Panel Decision for dispute CAC-ADREU-002957

Case number	**CAC-ADREU-002957**
Time of filing	**2006-09-06 11:39:06**
Domain names	**gayromeo.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**PlanetRomeo GmbH, Manuel Abraham**

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

I am unaware of any other legal proceedings (pending or decided) which relate to the disputed domain name.

FACTUAL BACKGROUND

The Applicant, Manuel Abraham, filed an application for registration of the domain name "gayromeo.eu" on 14 March 2006, which was within Sunrise Period II.

In support of the application, the Applicant submitted:-

(a). An affadavit signed by a legal practitioner, stating that the applicant and Jens Schmidt owned the domain name "gayromeo.com" and that 'gayromeo' was entitled to protection under German law as an unregistered trade mark; and
(b). An article from a German newspaper, reporting on the "gayromeo.com" portal; and
(c). A copy of a German legal case (BGH, Urteilv. 9.12.1958) which the applicant cited in support of its application.

The application was subsequently rejected by the Respondent on the basis of the evidence filed being insufficient; specifically in failing to include a supporting report of a marketing association. The Claimant has not denied that such a marketing report was not submitted.

A. COMPLAINANT

Although the Complainant's claim lacks specificity, it is based on two arguments:-

1. That the Complainant is the owner of the registered trade mark "gayromeo", which it purchased in August 2006; and
2. That it owns unregistered trade mark rights in the mark "gayromeo" and has operated a business under this mark since October 2004, giving rise to rights which are protected "under German as well as European regulations"; although the said regulations are not specfied.

On each of these bases, the Complainant considers that it is entitled to the registration of the "gayromeo.eu" domain.

B. RESPONDENT

The Respondent rejects each of the Complaiant's arguments as follows:-

A. The Respondent states that "the Complainant's trademark was registered only on 1 June 2006, i.e. more than two months after the end of the Sunrise Period, and could therefore not serve as a prior right, even if the Complainant had applied for the domain name. Consequently, the domain name may not be attributed to the Complainant and only the Respondent's decision with regards to the application by the Applicant (Abraham, Manuel) must be considered by this Panel." It is worth noting here that the Applicant and the

Complainant are not identical (Manuel Abraham versus PlanetRomeo GmbH, Manuel Abraham respectively).

B. The Respondent also argues that "Pursuant to article 14 of the Regulation, article section 12.3 of the Sunrise Rules and Annex 1 to the Sunrise Rules, a prior right consisting of an unregistered trademark protected under German law must be demonstrated by : (i) an affidavit undersigned by a legal practitioner stating that the name for which a prior right is claimed meets the conditions provided for in German (ii) such affidavit must be accompanied by at least a report of a marketing association. The documentary evidence received by the validation agent within the deadline only included the affidavit, without a report of a marketing association. Therefore, the validation agent found that the Applicant did not sufficiently establish the prior right relied upon in its application (an unregistered trademark protected under German law)." The Respondent therefore argues that the Registry was right to reject the Applicant's application.

DISCUSSION AND FINDINGS

On the first issue raised by the Complainant, namely its ownership of the German Trade Mark Registration for the "gayromeo" mark, I have to reject the Complainant's submission. The Complainant, in support of its complaint, submitted an extract from the German Trade Mark Register together with a further extract confirming the transfer of ownership of the "gayromeo" mark. From this evidence it is fairly clear that at the relevant time (i.e. the time of the application) the applicant was not the owner of the registered trade mark for "gayromeo". Indeed at no time thereafter was the applicant the owner of that mark, which appears to have been assigned to PlanetRomeo GmbH on 17 August 2006; which is presumably why PlanetRomeo has been added as a party to the Complaint. Be that as it may, the issue of ownership of the registered trade mark is irrelevant for the purposes of determining the validity or otherwise of the Applicant's application.

The second issue concerns what evidence the Applicant should have provided in support of its application; specifically, whether it was required to provide a report of a marketing association in aupport of its affidavit. In this regard, I am conscious that the Complainant has not made very clear in the Compliant the basis of its claim to prior rights but on balance my view is that the claim is founded on unregistered trade mark rights (and not any of the other rights set out in sections 13-18 of the Sunrise Rules).

Section 15 of the Sunrise Rules (and not section 14 as the Respondent states) makes it clear that applications based on unregistered marks should comply with the requirements of sections 12(2) or 12(3) and that applicants are thereby excused from the requirements set out in section 12(1).

Section 12(2) does not apply here as it relates to a judgment for the complete name for which prior rights exist and although I have not seen the judgment the Claimant submitted, my assumption is that it relates to a general point of legal principle and not specifically to the 'gayromeo' mark. Therefore 12(3) is the standard relevant to the Applicant's application and this section makes it clear (in Annexe 1) that with respect to Germany, the applicant's affidavit in support "must be accompanied by at least a report of a marketing association". This is a clear obligation and not an option and also seems to be a de minimis requirement - such that a diligent applicant should perhaps provide more than this minimum standard in support of the unregistered rights. This requirement is clearly called out in section 12(3) and I cannot see that the applicant should not have been aware of it. It is exactly this kind of evidence which would provide the validation agent with proof of the existence of the common law rights on which the application was based. In my view the applicant failed in its duty and the validation agent was therefore justified in rejecting the application.

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	**James Mitchell**

DATE OF PANEL DECISION 2006-12-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

On the first issue raised by the Complainant, namely its ownership of the German Trade Mark Registration for the "gayromeo" mark, I have to reject the Complainant's submission. The Complainant, in support of its complaint, submitted an extract from the German Trade Mark Register together with a further extract confirming the transfer of ownership of the "gayromeo" mark. From this evidence it is fairly clear that at the relevant time (i.e. the time of the application) the applicant was not the owner of the registered trade mark for "gayromeo". Indeed at no time thereafter was the applicant the owner of that mark, which appears to have been assigned to

PlanetRomeo GmbH on 17 August 2006; which is presumably why PlanetRomeo has been added as a party to the Complaint. Be that as it may, the issue of ownership of the registered trade mark is irrelevant for the purposes of determining the validity or otherwise of the Applicant's application.

The second issue concerns what evidence the Applicant should have provided in support of its application; specifically, whether it was required (as the Respondent maintains) to provide a report of a marketing association in aupport of its affidavit. In this regard, I am conscious that the Complainant has not made very clear in the Compliant the basis of its claim to prior rights but on balance my view is that the claim is founded on unregistered trade mark rights (and not any of the other rights set out in sections 13-18 of the Sunrise Rules).

Section 15 of the Sunrise Rules (and not section 14 as the Respondent states) makes it clear that applications based on unregistered marks should comply with the requirements of sections 12(2) or 12(3) and that applicants are thereby excused from the requirements set out in section 12(1).

Section 12(2) does not apply here as it relates to a judgment for the complete name for which prior rights exist and although i have not seen the judgment the Claimant submitted, my assumption is that it relates to a general point of legal principle and not specifically to the 'gayromeo' mark. Therefore 12(3) is the standard relevant to the Applicant's application and this section makes it clear (in Annexe 1) that with respect to Germany, the applicant's affidavit in support "must be accompanied by at least a report of a marketing association". This is a clear obligation and not an option and also seems to be a de minimis requirement - such that a diligent applicant should perhaps provide more than this minimum standard in support of the unregistered rights. This requirement is clearly called out in section 12(3) and I cannot see that the applicant should not have been aware of it. It is exactly this kind of evidence which would provide the validation agent with proof of the existence of the common law rights on which the application was based. In my view the applicant failed in its duty and the validation agent was therefore justified in rejecting the application.