Panel Decision for dispute CAC-ADREU-002364

Case number	**CAC-ADREU-002364**
Time of filing	**2006-07-24 12:59:30**
Domain names	**lecapitaine.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**PETIT FORESTIER, Monsieur Olivier FERNANDES, Admnistrateur systèmes et réseaux**

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 other legal proceedings.

FACTUAL BACKGROUND

The company LECAPITAINE (Complainant) has opposed to the decision made by EURid to reject its application for the domain name lecapitaine.eu.

The Complainant filed an application for the domain name in the first Sunrise period on December 7, 2005.

The application was based on a prior right to a trademark and the Complainant submitted the documentary evidence in due time before the deadline on for January 16, 2006.

The Complainant's prior right consists of a Community Trademark registration (CTM) issued on October 18, 2005 (Registration No 003996089). The trademark consists of a device (figurative) mark including words and graphic elements. Thus, the mark consists of the word: "Lecapitaine" and underneath in lower case letters the words: "CARROSSIER FRIGORIFIQUE". The words are intersected by two parallel bands. The first band is blue and widens as it reaches the top. The second band is green and widens as it reaches the top but shorter.

EURid (the Respondent) rejected the application by its decision of June 6, 2006.

The Complainant does not agree with this decision and requests to have the domain name granted to the Complainant.

A. COMPLAINANT

According to the Complainant the documentary evidence shows that the Complainant has a prior right to the domain name in form of a registered device (figurative) CTM.

Consequently, the Complainant disputes the decision taken by the Respondent to refuse its application for the domain name lecapitaine.eu.

According to the Complainant it has submitted all necessary and relevant evidence in support of its claim including the name of the domain name applied for, address for the company and a copy of the certificate of registration (No. 003996089) of the CTM.

The Complainant argues that the CTM submitted as documentary evidence sufficiently establishes the Complainant's prior right to the

name LECAPITAINE.

Consequently, the Complainant requests that the Respondent's decision is annulled and that the domain name lecapitaine.eu is granted to the Complainant pursuant to the provisions of the EC Regulation 874/2004 especially Art. 10(1).

B. RESPONDENT

The Respondent refers to Art. 10(1) and 10(2) of the Regulation which state that holders of prior rights shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts (sunrise). A registration based on a prior right to a trademark shall consist of a trademark to a name, which is similar to the domain name applied for. Furthermore, the Respondent relies on Section 19(2) of the Sunrise Rules which clarify Art. 10(1) and (2) of the Regulation and states that the documentary evidence – in case of a device (figurative) mark - clearly must illustrate the name for which a prior right is claimed and the evidence will only be accepted if the sign exclusively contains a name, or if the word is predominant and can easily be separated from the remaining graphic elements of the mark.

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 to the name LECAPITAINE, based on the device (figurative) trademark submitted as documentary evidence.

Instead, the Complainant could have applied for a domain name which corresponded to its prior rights according to the full text -"LE CAPITAINE CARROSSIER FRIGORIFIQUE" - of its CTM.

Since the Applicant applied for the domain name LECAPITAINE (and not for the domain name which corresponds to the complete name for which a prior right exists), the Respondent in its own view correctly rejected the Complainant's application for the domain name lecapitaine.eu.

In support of its view the Respondent refers to the cases No. 470 (O2), 1053 (SANTOS), 1438 (ELLISON) and 713 (HUETTINGER).

DISCUSSION AND FINDINGS

Pursuant to the principles in Art. 14 of the Regulation, the burden of evidence lies on the Applicant to submit documentary evidence showing that it is the holder of a prior right to the domain name in question.
The domain name application is solely based on a certificate of registration for a device (figurative) Community Trademark (No. 003996089).

Furthermore, the Complainant has in the course of these proceedings submitted documents showing the registration details of the application for the domain name and the certificate of registration of the CTM.

The Panel is aware that the Complainant might actually have rights to the name LECAPITAINE e.g. as a company name or by virtue of other common law rights, but since the Complainant has applied for the domain name based on its registered CTM, the Panel can only take this CTM into consideration, when determining whether the Complainant has documented a prior right to the domain name.

Art. 10(2) of the Regulation states:

"2. 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."

Section 19(2) of the Sunrise Rules clarifies Art. 10(2) in so far as names included in device marks are concerned.

The provision states that a prior right claimed to a name included in a device mark 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, 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 those characters appear."

The Complainant's trademark consists of a text and graphic elements as described above.

The text does not exclusively contain the name LECAPITAINE. Therefore the matter in question does not fall within Section 19(2)(i) of the Sunrise Rules.

Whether or not the word element LECAPITAINE is predominant as required by Section 19(2)(ii) of the Sunrise Rules is a matter of interpretation.

However, Section 19(2)(ii)(a) of the Sunrise Rules provides that all alphanumeric characters in the sign must be contained in the domain name.

The Complainant's CTM consists of the following alphanumeric characters: "LECAPITAINE CARROSSIER FRIGORIFIQUE".

The Panel refers to the similar case no. 470 (O2) in which the Complainant had applied for the domain name "o2.eu" on basis of a prior right to a trademark consisting of a device mark including words and graphic elements, namely the stylized characters "O2" printed on a blue background and accompanied, on the right side by the stylized words "l'oxygène de votre quotidien". The Panel found that the Complainant only had prior right in the complete name, and not to the element "O2". For this reason the Panel concluded that the decision taken by the Respondent (EURid) to deny the application did not conflict with the Regulation and denied the complaint.

Also, the Panel refers to the findings of the Panel in case no. 1053 (SANTOS) in which the Panel found that the figurative letter "S" which on the left side accompanied the word "SANTOS" had to be contained in the domain name as it would then be the domain name ssantos.eu and not santos.eu that the Complainant had a prior right to. The Panel reached this decision despite the fact that the Complainant undoubtedly had rights to the word "SANTOS", but this was not apparent from the documentary evidence submitted.

Furthermore, reference is made to the cases No.713 (HUETTINGER), No. 1438 (ELLISON) and No. 1728 (ANONSE, OFEERTA) all concerning the same issue as this case and all ruling that the domain name applied for has to consist of the complete name of the prior right even if some of the letters are stylized.

In this case none of the letters are stylized.

The words "LECAPITAINE" are certainly more distinct than the rest of the characters in the device mark. However, distinctiveness alone for some of the alphanumeric characters do not allow the Complainant to have a part of the characters of the complete sign registered as a .eu domain name.

On basis of the relevant provisions and the referred decisions the Panel therefore finds that the Complainant has not shown prior rights to the name "LECAPITAINE" and therefore it could not have the domain name "lecapitaine.eu" registered.

The Panel finds that all the alphanumeric characters of the device mark - which the Complainant has a prior right to - are not contained in the domain name "lecapitaine.eu", and accordingly the decision taken by the Respondent to reject the Complainant's application for the domain name does not conflict with the Regulation.

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	Jakob Plesner Mathiasen

DATE OF PANEL DECISION 2006-10-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contends that the Respondent's decision to reject its application for the domain name lecapitaine.eu is in conflict with the Regulations regarding eu. domain names.

The Complainant is the holder of a device (figurative) Community Trademark consisting of the alphanumeric characters "LECAPITAINE CARROSSIER FRIGORIFIQUE" and graphic elements. The word "LECAPITAINE" is emphasized when compared to the rest of the alphanumeric characters in the device mark.

The Panel agrees with the Respondent's decision to reject the domain name application based on Art. 10(1) and 10(2) of the Regulation and Section 19(2) of the Sunrise Rules especially section 19(2)(ii)(a) which provides that all alphanumeric characters in the mark must be contained in the domain name applied for.

The words "LECAPITAINE" is certainly more distinct than the rest of the device mark. However, pursuant to the requirements of the Regulations and the Sunrise Rules the Complainant cannot have only a part of the characters of the complete device mark registered as a eu. domain name. This applies even when some of the characters in the sign are more distinct than others.

On basis of the relevant provisions and the referred decisions the Panel finds that the Complainant has not shown prior rights to the name "LECAPITAINE", but only to the full alphanumeric content of the device (figurative) mark as it is "LECAPITAINE CARROSSIER FRIGORIFIQUE".

The Respondent's decision does not conflict with the provisions of the Regulations and therefore the Panel dismiss the complaint.