Panel Decision for dispute CAC-ADREU-001929

Case number	**CAC-ADREU-001929**
Time of filing	**2006-06-26 11:02:56**
Domain names	**national-bank.eu**

Case administrator

Name	**Eva Zahořová**

Complainant

Organization / Name	**National-Bank AG**

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

None

FACTUAL BACKGROUND

On 7 December 2005 (that is to say during the Sunrise 1 period), the Complainant filed an application for registration of the domain name “national-bank”.

Documentary Evidence transmitted by the Complainant is limited to one letter, originating from “Deutsches Patent- und Markenamt”, dated May, 20th, 2005, sent to a lawyer, whose title is “Empfangsbescheinigung”, stating as such:

(Begin of quote)

Ihre Anmeldung der Marke Nr.: 305 23 619 ist am 20.04.2005 beim Deutsche Patent- und Markenamt eingegangen. Sie wird unter dem Aktenzeichen 305 23 619.9/36 für die Leitklasse 36 zuständigen Markenstelle bearbeit (…)

Anmeider: Nationale-Bank Aktiengesellschaft, 45127 Essen
Markenform: Wort- / Bildmarke
Markentext: N NATIONAL-BANK

(End of quote)

Application has been rejected by Respondent, based on the fact that the trademark is “N NATIONAL-BANK” where the domain name requested was “national-bank”.

A. COMPLAINANT

The Complainant first claim to be the owner of various trademarks, including the following German word/picture trademarks duly registered with the German Patent and Trademark Office (“DPMA”):

- “NATIONAL-BANK”, no. 39743866.4
- “NATIONAL-BANK”, no. 39743867.2
- “N NATIONAL-BANK”, no. 0523619.9
- “DAS ZEICHEN GUTER PARTNERSCHAFT. NATIONAL-BANK”, no. 0523620.2
- “N NATIONAL BANK” no. 30523621.0

The Complainant produces DPMA database printout to prove the ownership of those trademarks.

Further, the Complainant underlines that beside trademarks, its registered trade name is “National-Bank”, and it produces its companies’ registry entry.

As a conclusion of the first two points, the Complainant contends to be eligible to obtain the domain name “national-bank.eu” during the period of phased registration before general registration of .eu domains (the “sunrise period”) pursuant to Chapter IV, Article 10(1) of the Commission Regulation (EC) No 874/2004 of 28 April 2004 (the “Regulation”).

More precisely:

- The Complainant contends to be registered under the trade name “National-Bank” with the Commercial Register of the Amtsgericht Essen, Germany, docket number HRB 820. The Complainant has been registered under this name since 13 December 1922.

- The Complainant contends that it is the registered proprietor of German national trademarks registered with the German Patent and Trademark Office. Among others, the Complainant is the registered proprietor of the trademarks number 39743866.4 and 39743867.2. The textual elements of those trademarks consist solely of the name “National-Bank”.

- The Complainant contends that it is also holding prior rights which are deemed identical to the domain name “National-Bank” under Chapter IV, Article 11 of the regulation. The word elements of the trademarks number 0523619.9, 0523620.2, and 30523621.0 consist of the name “National-Bank”.

B. RESPONDENT

Respondent first underlines that it discovered, during this procedure, that the Complainant had so many trademarks.

Respondent contends that it “would like to note that the documentary evidence only contained a letter stating that the N NATIONAL-BANK trademark had been applied for by the Complainant. The documentary evidence did not refer to any other right. The Respondent would like to note that the Complainant did not enclose the trademark registration, or even refer to it in any way, with its documentary evidence. These documents were provided to the Respondent for the first time in the framework of the present ADR proceedings”.

The Respondent asks the Panel not to consider new evidence provided by the Complainant for the first time during this procedure.

The reason for this is that as a consequence of article 14 (4), the validation agent shall make its assessment on the basis of the documentary evidence which it was timely provided with. Therefore, only the documentary evidence which the Respondent was able to examine at the time of validation of an application should be considered by the Panel.

In the Respondent view, “article 22 1 (b) of the Regulation states that ADR proceedings may only be initiated against the Respondent when the Respondent's decision conflicts with the Regulation or Regulation 733/2002. The Respondent cannot have made a decision which conflicts with these texts if it wasn't provided with all information it needed. The Respondent's decision cannot be considered to be in conflict with the applicable rules on the basis of documents it never had the opportunity to assess. Therefore the Respondent requests the Panel to disregard the new evidence submitted by the Complainant”.

On this issue, Respondent refers to cases 294 (COLT), 954 (GMP), 1186 (ERDAS), 01549 (EPAGES) and 1674 (EBAGS).

oOo

Concerning the Documentary Evidence produced during the verification process of the Sunrise Period, Respondent view is that pursuant to the Regulation and the Sunrise Rules, it is to the applicant to submit all documents which the validation agent needs to assess whether an applicant is the holder of a prior right corresponding to the domain name. In case an applicant fails to submit such documents, its application must be rejected.

On this issue, Respondent refers to cases 294 (COLT), 1071 (ESSENCE), 1232 (MCE), 1318 (SYS) and 1710 (EMI et al).

In this respect, it is respondent view that:

- The documentary evidence submitted by the Complainant (at the stage of the verification process) only includes a trademark application and provides no proof of the actual and subsequent registration of the trademark. Respondent contends that the Complainant's trademark application cannot be considered a prior right. For that reason alone, the Complaint must be rejected

- Regardless of the first point, the Respondent also underlines that the domain name applied for, did not consist of the complete name of the trademark application. The trademark application which the Complainant submitted as documentary evidence consisted of the sign “N NATIONAL-BANK” whereas the Complainant applied for the domain name “NATIONAL-BANK”. The domain name applied for missed an N.

oOo

Eventually, as far as the trade name of Complainant is concerned, Respondent recalls that it cannot be accepted per se as proof of a prior right. Indeed, domain names applied for during the first stage of the Sunrise Period [note of the Panel: the application of the Complainant was made on December, 7, 2005] may not be based on trade names, as stated in article 12 (2) of the Regulation. The Complainant's application was submitted on December 7, the first day of the Sunrise Period. The second stage started only on February 7, 2006.

DISCUSSION AND FINDINGS

There are three different categories of new evidence produced by the Complainant:
- Never-produced information on never-claimed trademarks
- Never-produced information on trade name
- Additional information concerning the prior right claimed in the application

The Panel will analyze each category separately.

Never-produced information on never-claimed trademarks

The Complainant produces evidence of ownership of the following trademarks:

- “NATIONAL-BANK”, no. 39743866.4
- “NATIONAL-BANK”, no. 39743867.2
- “DAS ZEICHEN GUTER PARTNERSCHAFT. NATIONAL-BANK”, no. 0523620.2
- “N NATIONAL BANK” no. 30523621.0

With this new documentary evidence, the Complainant substantiates prior rights that it did not even claim to have in its application! The Complainant claims today to be the owner of these trademarks (and he probably is, based on the documents provided to the Panel), but as a matter of fact, the documentary evidence given at the stage of the verification process was completely silent on them.

Accepting to take into consideration a new prior right that the Complainant did not even talked about in its application, could be detrimental to other parties who expect the Panel to apply the Rules, nothing more nothing less.

Sunrise Appeal has been created to guarantee both parties a fair trial on the way Respondent assessed the prior right claimed in the application; its purpose is not to permit applicant to add new prior rights they didn’t even claim to have in their application.

The Panel won’t take into consideration these trademarks.

Never-produced information on trade name

The Panel won't debate on this issue because regardless the answer to the question, it is for sure that a trade name is not a prior right in the sense of the Sunrise 1 Period [note of the Panel: the application of the Complainant was made on December, 7, 2005].

Article 12 (2) of Regulation 874/2004 is very clear on this:

"The duration of the phased registration period shall be four months. General registration of domain names shall not start prior to the completion of the phased registration period.

Phased registration shall be comprised of two parts of two months each.

During the first part of phased registration, only registered national and Community trademarks, geographical indications, and the names and acronyms referred to in Article 10(3), may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in Article 10(1) [note of the Panel: this period is the so-called Sunrise 1 Period].

During the second part of phased registration, the names that can be registered in the first part as well as names based on all other prior rights can be applied for as domain names by holders of prior rights on those names".

Additional information concerning the prior right claimed in the application

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The question here is quite different.

Obviously, in its application and in the Documentary Evidence, the Complainant claimed a prior right on trademark "N NATIONAL-BANK", no. 0523619.9. To substantiate its prior right, the Complainant produced at that time a letter originating from "Deutsches Patent- und Markenamt", dated May, 20th, 2005, sent to a lawyer, whose title is "Empfangsbescheinigung" (see here above 'Factual Backgrounds' for details).

Now, in the course of this proceeding, the Complainant produces a printout of the German Patent and Trademark Office (DPMA) database.

In the Panel view, the production of the new evidence follows a different regime because the central question raised by the "Empfangsbescheinigung" is its status: is it a valid evidence of a trademark?

The Respondent saw this document merely as "a trademark application and provides no proof of the actual and subsequent registration of the trademark. The Complainant's trademark application cannot be considered a prior right. For that reason alone, the Complaint must be rejected".

If the new evidence provided today was useful for the Panel to verify whether or not the Respondent made a good assessment of the application and took the right decision (for example if this new evidence was necessary to assess the exact status of the "Empfangsbescheinigung"), the Panel would have take it into consideration.

This said, it appears that this debate is not necessary in the present procedure.

Indeed, 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.

The prior right claimed by the Complainant consisted of the sign "N NATIONAL-BANK".

The "Empfangsbescheinigung" states as such:

(Begin of quote)

Anmeider: Nationale-Bank Aktiengesellschaft, 45127 Essen
Markenform: Wort- / Bildmarke
Markentext: N NATIONAL-BANK

(End of quote)

Also, in the cover letter, the prior right referred to is: N NATIONAL-BANK.

The application of the Complainant and the Documentary Evidence refer to the sign “N NATIONAL-BANK” whereas the Complainant applied for the domain name “NATIONAL-BANK”.

It is thus unnecessary to debate on the validity of the new evidence provided, because whatever the answer to that question is, the Panel will always reach the same conclusion: the domain name applied for on the one hand, and the prior right claimed on the other hand, are different (it missed an ‘N’), and Respondent correctly applied the Regulation when it rejected the application based on a breach of article 10(2).

Situation was quite the same in case 01053 (SANTOS), where the Panel decided that:

“The Panel is however conscious that the Complainant’s case is not without merit. The Complainant is clearly is known as SANTOS. SANTOS is its company name. It appears to have common law rights in the name SANTOS. It has an Internet presence in its web site established at the <santos.fr> address. Third parties refer to the Complainant’s goods as SANTOS goods. While these do not amount to Prior Rights for the purposes of the first phase of the Sunrise Period, they do indicate that the Complainant has undoubtedly rights in the SANTOS trade mark.

It appears from the documents submitted that the Complainant does not use the word mark S SANTOS.

Furthermore the Complainant has persuasively argued that the word element in the Prior Right relied upon is SANTOS and not S SANTOS and that when spoken the mark is SANTOS and not S SANTOS.

The Sunrise Rules however clearly require at Rule 19.2(ii)(a) 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”.

Section 19.2(ii) of the Sunrise Rules refers to the “sign”. It applies to figurative or composite signs. In the present case the “sign” consists of the stylised letter “S” and the word SANTOS.

Since the device element in the Prior Right relied upon by the Complainant is a stylised alpha numeric character, the letter “S” applying the methodology laid down in Rule 19.2(i) of the Sunrise Rules or even the methodology laid down in Rule 19.2(ii) that all alphanumeric characters (including hyphens, if any) included in the sign should be contained in the Domain Name applied for, in the same order as that in which they appear in the sign, it was reasonable that the Respondent should have rejected the application in those circumstances.

The Complainant’s application for the domain name <santos.eu> must fail.”

Various Panels came to the similar conclusion and applied similar principles in cases 1393 (HANSA), 487 (BENTLEY) and 470 (O2 DEVELOPMENT).

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	**Thibault Verbiest**

DATE OF PANEL DECISION 2006-09-12

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant produces evidence of ownership of several trademarks.

With this new documentary evidence, the Complainant substantiates prior rights that it did not even claim to have in its application! The Complainant claims today to be the owner of these trademarks (and he probably is, based on the documents provided to the Panel), but as a matter of fact, the documentary evidence given at the stage of the verification process was completely silent on them.

Sunrise Appeal has been created to guarantee both parties a fair trial on the way Respondent assessed the prior right claimed in the application; its purpose is not to permit applicant to add new prior rights they didn't even claim to have in their application.

The Panel won't take into consideration these trademarks.

Then, the Complainant produces evidence related to its trade name.

Situation is the same as here above : Complainant claims in this procedure a prior right that it didn't claim in its application. The Panel won't debate on this issue because regardless the answer to the question, it is for sure that a trade name is not a prior right in the sense of the Sunrise 1 Period [note of the Panel: the application of the Complainant was made on December, 7, 2005].

Eventually, the Complainant produces new evidence related to the trademark claimed in the initial application. Respondent request the Panel not to take this new evidence in consideration.

The Panel first recall that if the new evidence provided today was useful for the Panel to verify whether or not the Respondent made a good assessment of the application and took the right decision, the Panel would take it into consideration.

But, the Panel considers that this debate is not necessary in the present procedure, because whatever the answer to that question is, the Panel will always reach the same conclusion: the domain name applied for on the one hand, and the prior right claimed on the other hand, are different. Indeed, the application of the Complainant and the Documentary Evidence refer to the sign "N NATIONAL-BANK" whereas the Complainant applied for the domain name "NATIONAL-BANK".

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. Respondent correctly applied the Regulation when it rejected the application based on a breach of article 10(2).