Panel Decision for dispute CAC-ADREU-002061

Case number	**CAC-ADREU-002061**
Time of filing	**2006-07-24 11:05:50**
Domain names	**modline.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Dr Massimo Introvigne**

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

There are no other legal proceedings of which the Panelist is aware.

FACTUAL BACKGROUND

This Complaint arises out of the decision of the Registry EURid to reject the application for the domain name “MODLINE.EU”.

On 24.01.2006, the company Tecno Center s.r.l. (hereinafter the “Applicant”) applied for the rights on the domain name “MODLINE.EU”, submitting, as ground for the application, its rights on the Italian trademark no. 795356 “MODLINE MODULI LINEARI” and device filed on 16.12.1997 and registered on 29.11.1999.

On 16.06.2006, the Registry EURid refused the application for the domain name “MODLINE.EU” deeming that the trademark submitted by the Applicant could not serve as a prior right for the domain name applied for.

On 27.06.2006, Dr. Massimo Introvigne (hereinafter the “Complainant”), on behalf of the Applicant, filed a Complaint against the mentioned decision of the Registry EURid (hereinafter the “Respondent”), indicating English as the language of the proceedings.

Afterwards, the Complainant provided with the payment of the relevant fees. The Time of Filing was 24.07.2006 at 11:05:50. Also, on the same date, the Case Administrator filed the “Request for EURid Verification”.

On 01.08.2006, the Respondent filed a “Nonstandard Communication” answering to the “Request for EURid Verification” and indicating, inter alia, as the date of commencement of the Sunrise Appeal Period the date of 19.06.2006. The Respondent attached the “Documentary Evidence” related to the disputed domain name.

On 02.08.2006, the Case Administrator filed the “Complaint Check” together with the communication of “Commencement of the ADR Proceeding”.

On 18.09.2006, the Respondent filed the “Response to Complaint”. On the same date, the Case Administrator filed the “Acknowledgement of Receipt of the Response”.

On 18.09.2006, a first “Panelist Selection” was issued.

Again, on 18.09.2006, the Complainant filed a “Nonstandard Communication” specifying his claims and allegations concerning the rights on the disputed domain name.

On 22.09.2006, the actual Panelist has been selected and, on the same date, this Panelist filed the “Statement of Acceptance and Declaration of Impartiality and Independence”. Therefore, the Case Administrator served the parties with the “Notification of Appointment of the ADR Panel and Projected Decision Date”.

On 25.09.2006, the “Case File” was transmitted to the Panelist.

A. COMPLAINANT

The Complainant filed a Complaint indicating the factual and legal grounds to obtain the sought remedy of “the annulment of the disputed decision, and the attribution of the domain name modline.eu applied for on January 24, 2006 at 12:34:28.182 to applicant Tecno Center S.r.l.”.

The Complainant affirmed that Tecno Center s.r.l. uses since the early 1990s the trademark “MODLINE” for its products (machine tools for industrial use). The Applicant, continues the Complainant, is the owner of the Italian trademark registration no. 795356 (attached to the Complaint) applied for on 12.12.1997 and registered on 29.11.1999, which is in duly force and largely used.

According to the above, the Complainant affirmed that it is completely unclear why the copies of the registration certificate were regarded as not sufficient to prove the claimed right. Finally, the Complainant alleged that there are no other applicants for the domain name “MODLINE.EU” in the registration queue and, therefore, no one may be damaged by a decision in favour of the Complainant.

Moreover, with his “Nonstandard Communication” of 18.09.2006, the Complainant specified his claims affirming that in the case at issue, the word “MODLINE” is the “heart” of the trademark and the trademark’s relevant element is clearly this fancy word. The Complainant continued claiming that the inclusion in the trademark registration of the generic name of the products (in this case, “moduli lineari”) should not prevent the registration of the domain name consisting in the “heart” of the same trademark, and that such a conduct would consist in an extremely formalistic application of the rules, unfair for the trademark owner. Finally, the Complainant affirmed that the application for the trademark “MODLINE” by a third party would be regarded as an infringement of the rights of the Applicant on the trademark “MODLINE MODULI LINEARI”, since “MODLINE” is the “heart” of this trademark.

B. RESPONDENT

The Respondent filed a Response indicating the factual and legal grounds basing the decision to reject the domain name application and requested the rejection of the Complaint.

In particular, the Respondent focused its analysis on the application of Articles 10(1) and 10(2) of the Commission Regulation EC no. 874/2004 (hereinafter the “Regulation no. 874/2004) and Articles 19(1) and 19(2) of the “.eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period” (hereinafter the “Sunrise Rules”), according to which the validation agent concluded that the Applicant did not demonstrate to be the holder of prior right on the name “MODLINE”, based on the Italian figurative trademark no. 795356 submitted.

To the same extent, the Respondent quoted some previous decisions (case no. 470 - “O2”; case no. 1053 - “SANTOS”; case no. 1438 - “ELLISON”; case no. 713 - “HUETTINGER”) issued in similar cases, to support its allegations.

Finally, the Respondent denied any relevance to the circumstance that the Applicant was the only applicant for the domain name “MODLINE.EU” during the phased registration.

DISCUSSION AND FINDINGS

The ADR procedure at issue has been commenced by the Complainant against the decision to reject a domain name application. The application for the domain name “MODLINE.EU” has been filed, according to the “Sunrise Rules”, by the Applicant on the ground of asserted prior rights.

From the Case File, it results that the domain name application is solely based on the Italian trademark registration no. 795356, the validity of which is out of discussion in the present case.

(1) The applicable regulations.

Article 10(1) of Regulation no. 874/2004 provides that “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". The provision continues stating that "prior rights shall be understood to include, inter alia, (…) registered national and Community trademarks".

Article 10(2) of the Regulation no. 874/2004 states 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".

According to the above mentioned provisions, Article 19(1) of the Sunrise Rules affirms that "as stated in Article 10(2) of the Public Policy Rules [i.e. the Regulation no. 874/004], registration of a Domain Name on the basis of a Prior Right consists in the registration of the complete name for which the Prior Right exists, as manifested by the Documentary Evidence. It is not possible for an Applicant to obtain registration of a Domain Name comprising part of the complete name for which the Prior Right exists".

Moreover, Article 19(2) of the Sunrise Rules provides as follows: "Documentary Evidence must clearly depict the name for which a Prior Right is claimed. A Prior Right claimed to a name included in figurative or composites signs (signs including words, devices, pictures, logos, etc.) will only be accepted if
(i) the signs exclusively contains a name, or
(ii) the word element is predominant, and can be clearly separated or distinguished from the device element,
provided that
(a) 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, and
(b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which characters appear."

(2) The case at issue.

The rejected domain name application – for the domain name "MODLINE.EU" – on the ground of the Italian trademark registration no. 795356 submitted by the Applicant fully satisfies the requirements set forth by Article 10(1) of the Regulation no. 874/2004. In fact, there is no discussion concerning the validity and the ownership of the mentioned trademark which is a valid ground for the Sunrise Period domain name application.

Therefore, it is now necessary to perform an analysis of the Italian trademark no. 795356.

The mentioned trademark consists in the word "MODLINE" with the letter "M" written in bigger character and positioned on a level lower than the other letters of the word; on the side of the letter "M" behind the other letters (i.e. "ODLINE") there is the wording "MODULI LINEARI" written in smaller characters, and four (4) parallel stripes.

Therefore, the trademark no. 795356 includes "figurative or composites signs (signs including words, devices, pictures, logos, etc.)" in the meaning of Article 19(2) of the Sunrise Rules. Applying the mentioned provision, it results that in the trademark no. 795356 "the word element is predominant, and can be clearly separated or distinguished from the device element". In this case, the world element is clearly consisting in the whole expression "MODLINE MODULI LINEARI".

According to the above, to obtain the registration of a domain name on the ground of the trademark no. 795356, all alphanumeric characters (including hyphens, if any) included in the sign have to be contained in the Domain Name applied for, in the same order as that in which they appear in the sign, and the general impression of the word must be apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which characters appear (cfr. Article 19(2) of the Sunrise Rules).

Therefore, to satisfy the requirements set forth by the Sunrise Rules, the domain name applied for on the base of the trademark no. 795356 has to include all the alphanumeric characters – "MODLINE-MODULI-LINEARI" – and not only the expression "MODLINE" which is only a part of the examined trademark.

With regard to the affirmation of the Complainant concerning the circumstance that the expression "MODLINE" is the "heart" of the trademark no. 795356, being the wording "MODULI LINEARI" only the generic terms to describe the products, it is important to note that the applicable regulations relevant for the .eu domain names applications in the Sunrise Period do not take into consideration this kind of approaches and, contrarily, do not allow the registration of a domain name consisting only in a part – being or not the "heart" of the sign – of the complete name for which the prior right exist. To the same extent, it is not relevant the Complainant's affirmation according to which the word "MODLINE" applied as a trademark by a third party would be an infringement of the Applicants rights on the trademark no. 795356.

Now, since – as clearly outlined by Article 10(2) of the Regulation no. 874/2004 and Article 19(1) of the Sunrise Rules – the registration on the basis of a prior right must be the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists and it is not possible for an applicant to obtain registration of a domain name comprising part of the complete name for which the prior right exists, it results that the registration on the basis of the trademark no. 795356 had to be the complete wording "MODLINE MODULI LINEARI" and it is not possible to obtain the registration only for the part "MODLINE".

The Panelist is aware that this principle has been already affirmed by several previous decisions in similar proceedings (case no. 470 - "O2"; case no. 1053 - "SANTOS"; case no. 1438 - "ELLISON"; case no. 713 - "HUETTINGER").

Finally, with regard to the allegation of the Complainant that there are no other applicants for "MODLINE.EU" in the registration queue which may be damaged by a decision in favour of the Complainant, it is important to note that such evaluation is irrelevant to determine if the Respondent's decision to reject the domain name application is in compliance with the relevant regulations.

According to the above, the Complaint should be denied and the disputed decision should become final.

DECISION

For all the foregoing reasons, in accordance with paragraph B12 (b) and (c) of the "ADR Rules", the Panelist orders that the Complaint is denied.

PANELISTS

Name	**Francesco Paolino**

DATE OF PANEL DECISION 2006-10-16

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed a Complaint against the decision to reject the domain name application for "MODLINE.EU" based on the Applicant's rights on the Italian trademark registration no. 795356, applied for on 12.12.1997 and registered on 29.11.1999.
The Complainant affirmed that it is completely unclear why the copies of the registration certificate were regarded as not sufficient to prove the claimed right. The Complainant claimed that the word "MODLINE" is the "heart" of the trademark and the trademark's relevant element is clearly this fancy word. Finally, the Complainant alleged that there are no other applicants for the domain name "MODLINE.EU" in the registration queue and, therefore, no one may be damaged by a decision in favour of the Complainant.

The Respondent filed a Response indicating the factual and legal grounds basing the decision to reject the domain name application and requested the rejection of the Complaint. In particular, the Respondent focused its analysis on the application of Articles 10(1) and 10(2) of the Regulation no. 874/2004 and Articles 19(1) and 19(2) of the Sunrise Rules. Moreover, the Respondent quoted some previous decisions (case no. 470 - "O2"; case no. 1053 - "SANTOS"; case no. 1438 - "ELLISON"; case no. 713 - "HUETTINGER") issued in similar cases, to support its allegations. Finally, the Respondent denied any relevance to the circumstance that the Applicant was the only applicant for the domain name "MODLINE.EU" during the phased registration.

The Panelist found that the trademark no. 795356 includes figurative or composites signs in the meaning of Article 19(2) of the Sunrise Rules, and the predominant world element is consisting in the whole expression "MODLINE MODULI LINEARI". According to the above, to obtain the registration of a domain name on the ground of the trademark no. 795356, all alphanumeric characters (including hyphens, if any) included in the sign have to be contained in the domain name applied for, in the same order as that in which they appear in the sign, and the general impression of the word must be apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which characters appear (cfr. Article 19(2) of the Sunrise Rules). Therefore, to satisfy the requirements set forth by the Sunrise Rules, the domain name applied for on the basis of the trademark no. 795356 has to include all the alphanumeric characters – "MODLINE MODULI LINEARI" – and not only the expression "MODLINE" which is only a part of the examined trademark.

For all the foregoing reasons, the Panelist orders that the Complaint is denied.