Panel Decision for dispute CAC-ADREU-002093

Case number	**CAC-ADREU-002093**
Time of filing	**2006-08-10 10:42:45**
Domain names	**mazur.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Oficyna Wydawnicza MAZUR sp. z o.o., Dr. Maciej Krzysztof Mazur**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

Oficyna Wydawnicza MAZUR Sp. z o.o. (hereafter "the Complainant") applied for the domain name MAZUR on 1 April 2006. The Complainant's company name "Oficyna Wydawnicza MAZUR sp. z o.o." has been registered in the Polish court under the number KRS 0000107944.

The documentary evidence was received on 3 April 2006, which was before the 11 May 2006 deadline.

The Complainant submitted documentary evidence substantiating that the Complainant's company name is "Oficyna Wydawnicza MAZUR sp. z o.o.".

The validation agent concluded from its examination of the documentary evidence that the Complainant did not demonstrate that it was the holder of prior right on the name MAZUR alone.

Consequently, the Respondent rejected the application for the domain name MAZUR.

A. COMPLAINANT

The complainant asserts that his registered company name gives a prior right to the registration of the domain name MAZUR. The rejection of the application for the domain name must therefore be annulled as the prior rights claimed by the Complainant are fully existent and have been proved through the appropriate Documentary Evidence by the Complainant.

The complainant points out that the company name consists of three members. The first member (Oficyna Wydawnicza) is descriptive and describes that the company is the Editing House. The second member (MAZUR) is the actual name of the company which is the same of the family name of its founder and owner Dr. Maciej K. Mazur. And the third member describes the legal form of the company and is obligatory by the Polish law for the limited liability companies. The complainant then explains that such a methodology of naming companies is very clear and obvious in Poland but that nevertheless for the daily operations short names are used wherever possible.

Furthermore the complainant argues that the name MAZUR is a world famous trade mark. Oficyna Wydawnicza MAZUR sp. z o.o. is editing periodical magazines and other publications. Two most important titles are "Samochody Specjalne" and "Rotarianin". "Samochody Specjalne" is a leading magazine devoted to commercial vehicles (vans, trucks and buses). "Rotarainin" is the magazine in the District 2230 of the world famous charity organisation Rotary International. "Samochody Specjalne" magazine is published since 1997. MAZUR, as the editor of this magazine, has been registered in the international professional association ACE (Association of Commercial Vehicles Editors). MAZUR as the editor of "Rotarianin" magazine published in Belarus, Poland and Ukraine has been registered at Rotary International with the seat in Evanstone, Illinois, USA. The name MAZUR has also been registered at the Wroclaw Chamber of Commerce. The trade mark MAZUR in the form of logothype appears on hundreds of thousands of copies of published magazines and other publications, stamps etc. The name MAZUR appears also on the stationary forms and all other elements of the corporate identity system, as well as in press and TV commercials etc.

In addition, the Complainant asserts that he is the owner of the domain name www.mazur.biz.pl for many years.

The complainant is therefore of the opinion that the rejection of the application by the Respondent shows a clear breach of Article 5 (1) (b) EC Regulation No. 733/2002 and the superior principle (11) of Commission Regulation No. 874/2004, namely the principle of first come first served. Furthermore the Respondent’s decision conflicts with and states a breach of Article 12 (3) of Commission Regulation No. 874/2004 and Section 21.3 of the .eu Sunrise rules.

B. RESPONDENT

The respondent refers to article 10 (2) of the Regulation, which 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.

Section 19.4 of the Sunrise Rules provides for a clarification to this rule, by providing 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".

The Complainant submitted documentary evidence substantiating that the Complainant's company name relied upon as a prior right is "Oficyna Wydawnicza MAZUR sp. z o.o.".

Pursuant to article 10.2 of the Regulation and section 19 of the Sunrise Rules, the domain name based on this prior right must consist of all alphanumerical characters, except for the company type.

Therefore, the company name relied upon as a prior right could only serve as a prior right for the domain name “OFICYNAWYDAWNICZAMAZUR”, which is the complete name for which the prior right exists, except for the company type.

To corroborate this point of view, the respondent refers to the cases No. 407 (O2), No. 1053 (SANTOS), No.1438 (ELLISON), No. 713 (HUETTINGER), No. 1427 (BONOLLO) and No. 2061 (MODLINE).

The Panel in ADR 2061 (MODLINE) had to answer the exact same arguments and replied in those terms:

"(…) 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 approach 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.

The Complainant’s assertion that MAZUR is a world famous trademark is not considered any further by the respondent since it is not supported by any documentary evidence. The deadline to submit documentary evidence expired forty days after the application, i.e. 11 May 2006.

As the Complainant applied for the domain name MAZUR (and not for the domain name which corresponds to the complete name for which the prior right exists), the Respondent correctly rejected the Complainant's application.

DISCUSSION AND FINDINGS

The issue to be addressed is whether the complainant’s right to the registered company name “Oficyna Wydawnicza MAZUR sp. zo.o.” can be used to claim a prior right on the name MAZUR alone.

Art. 10 (2) of the Regulation 874/2004 and Article 19 (1) of the Sunrise Rules state clearly that the domain name based on this prior right must consist of all alphanumerical characters, except for the company type.
The complainant’s contention that the first part “Oficyna Wydawnicza” is only descriptive and can therefore be neglected cannot be followed with regard to the clear wording of Art. 10(2) of Regulation 874/2004 and Art. 19 (1) of the Sunrise Rules. The case law has also well established that not only the main “identifier” of a company’s name forms the basis for registration but the exact characters of the registered prior right (No. 1053 (SANTOS), No. 470 (O2), No. 2061 (MODLINE)). This practice is not a mere formalism. The limited nature of “.eu” domain names justifies a domain name distribution strictly based on alphanumerical characters of the prior right. If the complainant’s company only registered MAZUR as an editing house he will only receive the domain name for MAZUR in this function.

The complainant argues that his right to the domain MAZUR.eu can be based on the fact that his company is world famous. This statement in itself is not a sufficient basis for registration and was not supported by any documentary evidence.

Furthermore, the complainant points out that he is the owner of the polish domain name www.mazur.biz.pl for many years. However, a right to a national domain name is not recognized as a prior right under the “Sunrise-Rules”, Art. 10 (1) 874/2004 and cannot be invoked here. The registration of the Polish domain name does emphasize that the main identifier of the complainant’s company is MAZUR but as pointed out above, this is not relevant for a “.eu” registration.

The respondent is thereby correct to state that the complainant’s prior right could only serve as a prior right for the domain name “OFICYNAWYDAWNICZAMAZUR

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	**Thomas Johann Hoeren**

DATE OF PANEL DECISION 2006-10-24

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Polish complainant held that his registered company name “Oficyna Wydawnicza MAZUR sp. zo.o.” can be used to

claim a prior right on the name MAZUR alone. This approach however neglects that Art 10 (2) of the Regulation 874/2004 and Article 19 (1) of the Sunrise Rules state clearly that the domain name based on this prior right must consist of all alphanumerical characters, except for the company type.

Furthermore, the complaint could not based upon the fact that the compainant is the owner of the polish domain name www.mazur.biz.pl as. a right to a national domain name is not recognized as a prior right under the “Sunrise-Rules”, Art. 10 (1) 874/2004.