Panel Decision for dispute CAC-ADREU-002136

Case number	**CAC-ADREU-002136**
Time of filing	**2006-07-11 11:19:23**
Domain names	**ticketpro.eu**

Case administrator

Name	**Eva Zahořová**

Complainant

Organization / Name	**TICKETPRO a.s., Jiri Vrba**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

On December 9, 2005 during the Sunrise Period the Complainant applied as an Applicant for the registration of the domain name “www.ticketpro.eu”. This request for registration was based on and made full consideration of the Applicant’s prior right stemming from the registration of the Czech (composite) trademark that contained in its context the word elements “TICKETPRO WWW.TICKETPRO.CZ”. The documentary evidence which was legally and duly received by the Processing Agent included a trademark certificate for the Czech (composite) trademark “TICKETPRO WWW.TICKETPRO.CZ”.

The Respondent rejected the application for the domain name “www.ticketpro.eu” because the composite trademark submitted to him by the Applicant was incompletely transcribed.

The Applicant filed a complaint against the Respondent on July 11, 2006, thus he became Complainant, which was received in hard copy by the Czech Arbitration Court on July 21, 2006. The Respondent filed a response to the Complainant which was received by the Czech Arbitration Court on September 8, 2006. On September 11, 2006, the Czech Arbitration Court appointed the undersigned herewith as a Panelist.

A. COMPLAINANT

1. The Complainant applied for the Domain Name “www.ticketpro.eu”, which corresponds to his registered national trademark with the Industrial Property Office of the Czech Republic (under registration no. 255635) with the wording TICKETPRO, and made use of his prior right according to Section 13 of the Sunrise Rules.
2. The Complainant satisfied all registration criteria according to the Sunrise Rules.
3. The Complainant provided sounding proof of his prior right submitting the official certificate for registration issued by the appropriate and official state authority of the Czech Republic as a member state of EU according and pursuant to Section 13(2)(i) of the Sunrise Rules.
4. The domain name “www.ticketpro.eu” is in accordance with the Complainant’s business name TICKETPRO s.a., and the Complainant has the right to use said business name according Section 8 of the Czech Commercial Code no. 513/1991 Coll.

B. RESPONDENT

1. According to article 10§1 and 14 of the Regulation (EC) 874/2004 the burden of proof of prior right remains on the Applicant/Complainant to substantiate who is the claimed holder of a prior right [cases no. 294(COLT), 551(VIVENDI), 984(Isabella), 843(starfish) 1886(GBG)].
2. “The composite trademark which the Complainant submitted as documentary evidence consists of the following elements:
a. A stylized version of the word “TICKETPRO” and
b. The words WWW.TICKETPRO.CZ
The composite trademark is therefore composed of the following alphanumeric elements: “TICKETPRO WWW.TICKETPRO.CZ”. Consequently and pursuant to section 19(2) of the Sunrise Rules this trademark establishes a prior right on the signs TICKETPROWWWTICKETPROCZ or on variants such as TICKETPRO-WWW-TICKETPRO-CZ. However, it does not establish a prior right on the sign TICKETPRO alone [relevant cases 470(O2), 1053(SSANTOS), 1393(HANSA), 487(BENTLEY)] because according to said section 19(2) of the Sunrise Rules all alphanumerical characters contained in the prior right must be included in the domain name”.
3. According to article 12(2) of Regulation (EC) 874/2004, applications for .eu domain names submitted during the first stage of the Sunrise Period may not be based on business names. Said EC Regulation caters for applications for .eu domain names submitted during the first period only which regard to (a) registered trademarks (b) geographical indications and (c) names and acronyms of public bodies. Said applications may be accepted provided that there is sounding evidence on prior rights for the applied domain name.
4. According to article 22(1)(b) of Regulation (EC) 874/2004, new documents submitted by a Complainant may not be taken into consideration by the Panel stating that a decision taken by the Respondent may only be annulled when it conflicts with the applicable rule and regulations [relevant cases 551(VIVENDI), 810(AHOLD), 1194 (INSURESUPERMARKET), 294(COLT), 954(GMP), 01549(EPAGES) & 1422(PORTAS)].

DISCUSSION AND FINDINGS

1. According to article 10§1 and (2) of Regulation (EC) 874/2004, “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 names. ‘Prior rights’ shall be understood to include, inter alia, registered national and community trademarks...”
2. According to article 12§2 of Regulation (EC) 874/2004, the duration of the phased registration period shall be four months and shall comprised of two parts of two months each part. “During the first part of phased registration, only registered national and community trademarks geographical indications and the names and acronyms referred to in article 10(3) may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in article 10(1). During the second part of phased registration the names that can be registered in the first part as well as names based on all other prior rights can be applied for as domain names by holders of prior rights on those names.” The Sunrise Period ran from December 7, 2005 to April 7, 2006.
3. According to article 22§1(b) and 22§11(c) of Regulation (EC) 874/2004, “In the case of a procedure against the Registry, the ADR Panel shall decide whether a decision taken by the Registry conflicts with [Regulation (EC) 874/2004] or with Regulation (EC) 733/2002. The ADR Panel shall decide whether the decision shall be annulled and…” The decision upon the case at hand does not concern to the examination of Prior Right of the Complainant according to Documentary Evidence which was submitted as a consequence of and because of the provisions of the framework of the ADR proceedings.
4. According to article 14§4 of Regulation (EC) 874/2004 and article 8§5 of the Sunrise Rules “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. If the documented evidence has not been received by this deadline, the application for the domain name shall be rejected.” According to article 14§4 of Regulation (EC) 874/2004, the Complainant/Applicant has the burden to prove Prior Right on the domain name during the phased registration.
5. Following section 13§2(i) and (ii) of the Sunrise Rules for a registered trademark it is sufficient to submit the following documentary evidence: “(i) a copy of an official document issued by the competent trademark office indicating that the trademark is registered (certificate of registration etc.) or (ii) an extract from an official online database operated and/or managed by the relevant national trademark office, the Benelux Trademarks Office, the OHIM or the WIPO. Extracts from commercial databases are not acceptable even if they reproduce exactly the same information as the official extracts.” Also,

“In the foregoing cases the Documentary Evidence must clearly evidence that the Applicant is the reported owner of the registered trademark.”
6. According to Section 19§1 and 2 of the Sunrise Rules, “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. 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 composite signs (signs including words, devices, pictures, logos etc) will only be 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…”
7. According to Section 19§5 of the Sunrise Rules, if an applicant claims a Prior Right to a name that includes an internet top-level domain (such as, but not limited to, .com, .net or .eu) the complete name for which a Prior Right exists includes that domain suffix.
8. The Complainant applied for the domain name “www.ticketpro.eu” on December 9, 2005, i.e during the first two months of the Sunrise Period with duration from December 7, 2005, and until April 7, 2006, and its prior right was based on its composite Czech Trademark “TICKETPRO WWW.TICKETPRO.CZ”, according to article 10§1 and (2) of Regulation (EC) 874/2004, which posits 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. ‘Prior rights’ shall be understood to include, inter alia, registered national and community trademarks...” (In consideration, also, of article 12§2, 14§4 of Regulation (EC) 874/2004 and article 13§2(i) and (ii) and 8§5e of the Sunrise Rules as mentioned hereto).
8. In consideration of the facts that
a. The Complainant submitted with his application only a trademark certificate of the Czech (composite) trademark that included the word elements:
i. TICKETPRO in a stylized version and
ii. the words www.ticketpro.cz
b. In the frame of the ADR Proceedings the Complainant allege that he has prior rights based on his business name,
the decision upon the case at hand pertains only to the examination of Prior Right of the Complainant according to the trademark certificate delivered to the processing agent within the time period of 40 days and in accordance with article 14§4 of the Regulation (EC) 874/2004 as well as article 8§5 of the Sunrise Rules. Said decision upon the case at hand does not concern to the examination of the Complainant’s Prior Right stemming from his business name, according to article 22§1(b) and 22 §11(c) of the Regulation (EC) 874/2004.
9. In careful consideration of the registration certificate submitted by the Complainant to the Validation Agent during the Sunrise Period, the complete name of the Czech registered trademark, which is composite and the word element in it is predominant, includes the following word elements:
a. The word “TICKETPRO” being incorporated in a stylized version and
b. The words “www.ticketpro.cz”
Thus, said trademark is composed of the alphanumeric elements “TICKETPRO WWW.TICKETPRO.CZ”. According to Section 19§1, 2, and 5 of the Sunrise Rules, a Prior Right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos etc) will only be accepted if the domain name consists the complete name for which the Prior Right exists as said complete name is manifested by the Documentary Evidence. Also, especially composite signs will only be accepted if the word element is predominant and can be clearly separated or distinguished from the device element provided that all alphanumeric characters 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. According to Section 19 of the Sunrise Rules, the complete name for which a Prior Right exists includes the domain suffix, which in the case at hand is the “.cz”. Therefore the complete name of the trademark consists of the alphanumeric elements “TICKETPRO WWW.TICKETPRO.CZ”. It does not consist of only the alphanumeric elements “TICKETPRO”, which are included in the domain name www.ticketpro.eu which was applied for by the Complainant.
10. Therefore, in consideration of and pursuant to the provisions of applicable law the application for the registration of the domain name “www.ticketpro.eu” was lawfully rejected according to article 10§1 and 2, 12§2. 14§4, 22§1(b) and 22§11(c) of the Regulation (EC) 874/2004 as well as Section 13§2 and 19 of the Sunrise Rules.

Relevant decisions cases No. 01053 (SANTOS), No. 00470(O2).

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) of the Rules, the Panel orders that the Complaint is denied.

PANELISTS

Name	**Alexandra Kaponi**

DATE OF PANEL DECISION 2006-09-29

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed a complaint against the Respondent regarding the rejection of his application for the registration of the domain name www.ticketpro.eu during the Sunrise Period based on the registration of his trademark which consists of the word TICKETPRO in a stylized form and the alphanumeric characters WWW.TICKETPRO.CZ. However, the Complaint is denied. That decision which denies the registration of the domain name www.ticketpro.eu is taken pursuant to the Regulations (EC) 874/20004 and (EC) 733/2002 and in consideration of the following premises:

1. The Complainant applied for the registration of the domain name www.ticketpro.eu during the first phase of the Sunrise period and his prior right was based on his trademark “TICKETPRO WWW.TICKETPRO.CZ”, but not on the trademark “TICKETPRO” according to the registration certificate which he submitted.
2. The decision which examines the Complainant’s prior right must consider said prior right based on his trademark as it is fully and legally described in the registration certificate which the Applicant furnished the Validation Agent with. Said decision cannot be based on the Applicant’s business name.
3. The Complainant’s trademark is composed of the alphanumeric elements “TICKETPRO WWW.TICKETPRO.CZ”. According to Section 19§1, 2, and 5 of the Sunrise Rules, a Prior Right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos etc) will only be accepted if the domain name consists the complete name for which the Prior Right exists as said complete name is manifested by the Documentary Evidence. Also, especially composite signs will only be accepted if the word element is predominant and can be clearly separated or distinguished from the device element provided that all alphanumeric characters 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. According to Section 19 of the Sunrise Rules, the complete name for which a Prior Right exists includes the domain suffix, which in the case at hand is the “.cz”. Therefore the complete name of the trademark consists of the alphanumeric elements “TICKETPRO WWW.TICKETPRO.CZ”. It does not consist of only the alphanumeric elements “TICKETPRO”, which are included in the domain name www.ticketpro.eu which was applied for by the Complainant

Therefore the Respondent lawfully rejected the application for the registration of domain name www.ticketpro.eu because it does not include all alphanumeric elements which the Applicant’s trademark consists of according to article 10§1 and 2, 12§2, 14§4 of Regulation (EC) 874/2004 and Section 13§2 and 19 of the Sunrise Rules.