Panel Decision for dispute CAC-ADREU-002813

Case number	**CAC-ADREU-002813**
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Domain names	**noble.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Noble Group Limited, Mr Joe Philipsz**

Respondent

Organization / Name	**EURid**

FACTUAL BACKGROUND

The Complainant applied for the domain name “NOBLE” on 7 December 2005.

The documentary evidence submitted by the Complainant shows that its mark consists of the word “NOBLE” preceded by a stylized letter “N”.

The Sunrise appeal period started to run on 7 July 2006.

The Complainant submitted its Complaint, directed against the Registry’s decision to reject its application, on 15 August 2006.

A. COMPLAINANT

1. This Complaint is an appeal under section 19 of the Sunrise Rules against the Registry’s decision to reject the application of Noble Group Limited (“Noble”) for the Domain Name.

2. The Complainant is the registered proprietor of Benelux Trade Mark number 0779657 for a mark featuring the word NOBLE and device (the “Noble Trade Mark”) registered in November 2005. The word NOBLE is the predominant element of the Noble Trade Mark. Trade mark search details are attached at Annex 1.

3. The Complainant was the first applicant for the Domain Name. The first application was submitted on 07/12/2005 at 11.13. Documents in support of the application were filed and were received by EURid on 13/01/2006, within the deadline set of 16/01/2006.

4. The Complainant’s application was supported by the Noble Trade Mark (the “Prior Right Registration”).

5. The Complainant contends that the Registry’s decision to reject the Complainant’s application for the Domain Name conflicts with the Regulation (Commission Regulation (EC) No.874/2004) and the Sunrise Rules and should be annulled.

6. The Complainant contends that it is eligible to apply to register the Domain Name in the Sunrise period because of the provisions in Section 19 of the Sunrise Rules. Section 19(2) states that Documentary Evidence must clearly depict the name for which a Prior Right is claimed. It also states that where a Prior Right claimed to a name included in a figurative sign is relied on by the applicant, the Prior Right will be accepted if the word element is predominant and can clearly be separated or distinguished from the device element provided 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).

7. The Complainant contends that the Prior Right Registration clearly depicts the NOBLE name underneath the device. Accordingly, the Complainant contends that the application for the Domain Name was rejected by the Respondent in contravention of Section 19 of the Sunrise Rules because the Prior Right is for a figurative mark, the predominant element of which is the name NOBLE. The Domain Name consists exclusively of the name NOBLE and the characters appear in the same order with no reasonable possibility of misreading the characters or the order in which they appear.

8. Finally, since the Complainant's application is the first (and second) application in the queue for the Domain Name, and since the Complainant satisfies the registration criteria under the Regulation, the Complainant requests that the Panel determines that the Complainant is eligible for the Domain Name and that the Domain Name is transferred or attributed to the Complainant.

B. RESPONDENT

1. GROUNDS ON WHICH THE REGISTRY HAS REJECTED THE APPLICATION FOR THE DOMAIN NAME NOBLE BY NOBLE GROUP LTD

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 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.

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 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.

NOBLE by Noble Group Ltd (hereafter "the Complainant") applied for the domain name NOBLE on 7 December 2005.

The processing agent received the documentary evidence on 13 January 2006, which was before the 16 January 2006 deadline.

The documentary evidence consisted of a Benelux trademark certificate of the composite trademark n° 779657.

The validation agent concluded from its examination of the documentary evidence that the domain name applied for, NOBLE, did not consist of the complete name of the trademark which was submitted as documentary evidence. Based on these findings, the Respondent rejected the Complainant's application.

2. COMPLAINANT'S CONTENTIONS
The Complainant argues that Benelux trademark certificate of the composite trademark n° 779657 grants it a prior right on the name NOBLE.

More in particular, the Complainant argues that the word NOBLE is predominant in the composite trademark.
Therefore, the Complainant requests the Panel to annul the Respondent's decision and to attribute the domain name NOBLE to the Complainant.

3. RESPONSE
It must be noted that 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 domain name applied for must also consist of the complete name of that prior right. Indeed, article 10 (2) of the Regulation 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.
Section 19 (2) of the Sunrise Rules further clarifies article 10 (2) of the Regulation, by stating 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
(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 figurative trademark submitted as documentary evidence by the Applicant consists of the following elements:

(1) an alphanumerical character "N" printed in italic under a dark background,
(2) the word "NOBLE" printed in bold.
Pursuant to this section 19 (2) of the Sunrise Rules, the Registry must separate the alphanumerical elements from the device elements.
In the case at hand, the stylized character N clearly depicts the alphanumerical character N. This alphanumerical character can clearly be separated from its stylized appearance. Moreover, this alphanumerical character is predominant over its stylized appearance.
Therefore, the letter N should be included in the domain name. The question of whether the part of the trademark consisting of the word NOBLE is or is not predominant is not relevant at all in the present case. It is clearly established by article 10.2 of the Regulation and section 19 of the Sunrise Rules that the domain name based on this prior right must consist of all alphanumerical elements.
The trademark is therefore comprised of the following alphanumerical elements: "N NOBLE". Consequently, pursuant to article 10.2 of the Regulation and section 19 (2) of the Sunrise Rules, this trademark establishes a prior right on the sign N NOBLE, but not on the sign NOBLE as such.
As the Applicant applied for the NOBLE domain name (and not for the N NOBLE domain name), the Registry had no other option than to reject the Applicant's application for the NOBLE domain name.
In case ADR 1053 (SANTOS), the Panel had to decide on very similar facts. The applicant applied for the domain name SANTOS, based on a trademark comprising the name SANTOS and a stylized S. The Panel decided that:
"The Panel is however conscious that the Complainant's case is not without merit. The Complainant is clearly is known as SANTOS. SANTOS is its company name. It appears to have common law rights in the name SANTOS. It has an Internet presence in its web site established at the <santos.fr> address. Third parties refer to the Complainant's goods as SANTOS goods. While these do not amount to Prior Rights for the purposes of the first phase of the Sunrise Period, they do indicate that the Complainant has undoubtedly rights in the SANTOS trade mark.
It appears from the documents submitted that the Complainant does not use the word mark S SANTOS.
Since the device element in the Prior Right relied upon by the Complainant is a stylised alpha numeric character, the letter "S" applying the methodology laid down in Rule 19.2(i) of the Sunrise Rules or even the methodology laid down in Rule 19.2(ii) that all alphanumeric characters (including hyphens, if any) included in the sign should be contained in the Domain Name applied for, in the same order as that in which they appear in the sign, it was reasonable that the Respondent should have rejected the application in those circumstances.
In reaching this decision the Panel is conscious that the present case has certain similarities with the proceedings in O2 DEVELOPPEMENT v. EURid (Case 00470, 2006-07-05) where it would appear from the decision that the mark in issue was

also composite sign, albeit where the all elements appear to have been clearly alphanumeric.
In the present case both parties seem to have accepted that there were two distinct elements in the mark viz. the device element and the word element SANTOS. Nonetheless the device element is an alphanumeric character for the purposes of Section 19 of the Sunrise Rules."
In the decision ADR 713 (HUETTINGER), the applicant applied for the domain name HUETTINGER, based on a composite trademark HUETTINGER and two stylized letters H. The Panel decided that: “In the present case, the Panel finds that the composite mark does not comprise exclusively the name HUETTINGER but also the stylised letters HH. The word element HUETTINGER is not predominant and the letters “HH” contained in the composite trademark must be interpreted, for the purposes of article 19.2 (a) of the Sunrise Rules, as alphanumeric characters. Therefore the Panel finds that the letters HH should have been included in the domain name application as also decided in the case N. 00470 O2 Developpement v. EURid (O2), case N. 01053 SANTOS Jacques Fouquet v. EURid (SANTOS) and Case N. 01438 Ellison Educational Europe, Ltd. v. EURid (ELLISON)”.
Finally, the Respondent also refers the Panel to the decisions in ADR (1728 ANONSE, OFERTA), 1427 (BONOLLO) and 1364 (GUTSCHEINBUCH).

For these reasons, the Complainant’s complaint should be denied..

DISCUSSION AND FINDINGS

Procedural Points

Pursuant to 26.1 of the Sunrise Rules, an ADR proceeding against the Registry may be initiated within 40 days of a decision by the Registry. In the present case the Sunrise appeal period started to run on 7 July 2006 and the Complaint was submitted on 15 August 2006. The Complaint was therefore submitted within the deadline and is admissible.

Substantive Issues

As the Respondent EURid correctly notes, the legal question at hand has been dealt with in several previous cases, in particular cases nos. 470 (O2), 713 (HUETTINGER),1053 (SANTOS), and 1438 (ELLISON). Since those cases are now part of the case-law, the present decision will not cite them in extenso and will simply refer to the reasoning found in case no. 1438 (ELLISON).

The present case must be distinguished from case no. 1310 (ASTRODATA) because in that case the panel found that “the Complainant’s trademark consists of the predominant word element ASTRODATA and a figurative element, which consists of a stylized star consisting of 6 overlapping triangles drawing a kind of "A", but does not contain a separate alphanumeric character from the figurative element.” That is, in Astrodata, the facts ascertained by the Panel were different from the facts of the present case, because, in the present case, the Panel finds that the Complainant’s registered mark does indeed contain a separate alphanumeric character, namely the letter “N”.

As EURid correctly points out, the letter “N” is clearly part of the Complainant’s mark, in addition to the word “NOBLE”. In that light, the Panel concludes that the stylized “N” in the figurative mark must indeed be interpreted, for the purposes of the Regulation and the Sunrise Rules, as an alphanumeric character.

Therefore the Complainant would be entitled, under the Sunrise Rules, to the domain name “N NOBLE” but is not entitled to the domain name “NOBLE”.

Thus the Panel finds that EURid’s decision in this case is correct and that the Complaint must be dismissed.

DECISION

For the reasons set forth above, in accordance with B.11 of the ADR Rules, the Panel dismisses the Complaint.

PANELISTS

Name	**Richard Hill**

DATE OF PANEL DECISION 2006-10-20

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Complainant challenges EURid's decision not to accept its application for the domain name "NOBLE" on the ground that it has prior rights for the mark NOBLE. The Complainant's mark consists of the word NOBLE preceded by a stylized letter N.

When rejecting the application, EURid considered that the stylized rendering of the letter "N" in the Complainant's trademark was an alphanumeric character in the sense of 19.2 of the Sunrise Rules, and that, therefore, the Complainant would be entitled to the domain name "N NOBLE" but not to the domain name "NOBLE".

Having examined the evidence, the Panel concludes that the stylized "N" is indeed an alphanumeric character in the sense of 19.2 of the Sunrise Rules and that EURid's decision is correct.

Therefore the Panel dismisses the Complaint.