Panel Decision for dispute CAC-ADREU-002238

Case number	**CAC-ADREU-002238**
Time of filing	**2006-07-14 12:36:51**
Domain names	**asko.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**AM Appliance Holding AB, Olof Hammar**

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 legal proceedings which are pending or have been decided and which relate to the disputed Domain Name.

FACTUAL BACKGROUND

On 4 July 2006 the AM Appliance Holding AB (Sweden) (hereinafter referred to as 'the Complainant') filed a complaint at the Arbitration Centre for .eu Disputes requesting that the registration of the domain name asko.eu be annulled and the domain name be attributed to the next applicant in queue which satisfies the registration criteria.

The domain name asko.eu was applied for on 7 December 2005 by Asko Assekuranzmakler GmbH (hereinafter referred to as 'the Applicant'). According to the Complainant the European Registry of Internet Domain Names received an application from the Applicant only five minutes before it received an application for the same domain name from the Complainant. Following the 'first-come-first-served' principle set forth in art. 2 and (regarding the phased registration period) in art. 14 in fine of the Commission Regulation (EC) No. 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration (hereinafter referred to as 'the Regulation No. 874/2004') the domain name asko.eu was allocated for use to the eligible party whose request had been received first, that is the Applicant.

A. COMPLAINANT

The Complainant claims that he has made a search for the trademark "ASKO" in the Deutsches Patent- und Markenamt, the Community Trademark Register and the International Register and "in none of the registers Assekuranzmakler holds a registered trademark of the name ASKO". According to the Complainant, Assekuranzmakler does, however, hold, a Community Trademark registration of the name "asko asserkuranzmakler GmbH".
Basing on these facts, the Complainant claims that according to Section 19 (last sentence) of the .eu Sunrise Rules this does not entitle Assekuranzmakler to register the relevant domain name.

In the Complainant's opinion, the decision by EURid to register the domain name for Assekuranzmakler is non-compliant with article 10(2) of the Regulation (EC) No 733/2002.
Therefore, it is claimed that the decision to register the domain name for Assekuranzmakler shall be annulled and the domain name shall be attributed to the Complainant, as its application is next in queue. Since the Complainant claims that he not only has a prior right to ASKO, but also satisfies all other registration criteria, the domain name asko.eu should be transferred to him.

B. RESPONDENT

In response to the Complainant, the Respondent provided grounds on which the application by Asko-Assekuranzmakler GmbH was accepted. It was referred to article 12 (2) of the Regulation, which allows licensees of trademarks to apply for the corresponding domain

name. It was also claimed that the documentary evidence submitted by the Applicant clearly shows that:
• Mr. Robert Kögl is the holder of a valid Community trademark consisting of the sign ASKO; and
• Mr. Robert Kögl (Licensor) has licensed this trademark to the Applicant (Licensee).
It is concluded that since the Applicant has been licensed to use a valid Community Trade Mark to apply for the ASKO domain name, EURid's decision to accept the application is in line with the Rules and Regulation.

DISCUSSION AND FINDINGS

According to the Complainant the decision by EURid to register the domain name for the Applicant is non-compliant with art. 10(2) of the Regulation No 874/2004 (quoted in the complaint as Regulation No. 733/2002). On the basis of the aforementioned provision, 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. This principle is further developed and explained by the 'Sunrise Rules', which state that it is not possible to obtain a registration of a domain name comprising part of the complete name for which the prior right exists.

Thus, in the opinion of the Complainant the word 'asko' constitutes only a part of the registered Community Trade Mark from which the prior right was derived and as such is inadmissible for registration as a domain name in the phased registration period. It should therefore be annulled and the domain name shall be attributed to the Complainant since its application is next in queue. The Complainant claims to be the prior right holder in respect of the 'asko' trademark in the meaning of art. 10(1) of the Regulation No. 874/2004 on the basis of an application filed on 7 December 2005. It also claims it satisfies all other registration criteria.

Regulation No. 874/2004 stipulates in its art. 10(1) that applying for the registration of a domain name during the phased registration period is accessible only to holders of prior rights recognised or established by national and/or Community law and public bodies. 'Prior rights holders' are to be understood to include, inter alia, the holders of registered national and Community Trade marks.

On the basis of art. 12(2) of the Regulation No. 874/2004 the domain names during the first period of the phased registration can be applied for not only by prior right holders, but also by the licensees of a prior right. In such a case the applicant is obliged to enclose the documentary evidence, additional acknowledgement and a declaration duly completed and signed by both the licensor of the relevant registered trade mark and the applicant as a licensee form, as set forth in Section 20(1) of the .eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period 'Sunrise Rules' (hereinafter referred to as the 'Sunrise Rules').

In order to be an eligible party in the meaning of art. 10 (1), the Applicant based his application on a prior right concerning a registered Community Trade Mark. The Community Trade Mark application for the sign 'asko assekuranzmakler GmbH' was filed at the Office for Harmonisation in the Internal Market on 1 March 2000 and subsequently registered on 19 June 2001 under the no. 001535616. The owner of the Community Trade Mark is a natural person, Mr. Robert Kögl.

The Complainant claims that he made a search for the trademark "ASKO" in the Deutsches Patent- und Markenamt, the Community Trademark Register and the International Register and in none of the registers Asko-Assekuranzmakler GmbH holds a registered trademark of the name ASKO. This can, however, not be confirmed, as the Community Trade Mark CTM 001534866 "ASKO", was registered on 11/10/2002 for Mr. Robert Kögl. The Complainant, providing a scanned search report from the CTM register, should be aware of this fact, as it is of importance in this case.

The Respondent cites a panel decision in case no. 495 (STEMCELL). The case concerned the Benelux trademark 'Stemcell', which already was registered at the time of domain name application. A valid license for the aforementioned trademark had been granted in favor of Bureau Gevers, which applied for the domain name. The panel concluded in this case that enclosing a copy of the trademark license agreement (according to the template required by the Sunrise Rules) is sufficient to entitle the applicant (Bureau Gevers) to apply for the domain name 'stemcell.eu'.

Given the legal and factual circumstances of this Case, the Complaint must be denied.

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	Mariusz Kondrat

DATE OF PANEL DECISION 2006-10-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant requested to declare that EURid's decision to register the domain name for the Applicant is non-compliant with art. 10(2) of Regulation No 874/2004. On the basis of that provision, the registration based on 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. The Complainant claimed that the Applicant had no prior right with regard to the name "ASKO".

The Respondent provided grounds on which the application by "asko assekuranzmakler GmbH" was accepted. It was further referred to article 12 (2) of the Regulation, which allows licensees of trademarks to apply for the corresponding domain name. It was claimed that the documentary evidence submitted by the Applicant supported the decision for a registration.

The Panel decided to deny the Complaint on the base of legal and factual circumstances. The Complainant claims that the Applicant had no prior trade mark right within the meaning of art. 12(2) of Regulation No. 874/2004 to the sign "ASKO". This statement can not be regarded being correct as the Applicant had a prior right with regard to the Community Trade Mark „ASKO".