Panel Decision for dispute CAC-ADREU-001951

Case number	**CAC-ADREU-001951**
Time of filing	**2006-06-20 15:45:39**
Domain names	**xfab.eu**

Case administrator

Name	**Eva Zahořová**

Complainant

Organization / Name	**X-FAB Semiconductor Foundries AG, Tatjana Dorofejew**

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 of which the Panel is aware.

FACTUAL BACKGROUND

1. The Complainant, X-FAB Semiconductor Foundries AG, a body incorporated with limited liability under the laws of Germany, applied for the domain name xfab.eu ("the Domain Name") on 6 February 2006. It provided documentary evidence in support of that application on 15 February 2006.
2. The documentary evidence submitted by the Complainant in support of its application consisted of a registered Community Trade Mark "X-FAB" registered in the name of X-FAB GmbH, covering goods in class 9 (electrical circuits and devices). The application was processed by EURid as part of the first phase of the Phased Registration Period. EURid rejected the application on 12 May 2006 on the grounds that the evidence received by EURid and its validation agents did not sufficiently prove the claimed right.
3. The Complaint seeking the annulment of EURid's decision was filed on 12 June 2006. It was, however, technically deficient in a number of respects. The Complainant was asked by the Czech Arbitration Court to correct those deficiencies, and did so within the period allowed under the .eu Alternative Dispute Resolution Rules ("the ADR Rules"). The formal date of the commencement of the ADR proceeding was 18 July 2006. EURid responded on 5 September 2006, within the deadline provided for in the ADR Rules.
4. On 6 September 2006 Robert Elliott, Tuukka Ilkka Airaksinen and Andre Pohlmann were appointed as panelists in this matter ("the Panel"), having each filed the necessary Statement of Acceptance and Declaration of Impartiality and Independence.

A. COMPLAINANT

5. The Complainant addresses what are essentially only two points in its Complaint. The first is its belief that the Respondent, EURid, has misunderstood (or not properly taken into account) the evidence it provided in support of its application, to the effect that the holder of the registered Community Trade Mark "X-FAB", X-FAB GmbH, is effectively the same corporate entity as the Complainant itself, its business having merged into the Complainant's business by operation of law. The second is that, according to Section 16 of the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period ("the Sunrise Rules"), the documentary evidence shows a prior right to the company name "X-FAB".
6. The first point in particular is dealt with in some detail in the Complaint, but for the reasons which appear below, neither point has any bearing upon the Panel's decision, and therefore the full argument is not repeated here.
7. The Complainant requests that EURid's decision be annulled, and the Domain Name be attributed to the Complainant

B. RESPONDENT

8. The Respondent points out that the rejection of the application for the Domain Name was on the basis that the Complainant did not demonstrate that it was the holder of a prior right on the name "XFAB". The Respondent does not intend to dispute the Complainant's contentions that it is the owner of the Community Trade Mark "X-FAB" and of the company name "X-FAB".

9. Instead, the Respondent argues that the above-mentioned rights on the name "X-FAB" (both the registered trade mark and the company name) may not serve as prior rights for the application for the domain name “XFAB”. It relies on Article 10(2) of Commission Regulation No. 874/2004 (“the Regulation”), which provides that “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 Respondent argues that this means that all alphanumerical characters contained in the prior right (including the hyphens) must be present in the domain name applied for.
10. The Respondent asserts that the only exceptions to the “complete name” requirement of Article 10(2) of the Regulation are those listed in Article 11 of the Regulation, and are restricted to spaces or special characters that may not be part of a domain name for technical reasons. The hyphen is not one of such special characters. It is not listed in Article 11 of the Regulation and the Respondent says that one of the possible options to replace a special character or a space is to replace it with a hyphen which demonstrates that the hyphen is [not] one of the special characters [the wording of the Response actually omits the word “not”, although the Panel considers that in the context this is clearly what was intended].
11. Consequently, the prior right involved, consisting of the trade mark "X-FAB" (with the hyphen), may only serve as a basis for the application for the domain name “X-FAB” (with the hyphen) and not the Domain Name.
12. The Respondent refers in support to the recent decision of the Panel in the case of NATIONALBANK.
13. For the sake of completeness, the Respondent also addresses the Complainant’s second point, namely that it is the owner of the company name “X-FAB” according to Section 16(1) of the Sunrise Rules. Under Article 12(2)(3) of the Regulation, only registered trade marks, geographical indications, and the public body names may be applied for as domain names during the first period of Phased Registration. Therefore the Complainant’s contentions about any possible right in the company name “X-FAB” may not be taken into consideration (and in any event, were not part of the documentary evidence provided in support of the application).

DISCUSSION AND FINDINGS

14. Although it is perhaps unfortunate that the Complainant has misunderstood the reason for the rejection of its application for the Domain Name, in the Panel’s view the wording used by EURid in its rejection, although relatively brief, was reasonably clear. The actual wording used, in German, was “Der Nachweis den wir erhalten haben, hat das geltend gemachte Recht nicht ausreichend belegt”, which the Panel would translate as “the evidence we have received did not sufficiently prove the Prior Right claimed”.
15. The Panel has considered whether to permit the Complainant an opportunity to reply to EURid’s Response. It has concluded that it is not necessary for it to do so, in order to consider the position properly. If the Complainant wished, it could have provided a reply, by way of non-standard communication, but essentially the only question for the Panel is the proper interpretation of Article 10(2) and Article 11 of the Regulation. The Panel notes, from the decision of the Panel in NATIONALBANK, that the Complainant in that case made extensive submissions on the correct interpretation of Article 10(2) and Article 11 of the Regulation. However, the Panel in NATIONALBANK decided that the Complainant’s detailed arguments in that case in relation to the fact that applicants should be able to delete hyphens from prior rights when applying for the domain names did not advance the Complainant’s case any further, as the wording of the Regulation is clear. In this case, the Panel respectfully agrees.
16. Article 10(2) of the Regulation provides that when an applicant is seeking a registration on the basis of a prior right, the registration shall consist “of the complete name for which the prior right exists”. Unless there is a specific exception provided for in the Regulation, the Panel concludes that “the complete name” means what it says, that is, a name which is “identical”. Although Article 11 sets out a number of specific exceptions, in relation to special characters and spaces, the special characters do not include hyphens, and in the Panel’s view, the wording of Article 11 is to be construed restrictively. The cases included in Article 11 refer only to those special characters which cannot be reproduced in a domain name. In contrast, it is technically possible to register domain names including a hyphen. The hyphen should therefore not be seen as one of the special characters included in Article 11.
17. Although, as the Complainant apparently pointed out in the NATIONALBANK Complaint, such a construction may lead to uneven effects within the European Union (depending upon whether certain languages make more use of hyphens than others), EURid’s and the Panel’s task is to be guided by the express wording of the Regulation, which in the Panel’s view leaves no room for doubt. Therefore, the Panel concludes that EURid’s decision to reject the application was correct.
18. Although not in itself determinative of the correct interpretation of the Regulation, the Panel notes that the Sunrise Rules Section 19.2(a) stipulates that documentary evidence will only be accepted if (inter alia) “all of the alphanumeric characters (including hyphens, if any) included in the sign are contained in the Domain Name applied for…” This in itself should have been a sufficient guide to any applicant as to how EURid would determine an application which omitted the hyphen.
19. For the sake of completeness, the Panel would also record that it agrees with the Respondent’s contention that the Complainant’s attempt to rely upon the rights in the company name “X-FAB”, which were not, in any event, substantiated in the evidence provided in support of the application, does not assist it in relation to an application submitted under the First Phased Registration Period, as this was.

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	André Pohlmann

DATE OF PANEL DECISION 2006-09-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant challenged EURid's decision to refuse to register the disputed domain name "xfab.eu". EURid refused to register the disputed domain name, because the prior right claimed (a registered Community Trade Mark “x-fab”) did not support an application for the domain name, which excluded the hyphen. In common with the Panel in NATIONALBANK, the Panel considers that the wording of Article 10(2) of Commission Regulation no. 872/2004 is clear, in requiring the domain name which is to be registered to be the “complete name” for which the prior right exists including, where relevant, hyphens. Hyphens are not included in the special characters excluded by Article 11. Therefore, EURid was correct in its decision to refuse registration, and the Complaint was denied.