ‘elisabethen.eu’.

DECISION

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

With respect to the domain names ‘rosbacher.eu’ and ‘bizzl.eu’, EURid’s decision is annulled and the domain names ‘rosbacher.eu’ and ‘bizzl.eu’ are attributed to the Complainant;

With respect to the domain names ‘hassia-sprudel.eu’, ‘hassia-gruppe.eu’ and ‘elisabethen.eu’ the Complaint is denied.

PANELISTS

Name	**Konstantinos Komaitis**

DATE OF PANEL DECISION 2006-09-15

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant argues that the Respondent’s decision not to allow the registration of the domain names “rosbacher.eu”, “bizzl.eu”, “hassia-sprudel.eu”, “hassia-gruppe.eu” and “elisabethen.eu” is not in accordance with Article 14 of the Commission Regulation (EC) No. 874/2004 of 28th April 2004 and Chapter V (Validation of Prior Rights), section 13.2 (ii) of the Sunrise Rules.

The Respondent contends that the decision not to register the contested domain names was correct, because the Complainant had failed to carry the burden of proof and show that the Complainant had prior rights on the trade marks and therefore on the domain names.

The Panel found that the evidence submitted by the Complainant were sufficient to show prior rights on the domain names

‘rosbacher.eu’ and ‘bizzl.eu’ and therefore ordered these two domain names to be registered to the Complainant. However, for the domain names ‘hassia-sprudel.eu’, ‘hassia-gruppe.eu’ and ‘elisabethen.eu’, the Panel denied the Complaint.