Panel Decision for dispute CAC-ADREU-002496

Case number	CAC-ADREU-002496
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Domain names	neckermann.eu

Case administrator

Name	Kateřina Fáberová

Complainant

Organization / Name	neckermann.de GmbH

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

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FACTUAL BACKGROUND

On 7th December 2005 the Complainant applied via its registrar Cronon AG for the domain name “neckermann.eu”. A registered German trademark „n neckermann“ for the domain name “neckermann” was claimed as a Prior Right. The Complainant argues that the Prior Right is a word and device trademark in which the word element “neckermann” is predominant, and can be clearly separated and distinguished from the device element, which consists of a graphic decoration without meaning.

The Respondent in his response pointed out to the trademark application of the Applicant which was submitted as documentary evidence and that all alphanumerical characters must also be contained in the domain name applied for. Because at present case the domain name does not consist of the complete name of the trademark application, as not all alphanumerical characters depicted in the trademark have been included in the domain name applied for, the Complaint must be rejected.

A. COMPLAINANT

On 7th of December 2005 the Complainant applied via its registrar Cronon AG for the domain name “neckermann.eu”. The registered German trademark “n neckermann” should serve as Prior Right. A copy of the trademark certificate of the German trademark DE 397 51 262 “n neckermann” was enclosed as Documentary Evidence.

Regarding the fact that the name of the applicant and the name of the trademark owner is “Neckermann Versand AG” the Complainant clarifies that this company is identical to the Complainant “neckermann.de GmbH”. The Applicant and the Complainant are one and the same.

The Complainant to corroborate his claim argues with the principals governing registration Chapter IV of Commission Regulation (EC) No. 874/2004 of 28 April 2004 and especially points out that a holder of Prior Rights should benefit from a sunrise period in order to prevent speculative and abusive registration of domain names.
The Complainant further insists that Documentary Evidence provided by the Complainant clearly proved the existence of a Prior Right in the name claimed in the application. “Trademark: neckermann” is stated on the second page of the extract of the register after number [540].
The Complainant argues that the Documentary Evidence of the Complainant fulfils the requirements according to Section 13 (1) and (2) (i) and to Section 19 Sunrise rules. Specifically the requirements of Section 19 (3) Sunrise rules were met as the Documentary Evidence clearly depicts the name for which a Prior Right is claimed, i.e. "neckermann". The Complainant insists that the word element in the Prior Right is predominant, and can be clearly separated and distinguished from the device element.

The Complainant is of the opinion that the documentary evidence clearly proved to the validation agent that the applicant is the owner of prior rights regarding the requested domain name. The rejection of the application despite the presented trademark certificate conflicts with European Union Regulations.
Further the Complainant's / Applicant's right to the disputed Domain name "neckermann.eu" is documented by the name of the Complainant, neckermann.de GmbH / Neckermann Versand AG, and his reputation.
The Complainant taking into account the discretion of the validation agent (Section 21 (3) Sunrise rules) and the fact that the Complainant / Applicant is well-known all over Europe, is - besides the presented German trademark - the owner of a respective company name, has several identical domains with different generic and country code top level domains and has used "Neckermann" as his business identification for over 50 years. Only an acceptance of the application would conform to European Union Regulations.
The Complainant further emphasizes that intention of Regulation (EC) No. 733/2002 is to prevent speculative and abusive registration of domain names by exclusively reserving domain names during a sunrise period to holders of prior rights, cf. Preamble (16). Further the Registry shall manage these .eu domains on the basis of the principle of efficiency. Having this in mind the domain "neckermann.eu" should have been granted to the Complainant.
The Complainant in fine asks for the attribution of the domain name to the Complainant according to Paragraph B11 (c) ADR Rules respectively Section 27 (1) third paragraph Sunrise rules.

B. RESPONDENT

Respondent made a proposal to reject the complaint.
Neckermann Versand AG (hereafter "the Applicant") applied for the domain name neckermann.eu on December 7, 2005. The processing agent received the documentary evidence on January 10, 2005, which was before the January 16, 2006 deadline.
To support his opinion, the Respondent argues
- with Article 10 (1), that only holders of prior rights which are 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
- with Article 10 (2) of the Regulation of Commission Regulation (EC) No 874/2004 of 28 April 2004 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.
- with Section 19 (2) of the Sunrise Rules which states that 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 sign exclusively contains a name or if the word element is predominant, and can be clearly separated or distinguished from the device element. Pursuant to article 14 of the Regulation, it is up to the applicant to submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. Based on this documentary evidence, the validation agent shall examine whether the applicant has prior rights on the name.

The validation agent concluded from its examination of the documentary evidence that the domain name applied for, neckermann, did not consist of the complete name of the trademark. The trademark application which the Applicant submitted as documentary evidence consisted of the following alphanumeric characters: "n neckermann" (Emphasis added).
The Respondent with reference to the Article 10 (2) of the Regulation concludes 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 and adverts to the section 19 (2) of the Sunrise Rules, which further clarifies article 10 (2) of the Regulation, which states that:
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, 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 Respondent is the opinion that there can be no doubt that the domain name does not consist of the complete name of the trademark application, as not all alphanumerical characters depicted in the trademark have been included in the domain name applied for. The Complainant's application is therefore not compliant with article 10 (2) of the Regulation and section 19 (2) of the Sunrise Rules.
To support his argumentation the Respondent refered the Panel to ADR Decisions No.1438 (ELLISON) and 713 (HUETTINGER), and 487 (BENTLEY), where identical situations were at hand.
As to the Argumentation of the Complainant right to the domain "neckermann.eu" by the name of the Claimant - neckermann.de GmbH / Neckermann Versand AG - and his reputation, the Respondent argues with the Article 12 (2) of the Regulation. Article 12 (2) of the Regulation states that phased registration shall be comprised of two parts of two months each and a company/trade name may only be used in the second phase of the sunrise period.
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 starting date of the first part of the sunrise period was December 7, 2005, which ended two months later, on February 7, 2006. Only for applications made after February 7, 2006 can company names / trade names be accepted as prior rights.
The Respondent referred the Panel to ADR Decision No. 954 (GMP), where identical situation was at hand and for all these reasons the Respondent suggested to reject the Complaint.

DISCUSSION AND FINDINGS

The Complaint was submitted on the 2 August 2006. The contested decision was made on 2006-06-23. Pursuant to Section 26.1 of the Sunrise Rules, an ADR proceeding against the Registry may be initiated within 40 days of a decision by the Registry. The Panel finds that the Complaint was submitted on the last day of the appeal period hence within the deadline and is admissible.

The Panel finds that the trademark application for the Domain name “neckermann.eu” (Emphasis added) was based on the documentary evidence of the German Trade mark DE 397 51 262 consisted of the following alphanumeric characters “n neckermann” (Emphasis added) which should prove the prior right of the Applicant.

The Panel further finds that the Complainant based his complaint on two main arguments on Prior Rights:
1. A company name and trade name because the name “Neckermann” is well-known
2. Trade mark, because the Complainant’s Prior Right is a word and device trademark in which the word element “neckermann” is predominant, and can be clearly separated and distinguished from the device element, which consists of a graphic decoration without meaning.

Ad 1. As to the argumentation of the Complainant that company name and trade name “Neckermann” is well-known and that the business identifier of the Claimant / Applicant is “Neckermann”.
The Complainant argues that
- especially in Germany the name “Neckermann” is well-known
- in the last seven years the annual turnover was constantly over one billion Euros
- the annual distribution of the “Neckermann” main catalogue is 14 million pieces plus an additional summer catalogue at 5.5 million pieces and further 14 smaller special interest catalogues
- his foreign subsidiaries exist in France, Bosnia-Herzegovina, Croatia, Austria, Belgium, Poland, Switzerland, Serbia-Montenegro, Slovakia, the Netherlands, Slovenia, the Czech Republic and Ukraine and they have their own internet ordering homepages and catalogues
- therefore the Claimant is not only well-known in Germany but in all parts of Europe
- he uses the internet homepages: “www.neckermann.de”, “www.neckermann.fr”, “www.neckermann.ba”, “www.neckermann.hr”, “www.neckermann.at”, “www.neck.be”, “www.neckermann.ch”, “www.neckermann.sk”, “www.neck.nl”, “www.neckermann.si”, “www.neckermann.cz” or simply “www.neckermann.com”.

Respondent is of the opinion that a company/trade name may only be used in the second phase of the Sunrise period and cites Article 12 (2) of the Regulation which states: “Phased registration shall be comprised of two parts of two months each. 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.” (Emphasis added)

The Panel considers as proven that the Application was filled on December 7, 2005, which was the starting date of the first part of the Sunrise period. During this period only registered trademarks, geographical indications and the names and acronyms referred to in Article 10 (3) of the Regulation will be accepted as prior rights.
Therefore, the Panel to the Complainant's reference to its company name / trade name as a Prior Right could not accept.

Ad 2. As to the argumentation of the Complainant that
- if the Complainant’s Prior Right is a trademark “n neckermann” and
- the domain name, which the Applicant applied for, is neckermann.eu,
- the rejection of the application of the Complainant conflicts with European Union Regulations.

The Complainant insists that his “word and device trademark in which the word element “neckermann” is predominant and can be clearly separated and distinguished from the device element, which consists of a graphic decoration without meaning. At the most the

decoration might be interpreted as the outline of a house with a chimney or as a bridge."

The Respondent in opposite cites the Article 10 (2) of the Regulation, section 19 (2) of the Sunrise Rules and the Article 14 of the Regulation. The Respondent further noted that if the domain name applied for does not consist of the complete name of that prior right, it is insufficient to be the holder of a prior right so as to be granted a .eu domain name during the Sunrise Period.
The Panel has to consider the facts of the case according to Article 10 (1), Article 10 (2) and Article 14 of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") and with the section 19 (2) of the Sunrise Rules.

The Panel finds out that the Prior Right on which the application of the Complainant for the domain name neckermann.eu was based, was the German word and device trade mark DE 397 51 262 "n neckermann " (Emphasis added), which consists of of the word neckermann and stylized letter n above the word neckermann.
The Complainant submitted namely even with the Complaint as the supporting evidence at the present ADR proceeding the documentation of a further German word Trademark DE 397 02 329 of the Complainant/Applicant, which consists really and only of the word "Neckermann" (Emphasis added).
The Panel does not understand why the Applicant did not submit in the deadline determined in the Section 2 (1) (i) of the Sunrise Rules, the German word Trademark DE 397 02 329 which consists only of the word "Neckermann" (Emphasis added) and has submit the German word and device trade mark DE 397 51 262 "n neckermann " (Emphasis added) but applying for the domain name neckermann.eu.
The Section 2 (1) (i) of the Sunrise Rules states, that the receipt of Documentary Evidence by the Processing Agent has to be obtained within 40 calendar days following the date of receipt of the Application by the Registry.
In the case at hand the Complainant submitted the Documentary Evidence about the German word Trademark DE 397 02 329 which consists only of the word "Neckermann" (Emphasis added) till on the 2.8.2006, thus after the in the Section 2 (1) (i) of the Sunrise Rules determined deadline. The Panel cannot take into account Documentary Evidence provided this late and has to take into consideration/consider Documentary Evidence provided within the deadline stated in the Section 2 (1) (i) of the Sunrise Rules.

The Panel could not accept even the argumentation of the Complainant that the device element in the trademark n neckermann, which consists of a stylized letter n above the word neckermann, is without meaning and can be clearly separated and distinguished.
This allegation is contradicted by the Complainant himself when he applied for the trade mark "Neckermann" (Emphasis added) on the 22.1.1997 and for the trade mark "n neckermann" (Emphasis added) he applied on the 28.10.1997. If the trade mark "n neckermann" including stylized letter n above the word neckermann would be insignificant or a "mere decoration might be interpreted as the outline of a house with a chimney or as a bridge", it is clear that the Complainant would not apply for such trade mark and Deutsches Patentamt would, without any doubt, not accept trade mark without any "ability to be distinguished".
The Panel is of the opinion that the stylized "n" in the word and device trade mark of the Applicant (n neckermann) must indeed be interpreted, for the purposes of the Regulation and the Sunrise Rules, as an alphanumeric character.
The Panel concludes that not all alphanumeric characters of the trade mark of the applicant "n neckermann" (Emphasis added) were included in the application and as well were not applied for domain name "neckermann.eu" (Emphasis added), which violates Article 10.2 of the Regulation and section 19.2 of the Sunrise Rules.
The Applicant would be entitled, under the Sunrise Rules, to the domain name "n neckermann" (Emphasis added) but is not entitled to the domain name "neckermann" (Emphasis added).

The Panel finds out that the present case from the point of view of the use and interpretation of, in particular of the Article 10 (2) of the Regulations and of the section 19 (2) of the Sunrise Rules is very similar to cases ADR no. 01053 (SANTOS), ADR no. 1438 (ELLISON), ADR no. 713 (HUETTINGER), and ADR no. 487 (BENTLEY), where identical situations were at hand. The Panel did not find any reason for a different consideration of the facts of the case.

For all the foregoing reasons, in accordance with Paragraphs B 12 (b) and (c) of the Rules, the Panel orders that the Complaint is 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	**Vladimir Bulinsky**

DATE OF PANEL DECISION 2006-11-06

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

On 7th December 2005 the Complainant applied via its registrar Cronon AG for the domain name “neckermann.eu”. A registered German trademark „n neckermann“ for the domain name “neckermann” was claimed as a Prior Right. The Complainant argues that the Prior Right is a word and device trademark in which the word element “neckermann” is predominant, and can be clearly separated and distinguished from the device element, which consists of a graphic decoration without meaning.
The Respondent argued with Article 10 (1) (2), with Section 19 (2) of the Sunrise Rules and made a proposal to reject the complaint.
The Panel finds that the Complainant based his complaint on two main arguments on Prior Rights:
1. A company name and trade name because the name “Neckermann” is well-known
2. Trade mark, because the Complainant’s Prior Right is a word and device trademark in which the word element “neckermann” is predominant, and can be clearly separated and distinguished from the device element, which consists of a graphic decoration without meaning.
Ad 1) The Panel is of the opinion that a company/trade name may only be used in the second phase of the Sunrise period, which is not the case at hand.
Ad 2) The Panel has to consider the facts of the case according to Article 10 (1), Article 10 (2) and Article 14 of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") and with the section 19 (2) of the Sunrise Rules.
The Panel finds out that the Prior Right on which the application of the Complainant for the domain name neckermann.eu was based, was the German word and device trade mark DE 397 51 262 “n neckermann ” (Emphasis added), which consists of of the word neckermann and stylized letter n above the word neckermann.
The Panel is of the opinion that the stylized “n” (Emphasis added) in the word and device trade mark of the Applicant (n neckermann) must indeed be interpreted, for the purposes of the Regulation and the Sunrise Rules, as an alphanumeric character.
The Panel concludes that not all alphanumeric characters of the trade mark of the applicant “n neckermann” (Emphasis added) were included in the application and as well were not applied for domain name “neckermann.eu” (Emphasis added), which violates Article 10.2 of the Regulation and section 19.2 of the Sunrise Rules.
For all the foregoing reasons, in accordance with Paragraphs B 12 (b) and (c) of the Rules, the Panel orders that the Complaint is Denied.