Panel Decision for dispute CAC-ADREU-002659

Case number	CAC-ADREU-002659
Time of filing	2006-08-23 14:38:41
Domain names	promed.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	PRO.MED.CS Praha a.s., Ing. Milan Augusta

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

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain names.

FACTUAL BACKGROUND

On 7 December 2005, Complainant applied for the Domain Name under the phased registration (“Sunrise”) period. Complainant applied for the Domain Name on the basis of prior right, a registered trademark.

After validation of the application of Complainant the Respondent found that Complainant failed to demonstrate a prior right in the Domain Name in accordance with the procedure set out in Regulation 874/2004 and therefore the Respondent decided to reject the application of Complainant for the Domain Name.

The Complainant has lodged this Complaint against Respondents decision to reject Complainant’s application for the Domain Name.

A. COMPLAINANT

Complainant contends that it is a well-established company in the pharmaceutical field. Complainant states that it is known as “PROMED” in the branch, by experts and the local public. The ending letter in Complainant’s name “PRO.MED.CS” solely serves, according to Complainant, to designate the former Czechoslovakia as the country of origin of the Complainant.

The Complainant therefore requests that the decision of Respondent to reject Complainant’s application be annulled and subsequently that the Domain Name be transferred to the Complainant.

Complainant furthermore contends that is has been active in various European countries for more than 10 years and that it nowadays operates in nine countries of the European Union, including Germany. In addition the Complainant remarks that it is planning to expand to other markets in the near future.

B. RESPONDENT

In its Response to the statements and allegations made in the Complaint Respondent first sets out the grounds on which Respondent rejected the application for the Domain Name.

Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") states that only holders of prior rights which are recognized 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. Article 10 (2) of the 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. Section 19 (2) of the Sunrise Rules 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 word element is predominant and can be clearly separated or distinguished from the device element, provided that 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. The Complainant submitted as documentary evidence a certificate issued by the WIPO for registration of the composite trademark consisting of a device element and the words “PRO.MED.CS”. 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 on the name PROMED alone. Consequently, the Respondent rejected the application for the domain name PROMED.

The Respondent subsequently discusses the Complaint of Complainant. The Respondent argues that pursuant to article 10 (2) of the Regulation, 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.
The Complainant submitted as documentary evidence a certificate issued by the WIPO for registration of a composite trademark consisting of a device element and the words “PRO.MED.CS”. Pursuant to section 19 (2) of the Sunrise Rules, the Registry must separate the alphanumerical elements from the device elements if 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 argues that in the present case, the device element (the three quarters of a circle on the left) may be separated from the word elements “PRO.MED.CS”. Therefore, the trademark consists of the following alphanumerical characters (in the order in which those characters appear): “PROMEDCS”. Pursuant to article 10.2 of the Regulation and section 19 of the Sunrise Rules, the domain name based on this prior right must consist of all alphanumerical characters. Therefore, the prior right in question could only serve as a prior right for the domain name “PROMEDCS”. Respondent notes that the Complainant also applied for the domain name “PROMEDCS” and that this application was accepted by the Respondent.
However, in the present case, the Complainant applied for the domain name PROMED and not PROMEDCS.

As the Complainant applied for the domain name PROMED (and not for the domain name which corresponds to the complete name for which the prior right exists), the Respondent argues that it correctly rejected the Complainant's application for the domain name PROMED.

The Respondent also wishes to refer to the very similar case Nr 470 (O2). In this case, the applicant applied for the domain name "O2", on the basis of a French trademark consisting of the characters "O2" accompanied, on the right side, by the stylized words (slogan) "l'oxygène de votre quotidien". The Panel decided that "all alphanumeric characters of the composite sign invoked by Complainant (i.e. the French trademark), are not contained in the domain name "O2". Indeed, the words (slogan) "l'oxygène de votre quotidien" are part of the composite sign, namely the French trademark, but do not appear in the domain name Complainant applied for. Accordingly, the decision taken by Registry to reject the "O2" domain name application does not conflict with the Regulation 874/2004 ". The Respondent also refers the Panel to the ADR decisions 1053 (SANTOS), 1438 (ELLISON), 713 (HUETTINGER) and 1427 (BONOLLO).

On the basis of the foregoing statements the Respondent reaches the following conclusion:

Because the trademark submitted by the Complainant could not serve as a prior right for the domain name applied for, the Respondent correctly rejected the Complainant's application.
Since the Respondent correctly decided to reject the Complainant's application, pursuant to the Regulation, Respondent's decision may not be annulled and the Domain Name may not be granted to the Complainant. Indeed, a domain name may only be attributed to the Complainant by this Panel, when the Panel finds that the Respondent's decision conflicts with the Regulation (article 11 of the ADR Rules). For these reasons, the complaint must be rejected.

DISCUSSION AND FINDINGS

In accordance with Paragraph B11 (a) of the ADR Rules the Panel shall decide a Complaint on the basis of the statement and documents submitted and in accordance with the Procedural Rules.

The Complaint is filed against the Registry. In accordance with Paragraph B1 (b)(10)(ii) of the ADR Rules the Complainant shall describe the grounds on which the Complaint is made, in particular, the reasons why a decision is taken by the Registry conflicts with European

Union Regulations, including but not limited to Regulation 874/2004.

The Panel observes that the Complainant solely contends that it is a well-established company in the pharmaceutical field and that it is known as “PROMED” in the branch, by experts and the local public. Complainant further states that the ending letter in Complainant’s name “PRO.MED.CS” solely serves, according to Complainant, to designate the former Czechoslovakia as the country of origin of the Complainant. On the basis of these statement the Complainant therefore requests that the decision of Respondent to reject Complainant’s application be annulled and subsequently that the Domain Name be transferred to the Complainant.

The Panel notes that the Complainant’s statements are not in any way substantiated by facts or arguments which set out the reasons why the decision taken by the Registry conflicts with European Union Regulations. Moreover, the Complainant fails to provide any evidence. In the absence of any arguments which could demonstrate that the decision taken by the Registry conflicts with European Union Regulations, the Panel considers that Complainant has failed to make a reasonable case why the decision of the Registry should be annulled. Furthermore, the Panel would like to emphasize that it is not its task to find arguments for Complainant’s statements. The ADR Rules clearly indicate that in case of an ADR Proceeding against the Registry, the Complainant shall describe the grounds on which the Complaint is made and the reasons why a decision taken by the Registry conflicts with European Union Regulations. Although the Panel is, in accordance with Paragraph B7 (A) of the ADR Rules, permitted in its sole discretion to conduct its own investigation on the circumstances of the case, the Panel takes the view that the interpretation of this Paragraph does not imply that the Panel is obliged to find arguments for Complainant’s statements if the Complainant failed to provide any evidence or arguments for its assertions. The Panel shares the opinion that its point of view is supported by the fact that Paragraph 7B (a) explicitly stipulates that the Panel is not obliged, but is permitted (…) to conduct its own investigations on the circumstances of the case.

Notwithstanding the foregoing the Panel considers that the arguments put forward by the Respondent to demonstrate that its decision to reject the application of Complainant for the Domain Name are conclusive and evidently show that Respondent correctly rejected the Complainant’s application. More particular, the Respondent applied the Regulation correctly and decided on the basis of the following persuasive grounds that the Complainant’s trade mark does not match the Domain Name applied for in the Sunrise Period:

In accordance with Article 10 (2) of the Regulation, a domain name applied for during the Sunrise Period must consist of the complete name of the prior right. In the present case Complainant prior right was a composite trade mark consisting of a device element and the words “PRO.MED.CS”. Pursuant to section 19 (2) of the Sunrise Rules, the Registry must separate the alphanumerical elements from the device elements if 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. In the present case, the device element may be separated from the word elements “PRO.MED.CS”. Therefore, the trademark consists of the following alphanumerical characters (in the order in which those characters appear): “PROMEDCS”. Pursuant to article 10.2 of the Regulation and section 19 of the Sunrise Rules, the domain name based on this prior right must consist of all alphanumerical characters. Therefore, the prior right in question could only serve as a prior right for the domain name “PROMEDCS” and not for PROMED.

DECISION

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

PANELISTS

Name	Radim Polcak

DATE OF PANEL DECISION 2006-11-17

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Complainant challenged the decision of the Registry to reject Complainant’s application in the Sunrise period for the domain name promed.eu (hereinafter: “Domain Name”), and therefore Complainant requested the Panel to revoke the decisions of the Registry and transfer the Domain Name to Complainant. Complainant filed its application on the basis of a prior right, namely the device mark PRO.MED.CS.

To substantiate its complaint Complainant solely put forward that it is a well-established company in the pharmaceutical field and that it is known as “PROMED” in the branch, by experts and the local public. The ending letter in Complainant’s name “PRO.MED.CS” solely

serves, according to Complainant, to designate the former Czechoslovakia as the country of origin of the Complainant. More arguments or evidence were not provided by Complainant to justify its complaint.
In its Response the Registry explained why it rejected Complainant's application. Article 10 (2) of the 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. Section 19 (2) of the Sunrise Rules 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 word element is predominant and can be clearly separated or distinguished from the device element, provided that 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. The Complainant submitted as documentary evidence a certificate issued by the WIPO for registration of the composite trademark consisting of a device element and the words "PRO.MED.CS". The Respondent argued that in the present case, the device element (the three quarters of a circle on the left) may be separated from the word elements "PRO.MED.CS". Therefore, the trademark consists of the following alphanumerical characters (in the order in which those characters appear): "PROMEDCS". Pursuant to article 10.2 of the Regulation and section 19 of the Sunrise Rules, the domain name based on this prior right must consist of all alphanumerical characters. Therefore, the prior right in question could only serve as a prior right for the domain name "PROMEDCS". The validation agent therefore concluded from its examination of the documentary evidence that the Complainant did not demonstrate that it was the holder of prior right on the name PROMED alone. Consequently, the Respondent rejected the application for the domain name PROMED.

The Panel orders that the Complaint is denied. The Panel notes that the Complainant's statements are not in any way substantiated by facts or arguments which set out the reasons why the decision taken by the Registry conflicts with European Union Regulations. Moreover, the Complainant fails to provide any evidence. In the absence of any arguments which could demonstrate that the decision taken by the Registry conflicts with European Union Regulations, the Panel considers that Complainant has failed to make a reasonable case why the decision of the Registry should be annulled. Furthermore, the Panel emphasizes that it is not its task to find arguments for Complainant's statements. The ADR Rules clearly indicate that in case of an ADR Proceeding against the Registry, the Complainant shall describe the grounds on which the Complaint is made and the reasons why a decision taken by the Registry conflicts with European Union Regulations. Notwithstanding the foregoing the Panel considers that the arguments put forward by the Respondent to demonstrate that its decision to reject the application of Complainant for the Domain Name are conclusive and evidently show that Respondent correctly rejected the Complainant's application.