Panel Decision for dispute CAC-ADREU-002471

Case number	CAC-ADREU-002471
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Domain names	taiyo-yuden.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Taiyo Yuden Europe GmbH, Jost

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 concerning the disputed domain name.

FACTUAL BACKGROUND

The Complainant in this proceeding is “Taiyo Yuden Europe GmbH” based in Fuerth, Germany. The Respondent in this proceeding is EURid. The disputed domain name is “taiyo-yuden”.

The Complainant applied for the domain name on March 23rd 2006. The Complainant is the only applicant. The documentary evidence was handed in by the Complainant with a cover sheet dated 24th March 2006. The cover sheet indicated “Company Name / Trade Name / Business Identifier” as priority right. The application was supported by an extract from the companies register. According to this extract the name of the Complainant is “Taiyo Yuden Europe GmbH” while “GmbH” identifies the company type. Furthermore the extract shows that the Complainant is registered since 1979. No further documents were filed supporting the application.

On July 4th 2006 the Respondent rejected the application on the ground that the Complainant did not provide sufficient evidence supporting the priority rights claimed by the Complainant. On inquiry the Respondent specified the reason for the rejection of the application. In an email dated 20th July 2006 the Respondent informed the Complainant that the application was rejected because the requested domain name “taiyo-yuden” did not match the full name of the company “Taiyo Yuden Europe GmbH”.

Supporting the Complaint further documents were submitted. With reference to these documents the Complainant claims prior rights for the name “Taiyo Yuden”. This evidence includes documents showing the Complainant to be the licensee of the Community Trade Mark No. 002175263 “TAIYO YUDEN” being a figurative mark and No. 000500777 “Taiyo Yuden” being a word mark. Furthermore the Complainant claims priority rights on the name “Taiyo Yuden” as a company name, trade name, business identifier and unregistered trade mark.

The Complainant request EURid´s decision to be annulled and the domain name to be transferred to the Complainant. The Respondent requests the Complaint to be rejected.

A. COMPLAINANT

The Complainant challenges the decision by EURid on the following grounds:

The Complainant refers to Article 10 of Commission Regulation 874/2004 and claims that the Complainant is the holder of prior rights mentioned in Article 10. The Complainant claims to be the owner of various priority rights, namely a (1) company name, (2) trade name, (3) business identifier, (4) unregistered trademark (5) and the licensee of a registered trademark.

With respect to the documents filed during the application process the Complainant argues that the company name entered in the commercial register is “Taiyo Yuden Europe GmbH” while this company name obtains its distinctive character by means of the words “Taiyo Yuden”. According to the Complainant geographical specifications as well as the accretion regarding the legal form are not able to establish distinctiveness and the public understands “Taiyo Yuden” as the name of the company.

For this reason, according to the Complainant, it operates under the Uniform Resource Locators http://www.taiyo-yuden.com and http://www.taiyo-yuden.de. The Complainant argues that the accretion “Europe” results from the international and global business activities of the Taiyo Yuden Group of which the Complainant is the branch for Europe.

Therefore the Complainant concludes that the formalistic approach and verification the respondent applied violates relevant EU-regulations and prior right exists also for “Taiyo Yuden” and not only for the registered company name “Taiyo Yuden Europe GmbH”.

Furthermore the Complainant refers to further prior right and claims that the Complainant is acting under “Taiyo Yuden” and concludes that these words are a trade name and also a business identifier. The Complainant argues that under the German Trade Mark law “Taiyo Yuden” is also protected as a Companies Name.The Complainant also refers to “Taiyo Yuden” as an unregisterd Trade Mark protected under German Law. Finally the Complainant argues to be a licensee of a registered Community trade mark and the Complaint included documents showing the Complainant to be the licensee of such a Trade Mark.

With respect to the documents filed with the Complaint the Complainant argues that Complainants must be allowed to bring further evidence during the Alternative Dispute Resolution.

The Complainant request EURid´s decision to be annulled and the domain name to be transferred to the Complainant.

B. RESPONDENT

The Respondent has brought the following arguments before the Panel:

(1) Grounds on which the Respondent has rejected the application
The Respondent refers to Article 10 (1), (2) of Commision Regulation 874/2004. Article 10 (2) of this Regulation states that 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.

The Respondent describes the examination process as follows:

Taiyo Yuden Europe GmbH applied for the domain name TAIYO-YUDEN on 23 March 2006. The processing agent received the documentary evidence on 29 March 2006, which was before the 2 May 2006 deadline. The documentary evidence consisted of an extract from the German Companies Register. The validation agent concluded from its examination of the documentary evidence that the domain name applied for, TAIYO-YUDEN, did not consist of the complete name of the Complainant's company name. Based on these findings, the Respondent rejected the Complainant’s application.

(2) Complete name of the Complainant
The Respondent disagrees with the Complainant´s Contentions. The Respondent argues that it is insufficient to be the holder of "a" rior right so as to be granted a .eu domain name during the Sunrise Period.
The Respondent finds that the relevant question in this proceeding is not what part of the prior right/trademark is distinctive and what part is generic and that this question would only be relevant under trademark law. The Respondent argues that the legal framework for domain names set in place by the Regulation clearly states that the complete name must be applied for, not the distinctive element.
The Respondent notes that according to the evidence presented by the Complainant the complete name of this company name is “Taiyo Yuden Europe” while the "GmbH" should be disregarded pursuant to section 19 (4) of the Sunrise Rules, as this element designates the company type, not the company name as such.
According to the Respondnet this company name would have qualified to apply for the domain name “TAIYO-YUDEN-EUROPE” but not for “TAIYO-YUDEN”.

(3) Other priority rights
The Respondent also adresses to the other prior rights claimed by the Complainant. The Respondent refers to Article 14 of Commission Regulation 874/2004 that 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 Repondent argues that it is therefore of crucial importance that the Respondent is provided with all the documentary evidence necessary for it to assess if the applicant is indeed the holder of a prior right and that the

validation agent should assess the right on the basis of the evidence provided by the applicant.
According to the Respondent the documentary evidence did not demonstrate that the Complainant was the holder of other prior rights than its company name and no other evidence was submitted nor did the Complainant even refer to other prior rights in its documentary evidence.
The Respondent argues that all further evidence presented by the Complainant during the ADR proceedings can not be taken into account.
The Respondent requests the Complaint to be rejected.

DISCUSSION AND FINDINGS

(1) Main arguments of Complaint
The Complainant challenges the decision by EURid in the following way: in a first round of arguments the Complainant refers to the documents that were processed to the Validation Agent during the application process. The Complainant argues that these documents already give sufficient evidence of the priority right (company name) claimed by the Complainant. The Panel will address this aspect in section (2).

In a second round of arguments the Complainant adresses the documentary evidence that was included in the Complaint. The Complainant argues that if the priority right in the form of a company name has not been proven sufficiently during the application process at least several other priority rights should be examined during the ADR proceedings. The Panel will address these arguments in section (3).

(2) Documentary evidence processed to the Validation Agent
This Complaint challenges the Registry´s decision on the basis of Commission Regulation 874/2004 of 28 April 2004. Article 10 (1) of said Regulation 874/2004 provides that holders of Prior Rights recognised 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 that prior rights shall be understood to include, inter alia, registered national and community trademarks, trade names, business identifiers and company names.
Article 10 (2) of Commission Regulation 874/2004 states that the registration on the basis of such a priority right shall consist of the registration of the complete name for which the prior right exits, as written in the documentation which proves that such a right exists.
Concering company names the Sunrise Rules include further criteria concerning cases when an application is based on a company name. Section 16 (1) of the Sunrise Rules states that a company name is an official name of a company, i.e. the name under which the company is incorporated or under which the company is registered. According to Section 16 (4) of the Sunrise Rules an extract from the relevant companies or commercial register gives sufficient proof of this priority right.
Section 19 (1) of the Sunrise Rules states that it is not possible for an applicant to obtain the registration of a domain name comprising part of the complete name for which the prior right exits.
Finally Section 19 (4) of the Sunrise Rules allows the company type (such as “SA”, ““GmbH” or “Ltd.”) to be omitted from the complete name for which the prior right exists.

The Complainant´s application was supported by an extract from the companies register. This extract gives evidence that the name of the Complainant is “Taiyo Yuden Europe GmbH”.

The Panel finds that the question of the “Complete Name” in the case of a company name is adressed in full detail in the above mentioned regulations. Article 10 (2) of Commission Regulation 874/2004 clearly expresses that the “complete name” as written in the documentary evidence is the basis for the registration of a domain name. Concerning a company name this principle that the complete name – not a part of a company name – has to be regarded during the validation process further details are included in the Sunrise Rules. The only exception of the principle of completeness can be found in Section 19 (4) of the Sunrise Rules that allows the company type – in this case the “GmbH” – to be omitted.

In the case of the Complainant the complete name shown in the companies register is “Taiyo Yuden Europe GmbH”. If the company type “GmbH” would be omitted the complete name reads “Taiyo Yuden Europe“. Therefore the company name of the Complainant would qualify as priority right for the registration of “taiyo-yuden-europe.eu” but not for “taiyo-yuden.eu”.

The Panel disagrees with the Complainant´s argument that the word “Europe” in “Taiyo Yuden Europe“ is descriptive and should be disregarded. There is no EU Regulation or Sunrise Rule concerning the implementation of the .eu Top Level Domain that supports this opinion brought forward by the Complainant. In this context also German Trade Mark Law cannot support the Complainant´s argument as it is a company name, not a trade mark, that has been the basis for the Complainant´s application.

(3) Documentary evidence filed with the Complaint

As the documentary evidence that was processed to the Validation Agent has shown not to prove a prior right for “Taiyo-Yuden” the Panel has to take the further arguments and documents into account that have been filed by the Complainant during the ADR proceedings. The Complainant has filed an extensive number of documents within the ADR proceedings and claims that these documents give sufficient proof of various other prior rights, namely a trade name, a business identifier, an unregistered trade mark and the licensee of a registered trade mark.

The Panel is aware that the question whether additional evidence has to examined during the ADR proceedings has been addressed in several decisions in the past. According to Article 14 of Commission Regulation 874/2004 the documentary evidence that has been submitted to the Validation Agent is the basis for the examination whether a priority right exists. There is substantial case law that all evidence has to be presented during the validation process (cases no. 127 (BPW), 219 (ISL), 294 (COLT), 843 (STARFISH)) and therefore new evidence presented during the ADR proceedings should be disregarded.

The Panel is also aware that in several cases additional evidence has been taken into account. In case no. 253 (SCHOELLER) and case no. 396 (CAPRI) additional evidence was taken into account to clarify documentary discrepancies that had lead to the application´s rejection. However in these cases it was not new evidence supporting a prior right different from the one the application was based on that was taken into account, but supporting evidence that was taken into account to clarify documentary discrepancies.

Also in the case no. 431 (CASHCONTROL) mentioned by the Comlplainant it was not complete new evidence that was taken into account as a trade mark certificate supporting the prior right had already been filed to the Validation Agent during the application process.

It is therefore the Panel´s opinion that new evidence can only be taken into account for the purpose of clarifying the documents filed to the Validation Agent under certain circumstances. Such circumstances arise when
(a) these documents adress the priority right on which the application was based on and
(b) there is sufficient evidence that the Validation Agent did not conduct a full and accurate review of the application.

The Complainant has based the application on the priority right “company name” and filed an extract from the companies register. Regarding the additional evidence filed with the Complaint no further evidence has been presented that would give proof of a different company name than the one shown in the companies register. The Panel finds that in a case where an official register like the companies register is the basis for the proof of a priority right neither the Validation Agent nor the Panel has the discretionary powers to find a different company name valid to qualify for a domain name than the one shown in the companies register. In such a case the Validation Agent has to regard the companies register as done in this case and there is no indication or evidence that the application was not reviewed accurately by the Validation Agent.

Therefore the Respondent correctly found that the company name “Taiyo Yuden Europe GmbH” does not qualify for the domain name “Taiyo-Yuden” according to Article 10, 14 of Commission Regulation 874/2004.

The Panel finds that no circumstances that would allow new evidence to be taken into account have been introduced by the Complainant. For the sake of completeness the Panel has regarded the additional evidence and comes to the conclusion that the evidence can not be taken into account for several reasons in addition to the general approach concerning new evidence stated above.

Concerning the priority right “trade name” the new evidence does not show the Complainant to be the owner of the marks “Taiyo Yuden” but the firm Taiyo Yuden Co., Ltd. based in Japan. With regard to the priority right “business identifier” the new evidence contains no affidavit or court judgment that would prove this right according to Section 12, (3), 16 (3), 16 (5) of the Sunrise Rules. There is also no evidence for an unregistered trade mark according to Section 12 (2), 12 (3), 15 of the Sunrise Rules.
Finally the licence declaration filed by the Complainant can also not been taken into account as it has not been filed during the application process and cannot be regarded as new evidence within the ADR proceedings.

Regarding all this the Panel finds the decision by the Registry in accordance with Article 10, 14 of Commission Regulation 874/2004.

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	**Volker Herrmann**

DATE OF PANEL DECISION 2006-10-31

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant had filed an application for the domain name “taiyo-yuden” and processed an extract from the companies register to the Validation Agent showing the name of the Complainant to be “Taiyo Yuden Europe GmbH”.
The Registry rejected the application on the ground that the complete company name “Taiyo Yuden Europe GmbH” would not qualify for the domain name “taiyo-yuden” but only for “taiyo-yuden-europe” even when the company type “GmbH” was omitted.
The Complaint included various documentary evidence claiming several additional priority rights.
The Panel found that in a case where an official register like the companies register is the basis for the proof of a priority right neither the Validation Agent nor the Panel has the discretionary powers to find a different company name valid to qualify for a domain name than the one shown in the companies register. The company type “GmbH” could be omitted according to Section 19 (4) of the Sunrise Rules but not the word “Europe” being a part of the company´s name.
The Panel also found that new evidence can only be taken into account for the purpose of clarifying the documents filed to the Validation Agent under certain circumstances. Such circumstances arise when
(a) these new documents address the priority right on which the application was based on and
(b) there is sufficient evidence that the Validation Agent did not conduct a full and accurate review of the application.
In conclusion the Panel found the decision taken by the Registry in accordance with Article 10, 14 of Commission Regulation 874/2004 as the priority right “company name” has not been proven by the extract from the companies register.
The new evidence could not be taken into account as it did not address the priority right on which the application was based on and there was no indication or evidence that the appliaction was not reviewed accurately by the Validation Agent.
In conclusion the Panel denied the Complaint.