Panel Decision for dispute CAC-ADREU-002706

Case number	CAC-ADREU-002706
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Domain names	na-ag.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Norddeutsche Affinerie AG - Rechtsabteilung, Henning Michaelsen

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 acknowledged by Panel

FACTUAL BACKGROUND

Norddeutsche Affinerie AG - Rechtsabteilung, Henning Michaelsen (hereinafter “the Complainant”) applied for registration of the domain name “na-ag.eu” on February 17, 2006 at 10:15 A.M.

The validation agent received documents from the Complainant evidencing the application on March 27, 2006, before the March 29, 2006 deadline.

In particular the documentary evidence submitted to the validation agent consisted of:
- a certificate of registration for German figurative trademark no. 39973145, consisting of the following alphanumerical characters : "NA Norddeutsche Affinerie AG"
- a certificate of registration for the German figurative trademark No. 39973140, consisting of the following alphanumerical characters : "NA Norddeutsche Affinerie AG"
- a certificate of registration for the German figurative trademark No. 39973141, consisting of the following alphanumerical characters : "NA"
- a certificate of registration for the German figurative trademark No. 39973142, consisting of the following alphanumerical characters : "NA "
- a letterhead showing the name and logo of the Complainant

The validation agent found that the documentary evidence sent by the Complainant did not substantiate its prior right to the name “NA-AG”, and therefore EURID (hereinafter “the Respondent”) decided to reject its application.

The Complainant filed a Complaint against the Respondent’s decision. The Complaint was received by the Czech Arbitration Court (hereinafter “CAC”) by e-mail on August 07, 2006, with a hard copy received on November 2, 2006. The Complainant requested annulment of the Respondent's decision and assignment of the domain name “na-ag.eu” to the Complainant.

The formal date of the commencement of the ADR Proceeding was November 3, 2006

A. COMPLAINANT

The Complainant claims that it is the owner of the trademark “NA”, as documented in the enclosure by the German Patent and Trademark Office and so holds the right to the domain name na-ag.eu, obtained by combining the letter NA and the company type AG

with a hyphen to produce the name NA-AG.

The Complainant adds that it is also the holder of trademark no. 30619281 to the name “NA-AG” registered on May 29, 2006 by the German Patent and Trademark Office as it appears in the certificate attached to its Complaint.

Finally, the Complainant argues that its prior right to the name NA-AG is also proved by the letterhead submitted to the validation agent and adds that it is already the holder of the domain names na-ag.com and na-ag.de.

B. RESPONDENT

The Respondent affirms that the burden of proof lies with the Complainant to demonstrate that it is the holder of the claimed prior right to the name “NA-AG”. In fact Article 10 (1) of Commission Regulation (EC) No. 874/2004 of 28 April 2004 (hereinafter "the Commission Regulation") states that only holders of prior rights shall be eligible to request registration of domain names during the phased registration period, and pursuant to Article 14 of the Commission Regulation, the Applicant must submit documentary evidence showing that he or she is the holder of the prior right claimed for the name in question. Based on this documentary evidence, the validation agent shall examine whether the applicant has prior rights to the name. The Respondent adds that Section 21.2. of the Sunrise Rules clearly explains that the validation agent shall examine whether the Applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence received and scanned by the processing agent. In this case, the Complainant failed to substantiate that it is the holder or licensee of a prior right to the name “NA-AG."
The Respondent specifies that pursuant to Article 10 (2) of the Commission Regulation and Section 19 of the Sunrise Rules, the trademarks submitted by the Complainant could not establish a prior right to the name “NA-AG”. For these reasons the Respondent correctly rejected the Complainant's application, and the complaint must be dismissed because “NA-AG” is not the complete name for which the prior right exists as indicated in the documentary evidence.

The Respondent moreover notes that the other documentary evidence (namely the letterhead) is not relevant to establish the claimed prior right (i.e. a registered trademark) and also notes that the registration of the domain name na-ag.com may not be considered a prior right in the sense of Article 10 of the Commission Regulation .

The Respondent finally argues that the certificate of registration of the trademark under the name “NA-AG” (registered on May 29, 2006 under number 30619281) from the German Patent and Trademark Office proceedings may not be taken into consideration by the Panel because this document was submitted only with this complaint, and thus is untimely. Pursuant to Article 14 of the Commission Regulation, in fact, the Respondent may only accept documentary evidence that is received by the validation agent within 40 days after the submission of the application for the domain name; and in this case the 40 day period ended on March 29, 2006. For the Respondent, the new documents attached to the present complaint were not received by the validation agent during the 40 day period, which means that the Respondent could not use this information to make its decision. So, this new information may not be taken into consideration to evaluate whether the Respondent's decision conflicts with the Commission Regulation, which is the only purpose of the present ADR proceedings. In fact, Article 22 (1) b of the Commission Regulation states that a decision made by the Respondent may only be annulled when it conflicts with the Commission Regulation.
Therefore, only the documentary evidence which the Respondent was able to examine at the time of validation of the application should be considered by the Panel to assess the validity of the Respondent's decision.

For the reasons mentioned above, the Respondent argue that it correctly decided to reject the Complainant's application, pursuant to the Commission Regulation. Consequently it requests that
the complaint must be rejected

DISCUSSION AND FINDINGS

Article 10(1) of the Commission 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. ‘Prior rights’ shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works”

Article 10 (2) of the Commission Regulation states that “the registration on the basis of a prior right shall consist of the registration of the complete name on which the prior right exists, as written in the documentation which proves that such a right exists”

Article 12 (2) of the Commission Regulation states that “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".

Article 14 of the Commission Regulation 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 documentary evidence shall be submitted to a validation agent indicated by the Registry. The applicant shall submit the evidence in such a way that it shall be received by the validation agent within forty days from the submission of the application for the domain name. If the documentary evidence has not been received by this deadline, the application for the domain name shall be rejected".

Article 22 paragraph 1, b) of the Commission Regulation states that when an action is filed against the Registry (the Respondent), the Panel shall decide whether a decision taken by the Registry conflicts with this regulation or with Regulation (EC) no. 733/2002.

Section 19 (1) of the Sunrise Rules states that "As stated in Article 10(2) of the Public Policy Rules, registration of a Domain Name on the basis of a Prior Right consists in the registration of the complete name for which the Prior Right exists, as manifested by the Documentary Evidence. It is not possible for an Applicant to obtain registration of a Domain Name comprising part of the complete name for which the Prior Right exists.

Section 19 (2) of the Sunrise Rules 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".

Section 19 (4) of the Sunrise Rules states that "For trade names, company names and business identifiers, the company type (such as, but not limited to, "SA", "GmbH", "Ltd.", or "LLP") may be omitted from the complete name for which the Prior Right exists.

Section 21 (2) of the Sunrise Rules provides that "The Validation Agent examines whether the Applicant has a Prior Right to the name exclusively on the basis of a prima facie review of the first set of Documentary Evidence received and scanned by the Processing Agent (including the Documentary Evidence received electronically, where applicable) and in accordance with the provisions of these Sunrise Rules".

In the opinion of the Panel, to decide this case it is necessary to verify, according Article 22 paragraph 1, b) of the Commission Regulation, if the decision made by the Registry conflicts with the Commission Regulation or with Regulation (EC) no. 733/2002. In other words, the Panel shall verify if the documentary evidence submitted by the Complainant within the March 29, 2006 deadline substantiated its prior right to the name "NA-AG" for the registration of the domain name na-ag.eu.
According to Article 14 of the Commission Regulation, in fact, the applicant shall submit the evidence in such a way that it shall be received by the validation agent within forty days from the submission of the application for the domain name. Therefore, documents submitted by the Complainant after the term mentioned above cannot be taken into consideration to resolve this case. In particular, the fact that the Complainant is the holder of trademark no. 30619281 for the name "NA-AG" registered on May 29, 2006 by the German Patent and Trademark Office as it appears in the certificate attached to its Complaint, is irrelevant to establish its claimed prior right.

Consider, however, that pursuant to Article 10(1) and Article 12 of the Commission Regulation, during the period of phased registration only holders of prior rights to a name may apply for a registration of the relative domain name. At the time it applied for the domain name na-ag.eu (February 17, 2006) the Complainant was not yet the holder of the trademark "NA-AG," which was registered on May 29, 2006 and so it could not have submitted the correspondent certificate previously.

Complainant submitted documentary evidence to the validation agent showing that it was the holder of two figurative trademarks (no. 39973140 and no. 39973145) to the name "NA Norddeutsche Affinerie AG" and two figurative trademarks (no. 39973141 and no. 39973142) to the name "NA." According to the Complainant, the fact that it is the holder of the trademark "NA" establishes its prior right to the name "NA-AG". The Panel, on the other hand, feels that the documentary evidence submitted by the Complainant did not substantiate its claimed prior right to that name. In fact, pursuant to Article 10(2) of the Commission Regulation and Section 19 (1) of the Sunrise Rules the "Registration of a Domain Name on the basis of a Prior Right consists in the registration of the complete name for which the Prior Right exists, as manifested by the Documentary Evidence".

Pursuant to Section 19(2) of the Sunrise Rules, in the case of a figurative trademark, the word element shall be separated from the device element and all alphanumerical characters (including hyphens, if any) included in the sign must be contained in the Domain Name applied for, in the same order as that in which they appear in the sign. In this case, as the Complainant was the owner of trademarks consisting in the word elements “NA Norddeutsche Affinerie AG” and "NA," it was eligible to apply for a eu.domain name exactly corresponding to these word elements. Article 19 (4) of the Sunrise Rules states that only the company type may be omitted from the complete name for which the Prior Right exists. So, on the basis of the documentary evidence submitted, the Complainant should not have applied for the domain names "na-ag.eu," and the Respondent's decision to reject the Complainant’s application was correct. There is no provision that permits it to add the company type, as the Complainant did.

Finally the Panel disagree with the Complainant and considers that its use of the name “NA-AG” in the letterhead submitted to the validation agent is irrelevant to demonstrate its clamed prior right to that name. The use of that name in the letterhead, in fact, can’t be considered a prior right in the sense of Article 10(1) of the Commission Regulation . For the same reason, it is also irrelevant that the Complainant was already the holder of the domain names na-ag.com and na-ag.de, which domain names are moreover subject to different regulations.

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	**Pietro Tamburrini**

DATE OF PANEL DECISION 2006-12-20

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Complainant applied for registration of the domain name “na-ag.eu” and submitted documentary evidence to the validation agent showing that it held two trademarks to the name “NA Norddeutsche Affinerie AG” and two to the name "NA." Complainant also submitted a letterhead showing its name and logo.

The validation agent found that the documentary evidence provided by the Complainant did not substantiate its prior right to the name “NA-AG”, and so the Respondent decided to reject its application.
The Panel affirms that the documentary evidence submitted by the Complainant did not substantiate its claimed prior right to that name. In fact, pursuant to Article 10(2) of the Commission Regulation and Section 19 (1) of the Sunrise Rules, the “Registration of a Domain Name on the basis of a Prior Right consists in the registration of the complete name for which the Prior Right exists, as manifested by the Documentary Evidence”.
According to Section 19(2) of the Sunrise Rules, in the case of a figurative trademark, the word element shall be separated from the device element and all alphanumerical characters (including hyphens, if any) included in the sign must be contained in the Domain Name applied for, in the same order as that in which they appear in the sign. In this case, as the Complainant was the owner of trademarks consisting in the word elements “NA Norddeutsche Affinerie AG” and "NA," it was eligible to apply for a eu.domain name exactly corresponding to these word elements. Article 19 (4) of the Sunrise Rules states only that the company type may be omitted from the complete name for which the Prior Right exists. So, on the basis of the documentary evidence submitted, the Complainant should not have applied for the domain names "na-ag.eu," and the Respondent's decision to reject the Complainant’s application was correct. There is no provision that permits it to add the company type, as the Complainant did.

The Complainant added in its Complaint that it was also the holder of trademark no. 30619281 to the name “NA-AG” registered on May 29, 2006 by the German Patent and Trademark Office as it appears in the certificate attached.
The Panel argues that, according to Article 14 of the Commission Regulation, the applicant shall submit the evidence in such a way that it shall be received by the validation agent within forty days from the submission of the application for the domain name. Therefore, documents submitted by the Complainant after the term mentioned above may not be taken into consideration to decide the case.
Finally, the Panel disagrees with the Complainant and considers that its use of the name “NA-AG” in the letterhead submitted to the validation agent is irrelevant to demonstrate its clamed prior right to that name.
For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel denies the Complaint.