Panel Decision for dispute CAC-ADREU-002055

Case number	CAC-ADREU-002055
Time of filing	2006-06-29 12:16:44
Domain names	it-akademiet.eu, aboutlearning.eu, 4mat.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	ITA Group A/S

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 pending proceedings regarding the disputed domain names "IT-AKADEMIET", "ABOUTLEARNING" and "4MAT".

FACTUAL BACKGROUND

ITA Group A/S (the "Complainant") applied for the registration of the domain names "it-akadamiet.eu", "4mat.eu" and "aboutlearning.eu" on 7 February 2006 and the documentary evidence then on 17 March 2006.

A. COMPLAINANT

In its complaint the Complainant challenged the decisions of the Registrar by which the registration of the domains (i) www.it-akadamiet.eu, (ii) www.4mat.eu, and (iii) www.aboutlearning.eu had been denied.

The Complainant alleged that the words "IT-akademiet", "About Learning" and "4mat" were protected as word trademarks in Denmark and that the Complainant held the respective prior rights.

The Complainant emphasized the previous use of the words "It-akademiet" as the company name and the registration of the respective domain (www.it-akademiet.dk) since December 09, 1997.

Regarding the words “4mat” and “About Learning” the Complainant mentioned that these words are registered as trademarks in the United States in the name of the company About Learning Inc., 44 West Bonner Road, Wauconda, Illinois. The respective license agreement between About Learning Inc. and the Complainant was enclosed to the complaint.

The Complainant informed the Tribunal that all of the aforementioned words/domains were protected by Danish law, namely by the Danish Trademarks Act (Consolidated Act no. 782 of 30. august 2001 - Varemærkeloven) § 3 sect. 1, no. 2, and §§'s 1 and 5, and by the Marketing Practices Act (Consolidated Act No. 699 of 17 July 2000 - "Markedsføringsloven).

The reasoning of the Complainant contains further the following allegations (i) in order to be protected under the IP laws of Denmark it is not necessary for a trademark/word to be registered, (ii) the Danish IP laws provide protection for unregistered trademarks if they have been used commercially, (iii) the words ("IT-akademiet", "About Learning" and "4mat") have been used commercially and intensively by the Complainant, and (iv) the words have been sufficiently commercially used in order to be granted protection under the respective Danish laws, and (v) the Complainant should thus be granted the right to the disputed domain names, according to the Sunrise Rules, Section 15.

B. RESPONDENT

The Respondent cited in its extensive Response to the Complaint (i) Article 10 (1) of the Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation"), (ii) Article 12 (2), paragraph 4 of the Regulation, (iii) Article 14 of the Regulation, (iv) Section 15 of the Sunrise Rules, (v) Section 12.3 of the Sunrise Rules, (vi) Section 16 (1) of the Sunrise Rules, (vii) Section 16 (4) of the Sunrise Rules, (viii) Section 16 (2) of the Sunrise Rules, and (ix) Section 16 (5) of the Sunrise Rules.

According to the Respondent, the Complainant applied for the domain names IT-AKADEMIET, ABOUTLEARNING and 4MAT on 7 February 2006. The documentary evidence was allegedly received on 17 March 2006, which was before the 19 March 2006 deadline.

The argumentation of the Respondent regarding the domain name IT-AKADEMIET is based on the facts that (i) the secondary name (in Danish "BINAVNE", or as the Complainant translated it "a side name") "IT-AKADEMIET A/S" is in fact a trade name, not the company name and (ii) the documentary evidence submitted by the Complainant consisted only of a certificate of registration of the company "ITA Group A/S", and although this referred also to the secondary name "IT-AKADEMIET A/S", it was insufficient for registration of the domain in the period of phased registration.

Regarding the domain names ABOUTLEARNING and 4MAT the Complainant claimed a prior right in the form of an unregistered trademark protected in Denmark. According to the Respondent, (i) the documentary evidence submitted by the Complainant did not comply with Sections 15 and 12.3 of the Sunrise Rules and Article 14 of the Regulation, since the only document submitted was a certificate of registration of the company "ITP Group A/S" showing as secondary names the names "ABOUTLEARNING A/S (ITP GROUP A/S)" and "4MAT A/S (IPT GROUP A/S)"; and (ii) the name mentioned in the documentary evidence as company name there is the name of " ITP Group A/S", and not the company name of the Complainant (" ITA Group A/S"). Those two names are different and the Complainant did not provide any documentary evidence showing that it is the same person as, the licensee of, or the legal successor to the company "ITP Group A/S".

The Respondent further mentioned that the present ADR proceedings may not be used to correct the Complainant's failure to present the relevant documentary evidence within the prescribed period.

The Respondent supports its argumentation with reference to the decisions of previous ADR panels, namely decisions Nr. 127 (BPW), Nr. 551 (VIVENDI), Nr. 984 (ISABELLA), Nr. 843 (STARFISH), Nr. 1931 (DIEHL, DIEHLCONTROLS), Nr. 1886 (GBG) Nr. 294 (COLT), Nr. 954 (GMP), Nr. 01549 (EPAGES), Nr. 1674 (EBAGS), Nr. 810 (AHOLD), Nr. 1194 (INSURESUPERMARKET), Nr. 219 (ISL), and Nr. 1627 ("PLANETINTERNET").

DISCUSSION AND FINDINGS

The panel carefully considered both submissions of the parties and the documentary evidence submitted by the Complainant when applying for the registration of the respective domains.

1. In respect of the application for registration of the domain “IT-AKADEMIET”, the panel found that the respective words are registered as secondary name (binavne) of the Complainant. The panel further found that the secondary name “IT-AKADEMIET” was registered in the public registry maintained with respect to the Complainant.

According to the panel’s opinion, the secondary name according to the Danish law shall be regarded as a trade name according to the Regulation and the Sunrise rules. Trade name is a name under which a businessman markets his/her/its business or part of his/her/its business. The secondary name is registered on the same place, on which a businessman registers the company name as a “sub-name” to the company name.

According to Article 10 (1) of the Regulation, holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of. eu domain starts. ‘Prior rights’ shall be understood to include, inter alia, trade names.

Pursuant Section 16 (2) of Sunrise Rules, since trade names are protected in all member states of the European Union, it is sufficient to provide the Validation Agent with the documentary evidence referred to in Section 16 (5) of the Sunrise Rules. Under Section 16 (5) of the Sunrise Rules it is sufficient to submit the following documentary evidence for trade names where it is obligatory and/or possible to register the relevant trade name in an official register: (i) an extract from that official register, mentioning the date on which the trade name was registered; and (ii) proof of public use of the trade name prior to the date of Application (such as, but not limited to, proof of sales volumes, copies of advertising or promotional materials, invoices on which the trade name is mentioned etc.).

From the documents presented by the Complainant to the Registrar it is obvious that the Complainant failed to provide the Registrar with

the documentary evidence regarding public use of the trade name prior to the date of Application (such as, but not limited to, proof of sales volumes, copies of advertising or promotional materials, invoices on which the trade name is mentioned etc.).

The Registrar therefore correctly rejected the registration of the respective .eu domain.

2. In respect of the applications for registration of the domains “About Learning” and “4mat”, the panel reviewed the respective documentation. The submitted documentary evidence was issued with respect the entity denoted as ITP GROUP A/S, CVR Nr. 25381505. Neither the identity of the Complainant and ITP GROUP A/S, nor the legal succession of the Complainant to rights of ITP GROUP A/S could be ascertained from the submitted documents.

The Registrar therefore correctly rejected the registration of respective .eu domains.

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	**Pavel Safar**

DATE OF PANEL DECISION 2006-10-17

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

For the domain name "IT-AKADEMIET", the Complainant claimed a prior right in the form of a Company Name/Trade Name/ Business identifier protected in Denmark. The documentary evidence submitted by the Complainant consisted only of a certificate of registration of the company "ITA Group A/S". From this document it is apparent that the name “IT-AKADEMIET” has been registered as the so called secondary name (“binavn(e)”).

The secondary name shall be regarded as a trade name. The panel points out that a trade name is the name under which the company markets the business or part of its business. For purpose of the .eu domain registration, it is documented by providing (i) an extract from that official register, mentioning the date on which the trade name was registered; and (ii) proof of public use of the trade name prior to the date of application for the .eu domain. The Complainant failed to fulfil the second requirement. The new documents attached to the complaint were not received by the validation agent during the 40 days period, which means that the panel could not use this information in its decision.

For the domain names "ABOUTLEARNING" and "4MAT", the Complainant claimed a prior right in the form of an Unregistered Trademark protected in Denmark. The documentary evidence submitted by the Complainant consisted only of a certificate of registration of the company "ITP Group A/S", and not "ITA Group A/S". Neither the identity of the Complainant and ITP GROUP A/S, nor the legal succession of the Complainant to rights of ITP GROUP A/S could be ascertained from the submitted documents. The Complainant therefore failed to provide the Registrar with the relevant documentary evidence.The Complainant failed to fulfil the second requirement. The new documents attached to the complaint were not received by the validation agent during the 40 days period, which means that the panel could not use this information in its decision.