Panel Decision for dispute CAC-ADREU-002072

Case number	**CAC-ADREU-002072**
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Domain names	**easycare-research.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**easycare Research GmbH, Rechtsanwalt Henry Richard Lauf**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

easycare Research GmbH (hereinafter "the Complainant") applied for the domain name “easycare-research.eu” on January 24, 2006.

The validation agent received the documents evidencing the application on January 30, 2006, i.e. within the prescribed period.

On May 24, 2006 the EURID (hereinafter the “Respondent” or the “Registry”) issued the decision based on which the application for the registration of the domain name “easycare-research.eu” was rejected.

In this context, the Complainant submitted to the Czech Arbitration Court the complaint by email on June 30, 2006 and on July 7, 2006 in hardcopy claiming the annulment of the decision and attribution of the domain name “easycare-research.eu” to the Complainant. The formal date of the commencement of the ADR Proceeding (hereinafter the “ADR Proceeding”) is July 12, 2006.

A. COMPLAINANT

The Complainant summarized that according to the WHOIS database the evidence of prior rights was received in due time, on January 30, 2006. In this context the Complainant further stated that the German trademark “easycare Research GmbH” No. 301 26 720.0, applied for on April 26, 2001 and registered in favor of the Complainant on August 30, 2001, attached in Exhibit No. 1 of the complaint, and the German trademark “easycare” No. 303 14 293.6, applied for on March 20, 2003 and registered in favor of the Complainant on September 24, 2003, attached in Exhibit No. 2 of the complaint, were enclosed to the official cover letter.

The Complainant further emphasized that the Complainant’s company name is “easycare Research GmbH“ and in the Exhibit No. 3 it submitted as prima facie evidence a copy of the excerpt from the Commercial Register of the Complainant’s registration (HRB 64535 of the local court of Sarrebruck, the Amtsgericht Saarbrücken) in German with an English translation.

In regard to the assessment of the legal ground of the dispute in question, the Complainant argued that, in its opinion, it met all requirements set for the registration of the domain name “easycare-research.eu“ and submitted the evidence required for the domain name in due time.

To support its standpoint, the Complainant cited Article 10 (1) of the (EC) Regulation No. 874/2004 of 28 April 2004 (hereinafter the "Regulation”) under which holders of prior rights according to national and/or Community laws are entitled to file applications in staged proceedings and “prior rights” are, in particular, registered national and Community trademarks as well as international registrations as far as they are protected in the European Community. The Complainant also pointed out that according to Article 10 (1) of the Regulation also company names are “prior rights” if protected under the laws of the individual Member State and stated that the said protection is granted in the present case according to sec. 5 of the German Trademark Act. The Complainant further cited Art. 10 (2) of the Regulation according to which the prior right has to be identical with the registered domain name and has to be proved by documentary evidence.

In consideration of the above cited provisions the Complainant concluded that the trademark “easycare Research GmbH“ and/or the trademark “easycare“ are prior rights within the meaning of the Regulation and pointed out that the prior right is identical with the domain name applied for in accordance with the Regulation, namely its Article 10 (2).

According to the Complainant it is necessary to state that the trademark “easycare Research GmbH“ and the trademark “easycare“ are combined signs composed of letters and a graphic element.

In the opinion of the Complainant, according to the rules on hand it is inadmissible to apply for the registration of a domain name only including a part of the full name for which prior rights are held. In the present case the combined trademarks include word elements which can be clearly separated from the background graphic and the word elements visually determine the overall impression of the combined trademarks. As from the phonetic perspective the graphic element is not suitable to contribute to the characteristic of the combined marks as its elements cannot be pronounced.

According to the Complainant, the trademark´s word element “easycare Research GmbH” respectively “easycare” prevails over the graphic element of secondary importance. Thus, the word element is dominating and can be clearly separated from the figurative element, sufficient according to section 19 par. 2 (ii) of the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter the “Sunrise Rules”). The additional “GmbH“ of this dominating word element in the trademark “easycare Research GmbH” finally reflects only the legal form of the Complainant’s entity and can, therefore, be dropped as straight descriptive element. “GmbH“ is the abbreviation of “Gesellschaft mit beschränkter Haftung“ (limited liability company) well-known in public, the legal form of the Complainant. With regard to the dominating word element the element “GmbH“ is again of the secondary importance.

The Complainant further stressed that the fact that the form of the company, i.e. the legal form like “GmbH“, in the present case is irrelevant and needs, therefore, not be taken into consideration results also directly from the Sunrise Rules, namely section 19 par. 4 according to which „for trade names, company names and business identifiers, the company type (such as, but not limited to, “SA“, “GmbH“,“Ltd.” or “LLP”) may be omitted from the complete name for which the prior right exists.”

The Complainant thus argued that the dominating element of the trademark “easycare Research GmbH“ as a prior right is “easycare Research” and this element is absolutely identical with the .eu domain name “easycare-research“ applied for so that the decision would be wrong if the refusal was based on this element.

Irrespective of the references to the trademark “easycare Research GmbH“ and the trademark “easycare“ as prior rights the Complainant argued in the “light” of section 19 par. 4 of the Sunrise Rules the existence of the prior right also on the basis of the Complainant’s company name "easycare Research GmbH".

The Complainant also referred to Section 21 (3) of Sunrise Rules and emphasized the duty of the validation agent/Registry to review and investigate the circumstances of the application, the asserted right and the submitted evidence at his own discretion.

Based on the said grounds the Complainant claimed the annulment of the decision and attribution of the domain name “easycare-research.eu” to the Complainant.

B. RESPONDENT

The Respondent argued by the citation of Article 10 (1) of Regulation under which the only holders of prior rights which are recognized or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts and Article 10 (2) of the Regulation under which the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists. In regard to the application of Article 10 (2) of the Regulation the Respondent referred to section 19 of the Sunrise Rules where the said rule is further clarified.

The Respondent in this context pointed out that the validation agent by the examination of the documentary evidence submitted by the Complainant concluded that the domain name applied for did not consist of the complete name of the prior right submitted and therefore, the Respondent rejected the Complainant's application.

The Respondent further noted that the only documentary evidence submitted with the application for the registration of the .eu domain was the certificate confirming the existence of the trademark “easy care Research GmbH“, i.e. German trademark No. 301 26 720.0. According to the Respondent, no other trademark certificates as well as no other documentation confirming the existence of the trade name were submitted.

According to the Respondent, Article 14 (4) of the Regulation clearly states that "every applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question. The documentary evidence shall be submitted to a validation agent indicated by the Registry. The applicant shall submit the evidence in such a way that it shall be received by the validation agent within forty days from the submission of the application for the domain name." Consequently, the validation agent shall make its assessment on the basis of the documentary evidence which it was timely provided with. 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.

To support its standpoint that "the Panel cannot take into account documents submitted in the framework of an ADR proceeding when assessing the validity of a decision of the Registry" the Respondent referred to the cases n° 294 (COLT), n° 954 (GMP), n° 1186 (ERDAS), n° 01549 (EPAGES) and n° 1674 (EBAGS).

The Respondent stressed that domain names applied for during the first stage of the sunrise period may not be based on the existence of trade names, as stated in Article 12 (2) of the Regulation and pointed out that the Complainant's application was submitted on January 24 whereas the second stage of the sunrise period started only on February 7, 2006.

In regard to the burden of proof, according to the Respondent it results from the Regulation and Sunrises Rules that it is for 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. Thus, in the opinion of the Respondent the relevant question is not whether the applicant is the holder of a prior right, but whether the applicant proves to the validation agent that it is the holder of a prior right.

In this respect the Respondent referred to Article 10 (1) of the Regulation under which only the holder of a prior right is eligible to be granted the corresponding domain name and Article 14 (4) of the Regulation under which the documentary evidence must clearly show that the applicant is the holder of the prior right claimed on the name in question.

According to the Respondent, that the burden of proof is with the applicant is also clear from section 21 (3) of the Sunrise Rules, which states that the validation agent is not obliged, but is permitted in its sole discretion, to conduct its own investigations into the circumstances of the application, the prior right claimed and the documentary evidence produced.

Moreover, the Respondent cited section 21 (2) of the Sunrise Rules under which the validation agent shall examine whether

an applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence it has received.

To support the said conclusion the Respondent referred to the cases n° 00119 (NAGEL), n° 219 (ISL), n° 954 (GMP), n° 1071 (ESSENCE), n° 1232 (MCE), n° 1318 (SYS) and n° 1710 (EMI et al).

Finally, the Respondent argued that the domain name EASYCARE-RESEARCH.eu did not consist of the complete name of the trademark which was submitted as documentary evidence.

In this context the Respondent pointed out that according to Article 10 (2) of the Regulation 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. To that regard, section 19 (2) of the Sunrise Rules, which further clarifies Article 10 (2) of the Regulation, states 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.

The trademark which the Complainant submitted as documentary evidence contains the following alphanumerical characters EASY CARE RESEARCH GMBH whereas the Complainant applied for the domain name EASYCARE-RESEARCH.

The Respondent argued that the complete name clearly stated on the trademark certificate is "easy care research gmbh". According to the Respondent there is no doubt that the domain name does not consist of the complete name of the trademark because the complete name includes the GMBH element.

To that regard, the Respondent referred to the cases n° 1393 (HANSA), n° 1053 (SANTOS) and n° 487 (BENTLEY) which confirm that all alphanumerical characters contained in the prior right must be included in the domain name.

In the opinion of the Respondent, the Complainant erroneously referred to section 19 (4) of the Sunrise Rules when arguing that the "GMBH" element should be disregarded when determining what the complete name of a trademark is. The Respondent admits that section 19 (4) of the Sunrise Rules states that for trade names, company names and business identifiers, the company type (such as, but not limited to, “SA”, “GmbH”, “Ltd.”, or “LLP”) may be omitted from the complete name for which the prior right exists." However, according to the Respondent section 19 (4) only refers to trade names, company names and business identifiers, but NOT TRADEMARKS.

According to the Respondent the said difference is based on the fact that the trade name or company name identifies a certain business/company, whereas a trademark identifies a certain product/service. The company type does not form part of the name of the company or the trade name. Indeed, when dealing with company names or trade names, the company type serves to designate the type of company. When included in a trademark however, one cannot argue that a word element, which can also be understood as an abbreviation of the company type, does not form part of the trademark.

The Respondent's decision is therefore in line with the applicable rules. For that reason, the complaint must be rejected.

DISCUSSION AND FINDINGS

According to Article 10 (1) of the Regulation, the holders of prior rights which are recognized or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts.

According to Article 10 (2) of the Regulation, the domain 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 section 19 (2) of the Sunrise Rules which further clarifies the application of Article 10 (2) of the Regulation, a prior right claimed to a name included in figurative or composite signs will be only accepted if (i) the sign 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.

However, according to section 19 (4) of the Sunrise Rules for trade names, company names and business identifiers, the company type (such as, but not limited to, “SA”, “GmbH”, “Ltd.”, or “LLP”) may be omitted from the complete name for which the prior right exists."

According to Article 14 paragraph 4 of the Regulation every applicant must submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question. The applicant shall submit the evidence in such a way within forty days from the submission of the application for the domain name otherwise the application for the domain name shall be rejected.

According to section 21 (2) of the Sunrise Rules, the validation agent shall examine whether an applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence it has received. According to section 21 (3) of the Sunrise Rules, the validation agent is not obliged, but is permitted in its sole discretion, to conduct its own investigations into the circumstances of the application, the prior right claimed and the documentary evidence produced.

As it results from section 11 of the Sunrise Rules, during the phased registration period it was possible to file the application for the the domain registration on the basis of a prior right understood as trade name, company name and/or business identifier only in its second phase, i.e. from February 7, 2006 until April 6, 2006 (hereinafter the “Sunrise II”).

The Complainant applied for the domain name “easycare-research.eu” on January 24, 2006, i.e. in the first phase of the phased registration period (hereinafter the “Sunrise I”) on the basis of the existence of the prior right, i.e. the trademark.

According to the Complainant the validation agent was provided on 30 January, 2006 with two (2) trademark certificates evidencing the existence of (i) the trademark “easycare Research GmbH” and (ii) the trademark “easycare” whereas according to the Respondent the Complainant provided the validation agent on 30 January, 2006 only with the trademark certificate confirming the existence of the trademark “easy care Research GmbH”. As it results from the documentation released from the part of Registry, the validation agent was only provided with the trademark certificate confirming the existence of the trademark “easy care Research GmbH“.

Taking into account the cited stipulations and the said facts it thus results that (i) every applicant must submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question, (ii) the domain 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, (iii) the burden of proof lies on the applicant who must submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question, (iv) the validation agent/Registry shall examine whether the applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence it has received and is not in any way obliged or forced to conduct its own investigations into the circumstances of the application.

In regard to the domain registration on the basis of a prior right, the Panel, in the “light” of section 19 (2) of the Sunrise Rules, further concluded that it is clear that all alphanumeric characters (including hyphens, if any) included in the sign shall be contained in the domain name applied for, in the same order as that in which they appear in the sign.

In the opinion of the Panel, it is also clear that, with regard to the fact that the domain registration was based on the existence of prior right corresponding to the trademark, rules contained in section 19 (4) of the Sunrise Rules do not apply. The said provision may only apply to the domain registrations based on prior right corresponding to trade names, company names and business identifiers, i.e. to domain registrations made in the Sunrise II period.

The trademark certificates provided by the Complainant in the ADR Proceeding confirm the existence of the trademark “easy

care Research GmbH" and the trademark "easy care". The Complainant claims the existence of the prior right based on the existence of the said trademarks. Nevertheless, the Complainant applied for the eu. domain name "easycare-research", the wording of which is clearly different from the wording of the said trademarks, in the Sunrise I period. There is no doubt that the domain name the Complainant applied for does not consist of the complete name contained in any of the said trademarks, thus, it is not possible to register it based on the existence of any of the said trademarks.

Due to the fact that neither the trademark "easy care Research GmbH" nor the trademark "easy care" may in any way serve as the basis for the registration of the domain name "easycare-research.eu" in this case the Panel did not consider whether the Complainant actually provided the validation agent/ Registry with the documentary evidence confirming the existence of the trademark "easy care" within the prescribed period.

On the ground that the Complainant applied for the registration of domain name in the Sunrise I period based on the existence of the trademark the Panel also did not consider as relevant for its decision the excerpt from the Commercial Register of the Complainant's registration provided from the part of the Complainant no sooner than in the ADR Proceeding.

The Registry correctly rejected the registration of the domain name "easycare-research.eu".

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	**Aleš Chamrád**

DATE OF PANEL DECISION 2006-09-28

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contested the decision of the Registry to reject the application for the registration of the domain name "easycare-research.eu" on the ground of alleged inconsistencies between the name to which the Complainant's prior right was claimed and the domain name applied for by the Complainant.

The Complainant primarily based its complaint on the existence of the German trademark "easy care Research GmbH" No. 301 26 720.0, applied for on April 26, 2001 and registered in favor of the Complainant on August 30, 2001.

According to Article 10 (2) of the Regulation, the domain 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 section 19 (2) of the Sunrise Rules which further clarifies the application of Article 10 (2) of the Regulation, a prior right claimed to a name included in figurative or composite signs will be only accepted if (i) the sign 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.

Since the complete name for which the Complainant's prior right existed did not conform to the domain name applied, the application was rightfully rejected by the Registry.