Panel Decision for dispute CAC-ADREU-002680

Case number	**CAC-ADREU-002680**
Time of filing	**2006-08-11 13:10:10**
Domain names	**siebert.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Siebert Industrieelektronik 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

None that the Panel is aware of

FACTUAL BACKGROUND

On February 24, 2006, the Complainant filed a request for registration of the domain name <siebert.eu> in the name of SIEBERT INDUSTRIEELEKTRONIK GmbH and on March 17, 2006 the processing agent received the relative documentary evidence. The submitted evidence consisted in copies of the following documents:
1) Certificate related to the registration of the International Trademark no. 648896 in the name of the Complainant.
2) Certificate related to the registration of the German Trademark no. 39407240 in the name of the Complainant.
3) Certificate related to the registration of the International Trademark no. 551833 in the name of the Complainant.
4) Certificate related to the registration of the German Trademark no. 1145996 in the name of the Complainant.
5) Certificate related to the registration of the International Trademark no. 532364 in the name of the Complainant.
6) Certificate related to the registration of the German Trademark no. 1114515 in the name of the Complainant.
7) Certificate related to the registration of the Danish Trademark no. VR 03.724 1993 in the name of the Complainant.
8) Certificate related to the registration of the Finnish Trademark no. 117631 in the name of the Complainant.
9) Certificate related to the registration of the Greek Trademark no. 95 135 in the name of the Complainant.
10) Certificate related to the registration of the Norwegian Trademark no. 143614 in the name of the Complainant.
11) Certificate related to the registration of the Swedish Trademark no. 225 774 in the name of the Complainant.
12) Certificate related to the registration of the Canadian Trademark no. TMA520,967 in the name of the Complainant.
13) Certificate related to the registration of the Irish Trademark no. 1389851 in the name of the Complainant.
14) Notice of Publication related to the U.S. Trademark Application no. 75/289,659 in the name of the Complainant.

On July 5, 2006, the Respondent rejected the request for registration on the grounds that the documentary evidence received did not sufficiently prove the right claimed.
The Complainant filed a Complaint on August 10, 2006. The Czech Arbitration Court ("CAC") acknowledged receipt of the Complainant on August 11, 2006. On August 24, 2006, CAC informed the Complainant that the registrar with whom the disputed domain name was registered had to be identified. On September 11, 2006 CAC received the Complaint in hardcopy and, after the compliance review, CAC declared that the formal date of the commencement of the ADR proceeding was September 11, 2006.
The Respondent submitted a Response on October 25, 2006.

A. COMPLAINANT

The Complainant contends that the application for the domain name <siebert.eu> was based on several trademarks owned by the Complainant and, in particular, on the German trademark SIEBERT and device no. 1145996 and on the correspondent International

Registration SIEBERT and device no. 551 883. The Complainant also argues that copies of the respective registration certificates were duly and timely provided to the Respondent. Therefore, in the Complainant's view, the above application should have been accepted according to article 10.2 of the Commission Regulation (EC) no.874/2004 and section 19.2 as well as section 19.3 of the Sunrise Rules. Actually, the Complainant points out that the trademark SIEBERT and device includes a predominant word element SIEBERT and that said word element can be easily distinguished from the device element of the trademark. With respect to the device element it is the Complainant's opinion that it consists of a black geometrical shape encircling a white symbol without any particular signification. With respect to the symbol ®, also included in the mark SIEBERT and device, the Complainant argues that said symbol, according to section 19.3 of the Sunrise Rules, must not be considered as a part of the prior right in question. For these reasons, the Complainant considers the decision made by the Respondent to be wrong and requests that the domain <siebert.eu> be assigned to Siebert Industrieelektronik GmbH

B. RESPONDENT

With reference to the rejection of the application, the Respondent outlines that article 10.2 of the Commission Regulation (EC) no.874/2004 states 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.
Furthermore, the Respondent clarifies that section 19.2 of the Sunrise Rules states that the documentary evidence must clearly depict the name for which a prior right is claimed. The Responent also argues that, according to the above rule, a prior right claimed to a name included in figurative or composite signs 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 they appear in the sign, and (b) the general impression of the word is apparent, without any real possibility of misreading the characters of which the sign consists or the order in which those characters appear. The Respondent states that the trademark registrations submitted by the Complainant as documentary evidence consisted of the alphanumeric characters S SIEBERT and that, according to section 19.2 of the Sunrise Rules, Complainant should have applied for the domain name <ssiebert.eu>. Actually, in the Respondent's view, since in the present case the sequence of the alphanumerical characters included in the trademark is SSIEBERT, said trademark cannot be considered as a valid prior right in order to substantiate the application for the domain name <siebert.eu>.

DISCUSSION AND FINDINGS

Article 10.1 of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") states that: "Holders of prior rights recognised or established by national and/or Community law and public bodies 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".
Article 14 of the Regulation states that "The Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in the second, third and fourth paragraphs".
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 (i) if the sign exclusively contains a name or (ii) 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".
Section 19.3 of the Sunrise Rules states that "For trademarks, the references "TM", "SM", "®" and the like do not form part of the complete name for which the relevant Prior Right exists".
In the case at hand, the trademarks upon which the domain name application was based are (i) signs consisting of a device element not including the word SIEBERT and (ii) signs consisting of a device element and of the word SIEBERT. The above trademarks are all owned by the Complainant. Part of the trademarks filed as documentary evidence are absolutely irrelevant and are not useful to support the application for the contested domain name (i.e. Canadian Trademark no. TMA520,967). In addition, the Panel notes that the signs above referred sub (i) cannot establish the claimed prior right since they do not even include the word SIEBERT corresponding to the requested domain name.
The Panel must now consider if the signs above referred sub (ii) may duly substantiate the application for the domain name <siebert.eu>. The Complainant stressed that Siebert Industrieelektronik GmbH clearly proved the ownership on the German trademark SIEBERT and device no. 1145996 and on the corresponent International Trademark n. 551833. The Panel agrees with this finding. The Panel also believe that the application could not have been refused in consideration of the symbol ® included in the Complainant's trademarks. This in consideration of the above mentioned section 19.3 of the Sunrise Rules.
The Respondent stated that the application for the domain name <siebert.eu> was refused in consideration of the fact that the requested domain name did not consist of all alphanumerical elements included in the prior rights filed by Complainant as documentary evidence.

With reference to figurative trademarks, section 19.2 of the Sunrise Rules establishes that the prior right, in order to be accepted, must include a predominant word element (providing that it can be clearly separated or distinguished from the device element).
The existence of the predominant word element is not the only condition requested by the above rule. Actually, all alphanumeric characters included in the mark (not only those included in the predominant word element) must be contained in the domain name applied for. In addition, it is requested that the alphanumeric characters of the domain name are placed in the same order as that in which they appear in the sign. Finally, it is also requested that 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 Panel has duly examined the German trademark SIEBERT and device no. 1145996 as well as the identical International Trademark n. 551833 and considers, prima facie, that the mark is composed by a device element (situated at the beginning of the mark) and by the predominant word element SIEBERT. Therefore, it is the Panel's view that according to a prima facie impression, the first condition (existence of the predominant word element) is fully satisfied.
While the Complainant states that the device element of the above mark consists of a black geometrical shape encircling a white symbol without any particular signification, the Respondent is of the opinion that said device element clearly corresponds to an alphanumerical character (the letter S in a stylized shape).
Should the impression of the Complainant be deemed as correct, then the Panel could conclude that the other conditions set out in the above section 19.2 are fulfilled and that, accordingly, the documentary evidence filed by the Complainant should have been considered as valid in order to substantiate the request for the contested domain name.
The Panel, after a further analysis of the German trademark no. 1145996 (or International Trademark n. 551833) has verified that the device element may be effectively seen as being the alphanumerical character S.
Should this impression be deemed as prevailing, the Panel could conclude that, considering the above section 19.2, the alphanumerical character S must be separated from its stylized appearance and therefore the initial letter S should have been included in the domain name applied for. This in consideration of the fact that the above rule (as well as article 10.2 of the the Regulation) clearly establishes that the domain name based on a prior right during the so called Sunrise Period must consists of all alphanumerical characters included in said prior right.
It is the Panel's view that in order to decide if a symbol is without any meaning it is necessary that no doubts exist in this respect. The Panel's impression is that German trademark no. 1145996 (or International Trademark n. 551833) includes the alphanumerical characters S SIEBERT, since the first part of the mark may be considered as the alphanumerical character S in a highly stylized form.
The Panel does not wish to decide the present case exclusively on the basis of a subjective impression and considers very useful to verify in which way the database (Madrid Express Database) available on the WIPO's website has interpreted the IR n. 551833. In the Panel's view, it is an important test since the above database, when the user inserts an IR number, immediately shows the verbal elements included in the IR searched. The Panel wishes to inform parties that the Madrid Express Database shows that the verbal elements included in the IR n. 551833 are "S SIEBERT".
According to the above, since there is not a fully correspondence between the number of the alphanumerical characters included in the prior right and those included in the requested domain name, in the Panel's view the Respondent's decision to refuse to register the disputed domain name <siebert.eu> is correct. Said decision does not conflict with the Regulation and the Sunrise Rules.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint be denied

PANELISTS

Name	**Guido Maffei**

DATE OF PANEL DECISION 2006-11-15

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Respondent refused to register the domain name <siebert.eu> because the requested domain name did not consist of all alphanumerical elements included in the prior rights filed by Complainant as documentary evidence. In the Respondent's view, the application was in conflict with article 10.2 of the Regulation and section 19.2 of the Sunrise Rules. On the contary, the Complainant was of the opinion that said application fulfilled the conditions set out in the above rules since the first character of the sign filed as prior right, interpreted by Respondent as the letter S, must be considered as a symbol without any particular signification.
In the Panel's opinion, in order to decide if a symbol is without any meaning, it is necessary that no doubts exist in this respect. It is the Panel's opinion that the Complainant's trademark consists of the predominant word element SIEBERT and of a figurative element which may be considered as corresponding to a stylized letter S. The Madrid Express Database has interpreted the verbal elements included in the prior right filed by the Complainant as being S SIEBERT.
In consideration of the above it is clear that there is not a fully correspondence between the number of the alphanumerical characters

included in the prior right and those included in the requested domain name.
Therefore, the Respondent’s decision to refuse to register the disputed domain name <siebert.eu> is correct according to article 10.2 of Regulation and section 19.2 of the Sunrise Rules